

Veeam Software Corporation v. Symantec Corporation, Final Written Decision IPR2013-00150

Article By:

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Takeaway: A proper substitute claim under 37 C.F.R. § 42.121(a)(i) must only narrow the scope of the challenged claim it replaces.

In its [Final Written Decision](#), the Board ordered that all challenged claims of the '086 Patent (i.e., claims 1, 11, 12, and 22) were unpatentable; denied Patent Owner's Motion to Amend; and denied Patent Owner's Motion to Exclude. Further, the Board indicated that it was concurrently entering final decisions in related inter partes review proceedings filed by Petitioner against certain claims of Patent Owner's '558 and '299 Patents.

The '806 Patent is directed to methods and computer systems for backing up virtual machines, and related computer readable media. The Board used the broadest reasonable interpretation (BRI) standard in construing various phrases recited in the claims.

In this regard, the Board had construed the recited "state of [first] virtual machine" in its Decision to Institute as meaning "information regarding the [first] virtual machine to permit the virtual machine to resume execution of the application at the point in time the state was captured." This was the prior construction that had been arrived at by the District Court for the Northern District of California in *Symantec Corp. v. Veeam Software Corp.*, Case No. 12-cv-00700-SI (N.D. Cal.). Patent Owner argued that this interpretation was unreasonably narrow and inconsistent with the specification, while Petitioner countered that Patent Owner's proposed construction was overly narrow. The Board agreed with Petitioner and thus did not modify the construction of this phrase that it had found in its Decision to Institute.

Patent Owner asserted that the recited "backup program" must be construed as performing the two recited steps in order to backup a virtual machine. The Board was not persuaded by this line of reasoning, because it deemed that claims 1 and 12 do not recite the term "backup." Thus, importing the limitation "backup program" into the claims, as urged by Patent Owner, was found by the Board to be an improper importation of subject matter from the specification into the claims.

Petitioner had asserted that the Lim reference anticipates the challenged claims of the '086 Patent under 35 U.S.C. § 102(e). Patent Owner argued that Lim was not an anticipatory reference, because Petitioner's expert never referred to Lim as a backup system. The Board was unpersuaded by

Patent Owner on this point, because in its claim construction the Board had concluded that claims 1 and 12 do not require a “backup program.” Patent Owner also argued that Lim does not anticipate claims 1 and 12, because it fails to disclose capturing a state of a virtual machine. The Board was not persuaded by this position either, relying both on cited disclosures from Lim and also the testimony of Patent Owner’s own expert. Patent Owner additionally argued that the capturing step in claims 1 and 12 requires the virtual machine to continue executing while its state is captured (i.e., without suspending the virtual machine). But the Board instead agreed with Petitioner’s position that in view of the limitations in dependent claim 10 and 22, claims 1 and 12 must be interpreted to include, at least, suspending the virtual machine during capture.” Relying on expert testimony and its view that at least some of Patent Owner’s arguments were not commensurate with the scope of the claims, the Board found that dependent claims 11 and 12 were anticipated by Lim as well.

The Board then addressed Patent Owner’s arguments that claims 1, 11, 12, and 22 were anticipated by each of VMware ESX and VMware GSG; that claims 1 and 12 were anticipated by Suzaki; and that claims 11 and 22 would have been obvious in view of Suzaki and Wang. The Board found the aforementioned anticipation assertions to be convincing for reasons similar to those expressed in its analysis of Lim. As for the alleged obviousness of claims 11 and 22 in view of Suzaki and Wang, Patent Owner argued that “Petitioner’s proposed combination would be improper because Suzaki is an operating system based checkpointing method and Wang is an application based checkpointing method.” The Board was not persuaded, instead finding that Patent Owner had “[failed] to identify sufficiently why Wang’s application based checkpointing method would not work when applied to Suzaki’s checkpointing method.” Patent Owner also argued that the combination of Suzaki and Wang lacked material elements of claims 11 and 22 “because Wang teaches a log of committed updates and the claims require a ‘log of uncommitted updates.’” The Board was likewise unpersuaded by this argument because, according to the Board, Patent Owner had “[failed] to identify why the modification of the log of committed updates in Wang for a log of uncommitted updates along with Suzaki’s checkpointing method would not have been a simple substitution of a known element for another known element.”

Having found all challenged claims 1, 11, 12, and 22 unpatentable, the Board then addressed Patent Owner’s Motion to Amend which included a contingent request to substitute new claims 31-34 in place of claims 1, 11, 12, and 22. The Board denied the Motion to Amend for the following reasons.

Patent Owner had proposed to add new claim 31 which served to add certain terminology, including reference to a “backup program,” in the preamble. Nonetheless, the Board agreed with Petitioner that substitute claim 31 did not narrow the scope of original claim 1 “because Patent Owner did not identify how this modification to the preamble acts as a limitation on the claims” and that the amendments do not impart life, meaning, or vitality to the claim “because there are no limitations in the body of claim 31 that rely upon or find antecedents in the amended language in the preamble. Moreover, the Board found that the terms “backup program” and “separately executing virtual machine kernel” do not narrow the scope of claim 1 and “do not respond to a ground of unpatentability involved in the trial are not referred to in the body of substitute claim 31.” Thus, the Board denied the proposed substitution of claim 31 in place of original claim 1.

Patent Owner had also proposed substitute claims 32 and 33 as a vehicle for adding certain limitations to challenged claims 11 and 12, respectively. Nonetheless, Petitioner argued that proposed substitute claims 32 and 33 were each unpatentable over Lim in view of Li, positions with which the Board agreed. Accordingly, the Board denied the proposed substitution of claims 32 and 33 in place of original claims 11 and 12, respectively.

Patent Owner had additionally proposed substitute claim 34 as a means for adding limitations to challenged claim 22. The Board denied this attempt, finding that “Patent Owner’s proposed amendments in substitute claim 34 improperly broaden the scope of original claim 22 by removing limitations from the claim that are not equally added to the proposed substitute independent claim.”

Finally, Patent Owner had filed a Motion to Exclude specified sections of the Petition, Petitioner’s Reply to Patent Owner’s Response, and the declarations of Dr. Shenoy in support of these papers. According to Patent Owner: (1) “Petitioner and its expert, Dr. Shenoy, rely upon hypotheticals concerning how the software products discussed in the cited prior art may have worked and, thus, are outside the scope of subject matter disclosed in the prior art;” and (2) “Petitioner’s Reply to Patent Owner’s Response and the corresponding declaration of Dr. Shenoy mischaracterize the testimony of Patent Owner’s expert, Dr. Green.” Nonetheless, the Board denied Patent Owner’s Motion to Exclude, citing its “discretion to determine the appropriate weight to be accorded to evidence based on such factors as whether the expert testimony discloses the underlying facts or data on which the opinion is based” and “to assign appropriate weight to any mischaracterizations by one expert of another expert’s testimony.”

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Paper 54: Final Written Decision

Dated: July 29, 2014

Patent 7,093,086 B1

Before: Francisco C. Prats, Thomas L. Giannetti, and Trenton A. Ward

Written by: Ward

Related Proceeding: IPR2013-00141 (6,931,558 B1); IPR2013-00142 (6,931,558 B1); IPR2013-00143 (7,191,299 B1); Symantec Corp. v. Veeam Software Corp., Case No. 12-cv-00700-SI (N.D. Cal.)

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