

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE, INC.,
Petitioner,

v.

CIRBA IP, INC.,
Patent Owner.

PGR2021-00098
Patent 10,951,459 B2

Before JUSTIN T. ARBES, DAVID C. McKONE, and RUSSELL E. CASS,
Administrative Patent Judges.

CASS, *Administrative Patent Judge.*

DECISION
Granting Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

A. Background

VMware, Inc. (“Petitioner”) filed a Petition requesting post-grant review of claims 1–63 (the “challenged claims”) of U.S. Patent No. 10,951,459 B2 (Ex. 1001, “the ’459 patent”). Paper 2 (“Pet.”). Petitioner also submits the Declaration of Dr. Erez Zadok, Ph.D. Ex. 1006. Cirba IP, Inc. (“Patent Owner”) elected to waive its Preliminary Response. Paper 11.

We have authority to determine whether to institute a post-grant review under 35 U.S.C. § 324 and 37 C.F.R. § 42.4. A post-grant review may not be instituted unless it is determined that “the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324 (2018); *see also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”).

For the reasons provided below and based on the record before us, we determine that Petitioner has demonstrated that it is more likely than not that at least one of the challenged claims is unpatentable. Accordingly, we institute a post-grant review on all grounds set forth in the Petition.

B. Real Parties in Interest

Petitioner states that “VMware, Inc.” is the real party in interest. Pet. 54. Patent Owner states that “[t]he real parties-in-interest are Cirba IP, Inc. and Cirba Inc. (d/b/a Densify).” Paper 4, 2.

C. 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.). Pet. 55; Paper 4, 2.

The parties identify IPR2021-01210 and IPR2021-01211 as involving the '459 patent.¹ Paper 4, 2. The parties also identify IPR2021-00008 as involving the parent '492 patent. *Id.*

D. 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.

To address this concern, the '459 patent discloses an analysis program for determining compatibilities in a computing environment and identifying

¹ Petitioner states that “[s]hould the Board find that the '459 patent is an AIA patent and eligible for [post-grant review (PGR)], [Petitioner] acknowledges that the '459 patent is not eligible for [*inter partes* review (IPR)] until December 16, 2021, and the concurrently filed IPR petitions [(IPR2021-01210 and IPR2021-01211)] should be denied on that ground.” Pet. 3.

consolidation solutions, as shown, for example, in Figure 1 reproduced below.

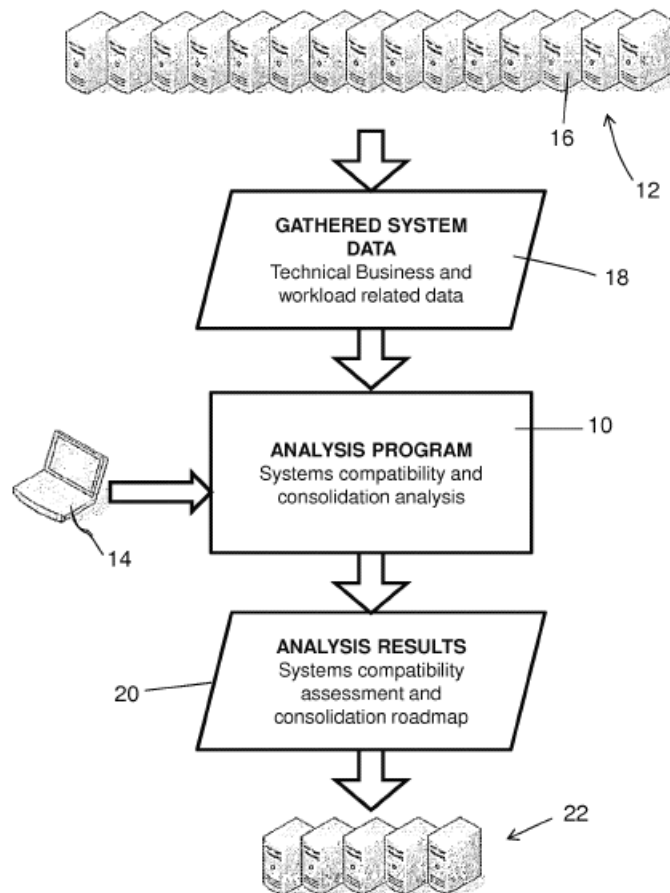


Figure 1

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, and workload characteristics or features of the respective system. *Id.* at 5:29–33. Analysis program 10 uses gathered data 18 to evaluate the

compatibility of the computer systems and provides roadmap 20 specifying how the original set of systems can be consolidated to a smaller number of systems 22. *Id.* at 5:20–24. The systems include source systems from which applications and/or data are to be moved, and target servers or systems to which such applications and/or data are to be moved. *Id.* at 5:57–60.

