

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

VIRTAMOVE, CORP.,
Patent Owner.

Case No. IPR2025-00490
Patent No. 7,784,058

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

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	DISCRETIONARY DENIAL IS NOT WARRANTED UNDER <i>FINTIV</i>	4
A.	Factor 1 (Stay Potential) Weighs Against Denial Because NDCA Commonly Stays Litigation Once IPR Is Instituted.....	6
B.	Factor 2 (Timing of Trial and FWD) Weighs Heavily Against Denial Because No Trial Date Has Been Set and Any Trial Date Will Be After FWD	7
1.	No trial date has been scheduled.....	7
2.	NDCA’s median time-to-trial statistics for civil actions	8
3.	Schedules in cases transferred into NDCA at a similar stage reinforce that a trial is unlikely to take place before FWD.....	10
4.	VirtaMove’s statistics here are not a reliable indicator of what trial date will be scheduled in VirtaMove’s litigation against Google	11
5.	NDCA is the correct venue to consider under <i>Fintiv</i>	13
6.	Factor 2 conclusion	14
C.	Factor 3 (Litigation Investment) Weighs Against Discretionary Denial.....	15
D.	Factor 4 (Issue Overlap) Weighs Against Discretionary Denial.....	16
E.	Factor 5 (Litigation Defendant) Weighs Against Discretionary Denial.....	22
F.	Factor 6 (Other Circumstances: Strong Merits)	23
III.	AMAZON’S INDEPENDENTLY-FILED PETITION AND UNIFIED PATENTS’ INDEPENDENT REEXAMINATION DO NOT WEIGH AGAINST INSTITUTION OF GOOGLE’S PETITIONS	26
A.	Amazon’s Independently-Filed Petition Does Not Weigh Against Institution of Google’s Petitions.....	26
B.	Unified Patents’ Independently-Filed Ex Parte Reexamination Request Does Not Weigh Against Institution of Google’s Petitions	31

IV. GOOGLE’S OTHER PETITION DOES NOT SUPPORT DISCRETIONARY DENIAL UNLESS AND UNTIL A TRIAL IS INSTITUTED ON THAT PETITION	33
A. It Was Appropriate for Google to File Two Petitions Given the Priority Date Dispute	33
B. VirtaMove’s Stipulation Provides No Basis to Discretionarily Deny This Petition Now	34
C. This Petition Being Second-Ranked Provides No Basis to Discretionarily Deny This Petition Now	34
D. Google Would Not Oppose Discretionary Denial of This Petition If and Only If a Trial on Google’s First-Ranked Petition (IPR2025- 00489) Is Instituted So That Discretionary Denial Here Would Trigger VirtaMove’s Stipulation	35
V. NONE OF THE OTHER CONSIDERATIONS LISTED IN THE DIRECTOR’S INTERIM MEMORANDUM SUPPORT DISCRETIONARY DENIAL	37
A. The Petition Does Not Over-Rely on Expert Testimony	37
1. The Petition does not inappropriately rely on Dr. Bhattacharjee’s testimony	38
2. VirtaMove does not substantiate any alleged inappropriate reliance on Dr. Bhattacharjee’s testimony	39
B. No Other Forum Has Already Adjudicated the Validity or Patentability of the Challenged Patent Claims, Which Weighs Against Discretionary Denial	44
C. No Settled Expectation of the Parties Supports Discretionary Denial	44
D. Compelling Economic Interests Weigh Against Discretionary Denial	47
VI. CONCLUSION: A HOLISTIC ASSESSMENT OF ALL DISCRETIONARY FACTORS WEIGHS STRONGLY AGAINST DENIAL	47

TABLE OF AUTHORITIES

CASES

<i>Amazon.com, Inc. v. NL Giken Inc.</i> , IPR2025-00250, Paper 14 (PTAB May 16, 2025).....	48
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	passim
<i>Apple, Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020).....	22
<i>B/E Aerospace, Inc. v. Mag Aerospace Indus., LLC</i> , IPR2014-01510, Paper 24 (PTAB Mar. 26, 2015).....	41
<i>BioNTech SE v. ModernaTX, Inc.</i> , IPR2023-01359, Paper 20 (PTAB Mar. 19, 2024).....	25
<i>Bio-Rad Labs., Inc. v. Cal. Inst. of Tech.</i> , IPR2024-01451, Paper 11 (PTAB Mar. 27, 2025).....	15
<i>BMW of N. Am., LLC v. Foras Techs., LLC</i> , IPR2024-01346, Paper 7 (PTAB Mar. 7, 2025).....	32
<i>BMW of N. Am., LLC v. Michigan Motor Techs., LLC</i> , IPR2023-01224, Paper 15 (PTAB Feb. 15, 2024)	8
<i>Canon USA, Inc. v. Slingshot Printing LLC</i> , IPR2022-01541, Paper 7 (PTAB May. 22, 2023).....	42
<i>Charter Commncs., Inc. v. Adaptive Spectrum & Signal Alignment, Inc.</i> , IPR2025-00087, Paper 14 (PTAB May 5, 2025).....	9
<i>CrowdStrike, Inc. v. Open Text Inc.</i> , IPR2023-00124, Paper 11 (PTAB June 15, 2023).....	23
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 579 U.S. 261 (2016)	46
<i>Ericsson Inc. v. Active Wireless Techs. LLC</i> , IPR2024-00985, Paper 11 (PTAB Dec. 12, 2024).....	25

<i>Ford Motor Co. v. Neo Wireless, LLC</i> , IPR2023-00763, Paper 28 (PTAB Mar. 22, 2024).....	27
<i>Freewheel Media, Inc. v. Intent IQ, LLC</i> , IPR2024-00419, Paper 9 (PTAB Sept. 4, 2024)	41
<i>General Plastic Indus. Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)	26, 31
<i>Google LLC v. Singular Computing LLC</i> , IPR2023-00397, Paper 8 (PTAB July 25, 2023).....	35
<i>GREE, Inc. v. Supercell Oy</i> 2020 WL 6731050 (E.D. Tex. Aug. 14, 2020).....	20
<i>HP Inc. v. Universal Connectivity Techs., Inc.</i> , IPR2024-01429, Paper 11 (PTAB Apr. 16, 2025)	9
<i>Hulu LLC v. Piranha Media Dist., LLC</i> , IPR2024-01252, Paper 16 (PTAB Mar. 4, 2025).....	33
<i>Liberty Energy, Inc. v. U.S. Well Servs., LLC</i> , IPR2025-00031, Paper 9 (PTAB Apr. 29, 2025)	9
<i>Markforged Inc. v. Continuous Composites Inc.</i> , IPR2022-00679, Paper 7 (PTAB Oct. 25, 2022.).....	17, 22, 23
<i>Nat’l Beef Packing Co., LLC v. Inst. For Envntl. Health, Inc.</i> , IPR2024-00186, Paper 8 (PTAB Jan. 13, 2025)	41
<i>Nokia of Am. Corp. v. Soto</i> , IPR2023-00680, Paper 30 (PTAB Dec. 3, 2024).....	22
<i>Palo Alto Networks, Inc. v. Centripetal Networks</i> , IPR2021-01149, Paper 10 (PTAB Feb. 22, 2022)	17
<i>Pisony v. Commando Constructions, Inc.</i> , 2020 WL 4934463 (W.D. Tex. Aug. 24, 2020)	20
<i>Protect Animals With Satellites LLC v. OnPoint Sys., LLC</i> , IPR2021-01483, Paper 11 (PTAB Mar. 4, 2022).....	15

<i>Purdue Pharma L.P. v. Collegium Pharm., Inc.</i> , 86 F.4th 1338 (Fed. Cir. 2023).....	21
<i>Regents of Univ. of Michigan v. Novartis Pharms. Corp.</i> , 2023 WL 6795971 (N.D. Cal. Oct. 12, 2023).....	6
<i>SAP Am. Inc. v. Cyandia, Inc.</i> , IPR2024-01433, Paper 13 (PTAB Apr. 7, 2025).....	25
<i>Shenzen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.</i> , IPR2024-01296, Paper 9 (PTAB Feb. 25, 2025).....	22
<i>SNF SA v. Chevron USA Inc.</i> , IPR2022-01534, Paper 12 (PTAB Apr. 19, 2023).....	42
<i>Solus Advanced Materials Co., Ltd. v. SK Nexilis Co., Ltd.</i> , IPR2024-01463, Paper 14 (PTAB Apr. 25, 2025).....	19
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020).....	18, 19
<i>Tesla, Inc. v. Charge Fusion Techs., LLC</i> , IPR2025-00032, Paper 11 (PTAB May 19, 2025).....	39, 43, 44
<i>Tesla, Inc. v. Graphite Charging Co., LLC</i> , IPR2024-00388, Paper 15 (PTAB Aug. 27, 2024).....	32
<i>Thryv, Inc. v. Click-To-Call Techs., LP</i> , 590 U.S. 45 (2020).....	45
<i>Twitch Interactive, Inc. v. Razdog Holdings LLC</i> , IPR2025-00307, Paper 18 (PTAB May 16, 2025).....	passim
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i> , IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019).....	26, 27, 31
<i>Videndum Prod. v. Rotolight</i> , IPR2023-01218, Paper 12 (PTAB Apr. 19, 2024).....	26, 27, 31
<i>Wasica Finance GmbH v. Continental Auto Sys.</i> , 853 F.3d 1272 (Fed. Cir. 2017).....	40

Zomm, LLC v. Apple Inc.,
391 F. Supp. 3d 946 (N.D. Cal. 2019).....6

STATUTES

35 U.S.C. §314(a)35
35 U.S.C. §315(e)(1).....18
35 U.S.C. §315(e)(2)..... 18, 19

OTHER AUTHORITIES

FAQs for Interim Processes for PTAB Workload Management 38, 42, 43
Interim Processes for PTAB Workload Management (Mar. 26, 2025).. 8, 37, 44, 47
Patent Trial and Appeal Board
Consolidated Trial Practice Guide (Nov 2019)..... 33, 34, 35

