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571-272-7822

Paper 17
Date: November 17, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

TOPIA TECHNOLOGY, INC.,
Patent Owner.

IPR2022-00782
Patent 10,067,942 B2

Before JOHN A. HUDALLA, MONICA S. ULLAGADDI, and
JOHN R. KENNY, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

Unified Patents, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 3–6, 10, and 12–15 (“the challenged claims”) of U.S. Patent No. 10,067,942 B2 (Ex. 1001, “the ’942 patent”), accompanied by the supporting Declaration of Dr. Darrell Long (Ex. 1005). Topia Technology, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).¹ With our authorization (*see* Ex. 3001; Paper 12), Petitioner filed a Reply (Paper 11, “Preliminary Reply” or “Prelim. Reply”) and Patent Owner filed a Sur-Reply (Paper 15, “Preliminary Sur-Reply” or “Prelim. Sur-Reply”) addressing discretion under 35 U.S.C. § 314(a) and 35 U.S.C. § 325(d).

The standard for institution is set forth in 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314; *see also* 37 C.F.R. § 42.4(a) (2021) (“The Board institutes the trial on behalf of the Director.”).

Having considered the parties’ arguments and the evidence of record, we determine that, for the reasons discussed herein, Petitioner demonstrates a reasonable likelihood that it would prevail with respect to at least one of the challenged claims. Patent Owner does not persuade us that we should exercise our discretion under 35 U.S.C. § 314(a) or 35 U.S.C. § 325(d) to deny institution. We thus institute an *inter partes* review on all challenged

¹ Patent Owner also filed a redacted version of the Preliminary Response. Paper 8.

claims on all asserted grounds. *See* 35 C.F.R. § 42.108(a); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide 64 (Nov. 2019) (“TPG”) (“The Board will not institute on fewer than all claims or all challenges in a petition.”).

II. BACKGROUND

A. *Real Parties in Interest*

A petition must identify all real parties in interest (“RPIs”). 35 U.S.C. § 312(a)(2). The petitioner bears the burden of persuasion to show that it accurately names all RPIs. *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1343 (Fed. Cir. 2018) (“*AIT*”) (citing *Zerto, Inc. v. EMC Corp.*, Case IPR2014-01295, slip op. at 6–7 (PTAB Mar. 3, 2015) (Paper 34)). We generally accept a petitioner’s initial identification of its RPIs unless the patent owner presents some evidence to support its argument that an unnamed party should be included as an RPI. *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018).

Petitioner identifies Unified Patents, LLC as the real party-in-interest. Pet. 82. Petitioner “further certifies that no other party exercised control or could exercise control over Unified’s participation in this proceeding, the filing of this petition, or the conduct of any ensuing trial.” *Id.* Petitioner asserts that, “[i]n view of *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242–44 (Fed. Cir. 2018), Petitioner has submitted voluntary discovery in support of its certification.” *Id.* (citing Ex. 1011 (First Declaration of Mr. Kevin Jakel)).

Patent Owner identifies Topia Technology, Inc. as the real party-in-interest. Paper 5, 1. Patent Owner contends that the Petition fails to name all RPIs as required by 35 U.S.C. § 312(a)(2) and, in particular, contends that

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Petitioner fails to name [REDACTED] as RPIs (“the alleged, unnamed RPIs”). Prelim. Resp. 19–20. Patent Owner acknowledges that “the Board has previously found that Unified Patents membership alone is insufficient ‘to make any member that has been sued on a patent an RPI for any Unified Patents petition challenging that same patent,’” but asserts that “this consideration was only in the § 312(a) context, not § 314(a).” Prelim. Sur-reply 7–8 (citing *Unified v. Arigna Tech. Ltd.*, IPR2022-00285, Paper 10, 6–7 (PTAB June 17, 2022) (“*Arigna*”). Patent Owner further argues that

in *Arigna*, the Board did not consider the plain language of Petitioner’s membership agreement(s). Petitioner’s membership agreement [REDACTED]

[REDACTED] . . . Petitioner continues to refuse to acknowledge that Topia is not an NPE, despite knowing this to be the case at least from publically [sic] available information, including Topia’s website (<https://www.topiatechnology.com>) and district court filings.

Id. at 8 (citing Ex. 2005, 4; Ex. 2013, 4) (footnote omitted).

Patent Owner further argues that, “[i]f trial is instituted, [REDACTED] [REDACTED] not held to be real parties in interest, [REDACTED] [REDACTED] will be able to avoid the deleterious effects of the estoppel that attaches to the parties in an IPR proceeding,” and that, “even if Petitioner were to prevail [REDACTED]” *Id.* at 9 (citing *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 24 (PTAB Oct. 2, 2020) (precedential) (“*AIT Remand*”). Patent Owner further argues that, “as in *AIT Remand*, Unified Patents has a strong

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incentive to act on behalf of its members [REDACTED]

[REDACTED] and that [REDACTED]

[REDACTED]” *Id.* (citing Ex. 2005, 15; Ex. 2013, 15).

Whether a particular entity is an RPI is a “highly fact-dependent question” that is assessed “on a case-by-case basis.” TPG, 77 Fed. Reg. at 48759. We consider the following factors: whether a non-party is funding, directing, or controlling the IPR; whether the non-party had the ability to exercise control; the non-party’s relationship with the petitioner and with the petition, including any involvement in the filing; and the nature of the entity filing the petition. *Id.* at 48759–60.

Patent Owner’s contentions are unavailing, at this stage of the proceeding. Initially, we note that irrespective of whether we consider the issue of proper identification of RPI with respect to § 312(a) or § 314(a), the inquiry remains the same and is governed by the TPG and precedential case law.

The facts of this case are distinguishable from *AIT* where Salesforce—the alleged unnamed RPI—made a payment to Petitioner RPX shortly before RPX filed its petition, discussed the patent and related litigation with RPX, shared a board member with RPX, and where RPX negotiated a license on behalf of Salesforce. *AIT*, 897 F.3d at 1336. Further, unlike in the present proceeding, the alleged unnamed RPI in *AIT* would have been barred from filing a petition because of the time bar under 35 U.S.C. § 315(b). *Id.* at 1338–39.

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1. Time Bar and Estoppel

According to *SharkNinja Operating LLC v. iRobot Corp.*, IPR2020-00734, Paper 11 at 18 (Oct. 6, 2020, PTAB) (precedential), at the institution stage, “the Board need not address whether a party is an unnamed RPI where no time bar or estoppel provisions under 35 U.S.C. § 315 are implicated.” In the present proceeding, Patent Owner does not allege that [REDACTED] [REDACTED] would have been time barred, so this proceeding does not implicate § 315(b). *Cf. Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, Case IPR2017-00651 (Jan. 24, 2019) (Paper 152) (precedential). We also note that estoppel under § 315(e) only arises after “a final written decision under section 318(a)” has issued with respect to a challenged claim. *See* 35 U.S.C. §§ 315(e)(1), (2). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Therefore, because we determine that neither the time bar nor estoppel provisions of 35 U.S.C. § 315 are implicated in this case, at this stage, “we need not address whether [REDACTED] is an unnamed RPI.” *SharkNinja*, IPR2020-00734, Paper 11 at 18.

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Consistent with *SharkNinja*, we decline to decide, at this stage, whether the additional parties identified by Patent Owner should have been named as real parties-in-interest in the Petition.