The compatibility analysis is performed using differential rule sets to evaluate and quantify the compatibility of systems and produce an overall compatibility score. Ex. 1001, 6:66–7:7. A 1-to-1 compatibility analysis may be used to evaluate the compatibility of every possible source-target pair combination on a 1-to-1 basis. *Id.* at 7:19–21. This analysis is useful in assessing single transfer consolidation candidates. *Id.* at 7:21–23.

A multi-dimensional compatibility analysis can evaluate the compatibility of transfer sets where multiple sources are to be transferred to a common target. Ex. 1001, 7:26–28. To assess the compatibility of transferring multiple source entities (N) to a target, a rule-based analysis can compute a compatibility score based on a combination of N-to-1 and N-by-N compatibility analyses. *Id.* at 30:46–49. An N-to-1 intercompatibility analysis “assesses each source system against the target” to generate a score that “reflect[s] the compatibility between N source entities and a single target.” *Id.* at 30:49–51, 31:25–26. An N-by-N intracompatibility analysis “evaluates each source system against each of the other source systems” to generate a score that “reflect[s] the compatibility amongst N source entities with respect to a given rule set.” *Id.* at 30:51–52, 32:17–19. Based on this analysis, a consolidation solution (or roadmap) is generated containing one or more transfer sets based on a common pool of source and target entities. *Id.* at 6:46–48.

E. Illustrative Claim

The '459 patent includes challenged claims 1–63. Claim 1 is illustrative and is reproduced below.

1. A system for determining placement of source computer systems on target computer systems, the system configured to execute operations causing the system to:
 - collect data for a collection of computer systems, the collection of computer systems comprising a plurality of source systems and a plurality of target systems;
 - determine a placement of at least one source system from the collection of computer systems on at least one target system from the collection of computer systems by employing the following operations:
 - evaluate compatibility between a specific source system from the plurality of source systems and a specific target system from the plurality of target systems by evaluating one or more rules that operate against attributes or data relating to the source and target systems being evaluated;
 - evaluate compatibility between the specific source system from the plurality of source systems and one or more other source systems either already placed on the specific target system, or being evaluated for placement onto the specific target system, to determine if the specific source system can be placed with those other source systems on the specific target system, by evaluating one or more rules that operate against attributes or data relating to the source systems;
 - evaluate compatibility between the specific source system and the specific any one of the plurality of target system by evaluating the impact on resource utilization of the specific target system of placing the specific source system on the specific target system, in combination with the one or more other source systems, either already placed on the specific target system, or being