REGULATIONS

37 C.F.R. §42.65(a).....43

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	[RESERVED]
1006	U.S. Patent App. Pub. No. 2003/0041118 (“Elnozahy”)
1007	U.S. Patent No. 6,263,376 (“Hatch”)
1008	U.S. Patent No. 6,260,075 (“Cabrerero”)
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-966”)
1012	U.S. Patent App. Pub. No. 2004/0216145 (“Wong”)
1013	RESERVED
1014	RESERVED
1015	Excerpts from Charles Petzold, <i>Programming Windows 95</i> (Microsoft Press 1996) (“Petzold”)
1016	RESERVED
1017	U.S. Patent No. 6,349,355 (“Draves”)
1018	Excerpts from Silberschatz et. al, <i>Operating System Concepts</i> (Wiley 6 th ed. 2002) (“Silberschatz”)
1019	RESERVED
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”)
1023	RESERVED
1024	U.S. Patent No. 7,080,172 (“Schmalz”)
1025-1031	RESERVED
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 4 th Ed. 2002) (“Collin”)
1035	Microsoft Computer Dictionary (Microsoft 5 th ed. 2002) (“Microsoft”)
1036	RESERVED

Exhibit	Description
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”)
1040-1042	RESERVED
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”)
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 (June 30, 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	RESERVED
1055	RESERVED
1056	U.S. Patent No. 5,278,969 (“Pashan”)
1057	Excerpts of <i>Webster’s New World Dictionary</i> (4 th 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”)
1061-1064	RESERVED
1065	U.S. Patent No. 6,442,752 (“Jennings”)
1066	RESERVED

Exhibit	Description
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	RESERVED
1071	RESERVED
1072	U.S. Patent App. Pub. No. 2003/0037337 (“Yona”)
1073	U.S. Patent App. Pub. No. 2002/0083127 (“Agrawal”)
1074	U.S. Patent App. Pub. No. 2002/0004834 (“Guenther”)
1075	U.S. Patent No. 6,049,892 (“Casagrande”)
1076	U.S. Patent App. Pub. No. 2003/0023580 (“Braud”)
1077	U.S. Patent No. 6,917,627 (“Footer”)
1078	U.S. Patent No. 6,361,335 (“Calanni”)
1079	U.S. Patent App. Pub. No. 2002/0078135 (“Venkatsubra”)
1080	U.S. Patent No. 6,594,690 (“Cantwell”)
1081	U.S. Patent No. 5,394,547 (“Correnti”)
1082	U.S. Patent No. 5,931,925 (“McNabb”)
1083	U.S. Patent No. 5,966,543 (“Hartner”)
1084	U.S. Patent No. 7,171,494 (“Karamanolis”)
1085	U.S. Patent No. 6,029,160 (“Cabrera”)
1086	U.S. Patent No. 6,931,501 (“Narayanaswamy”)
1087	U.S. Patent No. 5,630,141 (“Ross”)
1088	U.S. Patent App. Pub. No. 2003/0007488 (“Rao”)
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	U.S. Patent No. 7,937,559 (“Parameswar”)
1092	U.S. Patent No. 7,200,761 (“Freeman”)
1093	U.S. Patent App. Pub. No. 2002/0027909 (“Brinkerhoff”)
1094	U.S. Provisional Patent Application No. 60/504,213
1095	Redline Comparison between U.S. Provisional Patent Application No. 60/504,213 and specification of U.S. Patent No. 7,784,058
1096	U.S. Patent No. 6,728,839 (“Marshall”)
1097	RESERVED
1098	U.S. Patent No. 5,815,701 (“Slavenburg”)

Exhibit	Description
1099	U.S. Patent No. 5,581,768 (“Garney”)
1100	European Patent Application EP1164480 (“Temple”)
1101	U.S. Patent Application Pub. No. 2002/0129085 (“Kubala”)
1102	U.S. Patent No. 6,874,144 (“Kush”)
1103	U.S. Patent No. 5,630,076 (“Saulpaugh”)
1104	U.S. Patent No. 5,983,021 (“Mitrovic”)
1105	U.S. Patent No. 5,305,461 (“Feigenbaum”)
1106	U.S. Patent App. Pub. No. 2002/0032821 (“Garrigues”)
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. 6, 2024)
1108-1149	RESERVED
1150	Cong. Rsch. Serv., R48016, The Patent Trial and Appeal Board and Inter Partes Review (May 28, 2024)
1151	Docket Navigator Statistics for Motion Success for Stay Pending IPR (Post-Institution) for NDCA
1152	Docket Navigator Median Time to Trial for NDCA (May 1, 2020 to May 11, 2025)
1153	RESERVED
1154	Civil Docket in <i>VirtaMove, Corp. v. Google LLC</i> , 5:25-cv-00860-NW (N.D. Cal.) (as of June 9, 2025) (includes civil docket for 7:24-cv-00033 (W.D. Tex.))
1155	Civil Docket in <i>Anonymous Media Research Holdings, LLC v. Roku, Inc.</i> , 3:24-cv-04171-VC (N.D. Cal.) (includes civil docket for 1:23-cv-01143 (W.D. Tex.))
1156	Civil Docket in <i>Universal Connectivity Techs. Inc. v. HP Inc.</i> , 5:24-cv-04097-NW (N.D. Cal.) (includes civil docket for 1:23-cv-01177 (W.D. Tex.))
1157	Civil Docket in <i>IP, LLC v. Lyft, Inc.</i> , 3:24-cv-03348-RFL (N.D. Cal.) (includes civil docket for 7:24-cv-00051 (W.D. Tex.))
1158	Civil Docket in <i>Safecast Ltd. v. Google, LLC</i> , 5:23-cv-03128-PCP (N.D. Cal.) (includes civil docket for 6:22-cv-00678 (W.D. Tex.))
1159	Civil Docket in <i>eCardless Bancorp, Ltd. v. PayPal Holdings Inc.</i> , 5:24-cv-01054-BLF (N.D. Cal.) (includes civil docket for 7:22-cv-00245 (W.D. Tex.))
1160	RESERVED
1161	Docket Navigator Data on Granted Petitions for Writ of Mandamus by Federal Circuit for Legal Issues Regarding Venue

Exhibit	Description
1162	RESERVED
1163	RESERVED
1164	Scheduling Order in <i>Safecast Ltd. v. Google, LLC</i> , 5:23-cv-03128-PCP (N.D. Cal. Nov. 27, 2023)
1165	Scheduling Order in <i>Safecast Ltd. v. Google, LLC</i> , 6:22-cv-00678-ADA (W.D. Tex. Jan. 6, 2023)
1166	Scheduling Order in <i>eCardless Bancorp, Ltd. v. PayPal Holdings Inc.</i> , 5:24-cv-01054-BLF (N.D. Cal. May 27, 2024)
1167	Scott R. Boalick (Chief APJ), Guidance on USPTO’s recission of “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (Mar. 24, 2025), <i>available at</i> https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf (last checked June 2, 2025)
1168	<i>Oracle Corp. v. VirtaMove, Corp.</i> , IPR2025-00982, Paper 4 (May 16, 2025) (joinder motion)
1169	<i>Microsoft Corp. v. VirtaMove, Corp.</i> , IPR2025-00855, Paper 3 (Apr. 18, 2025) (joinder motion)
1170	First Amended Complaint for Patent Infringement Against Google LLC in <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex. May 21, 2024)
1171	Unified Patents, FAQ webpage, “What is Unified?” available at https://www.unifiedpatents.com/faq (last visited June 10, 2025)
1172	VirtaMove Corp’s Petition for Writ of Mandamus, <i>In re VirtaMove Corp.</i> , Misc. Dkt. No. 25-130 (Fed. Cir. June 5, 2025)
1173	Civil Docket in <i>VirtaMove, Corp. v. Google LLC</i> , 7:24-cv-00033-DC-DTG (W.D. Tex.) (as of June 5, 2025)

I. INTRODUCTION

In filing both this IPR2025-00489 and IPR2025-00490 challenging the '058 patent, Petitioner Google explained that “[t]he potential priority dispute between the parties justifies institution of two petitions.” Paper 3 at 4. Google ranked IPR2025-00489 first and ranked this IPR2025-00490 second. *Id.* at 1. Patent Owner VirtaMove now states that “if the instant Petition is denied on discretionary grounds and IPR2025-00489 is instituted, Patent Owner stipulates that it will not contest the prior art status of the combination references relied on in IPR2025-00489 for purposes of that proceeding.” Paper 7 (VirtaMove’s Request for Discretionary Denial, hereafter “DD-Brief”) at 14. As discussed *infra* §IV.D, in reliance on VirtaMove’s stipulation which is conditioned on IPR2025-00489 being instituted, Google would not oppose this IPR2025-00490 being discretionarily denied institution if IPR2025-00489 is instituted. Accordingly, Google respectfully requests that the Director send this IPR2025-00490 to a merits panel with an instruction to discretionarily deny institution of this Petition, because of VirtaMove’s stipulation, ***if and only if*** the merits panel first institutes a trial in IPR2025-00489.

As discussed in the other sections below and likewise in Google’s Opposition to VirtaMove’s discretionary-denial request in IPR2025-00489, VirtaMove’s other alleged bases for requesting discretionary denial are meritless.

VirtaMove’s lawsuit against Google was recently transferred from the Western District of Texas (WDTX) to the Northern District of California (NDCA), where no trial date has been set and an initial case management conference has yet to be scheduled. The *Fintiv* factors weigh strongly against denial because it is highly likely that a final written decision (“FWD”) will issue in this IPR well before any trial will take place in NDCA.

As the Director found in the *Twitch Interactive* cases discussed *infra* §II.A, NDCA has stayed parallel litigation 76% of the time after institution of an *inter partes* review. And if the NDCA litigation is not stayed, there is no reason to believe that any trial date (there currently is none) would precede an FWD in this IPR. EX2003, 66; *infra* §§II.B.1-3. VirtaMove says that because of progress allegedly made in WDTX before the litigation was transferred, a trial is likely to take place in NDCA within the next 12 months. That baseless assertion is refuted by objective evidence. Fact discovery in WDTX had only just commenced before the case was stayed and then transferred to NDCA. *See infra* §II.C. In two examples of similarly-situated cases that were also recently transferred to NDCA from WDTX after claim construction briefing was concluded, trials were scheduled for 20 months or more after the initial case management conference (EX1164, EX1166), which is currently unscheduled in this case. *See infra* §II.B.3. Thus, any trial date to be scheduled in NDCA will likely be well after the FWD

issues. *Infra* §II.B. The *Fintiv* factors therefore weigh heavily against discretionary denial.