B. Related Matters

The parties indicate that the '942 patent is involved in the following district court cases: *Topia Technology, Inc. v. Egnyte, Inc.*, No. 1:21-cv-01821 (D. Del.) (filed Dec. 27, 2021); *Topia Technology, Inc. v. Dropbox, Inc.*, No. 6:21-cv-01373 (W.D. Tex.) (filed Dec. 29, 2021); and *Topia Technology, Inc. v. Box, Inc.*, No. 6:21-cv-01372 (W.D. Tex.) (filed Dec. 29, 2021). Pet. 82; Paper 5, 1.

The parties further indicate that the '942 patent is related to the following patents and patent applications: U.S. Patent No. 10,289,607 (maturing from U.S. Application No. 16/017,348); U.S. Patent No. 11,003,622 (maturing from U.S. Application No. 16/361,641); U.S. Patent No. 10,642,787 (maturing from U.S. Application No. 16/750,399); U.S. Patent No. 10,754,823 (maturing from U.S. Application No. 16/750,435); and U.S. Patent Application No. 17/306,548 (currently pending). Pet. 82; Paper 5, 1–2.

C. The '942 Patent

The '942 patent is titled “Architecture for Management of Digital Files Across Distributed Network.” Ex. 1001, code (54). The '942 patent concerns sharing files between electronic devices and aims to improve file transfer and synchronization between a user’s multiple computing devices. *Id.* at 1:18–36, 4:49–54. Figure 2 of the '942 patent shows an embodiment of the invention and is reproduced below.

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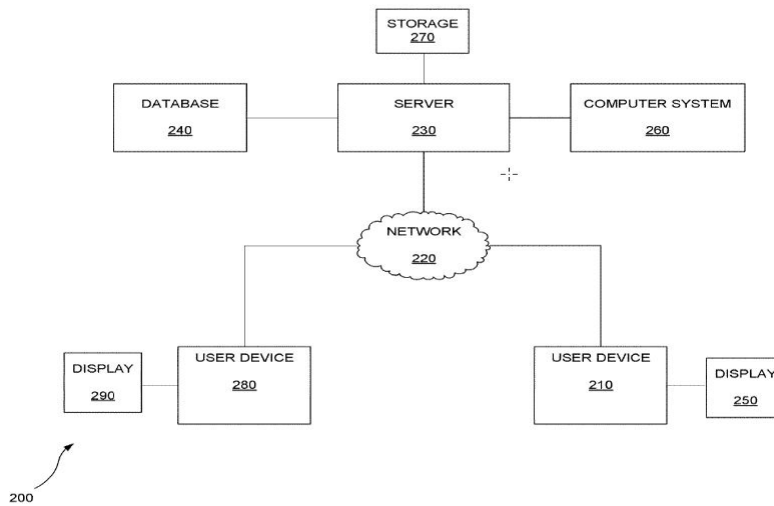


FIG. 2

Figure 2 shows computer network system 200 including electronic user devices 210, 280, such as personal computers or workstations, that are linked via network 220 (e.g., the Internet) to an electronic device or system, such as server 230. *Id.* at 7:26–32. Applications running on one or more user devices 210, 280 can cooperate in two-way communication with server 230 and one or more applications running on server 230. *Id.* at 7:49–54. A file-transfer and/or synchronization application on user devices 210, 280 having a user interface allows a user to view, access, and/or organize files to be synched among the user devices. *Id.* at 7:65–8:15.

A file that the user desires to be synched or shared is uploaded by user device 210 and received by server 230. *Id.* at 8:16–18, 8:32–44. Server 230 stores the received file to storage 270 if destination user device 280 is offline or otherwise temporarily not in communication with server 230. *Id.* at 8:26–29, 8:45–63. Upon resuming communication with destination user device 280, server 230 transfers the temporarily stored file to user device 280, whereupon the previous version of the file on user device 280 is replaced with the latest version of the file modified on user device 210. *Id.* at 8:29–

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31, 8:51–59. A similar reverse-direction synchronization process may be performed with regard to a file modified on user device 280 and synchronized to user device 210. *Id.* at 8:63–67.

D. Illustrative Claim

Claims 1 and 10 are independent. For purposes of the issues raised at this stage of the proceeding, claim 10 is illustrative and is reproduced below.

[10P] A method comprising:

[10.1] receiving, via a first application at a first electronic device, a copy of a modified first electronic file from a second application at a second electronic device associated with a user, wherein the modified first electronic file copy is automatically received from the second application responsive to the user modifying a content of the first electronic file;

[10.2] determining whether the first electronic device is in communication with a third electronic device;

[10.3] automatically sending, via the first application, the modified first electronic file copy to a third application at the third electronic device responsive to the determination that the first electronic device is in communication with the third electronic device and responsive to receiving the modified first electronic file copy from the second electronic device;

[10.4] receiving, via the first application, a copy of a modified second electronic file from the third application at the third electronic device associated with the user, wherein the modified second electronic file copy is automatically received from the third application responsive to the user modifying a content of the second electronic file;

[10.5] determining whether the first electronic device is in communication with the second electronic device; and

[10.6] automatically sending, via the first application, the modified second electronic file copy to the second application at the second electronic device responsive to the determination that the first electronic device is in communication with the second

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electronic device and responsive to receiving the modified second electronic file copy from the third electronic device,

[10.7] wherein, responsive to sending the modified first electronic file copy to the third electronic device, an older version of the first electronic file stored on the third electronic device is automatically caused to be replaced with the modified first electronic file copy such that the modified first electronic file copy is stored on the third electronic device in lieu of the older version of the first electronic file, and

[10.8] wherein, responsive to sending the modified second electronic file copy to the second electronic device, an older version of the second electronic file stored on the second electronic device is automatically caused to be replaced with the modified second electronic file copy such that the modified second electronic file copy is stored on the second electronic device in lieu of the older version of the second electronic file.

Ex. 1001, 12:16–64 (bracketed numbering added).

E. Asserted Grounds

Petitioner presents the following challenges as summarized in the chart below. Pet. 9. Petitioner supports its challenges with the Declaration of Dr. Darrell Long. Ex. 1005.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3, 4, 10, 12, 13	103(a) ²	Strong ³ , Brezak ⁴

² 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 after the effective filing date of the challenged claims. The earliest possible filing date is November 9, 2007. Ex. 1001, code (60). Therefore, we apply the pre-AIA versions of 35 U.S.C. §§ 102 and 103(a).

³ U.S. Patent Pub. No. 2006/0101064 A1, published May 11, 2006, to Strong et al. (Ex. 1006, “Strong”).

⁴ U.S. Patent Pub. No. 2006/0242206 A1, published October 26, 2006, to Brezak et al. (Ex. 1007, “Brezak”).

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Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
5, 6, 14, 15	103(a)	Strong, Brezak, Hamidi ⁵
1, 3, 5, 6, 10, 12, 14, 15	103(a)	Hamidi, Ellman ⁶
1, 3, 5, 6, 10, 12, 14, 15	103(a)	Hamidi, Ellman, Brezak

III. ANALYSIS

A. *Legal Standards*

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness.⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. *Level of Ordinary Skill in the Art*

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are

⁵ U.S. Patent Pub. No. 2004/0267697 A1, published December 30, 2004, to Hamidi (Ex. 1008, “Hamidi”).

⁶ WIPO Pub. No. WO 00/75781 A1, published December 14, 2000, to Ellman et al. (Ex. 1009, “Ellman”).

⁷ Patent Owner does not present objective evidence of nonobviousness at this stage of the proceeding.

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made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

According to Petitioner,

[a] person of ordinary skill in the art (“POSA”) would have been one having, by November 9, 2007: (1) an undergraduate degree in computer science, computer engineering, or closely-related field, or similar advanced post-graduate education; and (2) two or more years of experience with file sharing systems, with more experience substituting for less education and vice versa.