evaluated for placement onto the specific target system;
and

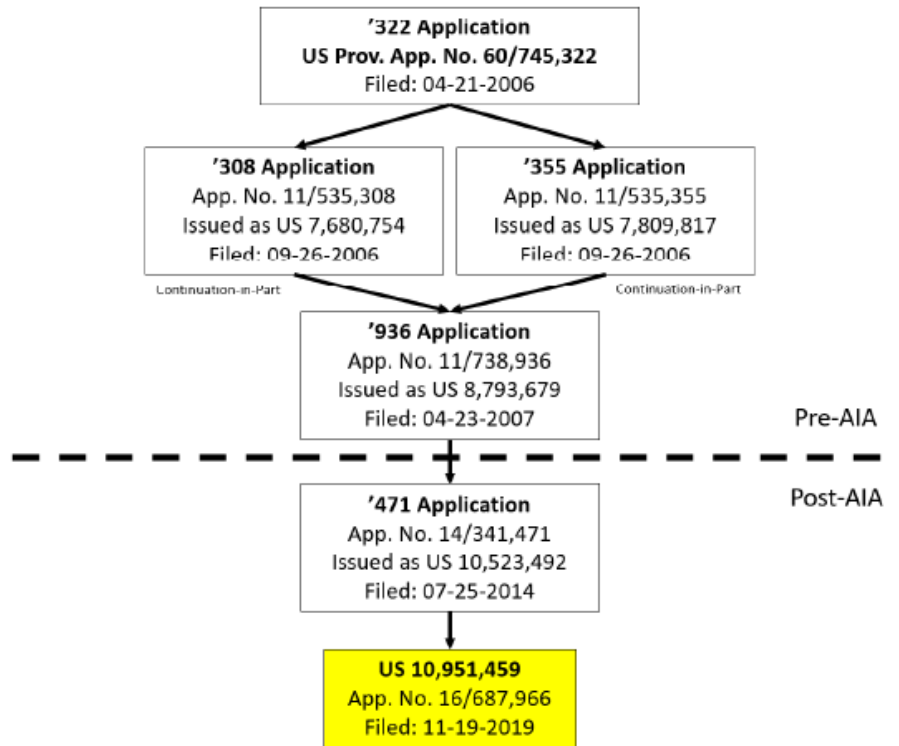
issue instructions to place the at least one source system on
the at least one target system in accordance with the
determined placement.

Ex. 1001, 40:2–39.

F. Priority Claims and Prosecution History of the '459 Patent

The '459 patent states that it is a continuation of Application No. 14/341,471, filed on July 25, 2014 (now U.S. Patent No. 10,523,492) (the “'471 application”), which is a continuation of Application No. 11/738,936, filed on April 23, 2007 (now U.S. Patent No. 8,793,679) (the “'936 application”). Ex. 1001, code (63). The '936 application is a continuation-in-part of Application No. 11/535,355 (now U.S. Patent No. 7,809,817) (the “'355 application”) and Application No. 11/535,308 (now U.S. Patent No. 7,680,754) (the “'308 application”), both filed on September 26, 2006. *Id.* The '459 patent also claims priority to Provisional Application No. 60/745,322, filed on April 21, 2006 (the “'322 application”). *Id.* at code (60). The '936 application states that it incorporates by reference the '355, '308, and '322 applications. Ex. 1009 ¶ 1.

Petitioner includes the following graphic to illustrate the priority chain for the '459 patent.



Pet. 21.

As originally filed, the application for the '459 patent included only one claim, which is reproduced below:

1. A computer-implemented method for determining a consolidation solution for a plurality of computer systems comprising:
 - a) obtaining a data set comprising a compatibility score for each pair of said plurality of computer systems, each said compatibility score having been computed using parameters of said plurality of computer systems to indicate a comparable compatibility of respective parameters of one of said plurality of computer systems with respect to another of said plurality of computer systems;
 - b) using said compatibility scores to determine one or more candidate transfer sets from said plurality of computer systems and, each candidate transfer set indicating one or more source computer systems having compatible

- parameters that enable the source computer system(s) to be transferred to a target computer system;
- c) selecting a desired one of said one or more candidate transfer sets according to a predetermined selection criterion and adding said desired one of said one or more candidate transfer sets to a first candidate consolidation solution;
- d) repeating b) and c) by, at each iteration, removing computer systems included in said desired one of said one or more candidate transfer sets and using said compatibility scores corresponding to remaining computer systems to generate at least one additional desired candidate transfer set to be added to said first candidate consolidation solution; and
- e) providing said first candidate consolidation solution as a desired consolidation solution when no additional candidate transfer sets can be determined in b).

Ex. 1002, 63.

In a preliminary amendment filed on July 2, 2020, Patent Owner canceled the originally filed claim and added 57 new claims. Ex. 1003, 2–58. These new claims included, among other things, limitations reciting “evaluat[ing] compatibility” between a source system and another source system that was “already placed” on a target system, and “issu[ing] instructions to place the at least one source system on the at least one target system in accordance with” a determined placement. *Id.* at 2. In the remarks accompanying the Preliminary Amendment, Patent Owner stated that “[s]upport for these amendments can be found throughout the application as filed,” but did not identify any specific portions of the application. *Id.* at 11.