VirtaMove’s separate assertion that discretionary denial is warranted because the Petition allegedly “over”-relies on expert testimony is baseless. VirtaMove exalts form over substance by criticizing the declaration’s length. The Director and the Board have consistently rejected that argument based on declarations of comparable or longer length. *See infra* §V.A. VirtaMove’s other complaint is that the expert declaration cites prior-art references (which VirtaMove pejoratively calls “shadow references”) to corroborate the expert’s explanations of background knowledge of those of skill in the art. These citations show exactly the opposite of “over”-reliance on expert testimony, by demonstrating that the Petition makes its case based on patents and printed publications rather than an expert’s say-so. Indeed, in a recent decision rejecting the same argument VirtaMove advances, the Board applauded an expert declaration for extensively citing corroborating references. *See infra* §V.A.2. There is nothing about the Petition’s citation to the expert declaration that warrants discretionary denial.

VirtaMove’s additional assertion that Amazon having filed its own petition, and Unified Patents having filed its own *ex-parte* reexamination on a few of the claims, warrant discretionary denial is premised on the assertion that Google “coordinated” with Amazon and Unified Patents on the IPRs and reexamination.

That unsubstantiated assertion is false. VirtaMove sued Amazon, Google, IBM, and Hewlett Packard Enterprise (“HPE”) over a two-week period, and then Microsoft and Oracle several months later, on the same patents. That VirtaMove faces IPRs from multiple petitioners is the unsurprising direct result of VirtaMove’s own choices. VirtaMove’s assertion that discretionary denial is warranted because unrelated companies (Amazon and Unified Patents) filed their own challenges to the ’058 patent is contrary to the Board’s established precedent.

Finally, VirtaMove ignores the Petition’s merits. Petitioner identified prior art that was not of record during original prosecution and that discloses the claim feature that the examiner found missing from the prior art of record during prosecution in allowing the ’058 patent. *See infra* §II.F. The strength of the Petition is reinforced by the fact that two sophisticated companies—Microsoft and Oracle—have moved to join this IPR. The Petition’s strong merits weigh against discretionary denial.

II. DISCRETIONARY DENIAL IS NOT WARRANTED UNDER *FINTIV*

There is no basis to deny this IPR under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (precedential) (Mar. 20, 2020) (“*Fintiv*”). The parties’ litigation was recently transferred from WDTX to NDCA and no trial date has been scheduled. Indeed, NDCA has yet to schedule an initial case management conference (“CMC”) to discuss a schedule and set a trial date.

There is every reason to believe that no trial will take place in NDCA until after an FWD issues in this IPR. Examples of other recent cases in procedural postures like Google’s NDCA case (i.e., transferred from WDTX to NDCA after claim construction briefing was completed), as well as NDCA’s median time-to-trial statistics, demonstrate that the trial is highly likely to be scheduled for a date *after* the date by which an FWD will issue here. *See infra* §§II.B.2-3. And as the Director recently found in deciding not to exercise her discretion to deny an IPR based on a parallel litigation in NDCA, stays are granted at a high rate (76%) in that jurisdiction after an IPR is instituted, which further weighs against discretionary denial. *See infra* §II.A.

“The framers of the AIA intended for IPR to serve as a faster, less costly alternative to district court litigation” and to “improve patent quality by providing a more efficient means to adjudicate patent validity issues.” EX1150, i, 13. Those objectives would be served here by having a merits panel evaluate Google’s IPR on the merits. The efficiencies gained if the Board were to institute an IPR trial would be further magnified given that Oracle and Microsoft have sought to join Google’s IPRs in understudy roles.

The *Fintiv* factors weigh heavily in favor of instituting this IPR.

A. Factor 1 (Stay Potential) Weighs Against Denial Because NDCA Commonly Stays Litigation Once IPR Is Instituted

Fintiv Factor 1, which considers the likelihood of a stay, weighs against discretionary denial. As *the Director recently recognized*, the stay rate in NDCA is 76% in cases like this where an FWD will precede the trial date (which is as-yet unscheduled here). See *Twitch Interactive, Inc. v. Razdog Holdings LLC*, IPR2025-00307, Paper 18 at 2-3 (May 16, 2025) (finding potential for stay in NDCA weighed against discretionary denial where a yet-to-be-scheduled trial would likely occur after FWD, because “[o]ver the past twelve years” NDCA judges “have granted or partially granted 76% of all post-institution motions to stay pending” IPRs) (citing evidence from Docket Navigator);¹ see also *Regents of Univ. of Michigan v. Novartis Pharms. Corp.*, No. 22-CV-04913-AMO, 2023 WL 6795971, at *1 (N.D. Cal. Oct. 12, 2023) (“Courts in this district have often recognized a ‘liberal policy in favor of granting motions to stay’ pending IPR.” (quoting *Zomm, LLC v. Apple Inc.*, 391 F. Supp. 3d 946, 956 (N.D. Cal. 2019))).

Nevertheless, VirtaMove argues “there is no reason to suggest” that NDCA will stay the litigation. See DD-Brief, 3-4. This is not credible. VirtaMove itself represented to the Federal Circuit in a mandamus petition filed just last week

¹ The most up-to-date stay percentage for NDCA is the same. EX1151 (76%).

seeking to undo the transfer to NDCA that the NDCA “is known to stay cases pending USPTO proceedings.” EX1172, 34.

Thus, Factor 1 weighs against discretionary denial.

B. Factor 2 (Timing of Trial and FWD) Weighs Heavily Against Denial Because No Trial Date Has Been Set and Any Trial Date Will Be After FWD

Factor 2 considers the relative timing of the court’s trial date and the IPR’s FWD. Because no trial date has been set in NDCA, and because any trial is likely to take place after the FWD here, Factor 2 weighs heavily against denial.

VirtaMove’s arguments, which are inconsistent with representations it has made in other forums, do not show otherwise.

1. No trial date has been scheduled

On May 7, 2025, WDTX ordered VirtaMove’s case against Google transferred to NDCA. EX1173, 9 (DKT#102). Google’s motion for transfer had been granted by the WDTX magistrate judge in January but was stayed at VirtaMove’s request to allow VirtaMove time to object. *See id.*, 8 (DKT#86), 9 (DKT#94-95). In May, the WDTX District Court Judge overruled VirtaMove’s objections to the magistrate’s transfer order, and ordered the case transferred to NDCA. *See id.*, 9 (DKT#102).

The court normally will not set a schedule with a trial date until at or after the initial case management conference, which itself currently does not have a

scheduled date.² Given that NDCA has not set a trial date, Factor 2 weighs against discretionary denial. *Twitch*, IPR2025-00307, Paper 18 at 2-3 (Director declining to discretionarily deny institution where, like here, an NDCA trial had not yet been scheduled but some discovery had already occurred); *id.*, Paper 11 at 12-13 (discussing some discovery having occurred); *see also BMW of N. Am., LLC v. Michigan Motor Techs., LLC*, IPR2023-01224, Paper 15 at 11 (Feb. 15, 2024) (“Factor 2 favors institution as it is undisputed that no trial date was set in district court.”).

2. NDCA’s median time-to-trial statistics for civil actions

In a memorandum dated March 24, 2025, Chief APJ Boalick stated that the Board will consider “median time-to-trial statistics for civil actions” under *Finitiv* Factor 2. EX1167, 3. The Director’s March 26, 2025 Memorandum addressing “Interim Processes for PTAB Workload Management” (hereafter “Interim Memo”) issued two days later on March 26, 2025. Since the issuance of the Director’s Interim Memo, several Board decisions have relied on the most recent median-time-to-trial statistics for all civil actions. *See Charter Commncs., Inc. v. Adaptive*

² There have been some false-starts in setting a case management conference in NDCA but, at present, no initial case management conference is on the schedule. *See* EX1154.

Spectrum & Signal Alignment, Inc., IPR2025-00087, Paper 14 at 9-11 (May 5, 2025) (citing the most recent median time-to-trial statistics for all civil cases); *Liberty Energy, Inc. v. U.S. Well Servs., LLC*, IPR2025-00031, Paper 9 at 11-12 (Apr. 29, 2025) (citing the Interim Memo as support for finding consistency between “median time-to-trial statistics” and a scheduled trial date); *HP Inc. v. Universal Connectivity Techs., Inc.*, IPR2024-01429, Paper 11 at 8-9 (Apr. 16, 2025) (citing the most recent median “time-to-trial statistics” for civil actions).

VirtaMove concedes that NDCA’s current median time-to-trial for all civil actions is 34.5 months. DD-Brief, 4-5 n.1 (citing EX2003, 66). Thus, even if VirtaMove were right that its litigation against Google in NDCA is about “halfway” to trial (DD-Brief, 4),³ applying NDCA’s median time-to-trial for all civil actions indicates that even if a case management conference were held tomorrow, a trial would likely be scheduled for a date more than 17 months (half of 34 months) from now, which would be two months *after* the FWD will issue here.⁴

³ The litigation is not halfway to trial. *See infra* §§II.B.3-4, II.C.

⁴ Also, as discussed *infra* §II.B.4, even if representative statistics for only patent cases were used, they still would put trial later than FWD.