Pet. 6 (citing Ex. 1005 ¶¶ 34–36). Patent Owner does not provide a description of the level of ordinary skill in the art.

At this stage of the proceeding, we adopt Petitioner’s definition of the level of skill in the art, which is consistent with the disclosure of the ’942 patent and asserted prior art of record.

C. Claim Construction

In *inter partes* review proceedings, we construe claims using the same claim construction standard that would be used in a civil action under 35 U.S.C. § 282(b), as articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. *See* 37 C.F.R. § 42.100(b) (2022).

Petitioner contends that “[c]onstruction is unnecessary because the Challenged Claims are obvious under any reasonable construction.” Pet. 6. Petitioner further argues that the claim limitations should not be interpreted to invoke 35 U.S.C. § 112 ¶ 6. *Id.* at 6–8. Patent Owner does not propose to construe any claim term.

We need not construe any claim term to resolve the institution question, and therefore, do not expressly define any claim term in our

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Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (explaining that construction is needed only for terms that are in dispute, and only as necessary to resolve the controversy).

D. Discretion to Deny Under 35 U.S.C. § 314(a)

Patent Owner contends that we should deny institution because of the co-pending, district court litigations. Prelim. Resp. 9–10 (citing *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”)); *supra* § II.B (district court cases identified as related matters). Patent Owner argues that the Board should not institute this *inter partes* review in view of our precedent and based on the advanced state of the parallel litigations in the Western District of Texas. *Id.* For the reasons that follow, we decline to exercise our discretion to deny the Petition on that basis.

Even when a petitioner has demonstrated that it is likely to prevail in showing one of the claims is unpatentable, the Board has discretion to deny a petition. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). Several nonexclusive factors that balance considerations of system efficiency, fairness, and patent quality when a patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding are:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;

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3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6. “[I]n evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6; *see also Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation* (June 21, 2022) (“Director’s *Fintiv* memo”) (*see* page 9 stating this Memorandum “applies to all proceedings pending before the Office” and instructing how the Board is to apply *Fintiv*).

The Director’s *Fintiv* Memo states that, “[w]here the PTAB determines that the information presented at the institution stage presents a compelling unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*.” Director’s *Fintiv* Memo, 4–5. Further, “[c]ompelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Id.* at 4; *see OpenSky Industries, LLC v. VLSI Technology LLC*, IPR2021-01064, Paper 102 at 49–50 (PTAB Oct. 4, 2022) (“A challenge can only ‘plainly lead to a conclusion that one or more claims are unpatentable’ if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.”) (precedential Director Decision).

On the current record, as set forth in Sections III.F–H below, we determine that Petitioner has set forth compelling unpatentability challenges

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such that the evidence, if unrebutted in trial, demonstrates that “it is highly likely that the [P]etitioner would prevail with respect to at least one challenged claim.” *See OpenSky Industries*, Paper 102 at 49–50. Further, we agree with Petitioner that Patent Owner’s “merits arguments,” to the extent there are merits arguments independent of § 325(d) arguments, “are based on distinguishable file history art or are directly contradicted by the strong grounds presented in the Petition.” Prelim. Reply 7; *infra* III.E (setting forth Patent Owner’s arguments concerning the Mohanty and Multer references set forth during prosecution of the ’942 patent and the parent of the ’942 patent). For the reasons below in our analysis, we determine that the merits of Petitioner’s obviousness ground based on Strong and Brezak appears to be particularly strong for the independent claims 1 and 10, and dependent claims 3, 4, 12, and 13. *Infra* § III.F (explaining that, on the current record, Petitioner has shown that Strong and Brezak read on independent claims 1 and 10, and dependent claims 3, 4, 12, and 13). Because Petitioner presents compelling evidence of unpatentability at this stage, we decline to exercise our discretion under § 314(a) to deny the Petition.

E. Discretion to Deny Under 35 U.S.C. § 325(d)

Institution of post grant review is discretionary. *See Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”); 35 U.S.C. § 314(a). Pursuant to 35 U.S.C. § 325(d), in determining whether to institute *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art

or arguments previously were presented to the Office.” In evaluating arguments under § 325(d), we use

[a] two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). In applying the two-part framework, we consider several non-exclusive factors, including:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (listing factors to consider in evaluating the applicability of § 325(d)).

Factors (a), (b), and (d) of the *Becton, Dickinson* factors relate to whether the art or arguments presented in the petition are the same or

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substantially the same as those previously presented to the Office. *Advanced Bionics*, 10. Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Only if the same or substantially the same art or arguments were previously presented to the Office do we then consider whether the petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

As part of our analysis under the first prong of the *Advanced Bionics* framework, we evaluate *Becton, Dickinson* factors (a), (b), and (d) with respect to the facts of the present proceeding. *Id.* at 9–10 n.10 (citing *Becton, Dickinson*, Paper 8 at 17–18). Patent Owner contends that the “[P]etition relies upon prior art that is similar to the prior art previously considered and distinguished by the Patent Office during prosecution of the ’942 Patent, and the arguments presented by Petitioner add nothing new from what was already known and considered by the Examiner during prosecution of the ’942 Patent.” Prelim. Resp. 22. Patent Owner does not argue that the Strong and Hamidi references, which form the bases of Petitioner’s challenges in the present proceeding, were cited during the prosecution of the ’942 patent. Instead, Patent Owner argues that these references “are cumulative of references considered and distinguished by the Patent Office during prosecution.” *Id.* at 24.

*1. Whether Strong is Cumulative to Prosecution References
Mohanty and Multer*

Patent Owner notes that the then-pending claims of the ’942 patent were rejected as anticipated by Mohanty in an Office Action dated

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December 18, 2017.⁸ *Id.* at 25 (citing Ex. 2001, 117). Patent Owner contends that

[t]he Examiner relied upon paragraphs [0032], [0044] and FIG. 5 of Mohanty as teaching the features, “receive a copy of a modified first electronic file from a second application at a second electronic device associated with the user, wherein the modified first electronic file copy is automatically transferred from the second application responsive to the user modifying a content of the first electronic file” and “automatically cause, via the first application, an older version of the first electronic file stored on the third electronic device to be replaced with the modified first electronic file copy such that the modified first electronic file copy is stored on the third electronic device in lieu of the older version of the first electronic file,” that were originally recited in claim 1.

Id. at 26 (citing Ex. 1002, 117–118). According to Patent Owner, “Mohanty . . . discloses in paragraph [0009] that the system may be configured to recognize when an instance of a file has been changed, and update other instances of that file according to flexible synchronization rules, and discloses in paragraph [0045] that the synchronization rules generally provide for a real-time propagation of ***changes to files***.” *Id.* at 25–26 (citing Ex. 2001 ¶¶ 9, 45). Patent Owner further argues that “Mohanty states in paragraph [0044] that synchronization generally refers to the process of ***proliferating changes*** in one instance of a file to other instances of the file throughout the network.” *Id.* at 26 (citing Ex. 2001 ¶ 44).

Patent Owner contends that, during prosecution of the ’942 patent, Patent Owner distinguished Mohanty on the basis that “Mohanty merely provides for weighted merging of ***changes*** so as to provide file

⁸ U.S. Patent Publication No. 2007/0180084 A1, filed February 1, 2006, published August 2, 2007 to Mohanty. Ex. 2001.

synchronization and . . . Mohanty fails to disclose that the mobile device 12 automatically receives a modified *copy of an electronic file* responsive to a user modifying content of the electronic file.” *Id.* at 27–28 (citing Ex. 1002, 153) (emphasis added). Patent Owner further contends that “[t]here are no material differences between Strong and Mohanty evaluated during prosecution” because “Strong discloses that a synchronization engine is provided on a server platform and is configured to send real-time *updates* (i.e., *changes*, as opposed to a modified file).” *Id.* at 28 (citing Ex. 1006 ¶ 27, Fig. 2, Abstract).

