

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VEEAM SOFTWARE CORPORATION,
Petitioner

v.

SYMANTEC CORPORATION,
Patent Owner

Case IPR2013-00150
Patent 7,093,086

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
FIRST MOTION TO AMEND**

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I. Statement of Relief Requested and Why the Board Should Deny the Motion to Amend

Petitioner Veeam Software Corporation (“Veeam”) respectfully requests that the Board deny Patent Owner’s Motion to Amend because Patent Owner’s motion is procedurally and substantively defective. First, Patent Owner has not met its threshold burden of establishing patentability of the substitute claims. Second, the proposed substitute claims are unpatentable over prior art known to the Patent Owner.

II. Patent Owner’s First Motion to Amend is Procedurally Deficient

A. Patent Owner has not established that the amended claims are patentable.

Patent Owner Symantec had the burden to support its motion and establish the “patentable distinction [of the amended claims] over the prior art of record and *also prior art known to the patent owner.*” *See Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, Paper 26 (June 11, 2013), p. 7 (emphasis added); *see also* 37 C.F.R. § 42.20(c). If the proposed amendment does not “respond to a ground of unpatentability involved in the trial,” the motion to amend may be denied. 37 C.F.R. § 42.121(a)(2)(i). Patent Owner’s Motion does not satisfy this burden.

Patent Owner only addresses patentability of the amended claims over five of the six references presented in Veeam’s IPR petition. Despite this cursory

treatment of patentability, Patent Owner, relying on its expert, Dr. Green, states that “[n]o combination of the prior art references cited in the Petition, nor any other prior art references of which Patent Owner is aware, disclose, teach, or suggest each and every limitation as recited in the substitute claims.” (Motion to Amend, p. 6 (Paper No. 27).) This conclusory statement is inaccurate, in this case, where Patent Owner has received a significant amount of highly relevant prior art in the two co-pending district court litigations involving the ’086 patent and during its prosecution of a continuation application of the ’086 patent.

Nevertheless, Dr. Green’s declaration inexplicably does not reference any prior art beyond the prior art cited in this proceeding. At deposition, Dr. Green testified that he did not review or consider any of the other prior art clearly known to the Patent Owner:

- the references applied against similar claims in the continuation of the ’086 patent. (*See Green Tr.*¹, 290:7-291:6.)
- the references cited in the invalidity contentions served by Veeam on Patent Owner in the co-pending district court litigation between the parties (*See Green Tr.*, 294:2-10.)
- the references cited in the invalidity contentions for the ’086 patent served by Acronis in *Symantec Corp. v. Acronis*, Case No: 11-cv-05310

¹ Provided at VEEAM 1026.

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