3. Schedules in cases transferred into NDCA at a similar stage reinforce that a trial is unlikely to take place before FWD

Petitioner has been able to identify two other cases that were transferred from WDTX to NDCA in the past two years at a similar procedural stage to VirtaMove’s case against Google—where claim construction briefing had occurred in WDTX but a *Markman* hearing had not—and thereafter had scheduling orders entered in NDCA. Those scheduling orders provide further evidence that trial likely will be scheduled for a date after the FWD in this case.

eCardless Bancorp, Ltd. v. PayPal Holdings Inc., 5-24-cv-01054 (NDCA) involved a case transferred to NDCA from WDTX after claim construction briefing was completed but before a *Markman* hearing. EX1159, 6 (DKT#61, 11/01/2023 reply claim construction brief filed in WDTX), 8 (DKT#86, 02/22/2024 transfer of case to NDCA). Trial in that case was scheduled for **20 months** after the case management conference—i.e., 23 months after WDTX’s transfer order. *See* EX1159, 10-11 (DKT#116, order setting case management conference for 05/02/2024; DKT#123, scheduling order setting trial for 01/12/2026).

Safecast Ltd. v. Google LLC was also transferred to NDCA from WDTX after claim construction briefing was completed but before a *Markman* hearing. EX1158, 5 (DKT#53, WDTX *Markman* hearing scheduled for 06/29/2023; DKT#54, joint claim construction brief filed; DKT#56, 06/23/2023 order granting

motion to transfer to NDCA). Trial in that case was scheduled for *24 months* after the case management conference—i.e., 28.5 months after WDTX’s transfer order. *See* EX1158, 9-10 (DKT#87, order setting case management conference for 11/09/2023; DKT#98, scheduling order setting trial for 11/10/2025).

Thus, the above two cases having similar procedural postures as Google’s had their NDCA trial dates scheduled for a date 20-24 months after the date of the case management conference. An FWD will be due in this IPR within 15 months from now; thus, similar timing in NDCA would place trial months after FWD, even if a case management conference in Google’s case were held tomorrow.

4. VirtaMove’s statistics here are not a reliable indicator of what trial date will be scheduled in VirtaMove’s litigation against Google

Initially, despite telling the Director that trial in NDCA is likely to happen within 9-12 months (DD-Brief, 5), in its just-filed petition seeking mandamus to overturn or vacate the order transferring the case to NDCA, VirtaMove told the Federal Circuit that “VirtaMove’s case is likely to languish in the NDCA for 6-7 years without trial.” EX1172, 1. Regardless, VirtaMove bases an estimated trial date on EX2002, which VirtaMove characterizes as including Docket Navigator’s “median time-to-trial statistics” for NDCA for patent cases “from May [01,] 2020 to” May 11, 2025. But as VirtaMove notes, this “exclud[es] cases with stays.” DD-Brief, 4. As such, VirtaMove lists just *five* patent cases. When cases with

stays are *not* excluded over the same five-year period covered by EX2002, there are 12 patent cases that went to trial, and Docket Navigator’s median time-to-trial for those cases in NDCA is **31** months. *See* EX1152. That is comparable to NDCA’s median time-to-trial for all civil cases, which VirtaMove concedes is 34.5 months. DD-Brief, 4-5 n.1 (citing EX2003, 66).

Despite the Board’s practice to the contrary (*supra* §II.B.2), VirtaMove alleges that stayed cases should be excluded when determining median time-to-trial because if this case were “hypothetically stayed pending IPR, then its time-to-trial is not relevant (because trial would necessarily occur after final written decision...)” DD-Brief, 5 n.1. VirtaMove cites no case where the Director or the Board has excluded stayed cases in determining a median time-to-trial. There is good reason why the Director and the Board should consider all cases (including stayed cases) in determining the median time-to-trial. Considering *all* patent cases in NDCA is a more accurate indicator of when this case will go to trial than VirtaMove’s sample because nothing suggests that this case will be among the minority of cases that would not be stayed if this IPR is instituted.

VirtaMove also argues that “[b]ecause claim construction briefing was already completed” in WDTX, “the case is approximately halfway to trial” so that “the time to trial will be reduced significantly” and “be set for 9-12 months from the May 7 transfer date.” DD-Brief, 4-5. This is unsupported by any *evidence*. As

discussed further below (§II.C addressing Factor 3), there is much work to be done before the trial would occur. While claim construction briefing occurred in WDTX, no *Markman* hearing has yet been held, and no decision has been issued. Fact discovery had only just opened on January 10 before the WDTX case was stayed on January 22 and then transferred. And as explained above (§§II.B.2-3), median time-to-trial statistics for all civil cases and actual schedules for similarly-situated patent cases transferred into NDCA illustrate that a trial is not likely to be scheduled to occur until after the FWD.

By any reasonable metric (*see supra* §§II.B.1-3), a trial in NDCA is highly unlikely to take place until after an FWD has issued in this IPR.

5. NDCA is the correct venue to consider under *Fintiv*

Although VirtaMove filed a petition for writ of mandamus with the Federal Circuit on June 4, 2025 seeking reversal or vacatur of the transfer to NDCA (EX1172, 3), VirtaMove does not dispute that the NDCA proceeding is the one to consider for *Fintiv* analysis. VirtaMove's request to the Director for discretionary

denial only argues for denial under *Fintiv* in view of the case proceeding in NDCA, not back in WDTX.⁵ DD-Brief, 2-11.

The Federal Circuit typically takes about two and a half months to issue orders responsive to mandamus petitions. *See* EX1155-EX1157. Docket Navigator lists few, if any, cases since 2017 where the Federal Circuit granted a *plaintiff's* mandamus petition to overturn or vacate a district court's venue-transfer order. *See* EX1161. Even in the highly unlikely event that the case was transferred back, WDTX would have to issue a new scheduling order. Trial in WDTX was still 12.5 months away when the court granted Google's transfer motion. EX1154, 4 (DKT#34, setting WDTX trial for 02/02/2026), 8 (DKT#86, 01/22/2025 order granting motion to transfer). It is highly unlikely that there will be a trial in WDTX at all, let alone one that would occur before the FWD issues.

6. Factor 2 conclusion

For the reasons discussed above (§§II.B.1-5), there is every reason to believe that no district-court trial will take place until after an FWD issues. Thus, Factor 2 weighs heavily against denial.

⁵ If the Director were to authorize VirtaMove to belatedly seek discretionary denial under *Fintiv* in view of an anticipated trial in WDTX rather than NDCA, Google would seek authorization to respond to any such belated argument.

C. Factor 3 (Litigation Investment) Weighs Against Discretionary Denial

There has been limited investment in the district-court litigation. “[A] significant portion of work remains to be done,” including scheduling and conducting a *Markman* hearing and conducting most “fact” discovery and all “expert discovery and dispositive motions.” *Protect Animals With Satellites LLC v. OnPoint Sys., LLC*, IPR2021-01483, Paper 11 at 14-15 (Mar. 4, 2022). Indeed, in NDCA, “the court has not set any deadlines for those activities” yet. *Bio-Rad Labs., Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11 at 10 (Mar. 27, 2025). Thus, Factor 3 weighs strongly against discretionary denial.

VirtaMove alleges that “the parties have already served extensive infringement and invalidity contentions, and fully briefed and already had a hearing on claim construction.” DD-Brief, 6. Much of that is false. A claim construction hearing was scheduled for January 21, 2025, but was never held because WDTX cancelled the hearing before transferring the case to NDCA. EX1154, 7 (DKT#84, cancelling *Markman* hearing). And only *preliminary* infringement and invalidity contentions were served, not final contentions. Fact discovery had opened January 10, 2025 (EX1081, 3) and the parties served discovery requests, but neither party responded to them given the transfer order and stay that occurred 12 days later.

VirtaMove further argues (without evidence) that, under an alleged “typical schedule,” by the time of the institution decision (three months from now), “a claim construction order will have issued, the parties will have nearly completed fact discovery, and the parties will be preparing opening expert reports.” DD-Brief, 6. But actual schedules in NDCA for similarly-situated cases (transferred from WDTX after claim construction briefing) support that a *Markman* hearing, an order, and nearly-complete fact discovery would not happen until after the institution decision. See EX1166 (*eCardless* scheduling order setting *Markman* hearing over 5 months after the case management conference, fact discovery closing 8.5 months after the case management conference); EX1165 (*SafeCast* scheduling order leaving *Markman* hearing unscheduled and setting fact discovery to close 12 months after the case management conference).

Factor 3 weighs heavily against denial.

D. Factor 4 (Issue Overlap) Weighs Against Discretionary Denial

This Petition challenges all 18 claims of the '058 patent, while only 7 are asserted in district court. EX1020; DD-Brief, 7. VirtaMove’s “stipulat[ion] that it will not assert against Google any claims of the '058 patent other than those already asserted against Google” (“if institution is denied”) (DD-Brief, 7) does not change the fact that Google’s IPR addresses 11 claims that NDCA will not address. That “fact alone minimizes the potential overlap between the issues raised here vis-

à-vis those raised in the parallel proceeding,” and weighs against denial.

Markforged Inc. v. Continuous Composites Inc., IPR2022-00679, Paper 7 at 32-33 (Oct. 25, 2022).

VirtaMove’s stipulation to not assert additional claims against Google (DD-Brief, 7) also does not tilt Factor 4 in VirtaMove’s favor because VirtaMove has not made the same assurances for any of Google’s customers, despite the fact that VirtaMove’s Complaint alleges induced infringement. EX1170, 12.

Moreover, if Google’s IPR is not considered on its merits, at least 11 demonstrably unpatentable claims will remain at large for VirtaMove to assert against others. Denying Google its opportunity to demonstrate to the Board why these claims should be cancelled to prevent further litigation would be a public disservice and contrary to the purposes and charge of the Board. That more than 60% of the ’058 patent’s 18 claims will be addressed by the Board but not NDCA further illustrates that an IPR trial will be a “true alternative” to the NDCA litigation in addressing issues the court will not address. *Palo Alto Networks, Inc. v. Centripetal Networks*, IPR2021-01149, Paper 10 at 10-11 (Feb. 22, 2022).

Furthermore, as noted above, the Director recently found that NDCA often issues a stay if an IPR trial is instituted. *Supra* §II.A (citing *Twitch*, IPR2025-00307, Paper 18 at 2-3). That reduces “concerns of inefficiency and the possibility of conflicting decisions” (*Fintiv*, IPR2020-00019, Paper 11 at 12) because the

parties will not expend further resources on any invalidity issue in parallel with this IPR.