Strong concerns “[a] server synchronization engine sends real-time updates to client devices when [a user] updates a file.” Ex. 1006, code (57). In the cited portion, Strong discloses that

if changes are made by one of the sharing clients 34 to a particular data object, an update message 30 is sent from the particular sharing client to the synchronization engine 32. The synchronization engine, in turn, will make the particular adjustment to the original or copy of the data object on the server and distribute the data object out to each of the sharing clients 34. The update message 30 may include instructions, such as a delete command to remove a particular data object or a modify command for modifying a particular data object. One way of representing a modification to an existing data object or the creation of a new data object is to include the actual data object in its modified form.

Id. ¶ 27. According to Patent Owner, “in Strong, when there are changes made to a particular data object (as opposed to a content of a file), an ‘update message’ 30 is sent from a sharing client to the synchronization engine 32” and “[t]he update message 30 is only described as instructions such as a delete command to remove a particular data object or a modify

command for modifying a particular data object.” Prelim. Resp. 29 (citing Ex. 1006 ¶ 27). Patent Owner further contends that

[a]ll that is disclosed in Strong is only that updated message including a command to remove a particular data object or modifying a particular data object is sent to the synchronization engine 32. There is no teaching or suggestion in Strong or in the knowledge of a person of ordinary skill in the art (“POSA”) who looks at Strong to send a copy of a modified first electronic file to a server. Strong’s disclosure fails to support such dramatic leap in logic.

Id. at 30 (citing Ex. 1006 ¶ 27).

Patent Owner further contends that “[t]his aspect is further evidenced by the prosecution history of Strong.”⁹ *Id.* (citing Ex. 2019, 43). Patent Owner argues that

⁹ Patent Owner quotes the following portion of Strong’s file history:

Independent claims 1 and 5 have been amended to recite “automatically determin[ing] whether to send the (real-time update)/(information associated with the changes) to the server-side synchronization engine.” For convenience and without limitation, support for automatically determining may be found in paragraph [0007] and [0028] (e.g., “Changes to files, email, and/or calendar entries may be synchronized automatically across a user’s computers . . . The system may be configured for transparent backup to a central server.” and “This two way [sic] synchronization may occur in real-time which, for example and not limitation, may occur with the files being updated whenever an autosave occurs to the data or file being edited.”). In the system of Kley, updates are performed when the system is instructed by the user to check in changes. “Once the selected data file 184 has been updated, then the current system user invokes the access control manager 156 using the user interface 134 and requests that the corresponding portion of the group activity and the selected data file be checked in.” (Col. 11, lines 26–32) This is not the same as “automatically determin[ing]

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Applicant clarified that the term “real-time update” recited in independent claims 1 and 5 means “information associated with the changes”, and that the synchronization in Strong may occur in real-time, which may occur with the files being updated whenever an autosave occurs to the data or file being edited). The “real-time update” and the “autosave” features imply that what Strong does is to merely send, in real time, information about the changes even before the changes are committed to a file. Therefore, to the extent that Strong requires the “real-time update” to be sent instantaneously when there is a change, including when an autosave occurs to the data or file, Strong teaches *away* from sending a copy of the modified first electronic file.

Id. Patent Owner characterizes Petitioner as “argu[ing] that Strong teaches that the entire or ‘actual data object in its modified form’ may be shared at paragraph [0027], which discloses the server receiving a copy of a modified first electronic file.” *Id.* Patent Owner contends that Petitioner’s position “is a mischaracterization of Strong” because “[s]ending an actual data object or an entire object is a completely different concept from sending an entire electronic file.” *Id.* (citing Pet. 15–17).

Petitioner responds to Patent Owner’s arguments by arguing that, “[i]n Strong, an update may be represented as an ‘entire data object’ in its ‘modified form,’ and Strong identifies a picture **file** as one example of a data object.” Prelim. Reply 2 (citing Pet. 12, 17–18; Ex. 1006 ¶ 27, claims 6 and 7). Petitioner argues that Patent Owner “misinterprets Strong by focusing on Strong’s file history.” *Id.* (citing Prelim. Resp. 35). Petitioner argues that

whether to send the (real-time update)/(information associated with the changes) to the server-side synchronization engine” as recited in amended claims 1 and 5. Claims 1 and 5 are therefore believed to be allowable.

Ex. 2019, 43.

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Strong's file history does not change its disclosure, which does not equate the word "update" with "change." Second, the file history excerpt cited by Topia distinguished a reference on the basis that it required a user to **manually** instruct a system to perform updates while Strong's claims recited a system that **automatically** did so.

Id. (citing Ex. 1006 ¶ 26; Ex. 2019, 43).

Based on the current record, we disagree that Strong is cumulative to Mohanty. We disagree with Patent Owner's argument that "[t]he update message 30 is *only* described as instructions such as a delete command to remove a particular data object or a modify command for modifying a particular data object" because Strong *also* discloses "[o]ne way of representing a modification to an existing data object or the creation of a new data object *is to include the actual data object in its modified form*" in which the data object is, for example, a "picture file" or an "email message," as Petitioner persuasively contends. Prelim. Resp. 29 (citing Ex. 1006 ¶ 27) (emphases added); Ex. 1006 ¶ 27, claims 6, 7.

Patent Owner's assertion that "[s]ending an actual data object or an entire object is a completely different concept from sending an entire electronic file" is not, at this stage, supported by evidence. Prelim. Resp. 30 (citing Pet. 15–17); *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) ("Attorney's argument in a brief cannot take the place of evidence."); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984) (lawyer arguments and conclusory statements which are unsupported by factual evidence are entitled to little probative value); *see In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997). At this stage of the proceeding, there also is insufficient evidence of record that would support a finding that Strong's "'real-time update' and . . . 'autosave' features imply that what Strong does is to merely

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send, in real time, information about the changes even before the changes are committed to a file” and that “Strong teaches *away* from sending a copy of the modified first electronic file.” *See id.*; Prelim. Resp. 30 (citing Ex. 2019, 43). Should Patent Owner maintain these arguments after institution of trial, Patent Owner should cite supporting evidence.

We further disagree that amendments to Strong’s pending independent claims 1 and 5 made during the prosecution limit Strong’s disclosure of “representing a modification to an existing data object or the creation of a new data object” by “includ[ing] the actual data object in its modified form.” Ex. 1006 ¶ 27. Strong’s dependent claims 6 and 7 limit the claimed “data object” recited in independent claim 5, not the claimed “changes made to the data object among the clients,” nor the claimed “real-time update” as Patent Owner asserts Strong’s independent claims 1 and 5 were subsequently amended to recite. *See* Prelim. Resp. 30 (citing Ex. 2019, 43). We further agree with Petitioner that in the cited portion of Strong’s prosecution history (Ex. 2019, 43), the Applicant distinguished Strong from Kley on the basis that user intervention was required, not on a basis that might have limited Strong’s claims to delta coding. In any event, the cited portion of Strong’s prosecution history does not limit the cited *disclosure* in Strong.