The Examiner allowed the claims on October 5, 2020, without issuing any rejections. Ex. 1004, 2. On December 10, 2020, Patent Owner filed a

Request for Continued Examination and made further amendments that added an additional limitation requiring that the “evaluat[ing] compatibility” between source systems may include “one or more other source systems either already placed on the specific target system, or being evaluated for placement onto the specific target system.” Ex. 1005, 2. Patent Owner did not identify support for the amendments in the application. *Id.* at 14. The Examiner then allowed the amended claims on January 11, 2021.

G. Asserted Ground of Unpatentability

Petitioner challenges the patentability of claims 1–63 of the ’459 patent based on the following ground:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–63	112(a) ²	Written Description

² 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 present record supports the conclusion that the pre-AIA priority applications lack sufficient written description for the challenged claims, we apply the post-AIA version of § 112 for purposes of this decision.

II. DISCUSSION

A. Claim Construction

A claim “shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.200(b) (2020).

Petitioner argues that the specification expressly defines a “source system” as “a system from which applications and/or data are to be moved,” and a “target system” as “a system to which [a source system’s] applications and/or data are to be moved.” Pet. 19 (citing Ex. 1001, 5:57–60) (alteration in original). In the section of the Petition arguing lack of written description, Petitioner also argues that these definitions imply that “a system’s applications and data are distinct from the system itself.” Pet. 33.

We determine that it is not necessary to provide an express interpretation of the terms “source system” and “target system” at this stage of the proceeding. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”). We also provide further observations on Petitioner’s application of the term “source system” in its written description analysis in Section II.D.1(a)(2) below.

B. Principles of Law

1. Post-Grant Review Eligibility

The post-grant review provisions set forth in section 6(d) of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (September 16, 2011) (“AIA”), apply only to patents subject to the first-

inventor-to-file provisions of the AIA. *See* AIA § 6(f)(2)(A) (stating that the provisions of section 6(d) “shall apply only to patents described in section 3(n)(1)”). Petitioner has the burden of establishing eligibility for post-grant review. *See Commonwealth Sci. & Indus. Res. Org. v. BASF Plant Sci. GmbH*, PGR2020-00033, Paper 11, 7 (PTAB Sept. 10, 2020); *Mylan Pharms. Inc. v. Yeda Res. & Dev. Co.*, PGR2016-00010, Paper 9, 10 (PTAB Aug. 15, 2016); *US Endodontics, LLC v. Gold Standard Instruments, LLC*, PGR2015-00019, Paper 17, 9–12 (PTAB Jan. 29, 2016).

Patents subject to the first-inventor-to-file provisions are those that issue from applications that contain or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after [March 16, 2013]; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

AIA § 3(n)(1).

Determining whether a patent is subject to the first-inventor-to-file provisions of the AIA, and therefore eligible for post-grant review, is straightforward when the patentee filed the application from which the patent issued before March 16, 2013, or when the patentee filed the application on or after March 16, 2013, without any priority claim. The determination is more complex, however, for a patent that issues from a “transition application,” that is, an application filed on or after March 16, 2013, that claims the benefit of an earlier filing date. *See* MPEP § 2159.04 (9th ed. Rev. 10.2019, June 2020). Entitlement to the benefit of an earlier date under 35 U.S.C. §§ 119, 120, 121, or 365 is premised on disclosure of the claimed invention “in the manner provided by section 112(a) (other than

the requirement to disclose the best mode)” in the earlier application. *See* 35 U.S.C. §§ 119(e)(1), 120.

Thus, for a patent issuing from a transition application, eligibility for post-grant review depends on whether the Petition shows that the patent contains or contained at any time a claim that lacks written description and enabling support in a priority application filed before March 16, 2013. If the Petition makes such a showing, the patent may be eligible for post-grant review even if it is a continuation of a priority application filed before March 16, 2013. *Commonwealth Sci.*, Paper 11 at 8–9 (“It is well-established by prior Board decisions that a patent claiming the benefit of a priority application filed before March 16, 2013 must have written description support in, and be enabled by, the earlier-filed application to avoid PGR-eligibility.”); *see* Pet. 15–16 (collecting cases).