And again, even if the litigation is not stayed, an FWD is highly likely to issue before any NDCA trial date. *Supra* §II.B. Once the FWD issues, Google will be estopped from asserting in litigation “any ground that the petitioner raised or reasonably could have raised during” the IPR. 35 U.S.C. §315(e)(2).⁶ The statutory estoppel provision ensures that the efficiency of Google’s IPR accrues regardless of which party prevails on claims challenged in the IPR and asserted in NDCA, and moots VirtaMove’s concern about potential overlap between invalidity arguments in NDCA. That is because if Google prevails the claims will have been found unpatentable, whereas if VirtaMove prevails Google would be estopped from “pursu[ing] the *same* invalidity theories” (DD-Brief, 9 (emphasis original)) in NDCA. Given that an FWD will so clearly precede a trial in the district court, it was unnecessary for Google to offer a *Sotera* stipulation because any such stipulation would be moot in view of statutory estoppel. But to remove any doubt,

⁶ Google would also be estopped from pursuing a reexamination “with respect to [any challenged] claim on any ground that the petitioner raised or reasonably could have raised during” this IPR. 35 U.S.C. §315(e)(1). That alleviates VirtaMove’s protestations about a possible duplicative reexamination. DD-Brief, 9.

Google hereby stipulates that if the Office institutes this IPR, then Google will not pursue in the district-court litigation any grounds that were raised or reasonably could have been raised in this IPR. *See* 35 U.S.C. §315(e)(2); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13 (precedential) (Dec. 1, 2020); *see also Solus Advanced Materials Co., Ltd. v. SK Nexilis Co., Ltd.*, IPR2024-01463, Paper 14 at 16-17 (Apr. 25, 2025) (finding *Sotera* stipulation causes Factor 4 to weigh against denial even where petitioner maintained right to pursue in district court “invalidity assertions based on combinations of art with ‘unpublished systems prior art’”).

Factor 4 weighs strongly against discretionary denial. VirtaMove’s below-addressed arguments to the contrary (DD-Brief, 6-9) are baseless.

VirtaMove argues “there is substantial overlap between the prior art arguments” in the Petition and those “advanced by Petitioner in the District Court litigation.” DD-Brief, 7. This ignores the lack of overlap in the challenged claims. With respect to the prior art, Google was obligated under the district court’s standing order to identify *all possible* prior art to preserve its defenses months before this Petition was filed. The purpose of disclosing invalidity contentions early in the litigation is to provide notice and preserve a right to make an argument later, not to identify the arguments that will ultimately be presented at trial, which

happens much later.⁷ Regardless, VirtaMove’s assertion that this causes Factor 4 to favor denial is premised on the assumption that “the District Court will likely decide the validity of the ’058 patent claims months prior to” the FWD (DD-Brief, 8), which again is plainly wrong. *See supra* §§II.A-B.

Finally, VirtaMove argues that this IPR should be discretionarily denied because “if the Board were to institute, Petitioner would be able to serially challenge the validity of the ’058 Patent in this proceeding, in the District Court Proceeding, and in an *ex parte* reexamination proceeding,” which is the “opposite of the efficiency contemplated” by the AIA. DD-Brief, 9. VirtaMove has it exactly wrong—instituting this IPR would *increase* efficiency.

⁷ *See, e.g., Pisony v. Commando Constructions, Inc.*, No. 6:17-CV-00055-ADA, 2020 WL 4934463, at *1 (W.D. Tex. Aug. 24, 2020) (“[T]he purpose of invalidity contentions is to provide notice while discovery is intended to develop details so that legal theories become more concrete as the litigation progresses.”) (internal quotation marks and citation omitted); *see also GREE, Inc. v. Supercell Oy*, No. 2:19-CV-00070-JRG-RSP, 2020 WL 6731050, at *3 (E.D. Tex. Aug. 14, 2020) (“Indeed, one of the desired outcomes of discovery and a result of expert reports is the crystallization of invalidity and infringement theories preserved in a party’s contentions.”).

As the Federal Circuit has explained, “the purpose of the AIA” is “to create a *more efficient* alternative to district court litigation.” *Purdue Pharma L.P. v. Collegium Pharm., Inc.*, 86 F.4th 1338, 1344 (Fed. Cir. 2023).⁸ Google is availing itself of the IPR process that Congress created to cost-effectively and efficiently demonstrate that the ’058 patent’s claims are unpatentable. If IPR is instituted, Google will seek a stay of the litigation, which will further help avoid “conflicting decisions.” DD-Brief, 8. If the Board finds merit in Google’s Petition and finds the challenged claims unpatentable, substantial cost savings and efficiencies will have been achieved for the parties and the NDCA court in not litigating over a patent that never should have issued in the first place. And if any asserted claim were to survive this IPR, Google will be subject to the AIA’s estoppel provisions.

The efficiencies that would be gained by instituting IPR here are further enhanced because two defendants in separate litigations (Microsoft and Oracle) have filed motions for joinder. *See Microsoft Corp. v. VirtaMove, Corp.*, IPR2025-00849, Paper 3 (Apr. 18, 2025); *Oracle Corp. v. VirtaMove, Corp.*, IPR2025-00964, Paper 4 (May 16, 2025); *see also infra* §III.A. The Board can efficiently address Google’s patentability challenges that Microsoft and Oracle seek to join in a single proceeding.

⁸ All emphases herein are added unless otherwise indicated.

Thus, for the reasons discussed above, Factor 4 weighs strongly against discretionary denial.

E. Factor 5 (Litigation Defendant) Weighs Against Discretionary Denial

VirtaMove argues “this factor weighs in favor of discretionary denial.” DD-Brief, 9 (citing *Apple, Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 15 [sic: 13-14] (May 13, 2020) (informative)).

VirtaMove ignores that the Board’s “precedent takes varying approaches on how to weigh the fifth *Fintiv* factor when the parties in the two proceedings are the same.” *Shenzen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9 at 20 (Feb. 25, 2025) (granting institution and collecting cases). Some panels have found that the petitioner being the litigation defendant is simply *neutral* and does not weigh in favor of denial. *See, e.g., Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 30 at 13 (Dec. 3, 2024) (Decision Granting Director Review) (“agree[ing] with the parties that *Fintiv* factor 5 is neutral” where petitioner was a litigation defendant, *see* Paper 1, 75); *Markforged Inc. v. Continuous Composites Inc.*, IPR2022-00679, Paper 7 at 33 (Oct. 25, 2022)

In fact, in cases such as this where the Board is “likely to address the challenged patent first” before the district court (*see supra* §II.B), panels have found that “this factor weigh[s] *against* exercising discretion to deny institution” because it is more efficient to have the Board address patentability so that the

district court does not have to. *Markforged*, IPR2022-00679, Paper 7 at 33; *CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00124, Paper 11 at 13 (June 15, 2023) (“This factor *weighs against exercising discretion to deny* institution because, although the parties are the same as in the related litigation..., that trial is scheduled to occur after the deadline for a final written decision in this proceeding.”).

Factor 5 weighs against denial here (or is, at worst, neutral) because the Board is likely to issue an FWD before a district-court trial, which will maximize efficiencies for the parties and the court.

F. Factor 6 (Other Circumstances: Strong Merits)

The merits of Google’s Petition are particularly strong because the cited prior art plainly teaches the alleged “distinction” between the ’058 patent and the prior art. EX1001, 1:46-48.

The ’058 patent alleges that “[a]n important distinction between” the alleged invention and “prior art systems and architectures is the ability to allow a CSE [critical system element] to execute in the same context as an application.” EX1001, 1:46-54, 1:25-27; *see also id.*, 7:63-8:3 (“This invention is contrasted with” admitted prior art because CSEs “are replicated, and embodied in the context of an application.”). The ’058 patent says this distinction is achieved by placing CSEs in a “shared library” available to applications; an example of such a shared

library is the well-known “dynamic linked library (DLL).” EX1001, Abstract, 2:45-51. Google’s Petition demonstrates that the Draves reference (EX1017) expressly teaches a “DLL” that makes critical system elements available to applications. *E.g.*, Petition (Paper 2), 14 (citing Draves, 3:57-61 (teaching that a “DLL” is a type of “shareable program module” used to share functionality between applications)). The Petition also demonstrates that Draves teaches

wherein a SLCSE related to a predetermined function is provided to the first of the plurality of software applications for running a first instance of the SLCSE, and wherein a SLCSE for performing a same function is provided to the second of the plurality of software applications for running a second instance of the SLCSE simultaneously

as recited in the ’058 patent’s claim element [1F], which is the element that the Examiner incorporated into the independent claim in order to allow it. *See* Petition, 8-9 (summarizing prosecution history), 39-41 (explaining how, in the Petition’s Elnozahy+Draves combination, the use of DLLs as taught in Draves meets element [1F]).

VirtaMove says its “merit-based briefing” will “highlight” “claim limitations [that] are not disclosed by *any* of the alleged combination references.” DD-Brief, 10-11 (original emphasis). Google cannot respond to arguments that VirtaMove has not yet made. But as discussed above, the Petition presents strong merits of

unpatentability because the allegedly novel disclosure of the '058 patent, and the limitation the Examiner incorporated into the independent claim in order to find the claims allowable, were explicitly taught to a person of ordinary skill (“POSA”) by the Petition’s prior-art Draves reference, or at minimum would have been obvious based on how a POSA would have understood Draves’s teachings in the context of POSAs’ well-known background knowledge in the art.

The Petition’s strong merits are further demonstrated by the fact that Microsoft and Oracle have each agreed to join the Petition. *See* EX1168-EX1169.

VirtaMove asserts that the Petition’s merits are not strong because the Petition “relies solely on obviousness under §103,” which allegedly “serves to highlight the novelty of the challenged claims.” DD-Brief, 10. But the Board has repeatedly found strong merits demonstrated by obviousness grounds. *See, e.g., SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01433, Paper 13 at 12-13 (Apr. 7, 2025); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00985, Paper 11 at 19-25 (Dec. 12, 2024); *BioNTech SE v. ModernaTX, Inc.*, IPR2023-01359, Paper 20 at 77 (Mar. 19, 2024). Google’s obviousness grounds present strong merits because the Petition shows that the allegedly novel feature of the '058 patent is taught by Draves, which in combination with Elnozahy meets every other limitation of the challenged claims.

