

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
Petitioner

v.

VIRTAMOVE, CORP.,
Patent Owner

Case No.: IPR2025-01001
U.S. Patent No. 7,519,814
Issue Date: April 14, 2009

Title: SYSTEM FOR CONTAINERIZATION OF APPLICATION SETS

**PETITIONER ORACLE CORPORATION'S NOTICE RANKING
PETITIONS REGARDING U. S. PATENT NO. 7,519,814
AND EXPLAINING MATERIAL DIFFERENCES**

Petitioner is filing four parallel petitions for *inter partes* review challenging U.S. Patent No. 7,519,814 (“the ’814 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 all petitions.

I. RANKING OF PETITIONS

Rank	Petition	Grounds
1	IPR2025-00964 (“Petition 1”)	1) Blaser in view of Calder renders obvious claims 1-4, 7-11, 14, and 16-30 2) Blaser in view of Calder and Schmidt-449 renders obvious claims 5-6, 12-13, 15, and 31-34
2	IPR2025-00965 (“Petition 2”)	1) Schmidt-479 in view of Tormasov renders obvious claims 2) Schmidt-479 in view of Tormasov and Calder renders obvious claims 1-34 3) Schmidt-479 in view of Tormasov and Schmidt-629 renders obvious claims 1-34 4) Schmidt-479 in view of Tormasov, Calder, and Schmidt-629 renders obvious claims 1-34
3	IPR2025-01001 (“Petition 3”)	1) Osman renders obvious claims 1, 2, 4, 6, 8-10, and 13-14 2) Tucker and Bandhole render obvious claims 1, 2, 4, 6, 8-10, and 13 3) Gélinas renders obvious claims 1, 2, 4, 6, 8-10, and 13-14

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

4	IPR2025-01002 ("Petition 4")	1) Osman renders obvious claims 3, 5, 7, 11-12, 15, and 31-34 2) Tucker and Bandhole render obvious claim 16 3) Gélinas renders obvious claim 16
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II. MATERIAL DIFFERENCES BETWEEN PETITIONS

A. Material Difference 1: Potential Priority Dispute

The '814 patent issued from an application filed September 13, 2004. It claims priority to provisional applications No. 60/512,103 filed October 20, 2003, and No. 60/502,619 filed September 15, 2003. Because these dates predate the enactment of the Leahy-Smith America Invents Act ("AIA"), the '814 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.

In the concurrent district-court proceeding between Patent Owner ("PO") and Petitioner ("Oracle"), PO asserts that "[t]he Asserted Claims of the '814 patent are entitled to a priority date *at least as early as* September 15, 2003, the filing date of provisional application No. 60/502,619," and that "VirtaMove reserves the right to supplement this response." EX1029, 4 (emphasis added). PO further identified documents "as related to evidencing conception and reduction to practice," while again "reserv[ing] the right to supplement." *Id.* By alleging "a priority date *at least as early as*" the earliest claimed date on the '814 patent's face, while leaving the possible date range open-ended and "reserv[ing] the right to supplement" (*id.*,

emphasis added), PO has expressly implicated the possibility that PO may attempt to defeat Petition 1 by antedating the prior art on which it relies.

Petition 1 challenges the '814 patent's claims over combinations based on U.S. Patent No. 7,117,495 ("Blaser"), which issued from an application filed June 11, 2003 (before the '814 patent's earliest provisional filing date) and published October 3, 2006 (after the '814 patent's nonprovisional filing date). Therefore, Blaser is prior art under pre-AIA 35 U.S.C. §102(e), but not under §102(b). PO could therefore attempt to defeat Petition 1 by establishing an invention date earlier than Blaser's filing date of June 11, 2003. To date, PO has left open that possibility, and has not stipulated that Blaser is prior art. *See* TPG at 61.

Petition 2 challenges the '814 patent's claims over U.S. Patent Application Publication No. 2002/0095479 ("Schmidt-479") in combinations with U.S. Patent Application Publication No. 2002/0124072 ("Tormasov"), U.S. Patent Application Publication No. 2002/0066022 ("Calder"), and U.S. Patent Application Publication No. 2002/0138629 ("Schmidt-629"). Schmidt-479 (published July 18, 2001), Tormasov (published September 5, 2002), and Calder (published May 30, 2002), each published more than a year before the September 15, 2003 filing date of the '814 patent's earliest provisional application, and therefore are indisputable prior art under §102(b). Schmidt-629 (used only in Grounds 3-4) was published September 26, 2002 (more than a year before the '814 patent's October 20, 2003 second

provisional filing date), and therefore is indisputable prior art under §102(b) unless PO can establish the challenged claims' entitlement to the September 15, 2003 provisional filing date. Even if PO did so, Schmidt-629 would still be prior art under §102(a) and §102(e). Because Petition 2's Grounds 1-2 rely on indisputable §102(b) prior art, Petition 2 would remain viable against the '814 patent should PO establish a priority date earlier than Blaser's June 11, 2003 filing date.