2. *Written Description*

To satisfy the written description requirement under 35 U.S.C. § 112(a), the specification must “reasonably convey[] to those skilled in the art that the inventor had possession” of the claimed invention as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). An adequate description does not require any particular form of disclosure or that the specification recite the claimed invention *in haec verba*, but must do more than render the claimed invention obvious. *Id.* at 1352. In evaluating the adequacy of the disclosure, a court may consider “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.” *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005) (cited with approval in *Ariad*, 598 F.3d at 1352).

C. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art at the time of the alleged invention “would have had at least a bachelor’s degree in computer science, computer engineering, electrical engineering, or a related degree and 2-3 years of experience with administering remote computing environments.” Pet. 18–19 (citing Ex. 1006 ¶ 59). Petitioner further asserts that “[m]ore education would be acceptable in place of work experience and vice versa.” *Id.* at 19 (citing Ex. 1006 ¶ 59).

At this stage of the proceeding, we adopt Petitioner’s assessment of the level of skill in the art, which is consistent with the ’459 patent and the evidence of record.

D. Eligibility of the ’459 Patent for Post-Grant Review

Petitioner contends that ’459 patent is eligible for post-grant review because its pre-AIA priority applications lack written description for the claims. Pet. 20–53. These pre-AIA applications include the ’936 application, and the ’355, ’308, and ’322 applications incorporated by reference into the ’936 application (collectively, the “pre-AIA applications”). *Id.*

Petitioner argues that the pre-AIA applications fail to provide adequate written description support for two aspects of claim 1: (1) evaluating a source system with “other source systems . . . already placed on the specific target system,” and (2) “issuing instructions to place the at least one source system on the at least one target system in accordance with the determined placement.” Pet. 25–53. We will discuss these arguments in turn below.

1. *Evaluating a source system with “other source systems . . . already placed on the specific target system”*

Claim 1 requires evaluating compatibility between a specific source system and one or more other source systems “either ***already placed on the specific target system***, or being evaluated for placement onto the specific target system,” to determine if that source system can be placed with the other source systems on the specific target system. Ex. 1001, 40:18–25 (emphasis added). Claim 1 also requires evaluating compatibility between a specific source system and one of a plurality of target systems by evaluating the impact of placing on the target system the specific source system in combination with one or more other source systems “either ***already placed on the specific target system***, or being evaluated for placement onto the specific target system” on resource utilization of the target system. *Id.* at 40:28–36 (emphasis added). Independent claims 32 and 63 include similar language. *Id.* at 42:51–67, 45:17–46:16. As discussed below, Petitioner argues that these limitations are not supported by adequate written description in the ’936 application, or any of the pre-AIA applications incorporated therein. Pet. 24–35, 42–47, 48–49, 50–52.

a) *Written Description Support in the ’936 Application (Ex. 1009)*

Petitioner argues that the ’936 application fails to provide adequate written description support for two limitations of claim 1: (1) evaluating a source system with “other source systems . . . already placed on the specific target system,” and (2) “issuing instructions to place the at least one source system on the at least one target system in accordance with the determined placement.” Pet. 25–42.

(1) Petitioner's Argument That None of the Analyses Disclosed in the '936 Application Involves Evaluating a Source System With Another "Already Placed" Source System

Petitioner argues that “[t]he ’936 application describes only three types of ‘compatibility analyses’ (‘1-to-1,’ ‘N-to-1,’ and ‘N-by-N’) as well as a ‘consolidation analysis,’” but “none of these involves evaluating a source system with another source system ‘already placed’ on a target system,” as required by the challenged claims. Pet. 25.

The 1-to-1 analysis, Petitioner contends, “evaluates only source systems with target systems.” Pet. 26. Therefore, according to Petitioner, it “does not evaluate a source system with another source system of any kind,” much less one that is “already placed” on a target system. *Id.* at 26 (citing Ex. 1009 ¶ 284; Ex. 1006 ¶ 67).