Lastly, VirtaMove argues that Factor 6 favors denial because “it [is] extremely likely” that the district court will decide validity before an FWD. DD-Brief, 10. That argument fails for the reasons discussed *supra* §II.B.

Given the Petition’s strong merits, Factor 6 weighs against denial.

III. AMAZON’S INDEPENDENTLY-FILED PETITION AND UNIFIED PATENTS’ INDEPENDENT REEXAMINATION DO NOT WEIGH AGAINST INSTITUTION OF GOOGLE’S PETITIONS

A. Amazon’s Independently-Filed Petition Does Not Weigh Against Institution of Google’s Petitions

Under the Board’s precedential *General Plastic* decision, the principal factor in deciding whether to deny institution of an IPR based on another IPR having challenged the same patent is “whether the *same petitioner* previously filed a petition directed to the same claims of the patent.” *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-16 (Sept. 6, 2017) (precedential). The “same petitioner” was extended to include a petitioner having “a significant relationship” with an earlier petitioner in *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 9-10 (Apr. 2, 2019) (precedential); *Videndum Prod. v. Rotolight*, IPR2023-01218, Paper 12 at 6 (Apr. 19, 2024) (Decision Granting Director Review) (“Under USPTO policy and precedent, *General Plastic* has not been extended to any cases in which the first and second petitioners do not have a significant relationship.”).

Google and Amazon are different entities and do not have a significant relationship under *Valve*. VirtaMove presents no evidence of such a relationship because no such relationship exists. Google had no involvement in preparing Amazon’s IPR, and vice versa.⁹ *See Ford Motor Co. v. Neo Wireless, LLC*, IPR2023-00763, Paper 28 at 9 (Mar. 22, 2024) (holding that petitioners with “different allegedly infringing products and in different district court proceedings” who did not coordinate, as here, did not have a “significant relationship” under *Valve*).

In cases like this, where separate petitioners have challenged the same patent but “are neither the same party, nor possess a significant relationship under *Valve*, *General Plastic factor one necessarily outweighs the other General Plastics factors*” and weighs strongly against discretionary denial. *Videndum*, IPR2023-01218, Paper 12 at 5-6.

VirtaMove alleges that discretionary denial of at least two of the three ’058 Petitions brought by Google and Amazon is warranted because “there appears to

⁹ Google’s and Amazon’s ’058 Petitions raise different grounds. *See Amazon.com, Inc. v. VirtaMove, Corp.*, IPR2025-00561, Paper 1 at 13 (Jan. 30, 2025) (challenging claims based on Ely, Levine, Thekkath, and Eggert, none of which are named in any ground of Google’s ’058 Petitions).

be a coordinated attempt by [these] technology giants” to challenge VirtaMove’s ’058 patent. DD-Brief, 14-15. VirtaMove does not even attempt to substantiate this baseless and irresponsible allegation of coordination. That Google and Amazon filed separate petitions against the ’058 patent around the same time is an unremarkable and highly predictable consequence of *VirtaMove’s strategic decision* to sue Google and Amazon within one week of each other. Amazon and Google did not coordinate their IPRs in any way. VirtaMove’s speculation to the contrary is baseless and simply wrong.

VirtaMove’s protestation that it is a “relatively small” company being “overwhelm[ed]” by litigation expenses (DD-Brief, 15) is belied by VirtaMove’s own strategic decision to assert its patents against six corporations in parallel across two districts. Within the span of two weeks last year, VirtaMove elected to sue four companies—Amazon, Google, IBM, and Hewlett Packard Enterprise—in two different jurisdictions (EDTX and WDTX), on two patents in different patent families. Several months later, VirtaMove elected to bring lawsuits in WDTX against two additional defendants—Microsoft and Oracle. Thus, in less than a year, VirtaMove chose to file *six* lawsuits in *two* separate districts against different

companies, with the full knowledge that multiple IPR petitions by those separate defendants were not just possible but also easily foreseeable.¹⁰

But even if the expenses of the party that chose to initiate litigation could be a relevant consideration for discretionary denial, IPRs were specifically designed to be *more efficient and streamlined* than district-court actions, as VirtaMove itself concedes. DD-Brief, 9. Two additional defendants (Microsoft and Oracle) have sought to join Google’s IPRs. *See supra* §II.D. Thus, if the Board grants either (or both) of those joinder motions, the overall efficiencies to be gained by (and potential litigation expenses to be saved because of) Google’s IPRs will be more even pronounced here as compared to a typical one-defendant IPR. *See* EX1168, 6-7 (joinder motion) (Oracle’s joinder motion “accepting an ‘understudy’ role”) (citing IPR2015-01353, Paper 11 at 6-7 (finding “joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” because the petitioners agreed to

¹⁰ At the time of filing its suits against Microsoft and Oracle, the ’058 patent was also involved in a declaratory-judgment suit brought by Red Hat in NDCA, which was recently dismissed for lack of subject matter jurisdiction and is on appeal. *See Red Hat Inc. v. VirtaMove, Corp.*, 5-24-cv-04740 (N.D. Cal.).

an “understudy” role)); EX1169, 5 (Microsoft’s joinder motion agreeing to “tak[ing] an ‘understudy’ role”).

Thus, to the extent VirtaMove’s alleged concern for reducing its litigation expenses are at all relevant to the Director’s consideration, the cost-saving benefit over district-court actions is *multiplied* here where two additional defendants can be joined with Google’s IPRs.

VirtaMove’s suggestion that it was entitled to sue six companies across multiple jurisdictions but that “at most” only one IPR should be instituted (DD-Brief, 15) is plainly unreasonable. Google would be prejudiced if the Director were to discretionarily deny Google’s Petition simply because Amazon filed its own. Google did not choose the prior art in Amazon’s ’058 petition and has no control over how (or even whether) that IPR will proceed. Amazon’s IPR petition is no substitute for Google being able to present its own challenge to the ’058 patent.¹¹ Moreover, Google’s and Amazon’s petitions were filed at essentially the same time. There is no basis to favor Amazon’s petition over Google’s.

¹¹ At this point, it is unclear whether Amazon’s ’058 petition will be instituted on its merits. VirtaMove’s “one institution” argument provides no basis for denying Google’s ’058 Petition because it might be the only petition filed against the ’058 patent that the Board finds meritorious enough to warrant institution.

Under the Board’s existing precedent (*General Plastic, Valve, and Videndum*) discussed above, Amazon’s ’058 petition provides no basis for discretionarily denying this Petition. *See also* Interim Memo, 2 (interim procedures are designed to be “consistent with the discretionary considerations enumerated in existing Board precedent”).

B. Unified Patents’ Independently-Filed Ex Parte Reexamination Request Does Not Weigh Against Institution of Google’s Petitions

VirtaMove notes that “Unified Patents has *separately* requested *ex parte* reexamination of the ’058 patent..., such that there are currently *four* pending unique challenges to the ’058 patent.” DD-Brief, 2 (emphasis original, citation omitted). However, the reexamination filed by Unified Patents only challenges two claims of the ’058 patent (*see* EX1060, page 21) whereas Google’s Petition challenges all 18 claims (*see* Paper 2 at 1). The reexamination filed by Unified Patents is also based on different prior art than Google’s Petition. *See* EX1060, page 21 (Unified Patents’ challenge based on Lucas, Blott, and Kamp). VirtaMove also alleges that Unified Patents’ reexamination request was filed “presumably for the benefit of large corporations such as Google and Amazon,” but provides no evidence supporting this “presum[ption].” DD-Brief, 15. Google had no involvement in preparing Unified Patents’ reexamination, and Unified Patents had no involvement in preparing Google’s IPR Petition. Furthermore, Unified Patents

takes action to assert its *own* interests in “improv[ing] patent quality and deter[ring] unsubstantiated or invalid patent assertions.” EX1171, p. 2.

As the Petition explained, multiple Board panels have held that the discretionary-denial factors applicable when there has been a previous IPR petition do not apply when there has been a previous *ex-parte* reexamination. See Petition, 71-72, citing *Tesla, Inc. v. Graphite Charging Co., LLC*, IPR2024-00388, Paper 15, at 6-8 (Aug. 27, 2024) (declining to apply *General Plastic* to deny institution in case where prior reexamination was filed by Unified Patents and rejecting patent owner’s argument that petition should be discretionarily denied under §314(a) (or under §315(d)) because of prior reexamination, collecting cases). VirtaMove does not refute the Petition’s explanation. Nor does VirtaMove cite any authority supporting discretionary denial of an IPR petition in view of a co-pending *ex parte* reexamination under *any* circumstances, much less where the re-examination is filed by an independent party challenging fewer claims and using different art, as is the case here. In fact, the Board regularly refuses to discretionarily deny IPR petitions based on co-pending *ex-parte* reexaminations filed by independent parties such as Unified Patents. See, e.g., *Tesla v. Graphite Charging*, IPR2024-00388, Paper 15, at 6-8; *BMW of N. Am., LLC v. Foras Techs., LLC*, IPR2024-01346, Paper 7 at 2-3 (Mar. 7, 2025) (granting institution despite noting reexamination filed by Unified Patents); *Hulu LLC v. Piranha Media Dist., LLC*, IPR2024-01252,

Paper 16 at 5-6 (Mar. 4, 2025) (granting institution and rejecting argument that institution should be denied in view of reexamination filed by Unified Patents where the reexamination “involves only [the] independent claims...and a different combination of prior art”).

Therefore, the reexamination filed by Unified Patents against the '058 patent provides no basis for denying Google's IPR Petition.

IV. GOOGLE'S OTHER PETITION DOES NOT SUPPORT DISCRETIONARY DENIAL UNLESS AND UNTIL A TRIAL IS INSTITUTED ON THAT PETITION

A. It Was Appropriate for Google to File Two Petitions Given the Priority Date Dispute

The Consolidated Trial Practice Guide (“CTPG”) recognizes that “more than one petition may be necessary” “when there is a dispute about priority date requiring arguments under multiple prior art references.” CTPG, 59.

