

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE, INC.,
Petitioner,

v.

CIRBA INC.,
Patent Owner.

PGR2021-00098
Patent 10,951,459 B2

Before DAVID C. MCKONE, STACY B. MARGOLIES, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 328(a)

I. INTRODUCTION

A. Background

In this post-grant review, VMware, Inc. (“Petitioner”) challenges the patentability of claims 1–63 (the “challenged claims”) of U.S. Patent No. 10,951,459 B2 (Ex. 1001, “the ’459 patent”), which is assigned to Cirba Inc. (“Patent Owner”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision, issued pursuant to 35 U.S.C. § 328(a), addresses issues and arguments raised during the trial in this post grant review. For the reasons discussed below, Petitioner has proven by a preponderance of the evidence that claims 1–63 are unpatentable.

B. Procedural History

In this proceeding, Petitioner submitted its Petition on July 6, 2001 (Paper 2 (“Pet.”)), challenging claims 1–63 based on the following ground:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–63	112(a) ¹	Written Description

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. § 112 that became effective as of March 16, 2013. The application for the ’459 patent was filed after March 16, 2013, but includes a priority claim to an application filed before this date. Ex. 1001, codes (22), (63). Petitioner contends that the challenged claims are not entitled to an effective filing date earlier than March 16, 2013, because the pre-AIA priority applications lack written description for the challenged claims. Pet. 20–53. Because, as discussed below, the record shows that the pre-AIA priority applications lack sufficient written description for the challenged claims, we apply the post-AIA version of § 112.

Pet. 20–54. With its Petition, Petitioner submitted the Declaration of Dr. Erik Zadok. Ex. 1006. Patent Owner elected to waive its Preliminary Response. Paper 11. We instituted trial on all grounds of unpatentability. (Paper 12 (“Inst. Dec.”)).

During the trial, Patent Owner filed a Response (Paper 14, “PO Resp.”), Petitioner filed a Reply (Paper 22, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 23, “PO Sur-reply”).

An oral hearing was held on September 15, 2022, a transcript of which appears in the record. Paper 37 (“Tr.”).

C. Real Parties in Interest

Petitioner states that “VMware, Inc.” is the real party in interest, and “is the sole party who has funded this Petition and has full and exclusive control over this proceeding.” Pet. 54. Petitioner also states that, “[o]ut of an abundance of caution, VMware discloses that it is a majority-owned subsidiary of EMC Corporation, which is a wholly-owned subsidiary of Dell Technologies, Inc.” *Id.* Petitioner further states that “VMware does not believe that either EMC Corporation or Dell Technologies, Inc. are real-parties-in-interest and, as far as VMware is aware, neither EMC Corporation nor Dell Technologies, Inc. has ever been served with a complaint accusing them of infringing the ’459 patent.” *Id.*

In its initial Mandatory Notices, Patent Owner stated that “[t]he real parties-in-interest are Cirba IP, Inc. and Cirba Inc. (d/b/a Densify).” Paper 4, 2. On August 17, 2022, Patent Owner filed Updated Mandatory Notices stating that, on April 20, 2022, “Cirba IP, Inc. was amalgamated (the Canadian version of merged) into Cirba Inc.” Paper 29, 1. According to Patent Owner, “Cirba Inc. (the amalgamated company), which now includes

both what was formerly Cirba Inc. and what was Cirba IP, Inc., succeeds to all rights and interests of Cirba Inc. and Cirba IP, Inc. (both of which survive the amalgamation).” *Id.* “As a result,” Patent Owner represents, “Cirba Inc. (the amalgamated company) is the owner of U.S. Patent No. 10,951,459 and is the real party-in-interest in this proceeding.” *Id.*

D. Related Proceedings

The parties identify the following consolidated district court cases involving the ’459 patent, and its parent, U.S. Patent No. 10,523,492 (the “’492 patent”): *Cirba Inc. et al. v. VMware, Inc.*, No. 1:19-cv-00742-LPS (D. Del.) and *VMware, Inc. v. Cirba Inc.*, No. 1:20-cv-00272-LPS (D. Del.) (the “District Court Litigation”). Pet. 55; Paper 4, 2.

The parties identify IPR2021-01210 and IPR2021-01211 as involving the ’459 patent.² Paper 4, 2. The parties also identify IPR2021-00008 as involving the parent ’492 patent. *Id.*

E. The ’459 Patent (Ex. 1001)

The ’459 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 ’459 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 1:47–58. Removing some of the servers from a large computing environment, the specification explains, can significantly reduce costs. *Id.* at 2:1–4.

² IPR2021-01210 and IPR2021-01211 were terminated on December 28, 2021. IPR2021-01210, Paper 16; IPR2021-01211, Paper 16.

To address this concern, the '459 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.

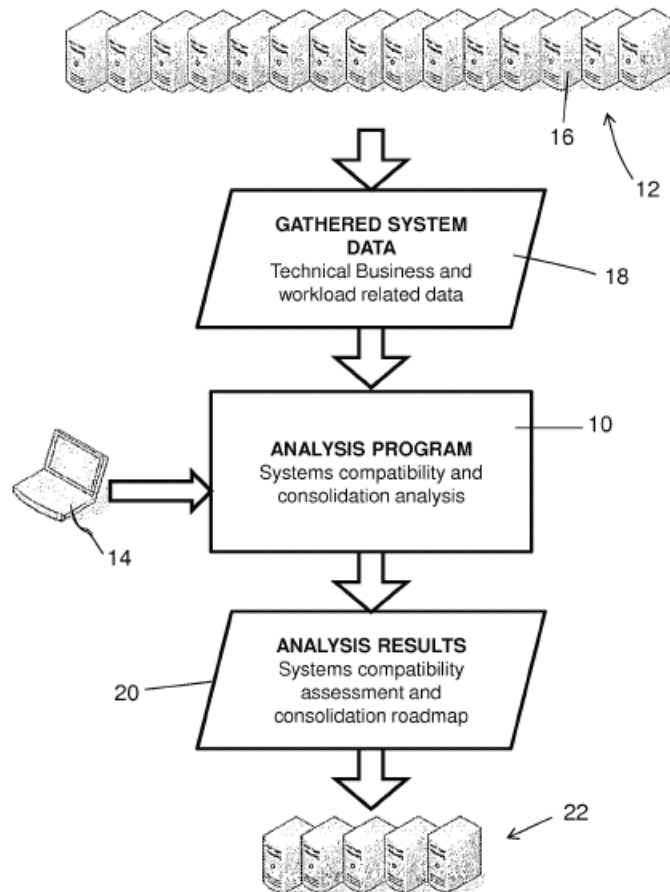


Figure 1

Figure 1 is a block diagram of an analysis program for evaluating the compatibility of computer systems to identify consolidation solutions.
Ex. 1001, 3:42–44, Fig. 1.

As shown in Figure 1, analysis program 10, accessed through computer station 14, gathers data 18 pertaining to a collection of systems to be consolidated 16. *Id.* at 5:18–20. The data is obtained for each system and includes one or more parameters that preferably relate to technical, business,

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