The N-to-1 analyses, according to Petitioner, “[l]ike 1-to-1 analyses,” evaluate “the compatibility of ‘each source against the target,’ and do[] not involve evaluating a source system against any other source system, including source system[s] that are ‘already placed’” on a target system. Pet. 27 (citing Ex. 1009 ¶¶ 255–256). Petitioner further argues that, in the N-to-1 analyses, “none of the source systems” is “assigned to a target system during the evaluation.” *Id.* at 28 (citing Ex. 1006 ¶ 68).

Petitioner acknowledges that the N-by-N analysis “evaluates source systems of a transfer set against each other,” but argues that “none of these source systems have been ‘already placed’ on a target system, nor have the applications or data been ‘already’ transferred to the target system.” Pet. 28 (citing Ex. 1009 ¶ 333). To support this argument, Petitioner points to the statement in paragraph 321 of the ’936 application that source systems in a transfer set are systems “*to be transferred to* the target.” *Id.* at 28–29 (citing

Ex. 1009 ¶ 321). Petitioner asserts that this is an express definition that “excludes source systems that have been *already transferred* to the target system.” *Id.* at 29 (citing Ex. 1006 ¶ 69).

Petitioner also argues that the ’936 application’s “consolidation analysis” does not “involve source systems that have been ‘already placed’ or transferred to a target system.” Pet. 29. According to Petitioner, this consolidation analysis “involves compiling ‘valid source and target candidates,’ setting up ‘auto fit parameters,’ compiling ‘candidate transfer sets,’ choosing the ‘best candidate transfer set,’ adding the transfer set to a ‘consolidation solution,’ repeating some or all of these steps to generate one or more possible consolidation solutions, and choosing the ‘best consolidation solution.’” *Id.* (citing Ex. 1009 ¶¶ 354–361). Petitioner argues that “[a]t no point does this process involve evaluating a source system against another source system that has been ‘already placed’ on a target system.” *Id.* “In fact,” Petitioner asserts, “no ‘placement,’ or other transfer, occurs as part of the consolidation analysis at all,” and the “analysis is a purely theoretical exercise.” *Id.*

Additionally, Petitioner argues that the consolidation analysis does not involve source systems “already placed” on a target system because “when the consolidation analysis identifies even a *potential* transfer of one or more source systems to a target system, it excludes the source and target systems involved in the transfer from subsequent evaluation steps.” Pet. 30. More specifically, Petitioner contends that the consolidation analysis “identifies a ‘best’ transfer set (i.e., a specific set of source systems to be consolidated onto a specific target system) by evaluating various candidate transfer sets that meet certain auto fit parameters,” and then adds this “best” transfer set

“‘to the intermediate consolidation solution,’ thereby *removing* the source and target systems that comprise the transfer set from ‘the list of available sources and targets.’” *Id.* (citing Ex. 1009 ¶¶ 355–358). Thus, according to Petitioner, “[t]he ’936 application does not describe—and in fact expressly excludes—evaluating source systems with other source systems that even have been *temporarily assigned* to a target system, let alone source systems whose applications and data have been ‘already placed’ on a target system.” *Id.* at 30–31 (citing Ex. 1006 ¶¶ 70–71).

Petitioner notes that the ’936 application states that the consolidation analysis “can be performed on an analysis with pre-existing source-target transfers,” but argues that this statement “does *not* describe source systems that are ‘already placed’ on target systems.” Pet. 31 n.5 (citing Ex. 1009 ¶ 345). “Rather,” Petitioner contends, this statement “simply notes that consolidation analyses may be performed using predefined transfer sets, rather than being limited to transfer sets generated using auto fit parameters.” *Id.* Petitioner argues that this understanding is supported by the immediately preceding sentences stating that “systems can be designated for consideration as a source only, as a target only or as either a source or a target,” and that these designations “serve as constraints when defining transfers” in the consolidation analysis. *Id.* (citing Ex. 1009 ¶ 145). Petitioner also points to the sentence following the statement referring to “pre-existing source-target transfers” which, according to Petitioner, “explains that analyses where certain systems are ‘designated as source or target-only’ are ‘referred to as “directed analysis.””” *Id.* Thus, Petitioner argues, this paragraph “concerns how transfer sets are defined or chosen,” and does not describe “any analysis where a source system is evaluated

against another source system that is ‘already placed’ on a target system.”
Id.