Patent Owner also presents substantially similar arguments in support of its position that Strong is cumulative to Multer.¹⁰ Prelim. Resp. 32–36. Patent Owner argues that, during the prosecution of U.S. Patent No. 9,143,561 (“the ’561 patent”), the parent to the ’942 patent, Patent Owner distinguished Multer on the basis that “Multer discloses a data transfer and file synchronization system that utilizes a common data store

¹⁰ EP1130511 A2, published September 5, 2001, to Multer. Ex. 2002.

that syncs to each of a plurality of systems by updating ‘*difference information.*’” *Id.* at 34 (quoting Ex. 1010, 266–267). Patent Owner further argues that “Multer, similar to Strong, is directed to ‘difference’ or ‘change’ information, which has an architecture that is fundamentally different from the claims of the ’942 patent.” *Id.* at 35; *see id.* at 36 (“Strong discloses that a synchronization engine is configured to send real-time *updates* (*i.e.*, *changes*, as opposed to a modified file) to a plurality of sharing clients when at least one of the sharing clients updates or changes one of said files, even before committing the changes to the file.”). Patent Owner also argues that it “made the distinction that claim 1 of ’561 Patent was patentable over McBride and Multer at least because nothing in Multer discloses such automatic receipt of such files when the user modifies the files.” *Id.* (citing Ex. 1010, 266–267) (footnote omitted).

Based on the current record, we disagree that Strong is cumulative to Multer. For the reasons discussed above with respect to Strong and Mohanty, we disagree that Strong is limited to synchronizing files by transferring only “difference” or “change” information. *See, e.g.*, Ex. 1006 ¶ 27, claims 6, 7.

2. *Whether Hamidi is Cumulative to Prosecution References
Mohanty and Multer*

Patent Owner’s analogizes Hamidi to Mohanty because, like Mohanty, “Hamidi discloses that a synchronization engine is provided on a server platform and is configured to send real-time *updates* (*i.e.*, *changes*, as opposed to a modified file) to a plurality of sharing clients when at least one of the sharing clients updates or changes one of said files.” Prelim. Resp. 37 (citing Ex. 1008, code (57)); *see id.* at 38–39 (citing Ex. 1008 ¶¶ 39–42).

As discussed above, Patent Owner contends that “Multer discloses a data transfer and file synchronization system that utilizes a common data store that syncs to each of a plurality of systems by updating ‘difference information.’” Prelim. Resp. 41 (emphasis omitted). Patent Owner explains that

Multer discloses a differencing transmitter on system A will extract differences in a file known to exist on System B, and any new files, and transmit **only those differences** to a differencing receiver 102 on System B which will reconstruct the differences on System B to synchronize System B with System A.

Id. (citing Ex. 2002 ¶¶ 30, 31). Patent Owner contends that “[t]here are no material differences between Hamidi and Multer evaluated during prosecution of the ‘561 patent (i.e., the parent application).” *Id.* at 42.

Based on these arguments, Patent Owner contends that “Hamidi is fundamentally directed to delta coding.” Prelim. Sur-Reply 3.

Petitioner responds that “Hamidi is expressly not limited to delta coding because it discloses the use of ‘the storage and distribution of entire files instead of changes files.’” Prelim. Reply 2 (citing Pet. 59–60 (quoting Ex. 1008 ¶ 55)) (emphasis omitted). Petitioner further contends that “Hamidi is cited in combination with Ellman, which undisputedly supports whole-file transfers.” *Id.* at 3 (citing Pet. 59–62) (footnote omitted). Patent Owner’s arguments that Hamidi is limited to delta coding are not availing because Hamidi expressly discloses what Petitioner says it does:

while it is believed that Saving and distributing changes files is more efficient than saving entire network storage files, it will be apparent to one of skill in the art that a variation of the system according to either of the first and second embodiments of the invention *supports the storage and distribution of entire files instead of change files.*

Ex. 1008 ¶ 55 (emphasis added). Patent Owner does not appear to address this portion of Hamidi. Accordingly, we disagree that Hamidi is limited to synchronizing files by delta coding. *See, e.g., id.* Based on the current record, we disagree that Hamidi is cumulative to Mohanty or Multer.

3. Conclusion

For the foregoing reasons, we are not persuaded that any of *Becton, Dickinson* factors (a), (b), and (d) under the first prong of the *Advanced Bionics* framework is sufficiently implicated. As such, we do not proceed to the second prong of the *Advanced Bionics* framework. In view of the above, we are not persuaded to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

F. Obviousness over Strong and Brezak

Petitioner argues that claims 1, 3, 4, 10, 12, and 13 would have been obvious in view of Strong and Brezak. Pet. 11–42. Patent Owner does not specifically dispute Petitioner’s challenge. *See generally* Prelim. Resp. For the reasons that follow, we are persuaded that Petitioner demonstrates sufficiently a reasonable likelihood of prevailing with respect to its obviousness challenge to claims 1, 3, 4, 10, 12, and 13 applying Strong and Brezak.

1. Overview of Strong

Strong is entitled “Method and Apparatus for a File Sharing and Synchronization System.” Ex. 1006, code (54). Strong discloses a file synchronization system in which a server platform synchronizes files across multiple computing devices. *Id.* ¶ 8. A server synchronization engine sends real-time updates to client devices when one updates a file. *Id.* at code (57).

2. Overview of Brezak

Brezak is entitled “System and Method for Peer to Peer Synchronization of Files.” Ex. 1007, code (54). Brezak relates to sharing files between machines in a peer-to-peer environment. *Id.*, code (57). A sync engine allows users to designate files for sharing with selected machines on an automatically consistent basis. *Id.* Each machine may detect and discover connectivity status to other machines within the group. *Id.* ¶ 6.

3. Independent Claim 10

[10P] “A method comprising:”

Petitioner contends that “Strong discloses ‘methods of synchronizing data.’” Pet. 14 (citing Ex. 1006 ¶ 2, code (57)) (emphasis omitted).

[10.1] “receiving, via a first application at a first electronic device, a copy of a modified first electronic file from a second application at a second electronic device associated with a user, wherein the modified first electronic file copy is automatically received from the second application responsive to the user modifying a content of the first electronic file;”

According to Petitioner, Strong’s “[s]erver 22 includes a synchronization engine (i.e., a first application at a first electronic device), which receives updated versions of data objects from an application running on one of the user’s devices, individually and collectively referred to as sharing clients 34.” Pet. 17 (citing Ex. 1006 ¶¶ 21, 26, 29).

Petitioner contends that “[t]he entire or ‘actual data object in its modified form’ may be shared; therefore, Strong discloses the server receiving a copy of a modified first electronic file.” *Id.* (citing Ex. 1006 ¶ 27, 28, 31, claims 6, 7; Ex. 1005 ¶ 49). Further, Petitioner contends that “Strong discloses that the modified first electronic file copy is automatically received from the second application responsive to the user modifying a content of

the first electronic file.” *Id.* at 18 (emphasis omitted) (citing Ex. 1006 ¶ 37 (“When a user with a sharing client 34 makes changes to albums or files on a local computer, the changes are synchronized automatically across all devices.”), Fig. 4 (“[c]hanges to albums synchronized automatically across all devices.”)).

Petitioner also contends that “Strong discloses that the file is automatically received by the server responsive to the user modifying a content of first electronic file because it discloses that the synchronization occurs in ‘real time,’ and ‘may occur with the . . . file being updated.’” *Id.* at 18–19 (citing Ex. 1006 ¶¶ 28, 22 (“If the user makes a change on one computer to the database or a file, the change is synchronized to the server and synchronized in real-time to the user’s other computers.”)) (emphasis omitted). “As another example, Strong discloses that the file may be sent with every autosave of the file and that the application auto-saves changes as a user makes edits.” *Id.* at 19 (citing Ex. 1006 ¶¶ 28, 40). According to Petitioner, “[t]he second electronic device is associated with the user in that it belongs to the user or is accessed by logging into an application running on a computer.” *Id.* (citing Ex. 1006 ¶¶ 22, 30, 31, 40 (“[C]hanges will be saved to the datastore and synchronized to other computers belonging to the user who made the changes.”), Figs. 1–3) (emphasis omitted).