Petition 3 and Petition 4 both challenge the '814 patent's claims over a printed publication entitled 'The Design and Implementation of Zap: A System for Migrating Computing Environments' ("Osman"), U.S. Pat. No. 7,437,556 ("Tucker") in combination with U.S. Pat. Pub. No. 2002/0171678A1 ("Bandhole), and a printed publication entitled Virtual Private Servers and Security Contexts ("Gélinas"). Gélinas published no later than 8/14/2002, and therefore is indisputably prior art under § 102(b). Osman published no later than 12/11/2002, and Bandhole published on 11/21/2002, and therefore are prior art under §§ 102(a) and (e). Tucker was filed 1/21/2004, with a priority date of 5/9/2003, and is prior art under § 102(e).

B. Material Difference 2: Different Evidence and Grounds

Each of the four petitions presents arguments directed to different prior art references, different challenged claims, or both. Petition 1 relies on a combination of Blaser and Calder, whereas Petition 2 relies on a base combination of Schmidt-479 and Tormasov, and Petitions 3 and 4 rely on the same prior art combinations

(Osman, Tucker and Bandhole, and Gélinas). While Petitions 3 and 4 rely on the same prior art, the petitions each challenge non-overlapping sets of claims.

The teachings supplied by Calder in the Blaser-Calder combination in Petition 1 are different and are mapped to different claim limitations than the teachings supplied by Tormasov in the Schmidt-Tormasov combination in Petition 2 or the Osman-Tucker-Bandhole-Gélinas combination in Petitions 3 and 4. Thus, apart from the material difference of the potential priority dispute, the unpatentability and obviousness issues between the petitions are also materially distinct and non-cumulative.

III. INSTITUTION OF ALL PETITIONS IS WARRANTED

The potential priority dispute between the parties justifies institution of the petitions. The 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 has ranked the petitions, instituting all petitions is the fairest outcome in view of the potential dispute between the parties about the priority date of the ’814 patent, absent a stipulation by PO, , and the materially distinct and non-cumulative nature of each petition.. TPG at 61. Further, by filing copycat petitions together with Motions for Joinder in which it agrees to an understudy role, Petitioner has surrendered its opportunity to pursue challenges and claims of its own choosing in order to avoid taxing the Board’s finite resources during this interim period of diminished resources. For each underlying petition resulting in institution, there will have been a determination that unpatentability is reasonably likely. This determination implicates the public’s strong interest in eliminating bad patents. Granting Petitioner’s copycat petition for each granted underlying petition serves

that public interest by allowing the underlying IPRs to continue in the event of settlement without impacting the Board's finite resources.

Respectfully submitted,
ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: May 16, 2025

/Bas de Blank/

Bas de Blank
Orrick, Herrington & Sutcliffe LLP
Lead Counsel for Petitioner
Registration No. 74,930
1000 Marsh Road
Menlo Park, CA 94025
Tel: 650-614-7400
Fax: 650-614-7401
Email: M2BPTABDocket@orrick.com

Attorney for Petitioner Oracle Corporation

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing Notice Ranking Petitions Regarding U.S. Patent No. 7,519,814 and Explaining Material Differences was caused to be served on May 16, 2025 via overnight courier upon the following counsel of record for Patent Owner:

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

Copies of this Petition and accompanying documents and exhibits were also served via electronic mail on Patent Owner's counsel of record for related PTAB proceedings and in the related district court litigation – Russ, August & Kabat:

Reza Mirzaie (rmirzaie@raklaw.com)
Marc A. Fenster (mfenster@raklaw.com)
Neil Rubin (nrubin@raklaw.com)
James A. Milkey (jmilkey@raklaw.com)
Qi (Peter) Tong (ptong@raklaw.com)
Jacob R. Buczko (jbuczko@raklaw.com)
Christian W. Conkle (cconkle@raklaw.com)
Jefferson Cummings (jcummings@raklaw.com)
Daniel B Kolko (dkolko@raklaw.com)
Jonathan Ma (jma@raklaw.com)
Mackenzie Paladino (mpaladino@raklaw.com)
James S. Tsuei (jtsuei@raklaw.com)

/Karen Johnson/

Karen Johnson