Based on the present record, we determine that Petitioner has met its burden of showing eligibility for post-grant review. On the present record, Petitioner has presented sufficient evidence to show that the ’936 application’s discussion of the 1-to-1 analysis, N-to-1 analysis, N-by-N analysis, and consolidation analysis, does not disclose the performance of these analyses on source systems that have been “already placed on the specific target system,” and instead involves source systems “being evaluated for placement onto the specific target system.”

On the present record, Petitioner also has presented sufficient evidence that paragraph 345 of the ’936 application does not disclose the performance of the compatibility analysis on systems that have been “already placed on the specific target system.” Paragraph 345 states as follows:

As part of a compatibility analysis input specification, systems can be designated for consideration as a source only, as a target only or as either a source or a target. These designations serve as constraints when defining transfers in the context of a compatibility analysis. ***The analysis can be performed on an analysis with pre-existing source-target transfers.*** Analyses containing systems designated as source or target-only (and no source or target designations) are referred to as “directed analysis.”

Ex. 1009 ¶ 345 (emphasis added). The statement emphasized in paragraph 345 above refers to performing the compatibility analysis on “***an analysis with*** pre-existing source-target transfers.” The statement does not appear to specify that compatibility is evaluated between a specific source system and another source system “already placed on the specific target system,” as the

claims require. The reference to “an analysis with” pre-existing source-target transfers, as well as the surrounding discussion of pre-designating systems as sources or targets, suggests that the “pre-existing source-target transfers” may refer to sources to be transferred to the target, rather than sources that have been “already placed” on a target.

Consequently, Petitioner has sufficiently shown, based on the evidence presently before us, that the ’936 application lacks sufficient written description support for the claim limitations requiring evaluating a source system with “other source systems . . . already placed on the specific target system.”

(2) Petitioner’s Argument that the ’936 Application’s Definition of a “Source System” Is Incompatible with the Idea of “Already” Transferred Systems

As noted in Section II.A above, Petitioner argues that the ’459 patent defines a “source system” as “a system from which applications and/or data are to be moved.” Pet. 19 (citing Ex. 1001, 5:57–58). Petitioner references the same definition in the ’936 application. *Id.* at 32 (citing Ex. 1009 ¶ 81). Petitioner argues that this definition of a “source system” “can only be meaningful in the context of a future or potential transfer, and not a transfer that has already occurred.” Pet. 32. According to Petitioner, this is because “a system can only be a ‘source’ while it is being considered as an actual source of applications or data,” and a “system whose applications and/or data have *already* been moved to another system is no longer a ‘source.’” *Id.* (citing Ex. 1006 ¶¶ 74–77).

Petitioner further argues that a “source system” is distinct from that source system’s applications and data, and that the ’936 application describes transferring only the source system’s applications and data, not the

source system itself, to the target system in a consolidation. Pet. 33 (citing Ex. 1006 ¶ 74). Thus, Petitioner argues, the '936 application does not support the claim limitations requiring source systems that are “already placed” on a target system. *Id.* at 33–34.

In a similar vein, Petitioner argues that the '936 application does not disclose “placement” of systems, but rather only discloses “transfers,” i.e., “the movement of ‘applications and/or data’ from source systems to target systems.” Pet. 34 (citing Ex. 1009, Abstract, ¶ 81). Petitioner argues that the '936 application never uses the term “placement,” and that the term “placement” “implies moving the entire source system itself (i.e., not just a part of it).” *Id.*

Because we determine in Section II.D.1(a)(1) above that, on the present record, Petitioner has sufficiently shown that the '936 application does not support the claims of the '459 patent, we need not resolve these arguments to determine whether the '459 patent is eligible for post-grant review. However, because these arguments may also be relevant to Petitioner’s claim that the '459 patent lacks adequate written description support in the specification, and to guide the parties’ presentations during the trial, we offer the following observations.