Petitioner contends that “[e]ach sharing client 34 preferably runs as an application installed on the device” and that “[a] POSA would have appreciated that the synchronization engine is a first application because Strong depicts it as an independent module that is part of a collection of server applications.” *Id.* (citing Ex. 1006 ¶¶ 8, 22, 31, 36, 43) (emphasis omitted); *see id.* at 20–21 (citing Ex. 1005 ¶¶ 55, 56; Ex. 1006 ¶¶ 20, 25).

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[10.2] “determining whether the first electronic device is in communication with a third electronic device;”

According to Petitioner, “Strong discloses that certain operations in its system occur only if the first electronic device (server 22) is in communication with a third electronic device (another device running sharing client 34, such as a laptop).” Pet. 21 (citing Ex. 1006 ¶¶ 23–25, 32, (“When a continuous connection is not available, then the next time the user is connected, the changes will be synchronized.”), 33, 34) (emphasis omitted). Petitioner contends that, “[t]herefore, Strong at least implies that this determination step occurs, as a POSA would have appreciated given the nature of server-client communications, in which servers ‘listened’ for potential clients and accepted connections and serviced requests.” *Id.* at 22 (citing Ex. 1005 ¶¶ 40, 41, 65, 66).

Petitioner alternatively takes the position that Brezak expressly discloses limitation 10.2. *Id.* Petitioner contends that “Brezak describes the use of a ‘sync engine’ to synchronize file changes between different machines, where the sending machine first ‘detect[s] the connection status’ of another to ‘determine those occasions when those machines enjoy connectivity between each other or other participating hardware’ (i.e., determining whether a first electronic device is in communication with another electronic device), via wired connections or wireless communication channels, or by tunneling through firewall resources.” *Id.* at 22–23 (citing Ex. 1007 ¶¶ 15, 23 (“In step 410, the network connection status of those designated machine or machines may be automatically discovered, for instance by sync engine 108 or other logic.”)) (emphasis omitted).

[10.3] “automatically sending, via the first application, the modified first electronic file copy to a third application at the

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third electronic device responsive to the determination that the first electronic device is in communication with the third electronic device and responsive to receiving the modified first electronic file copy from the second electronic device;”

Petitioner contends that Strong discloses that

the synchronization engine on server 22 automatically pushes the updated file copy (e.g., automatically sending, via the first application, the modified first electronic file copy) to another sharing client 34 of another device, such as a laptop (i.e., to a third application at the third electronic device) upon receiving the updated copy from the first sharing client 34 of a device, such as a desktop (i.e., responsive to receiving the modified first electronic file copy from the second electronic device).

Pet. 27 (citing Ex. 1006 ¶¶ 22, 26, 27 (update may comprise sending the entire data object), 29, 31 (“[F]iles in datastore 40 are again pushed out to other sharing clients 34 so that the most recent versions are available to the users”), 37, 40, 42 (“[T]he user can modify a picture . . . Immediately, those changes will be synchronized across all of the user’s multiple computers or device[s].”)) (emphasis omitted); *see id.* at 28–29 (citing Pet. § IV.A.4 (discussing limitations 10.2–10.3); Ex. 1007 ¶¶ 23, 24, Fig. 4).

[10.4] “receiving, via the first application, a copy of a modified second electronic file from the third application at the third electronic device associated with the user, wherein the modified second electronic file copy is automatically received from the third application responsive to the user modifying a content of the second electronic file;”

[10.5] “determining whether the first electronic device is in communication with the second electronic device; and”

[10.6] “automatically sending, via the first application, the modified second electronic file copy to the second application at the second electronic device responsive to the determination that the first electronic device is in communication with the second

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electronic device and responsive to receiving the modified second electronic file copy from the third electronic device,”

According to Petitioner, “[e]lements 10.4, 10.5, and 10.6 are like elements 10.1, 10.2, and 10.3, respectively, but for a second file copy going in the opposite direction.” Pet. 29. Petitioner contends that

[f]or the same reasons discussed regarding elements 10.1 through 10.3, Element 10.4 is disclosed by Strong or at most an obvious variation of Strong’s disclosure, and Elements 10.5 and 10.6 are obvious over Strong in view of Brezak. Strong discloses the bi-directional functionality claimed for a modified second file copy originating from the third device and sent to a second device. Strong describes its synchronization method as “two way” and uses the same reference number, 34, to refer to the different client applications and illustrates the reciprocal functionality of the client devices in Figure 3. Further, Strong explains and illustrates that the operations described are applicable for *each* of the devices running sharing clients 34.

Id. at 30 (citing Ex. 1006 ¶¶ 6–8, 23–26, 30–33, 37 (“When a user with a sharing client 34 makes changes . . . the changes are synchronized automatically across all devices.”), 40, 42). Petitioner further contends that “[t]his bi-directionality applies for multiple files *and* where the same file copy is modified.” *Id.* at 31 (citing Ex. 1006 ¶¶ 28, 35); *see id.* at 32 (citing Ex. 1005 ¶¶ 45–47, 53, 57–59).

[10.7] “wherein, responsive to sending the modified first electronic file copy to the third electronic device, an older version of the first electronic file stored on the third electronic device is automatically caused to be replaced with the modified first electronic file copy such that the modified first electronic

file copy is stored on the third electronic device in lieu of the older version of the first electronic file, and”

Petitioner contends that “Strong discloses element 10.7; alternatively, any differences would have been obvious variations to a POSA.” Pet. 33.

Petitioner further contends that

Strong discloses that when files are sent from server 22 to sharing clients 34, such as a file sent from the user’s desktop to server 22 and then pushed to the user’s laptop (wherein, responsive to sending the modified first electronic file copy to the third electronic device), the new file is saved and an older file copy is deleted from the receiving sharing client 34, such as a laptop, such that the modified copy is stored in lieu of an older version (an older version of the first electronic file stored on the third electronic device is automatically caused to be replaced with the modified first electronic file copy such that the modified first electronic file copy is stored on the third electronic device in lieu of the older version of the first electronic file).

Id. (citing Ex. 1006 ¶¶ 27, 28, 35) (emphasis omitted).

Petitioner alternatively contends that

To the extent Strong is not express that the new version of the modified first electronic file copy *automatically* replaces and is stored *in lieu of* an older version, a POSA would have been motivated to, and would have reasonably expected success in implementing Strong’s system this way in view of Strong’s disclosure of how conflicts are manually resolved—by replacing or overwriting the version not selected by the user. Strong discloses that sharing clients may automatically accept changed files sent from the server to avoid conflicts. Because Strong provides express teachings of replacing old files with newer versions in another context, a POSA would have recognized that, at least in embodiments where updates are represented as the entire data object, applying this procedure to the automatic acceptance of new files would have been well within the scope of its system. A POSA would have recognized that replacing the older files with the new to be one of the simplest ways from a

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programming perspective to implement the automatic acceptance of changes while avoiding conflicts.

Id. at 34 (citing Ex. 1005 ¶¶ 60, 61; Ex. 1006 ¶¶ 28, 35, 51; *Game & Tech. Co., Ltd. v. Activision Blizzard Inc.*, 926 F.3d 1370, 1380–81 (Fed. Cir. 2019)).

[10.8] “wherein, responsive to sending the modified second electronic file copy to the second electronic device, an older version of the second electronic file stored on the second electronic device is automatically caused to be replaced with the modified second electronic file copy such that the modified second electronic file copy is stored on the second electronic device in lieu of the older version of the second electronic file.”