Google's ranking paper ranks this Petition second behind the first-ranked petition in IPR2025-00489. *See* Paper 3, 1. This second-ranked Petition was filed because of a potential priority-date dispute that could affect Google's first-ranked petition by VirtaMove attempting to antedate that petition's prior art. This Petition relies on earlier-dated references that present a significantly higher burden for VirtaMove to attempt to antedate than the primary reference in IPR2025-00489. *Id.*, 1-4. VirtaMove not only does not dispute that there is a potential priority-date dispute, VirtaMove acknowledges that there is one. DD-Brief, 13-14. Given that,

Google respectfully submits that it was appropriate for Google to file two petitions under the guidance provided in the Trial Practice Guide. CTPG, 59.

B. VirtaMove’s Stipulation Provides No Basis to Discretionarily Deny This Petition Now

Despite acknowledging the potential priority-date dispute, VirtaMove seeks to have this Petition discretionarily denied based on a stipulation. But VirtaMove’s stipulation is qualified. Specifically, VirtaMove says that “*if* the instant Petition is denied on discretionary grounds and IPR2025-00489 is instituted, Patent Owner stipulates that it will not contest the prior art status of the combination references relied on in IPR2025-00487 for purposes of that proceeding.” DD-Brief, 14.

VirtaMove’s stipulation is thus contingent on both Google’s first-ranked petition in “IPR2025-00489 [being] *instituted*” and on this Petition being discretionarily denied. *Id.* Given that a condition precedent to VirtaMove’s stipulation (*i.e.*, institution of IPR2025-00489) has not yet occurred, VirtaMove’s stipulation provides no basis to discretionarily deny this Petition *now*.

C. This Petition Being Second-Ranked Provides No Basis to Discretionarily Deny This Petition Now

The Consolidated Trial Practice Guide explains that “[t]o aid the Board in determining whether more than one petition is necessary,” a petitioner may provide “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.” CTPG, 59-

60. Thus, the Trial Practice Guide contemplates that the Board will consider whether to discretionarily deny a lower-ranked petition *if* the Board decides to “*institute*” a higher-ranked petition. CTPG, 60; *see, e.g., Google LLC v. Singular Computing LLC*, IPR2023-00397, Paper 8 at 11 (July 25, 2023) (instituting a second-ranked petition and finding it unnecessary to “decide the issue of discretion under” §314(a) because the first-ranked petition was denied institution on the merits). Because the Board has not yet instituted IPR on Petitioner’s first-ranked petition in IPR2025-00489, the present Petition being ranked second provides no basis to discretionarily deny this Petition *now*.

D. Google Would Not Oppose Discretionary Denial of This Petition If and Only If a Trial on Google’s First-Ranked Petition (IPR2025-00489) Is Instituted So That Discretionary Denial Here Would Trigger VirtaMove’s Stipulation

If the Board were to institute a trial on Google’s first-ranked Petition and then discretionarily deny this Petition, that would meet both conditions precedent for VirtaMove’s stipulation. Thus, *if the Board were to institute* a trial on Google’s first-ranked Petition in IPR2025-00489, then in reliance on VirtaMove’s

stipulation¹² Google would not oppose the Office discretionarily denying this second-ranked Petition.

The Director should decline to discretionarily deny institution of Google's first-ranked petition in IPR2025-00489 for the reasons discussed in Google's Opposition (filed June 10, 2025) to VirtaMove's discretionary-denial request in that case. Thus, the Director should send IPR2025-00489 to a panel for consideration on its merits.

With respect to VirtaMove's request for discretionary denial of the present Petition (IPR2025-00490), it is baseless for all the same reasons (*supra* §§II-III; *infra* §V), with the single exception of VirtaMove's qualified stipulation that seeks to obviate the need for this Petition by removing the priority-date dispute. Given that VirtaMove's stipulation is conditioned on a trial being first instituted in IPR2025-00489, Google respectfully requests that the Director send this case to a merits panel with an instruction to discretionarily deny institution of this Petition, because of VirtaMove's stipulation, ***if and only if*** the merits panel first institutes a

¹² Again, VirtaMove's stipulation is that "***if*** the instant Petition is denied on discretionary grounds ***and IPR2025-00489 is instituted***, Patent Owner will not contest the prior art status of the combination references relied on in IPR2025-00489 for purposes of that proceeding." DD-Brief, 14.

trial in IPR2025-00489, and thereby ensures that a condition precedent to VirtaMove’s stipulation is met.

V. NONE OF THE OTHER CONSIDERATIONS LISTED IN THE DIRECTOR’S INTERIM MEMORANDUM SUPPORT DISCRETIONARY DENIAL

The Director’s Interim Memorandum has a list of other considerations that may be relevant for discretionary denial.¹³ Interim Memo, 2-3. None of these considerations warrants discretionary denial here.

A. The Petition Does Not Over-Rely on Expert Testimony

VirtaMove argues that discretionary denial is warranted because the Petition allegedly “is overly reliant on conclusory expert testimony.” DD-Brief, 12-13. Neither the Director nor the Board has ever discretionarily denied a petition on the basis of “over-reliance” (DD-Brief, 11) on expert testimony. VirtaMove hopes that this case will be the first. It should not be for numerous reasons discussed below.

¹³ Petitioner reserves the right to challenge the Interim Process for PTAB Workload Management announced in the Director’s March 26, 2025 memorandum at least because it is legally invalid as (1) exceeding the Director’s authority, (2) arbitrary and capricious, and (3) adopted without notice-and-comment rulemaking.

This Petition was filed before the Director’s Interim Memo issued and is supported by an expert declaration that is similar to, and relied upon in the same way, as numerous prior expert declarations that have been credited by the Board in instituting IPR trials and finding claims unpatentable at FWD. *See infra* §§V.A.1-2. There is nothing “extraordinary” about the Petition’s reliance on Dr. Bhattacharjee’s testimony. DD-brief, 11. The Petition demonstrates unpatentability based on patents and printed publications. The Petition does not in any sense *over*-rely on expert testimony, let alone do so in a manner that would warrant discretionary denial of this Petition despite its strong merits and the fact that the *Fintiv* factors (*supra* §II) weigh strongly against denial.

1. The Petition does not inappropriately rely on Dr. Bhattacharjee’s testimony

The prior art’s teachings themselves clearly meet the claims. Most of the Petition’s citations to Dr. Bhattacharjee’s declaration simply confirm that Dr. Bhattacharjee agrees with the Petition’s analysis of the prior-art teachings. That is different from the Petition *over-relying* on expert testimony to make its unpatentability showing. If there are any issues on which the Board might find it helpful to review expert testimony to “provide helpful context or to explain terms of art,” Dr. Bhattacharjee’s testimony corroborates everything he says with citation to a prior-art patent or printed publication. *See* USPTO’s “FAQs for Interim Processes for PTAB Workload Management” (“Interim-Processes FAQs”), FAQ

#21.¹⁴ While VirtaMove *criticizes* the corroborating references (pejoratively labelling them as “‘shadow’ references,” DD-Brief, 1-2), Board decisions have “*applauded*” similar expert testimony that is corroborated by extensive citation to published references. *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00032, Paper 11 at 39 (May 19, 2025); *see infra* §V.A.2.

2. VirtaMove does not substantiate any alleged inappropriate reliance on Dr. Bhattacharjee’s testimony

In its allegations of extensive reliance on expert testimony, VirtaMove mainly criticizes the *length* of Dr. Bhattacharjee’s declaration and the *number* of corroborating references. DD-Brief, 12-13, 1-2. As discussed below, both criticisms fail.

As to the declaration’s length, VirtaMove alleges that “the Petition relies on nearly 140 pages of expert testimony.” DD-Brief, 12.¹⁵ VirtaMove’s focus on length exalts form over substance. VirtaMove does not identify a single issue on which the Petition’s arguments would require the Board to base its decisions on

¹⁴ <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management> (last checked June 9, 2025).

¹⁵ In reality, Dr. Bhattacharjee’s declaration in this case is only 114 pages (excluding signature block and claim listing). *See* EX1003.

Dr. Bhattacharjee’s testimony alone instead of the teachings of the prior art that both the Petition and Dr. Bhattacharjee discuss.

The length of Dr. Bhattacharjee’s declaration results primarily from the fact that most substantive paragraphs of the Petition cite Dr. Bhattacharjee’s testimony. That is because, at least before the recent guidance in the Director’s Interim Memo dated after this Petition was filed, it had been common practice for petitioners to cite expert testimony to support every argument—even those that the petitioner did not expect the patent owner to reasonably dispute. It has been common for petitioners to do so because they could not anticipate what issue(s) a patent owner might dispute with expert testimony, and it was not uncommon for the Board to favor a party who submitted expert testimony on a disputed issue over one that relied simply on attorney argument. *See, e.g., Wasica Finance GmbH v. Continental Auto Sys.*, 853 F.3d 1272, 1284-85 (Fed. Cir. 2017) (finding it “reasonable for the Board to accept” one party’s “expert testimony over” the other party’s “bare attorney argument”). There is nothing “extraordinary” about the Petition being accompanied by a lengthy expert declaration. DD-Brief, 11. It is consistent with common practice since the AIA created IPRs.

The Director’s Interim Memo refers to the extent to which the Petition *relies on* expert testimony, not the declaration’s length. The length of Dr. Bhattacharjee’s declaration does not matter because the declaration does nothing

but provide “appropriate supporting technical details and/or testimony as to the understanding of a” person of ordinary skill in the art without “offer[ing] wholly new arguments not found in the Petition.” *Nat’l Beef Packing Co., LLC v. Inst. For Env’tl. Health, Inc.*, IPR2024-00186, Paper 8 at 50-51 (Jan. 13, 2025) (rejecting patent owner’s complaints about a 317-page expert declaration); *see also B/E Aerospace, Inc. v. Mag Aerospace Indus., LLC*, IPR2014-01510, Paper 24 at 13-14 (Mar. 26, 2015) (“[T]he length of the Declaration relative to the Petition is not the critical inquiry. The critical inquiry is whether an argument that is made in the Declaration is explained sufficiently in the Petition.”).