First, we note that Petitioner’s argument based on the meaning of the term “source system” does not address the '459 specification’s statement that “a ‘system’ or ‘computer system’ hereinafter referred, can encompass any entity which is capable of being analysed for any type of compatibility and should not be considered limited to existing or hypothetical physical or virtual systems etc.” Ex. 1001, 6:29–33; *see* Ex. 1009 ¶ 85 (identical language in the '936 application). Nor does it address the specification’s

statement that “entities can be components that comprise systems such as applications and database instances.” Ex. 1001, 6:19–21; *see* Ex. 1009 ¶ 84 (identical language in the ’936 application). During the trial, the parties may address, if appropriate, the impact of these disclosures in the specification on the meaning of the term “source system.”

Second, although Petitioner makes arguments based on the meaning of the term “placement” in the claims, Petitioner never conducts a claim construction analysis for the terms “placed” or “placement.” Pet. 34. To the extent appropriate, the parties may address the proper construction of these terms during the trial.

b) Written Description Support in the ’355, ’308, and ’322 Applications (Exs. 1010–1012)

For its assertions that the ’355, ’308, and ’322 applications fail to provide written description support for the “already placed” limitation, Petitioner relies on very similar arguments as those it advanced for the ’936 application. *See* Pet. 42–46, 48–52. For the reasons discussed above in Section II.D.1(a)(1), we determine that, on the present record, Petitioner has sufficiently shown that the ’355, ’308, and ’322 applications fail to provide adequate written description support for the “already placed” limitation of the claims.

2. The “Issue Instructions” Limitation

Claim 1’s final element requires that the system “issue instructions to place the at least one source system on the at least one target system in accordance with the determined placement.” Ex. 1001, 40:37–39. Independent claims 32 and 63 include a similar limitation. *Id.* at 43:1–3, 46:17–19. Petitioner argues that none of the ’936, ’355, ’308, and ’322

applications provide adequate disclosure for this limitation because they do not “describe any sort of instructions to *transfer* a source to a target in accordance with a consolidation solution,” but rather merely “describe[] an analytical technique that results in recommendations, and [are] silent as to implementation of those recommendations.” Pet. 36; *see id.* at 46–50, 52–53.

Because we determine in Section II.D.1 that, based on the current record, none of the ’936, ’355, ’308, and ’322 applications provide adequate disclosure for the “already placed” limitation, we do not need to resolve Petitioner’s argument as to the “issue instructions” limitation at this stage of the proceeding. The parties may address this limitation further, if appropriate, during the trial.

3. Conclusion as to Post-Grant Eligibility

Because we determine on the present record that none of the ’936, ’355, ’308, and ’322 applications provide adequate written description for the “already placed” limitation, we determine that the ’459 patent is not entitled to claim priority to any application filed before March 16, 2013. Therefore, based on the current record, the ’459 patent is only entitled to its filing date of November 19, 2019, which makes it eligible for post-grant review.

Also, a petition for post-grant review may only be filed not later than the date that is nine months after the date of the grant of the patent or of the issuance of a reissue patent, as the case may be. 35 U.S.C. § 321(c). The Petition was filed on July 6, 2021, within nine months of the grant of the ’459 patent on March 16, 2021. Petitioner certifies that the ’459 patent is available for post-grant review and also that Petitioner is not barred or

estopped from requesting post-grant review. Pet. 2; *see* 37 C.F.R. § 42.204(a).

E. Written Description of the '459 Patent

Petitioner contends that the '459 patent's specification is identical to that of the '936 application, and that the same is true for the '459 patent's only post-AIA priority application, the '471 application. Pet. 53. Thus, Petitioner argues, the '459 patent fails the written description requirement for the same reasons as the applications to which it claims priority. *Id.*

Based on the present record, we determine that Petitioner has established that it is more likely than not that the claims of the '459 patent lack written description for the reasons discussed in Section II.D.1 above.

III. CONCLUSION

After considering the evidence and arguments presented in the current record, we determine that Petitioner has demonstrated that it is more likely than not that the challenged claims of the '459 patent are unpatentable based on lack of adequate written description. Thus, we institute a post-grant review of all challenged claims on all grounds presented.

At this stage of the proceeding, we have not made a final determination as to the patentability of any challenged claim or as to the construction of any claim term.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 324, a post-grant review of claims 1–63 of the '459 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 324(c) and 37 C.F.R. § 42.4, post-grant review of the '459 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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