Petitioner contends that

[e]lement 10.8 is like element 10.7, but refers to the second file, originating from the third electronic device (e.g., a device running sharing client 34, such as a user’s laptop) and sent from server 22 to the second electronic device (e.g., another device running sharing client 34 such as the user’s desktop). For the reasons discussed regarding element 10.7, Strong discloses the “replacing” step of element 10.8; alternatively, any differences would have been obvious variations to a POSA. As detailed above regarding elements 10.4-10.6, Strong’s synchronization techniques are applied across each of the sharing clients and a POSA would have appreciated that the reciprocal nature of the operation of the server and client applications would apply to the replacement of the second modified file copy.

Pet. 35 (citing Ex. 1005 ¶ 59; Ex. 1006 ¶ 26) (emphasis omitted).

Rationale for Combining

Petitioner contends that “[a] POSA would have been motivated to modify Strong’s server to detect the connection status of a receiving client machine, as taught by Brezak, for at least three reasons.” Pet. 25. Petitioner persuasively contends that

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[f]irst, Strong provides an express teaching, suggestion, or motivation to combine through its disclosure of having a server perform synchronization the next time a user is connected; Brezak simply provides a more specific teaching on how the server would determine the connection status between itself and a user's devices.

Second, the combination would have been a matter of combining prior art elements according to known methods to yield predictable results, namely, combining Strong's disclosure of synchronizing the "next time the user is connected" with Brezak's teaching regarding *determining* the occasion when machines are connected.

Third, incorporation of the determination step would have merely involved using a known technique (e.g., Brezak's determining the connection status of receiving machines) to improve Strong's similar synchronization system in the same way, by assessing the connectivity status of sharing clients before attempting to push files to those devices, thereby avoiding unnecessary pushing attempts.

Additionally, a POSA would have had a reasonable expectation of success in making the combination because Brezak and Strong describe similar systems (computing devices with synchronization engines) with similar goals (synchronizing files between devices), and servers were known to determine whether a connection with a client existed, such as by waiting for an acknowledgment, before providing a service. Further, because Strong already discloses that the server maintains a list of the user's clients, incorporating Brezak's teachings of the *determining* step into Strong's system would have required at most minor modifications in software and would have yielded predictable results consistent with polling techniques known well before 2007.

Further, although Brezak describes peer-to-peer systems, a POSA would have appreciated that its teaching related to determining the connection status of a receiving device was applicable to client-server contexts, especially given Strong's own disclosure of performing synchronization when the

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designated sharing clients next becomes available. Indeed, “peer-to-peer” refers to systems where devices normally acting as clients take turns acting as servers and clients to one another, so Brezak’s teachings regarding determining a connectivity status were not limited to peer-to-peer arrangements; thus, modifying Strong’s server-client system to include this step would have been consistent with Brezak’s teachings.

Id. at 25–27 (citing Ex. 1005 ¶¶ 40, 41, 68–72; Ex. 1006 ¶ 32).

Patent Owner’s Arguments

Patent Owner does not specifically contest Petitioner’s showing for any limitation or its rationale for combining Strong and Brezak. To the extent Patent Owner’s arguments presented with respect to 35 U.S.C. § 325(d) are applicable to Petitioner’s challenges, we have already discussed these arguments above in Section III.E.

Conclusion

For the foregoing reasons, we are persuaded that the cited portions of Strong and Brezak and Dr. Long’s testimony support Petitioner’s contentions. We further determine that Petitioner’s rationale for combining Strong and Brezak is supported by sufficient rational underpinning at this stage of the proceeding. *KSR*, 550 U.S. at 406.

Accordingly, we are persuaded Petitioner sufficiently demonstrates a reasonable likelihood of prevailing with respect to its obviousness challenge to independent claim 10 applying Strong and Brezak, at this stage of the proceeding.

4. Independent Claim 1

With respect to independent claim 1, Petitioner cites, in large part, its analysis for independent claim 10. Pet. 36–39 (citing Pet. § IV.A.4; Ex. 1006 ¶ 7, Abstract; Ex. 1001, 7:41–56; 8:16–25). Patent Owner does not appear to

separately contest independent claim 1. *See generally* Prelim. Resp. For these reasons, our analysis for independent claim 10 is substantially applicable to independent claim 1. Accordingly, we determine that Petitioner sufficiently demonstrates a reasonable likelihood of prevailing with respect to its obviousness challenge to independent claim 1 applying Strong and Brezak, at this stage of the proceeding.

5. *Dependent Claims 3, 4, 12, and 13*

[3] The system of claim 1, wherein the first electronic device is configured to: store, via the first application, the modified first electronic file copy to a memory device associated with the first electronic device.

[12] The method of claim 10, further comprising: storing, via the first application, the modified first electronic file copy to a memory device associated with the first electronic device.

Petitioner contends that “Strong discloses that server 22 (i.e., the first electronic device) is configured to and does store, via the first application (e.g., synchronization engine 32), the modified first electronic file copy to a memory device (e.g., datastore 40) associated with the first electronic device (e.g., the datastore exists on server 22).” Pet. 39 (citing Ex. 1006 ¶¶ 10, 30, 37, Fig. 3) (emphasis omitted). Petitioner further contends that “a POSA would have appreciated that the synchronization engine 32 is a first application, or at least part of a first application, that runs on server 22.” *Id.* (citing Pet. § IV.A.4 (10.1)) (emphasis omitted). Petitioner also explains that, “if datastore 40 were not a memory device, a POSA would have appreciated that a memory device is at least obvious over Strong’s disclosure of datastore 40 given the nature of memory devices and Strong’s disclosure regarding servers generally having greater memory capacity than clients.” *Id.* at 40 (citing Ex. 1005 ¶ 49 n.14; Ex. 1006 ¶ 20) (emphasis omitted).

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[4] The system of claim 3, wherein the modified first electronic file copy is stored on the memory device associated with the first electronic device in lieu of an older version of the first electronic file copy that was stored on the memory device associated with the first electronic device.

[13] The method of claim 12, wherein the modified first electronic file copy is stored on the memory device associated with the first electronic device in lieu of an older version of the first electronic file copy that was stored on the memory device associated with the first electronic device.

Petitioner asserts that

Strong discloses that the modified first electronic file copy is stored on the memory device (datastore 40) associated with the first electronic device (server 22) in lieu of an older version of the first electronic file copy that was stored on the memory device associated with the first electronic device (e.g., updates are either made to the copy of the data object on the server or are represented as a new copy of the entire object, and instructions in an update message may be to delete the existing data object).

Pet. 40–41 (quoting Ex. 1006 ¶ 27) (citing Ex. 1006 ¶ 35, claim 6) (emphasis omitted).

We have reviewed Petitioner’s initial showing as to dependent claims 3, 4, 12, and 13, and note that Patent Owner does not separately address the patentability of these claims. For the foregoing reasons, we are persuaded that the cited portions of Strong and Brezak and Dr. Long’s testimony support Petitioner’s contentions. Accordingly, we are persuaded Petitioner sufficiently demonstrates a reasonable likelihood of prevailing with respect to its obviousness challenge to dependent claims 3, 4, 12, and 13 applying Strong and Brezak, at this stage of the proceeding.

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G. Obviousness over Strong, Brezak, and Hamidi

Petitioner argues that claims 5, 6, 14, and 15 would have been obvious in view of Strong, Brezak, and Hamidi. Pet. 42–53.