Just last month, the Director declined to discretionarily deny two related IPRs despite the patent owner arguing that the petition extensively relied on expert testimony because the petition “cite[d] its expert’s **269-page declaration at least 260 times.**” *Twitch*, IPR2025-00307, Paper 11 at 18-19 (patent owner’s request for discretionary denial); *id.*, Paper 18 at 3 (May 16, 2025) (decision denying request). That declaration’s 269 pages was significantly longer than Dr. Bhattacharjee’s 114-page declaration here, and the Director did not discuss the declaration’s length as relevant to her discretionary-denial consideration. That decision is consistent with prior decisions instituting an IPR despite a patent owner’s complaint about a declaration’s length. *See also Freewheel Media, Inc. v. Intent IQ, LLC*, IPR2024-00419, Paper 9 at 24 (Sept. 4, 2024) (instituting despite “[p]atent [o]wner

complain[t]s about” “a 349-page declaration”); *Canon USA, Inc. v. Slingshot Printing LLC*, IPR2022-01541, Paper 7 at 21 (May. 22, 2023) (instituting where petitioner submitted a “232 pages long” declaration); *SNF SA v. Chevron USA Inc.*, IPR2022-01534, Paper 12 at 21 n.15 (Apr. 19, 2023) (instituting where petitioner submitted a “290 page[.]” declaration).

There is no reason to treat this Petition differently.

VirtaMove’s other primary complaint is that the Petition and Dr. Bhattacharjee cite a substantial number of corroborating references. DD-Brief, 1-2 (referring to them derisively as “dozens of different ‘shadow’ references”), 9 (similar), 10 (similar), 12 (similar). But once again, VirtaMove does not identify a single instance where the Petition relies only on Dr. Bhattacharjee’s testimony to fill an alleged gap in the prior art’s teachings, because no such examples exist. *See supra* §II.F (discussing the Petition’s strong merits). Nor does VirtaMove identify any issue on which there could be a reasonable dispute between experts, let alone any questions “better resolved in an Article III court.” *See* Interim-Processes FAQs (FAQ #21).

Citation to corroborating references does not demonstrate overreliance on Dr. Bhattacharjee’s testimony—it demonstrates precisely the opposite. The substantial number of corroborating references reveals that the Petition relies on “prior art patents and printed publications” to make its case, rather than on Dr.

Bhattacharjee's testimony. *See* Interim-Processes FAQs (FAQ #21). The Board thus can decide any disputed issues of material fact from the corroborating references themselves, without relying on Dr. Bhattacharjee's testimony.

The Board's rules are clear that an expert must "disclose the underlying facts or data upon which the opinion is based" or the testimony may be given "little or no weight." 37 C.F.R. §42.65(a). That is all Dr. Bhattacharjee did here. Dr. Bhattacharjee's opinions are supported by multiple pieces of corroborating evidence. That does not render his testimony unfocused. It strengthens his testimony because he provides the underlying facts and data on which he based his opinions.

The Board recently instituted a petition and rejected discretionary-denial arguments by a patent owner that were nearly identical to VirtaMove's arguments here that criticize the length of the expert declaration and the number of corroborating references cited. *Tesla v. Charge Fusion*, IPR2025-00032, Paper 11 at 39. In *Tesla*, the patent owner (much like VirtaMove here) complained about an expert declaration that was "twice as long as the Petition at 278 pages with a substantive portion containing 42,329 words." *Id.* at 39 (internal quotation marks omitted). Like VirtaMove here, the patent owner in *Tesla* also complained that it was unfair to have "to wade through the 42,329 words" in the expert declaration to understand the petition's argument and complained that the expert "cit[ed] forty-

three references that are not expressly identified as a basis for that challenge” (what VirtaMove calls “shadow” references, DD-Brief, 1-2). The Board rejected those complaints because it did not find any improper incorporation by reference of arguments from the declaration into the petition, which is equally true here. Indeed, *the Board “applaud[ed]” the expert* for “support[ing] his extensive explanations of his opinions with citations to dozens of pieces of objective evidence,” which “is a feature, not a bug of his testimony” *because the expert “left] virtually none of the substance of his testimony unsupported by objective evidence.”* *Tesla*, IPR2025-00032, Paper 11 at 39. There is no reason to treat this Petition differently than the Board treated the *Tesla* petition.

B. No Other Forum Has Already Adjudicated the Validity or Patentability of the Challenged Patent Claims, Which Weighs Against Discretionary Denial

Neither the PTAB nor any other forum has adjudicated the validity or patentability of the challenged patent claims. *See* Interim Memo, 2. Thus, this consideration weighs against discretionary denial.

C. No Settled Expectation of the Parties Supports Discretionary Denial

The Director’s Interim Memorandum says that an additional consideration is the “[s]ettled expectations of the *parties*” (i.e., the settled expectations of the patent owner *and* petitioner). Interim Memo, 2. There were no settled expectations of the parties about the ’058 patent that would warrant discretionary denial.

The '058 patent issued in 2010. VirtaMove did not sue Google until over 13 years later. VirtaMove's complaint does not allege that VirtaMove ever called the '058 patent to Google's attention prior to suing Google.¹⁶ After being sued, Google filed this Petition because the '058 patent's claims are demonstrably unpatentable. The very "purpose and design" of IPRs—to "weed out bad patent claims"—would be fulfilled by the Board addressing the (strong) merits of the Petition, which demonstrates that VirtaMove's '058 patent should never have issued in the first place. *Thryv, Inc. v. Click-To-Call Techs., LP*, 590 U.S. 45, 54 (2020) ("By providing for inter partes review, Congress, concerned about overpatenting and its diminishment of competition, sought to weed out bad patent claims efficiently").

VirtaMove alleges that it had a "settled expectation[]" that it could "adjudicate its patent claims [only] before an Article III court" because the patent issued nearly fifteen years ago at a time before IPRs were available. DD-Brief, 13. VirtaMove has known for thirteen of those fifteen years (since 2012) that its patent was subject to IPR, and certainly knew that before it filed suit against Google and others. Any "expectation" VirtaMove allegedly had that the '058 patent was

¹⁶ Around the same time VirtaMove also sued Amazon, IBM, and HPE.

immune from IPR was baseless, unreasonable, and cannot warrant discretionary denial.

That the '058 patent has gone unchallenged for fifteen years also does not demonstrate that VirtaMove had a reasonable, settled expectation of patentability of the challenged claims. It is unsurprising that the '058 patent went unchallenged because it was never asserted before 2024. Once VirtaMove asserted its patent, multiple independent parties challenged its patentability on a multitude of independent grounds. *Google LLC v. VirtaMove, Corp.*, IPR2025-00489, -00490 (Jan. 31, 2025); *Amazon.com, Inc. v. VirtaMove, Corp.*, IPR2025-00561 (Jan. 30, 2025); *IBM Corp. v. VirtaMove, Corp.*, IPR2025-00591 (Feb. 6, 2025). There was never any settled expectation of patentability of the '058 patent's claims that would warrant discretionary denial.

Instead, the public interest is best served by the Director not rewarding VirtaMove for having waited until nearly the end of its patent's life to file suit against Google (and others) by insulating VirtaMove from having to defend the patentability of its claims in this IPR on the merits. *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 263 (2016) (“The purpose of inter partes review” includes “protect[ing] the public’s paramount interest in seeing that patent monopolies are kept within their legitimate scope.”) (internal quotation marks and citation omitted).

D. Compelling Economic Interests Weigh Against Discretionary Denial

There are compelling economic interests in instituting this IPR, which weigh against discretionary denial. Interim Memo, 2. VirtaMove is asserting the '058 patent against several companies: Google, Amazon, HPE, IBM, Microsoft, and Oracle. EX1170, 2; Petition, xi-xii. Thus, there are compelling reasons to have the Board efficiently assess the patentability of the asserted claims. Conversely, there stand to be substantial negative economic consequences if VirtaMove's unpatentable claims remain in force and continue to be asserted in more expensive and time-consuming litigations. These considerations weigh against discretionary denial.

VI. CONCLUSION: A HOLISTIC ASSESSMENT OF ALL DISCRETIONARY FACTORS WEIGHS STRONGLY AGAINST DENIAL

It is highly likely that an FWD will issue well before a district-court trial, which weighs heavily against discretionary denial under *Fintiv*. See *supra* §II.B.

VirtaMove's other primary assertion is that the Petition's supposed "extraordinary over-reliance on expert testimony" justifies denial. DD-brief, 11. That assertion is unsupported by any authority and has been repeatedly rejected by the Director and the Board. See *supra* §V.A; see, e.g., *Twitch*, IPR2025-00307, Paper 18 at 3.

The Interim Memo’s other additional considerations are considered under a “holistic assessment of all of the evidence and arguments presented” in determining whether to “exercise discretion to deny institution.” *Twitch*, IPR2025-00307, Paper 18 at 3; *Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 at 2 (May 16, 2025). No other consideration warrants discretionary denial unless and until IPR2025-00489 is instituted, as discussed above (§§III-V).

Discretionary denial under §314 is not warranted at this time.¹⁷

Respectfully submitted,

Date: June 10, 2025

/Elisabeth Hunt/

Elisabeth Hunt, Reg. No. 67,336
WOLF, GREENFIELD & SACKS, P.C.

¹⁷ As the Petition established and VirtaMove does not dispute, the Petition’s Draves reference was not previously presented to the Office. Petition, 73-74. Thus, there is also no basis to deny the Petition under §325(d), and VirtaMove does not allege otherwise.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24, the undersigned certifies that the foregoing **PETITIONER’S OPPOSITION TO PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** contains 10,260 words excluding; a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing. Petitioner has relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: June 10, 2025

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

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

I certify that on June 10, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

Reza Mirzaie	rmirzaie@raklaw.com
	rak_almondnet@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

Date: June 10, 2025

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