

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE, INC.,
Petitioner,

v.

CIRBA IP INC.,
Patent Owner.

IPR2021-00008
Patent 10,523,492 B2

Before DAVID C. McKONE, TERRENCE W. McMILLIN, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. Background

In this *inter partes* review, VMWare, Inc. (“Petitioner”) challenges the patentability of claims 1–33 (the “challenged claims”) of U.S. Patent No. 10,523,492 B2 (Ex. 1001, “the ’492 patent”), which is assigned to Cirba IP Inc. (“Patent Owner”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a), addresses issues and arguments raised during the trial in this *inter partes* review. For the reasons discussed below, Petitioner has proven by a preponderance of the evidence that claims 1–33 are unpatentable.

B. Procedural History

In this proceeding, Petitioner relies upon the following references:

Power et al., U.S. Patent No. 7,616,583 B1, issued Nov. 10, 2009 (Ex. 1004, “Power”);

Kerr et al., U.S. Patent No. 8,606,886 B2, issued Dec. 10, 2013 (Ex. 1006, “Kerr”);

Van Hoose et al., U.S. Patent Publication No. 2004/0034577 A1, published Feb. 19, 2004 (Ex. 1005, “Van Hoose”); and

Le et al., U.S. Patent No. 7,356,679 B1, issued Apr. 8, 2008 (Ex. 1007, “Le”).

Pet. iv, 15.

Petitioner submits the Declaration of Dr. Nader F. Mir (Ex. 1002). Patent Owner submits the Declaration of Dr. Vijay Madiseti (Ex. 2015).

Petitioner challenges the patentability of claims 1–33 of the '492 patent based on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–5, 9–16, 20–27, 21–33	102(e) ¹	Power
1–33	103(a)	Power, Kerr
1–33	103(a)	Van Hoose, Le

Pet. 15. Patent Owner filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We instituted trial on all grounds of unpatentability. Paper 10 (“Inst. Dec.”), 41.

During the trial, Patent Owner filed a Response (Paper 13, “PO Resp.”), Petitioner filed a Reply (Paper 23, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 25, “PO Sur-reply”).

An oral hearing was held on February 9, 2022, a transcript of which appears in the record. Paper 35 (“Tr.”).

C. Real Parties in Interest

Petitioner states that “VMware, Inc.” is the real party in interest. Pet. 87. Patent Owner states that “[t]he real parties-in-interest are Cirba IP, Inc. and Cirba Inc. (d/b/a Densify).” Paper 3, 2.

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. §§ 102 and 103 that became effective as of March 16, 2013. The application for the '492 patent was filed after March 16, 2013, but includes a priority claim to an application filed before this date. Ex. 1001, code (22), (63). Petitioner contends that the challenged claims are entitled to an effective filing date of April 21, 2006, and that the pre-AIA versions of §§ 102 and 103 apply here. Pet. 12, 15. Patent Owner does not challenge this assertion. PO Resp. In this decision, we apply the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

D. Related Proceedings

The parties identify the following district court case involving the '492 patent: *VMware, Inc. v. Cirba Inc. (d/b/a Densify)*, No. 1:20-cv-00272-LPS (D. Del.). Pet. 87; Paper 3, 2.

E. The '492 Patent (Ex. 1001)

The '492 patent relates to systems and methods for analyzing a collection of computers for consolidation based on various constraints, including compatibility. Ex. 1001, code (57). According to the '492 patent specification, challenges have arisen in managing distributed computing systems due to the sprawl that can occur over time as applications and servers proliferate, resulting in more processing capacity than is required by an organization. *Id.* at 1:45–56. Removing some of the servers from a large computing environment, the specification explains, can significantly reduce costs. *Id.* at 1:67–2:2.

To address this perceived concern, the '492 patent discloses an analysis program for determining compatibilities in a computing environment and identifying consolidation solutions, as shown, for example, in Figure 1 reproduced below.

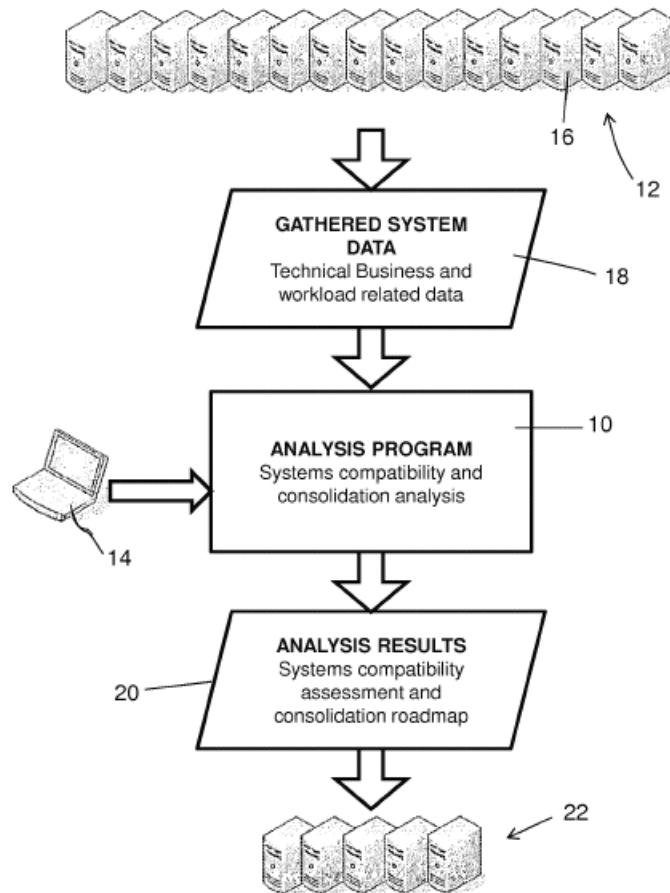


Figure 1

Figure 1 is a block diagram of an analysis program for evaluating the compatibility of computer systems to identify consolidation solutions.

Ex. 1001, 3:40–42, Fig. 1.

Ex. 1001, Fig. 1. As shown in Figure 1, an analysis program 10, accessed through a computer station 14, gathers data 18 pertaining to a collection of systems to be consolidated 16. *Id.* at 5:15–19. The data is obtained for each system and includes one or more parameters that preferably relate to technical, business, and workload characteristics or features of the respective system. Ex. 1001, 5:28–32. The analysis program 10 uses the gathered data 18 to evaluate the compatibility of the computer systems and provides a roadmap 20 specifying how the original set of systems can be consolidated

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