1. Overview of Hamidi

Hamidi is entitled “File Storage Network.” Ex. 1008, code (54). Hamidi discloses a computer network in which an enterprise cloned drive (ECD) server receives updates to a network storage file from client devices and transfers the updates to other clients authorized to maintain a copy of the network storage file. *Id.* ¶¶ 38–39. When a network storage file is modified and saved on a first client computer, the ECD server receives a “changes file” indicative of changes that have occurred to the network storage file. *Id.*, code (57), ¶ 39. The ECD server then provides the changes file to other client computers authorized to maintain a copy of the network storage file so that they may modify their copy, thereby generating a new version. *Id.* ¶ 39. If a client computer that normally maintains a copy of the network storage file is not accessible, the ECD server maintains the changes file and the client computer receives the changes file when it returns to the network. *Id.*

[5] The system of claim 3, wherein the modified first electronic file copy is stored on the memory device associated with the first electronic device responsive to a determination that the first electronic device is not in communication with the third electronic device.

[14] The method of claim 12, wherein the modified first electronic file copy is stored on the memory device associated with the first electronic device responsive to a determination that the first electronic device is not in communication with the third electronic device.

Petitioner contends that “Strong discloses that clients may communicate with one another directly” as is indicated in Figure 3 by

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“dashed arrows between clients.” Pet. 47 (citing Ex. 1006 ¶¶ 8, 24, 26, Fig. 3). Petitioner contends that “Hamidi discloses that a changes file is stored on the storage medium of ECD server 201 until the client computers that normally maintain a copy of the modified file return online.” *Id.* at 47–48; *see id.* at 48 (quoting Ex. 1008 ¶ 39). Petitioner further contends that,

[a]s modified by Hamidi and Brezak, Strong’s system would store an updated file received from a first sharing client (i.e., the modified first electronic file copy from the second electronic device) on datastore 40 of server 22 (i.e., the memory device associated with the first electronic device) only if the server 22 determined that the server is not in communication with a receiving sharing client (i.e., responsive to a determination that the first electronic device is not in communication with the third electronic device).

Id. at 49–50 (citing Ex. 1005 ¶ 78) (emphasis omitted).

Rationale for Combining

Petitioner argues that it would have been obvious to combine Hamidi with Strong and Brezak because

First, Hamidi provides express motivations to combine: (1) increasing security against hackers who might gain access to the central server; and (2) conserving server resources Second, a POSA would have recognized that the proposed modification would have simply been a matter of applying a known technique (storing data temporarily based on a negative determination related to the connection status of another device) to improve Strong’s synchronization techniques (increasing server security and decreasing costs and resource demands for server 22) to yield predictable results consistent with Hamidi’s teachings.

. . . .

Further, while the proposed modification may have had the potential disadvantage of slowing a user’s access to their files via a web browser, a POSA would have recognized that (1) such

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would have been offset by decreased storage costs and resource demands at the server and increased security and (2) by maintaining a list of files at Strong's server, ad hoc synchronization would still be possible. . . .

A POSA would have had a reasonable expectation of success in making the above combination because Strong and Hamidi describe similar systems with similar goals, and Hamidi shows that conditionally storing files was possible in a similar context.

Pet. 50–51 (Ex. 1006 ¶¶ 9, 34; Ex. 1005 ¶¶ 79–81; Ex. 1008 ¶¶ 6, 35, 45, 51). Patent Owner does not separately argue Petitioner's rationale for combining Strong, Brezak, and Hamidi. At this stage of the proceeding, we are persuaded that Petitioner's rationale is supported by sufficient rational underpinning for the reasons set forth above.

[6] The system of claim 5, wherein the first electronic device is configured to: responsive to resuming communication with the third electronic device, automatically transfer, via the first application, the modified first electronic file copy to the third electronic device to cause the older version of the first electronic file stored on the third electronic device to be replaced with the modified first electronic file copy.

[15] The method of claim 14, further comprising: responsive to resuming communication with the third electronic device, automatically transferring, via the first application, the modified first electronic file copy to the third electronic device to cause the older version of the first electronic file stored on the third electronic device to be replaced with the modified first electronic file copy.

Petitioner contends that, “as discussed regarding Claims 5 and 14, Hamidi discloses that, until a successful query, that is, when the client is ‘once again in communication with the network’ (i.e., resuming communication with the third electronic device), and all applicable clients receive a changes file, the ECD server will maintain the updated copy.”

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Pet. 52 (citing Ex. 1008 ¶ 39) (emphasis omitted). Petitioner further contends that, “for the reasons discussed regarding limitation 10.2 (determining whether a first device is in communication with a third device) and 10.7 (replacing an older version of a file), the combination of Strong and Brezak teaches the additional limitations of Claims 5 and 16.” *Id.*

Petitioner apparently relies on the same rationale for combining Strong, Brezak, and Hamidi for dependent claims 6 and 15 as set forth with respect to dependent claims 5 and 14. We find Petitioner’s rationale sufficiently supported by rational underpinning, at this stage of the proceeding, for the reasons set forth above.

We have reviewed Petitioner’s initial showing as to dependent claims 5, 6, 14, and 15, and note that Patent Owner does not separately address the patentability of these claims. For the foregoing reasons, we are persuaded that the cited portions of Strong, Brezak, and Hamidi, as well as Dr. Long’s testimony support Petitioner’s contentions. Accordingly, we are persuaded Petitioner sufficiently demonstrates a reasonable likelihood of prevailing with respect to its obviousness challenge to dependent claims 5, 6, 14, and 15 applying Strong, Brezak, and Hamidi, at this stage of the proceeding.

H. Obviousness over Hamidi and Ellman and Obviousness over Hamidi, Ellman, and Brezak

Petitioner contends that claims 1, 3, 5, 6, 10, 12, 14, and 15 would have been obvious in view of Hamidi and Ellman. Pet. 53–79. Petitioner also contends that these claims would have been obvious in view of Hamidi, Ellman, and Brezak. *Id.*

1. Overview of Ellman

Ellman is entitled “Work Monitor with File Synchronization.” Ex. 1009, code (54). Ellman discloses synchronizing files between a user’s

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home and office computers so that they may work remotely without manually copying files between computers. *Id.* at 6:2–20. The newer version of the file overwrites the older version on either the home or office computer. *Id.*, code (57).

[10P] “*A method comprising:*”

Petitioner contends that “Hamidi discloses a method of storing electronic data files.” Pet. 54 (citing Ex. 1008 ¶ 7).

[10.1] “*receiving, via a first application at a first electronic device, a copy of a modified first electronic file from a second application at a second electronic device associated with a user, wherein the modified first electronic file copy is automatically received from the second application responsive to the user modifying a content of the first electronic file;*”

According to Petitioner,

Hamidi describes receiving via software at an ‘enterprise cloned drive server,’ ECD server 201 (i.e., an application at a first electronic device), a changes file generated by software on a client computer, such as a user’s laptop 202 (i.e., a second application at a second electronic device associated with a user), wherein the changes file is automatically copied from the client (i.e., is automatically received from the second application) upon a notification that the client has saved a file (i.e., responsive to the user modifying a content of the first electronic file).

Pet. 54–55 (quoting Ex. 1008 ¶ 39) (citing Ex. 1008 ¶¶ 15–17, 45–49, Figs. 2, 4) (emphasis omitted). According to Petitioner, “[t]he client may provide the changes file without a data transfer indicating that the server is ready to receive it.” *Id.* at 55 (citing Ex. 1008 ¶ 39). Petitioner further contends that “[t]he ECD server runs ‘server software,’ i.e., a first application to implement the functions of the ECD server.” *Id.* (citing Ex. 1008 ¶¶ 39, 44, 50; Ex. 1005 ¶ 75) (emphasis omitted); *see id.* at 56–58 (Petitioner asserting

that “Hamidi discloses the ‘automatically received’ concept in another way”).

Petitioner contends that “[i]t would have been obvious to modify Hamidi to transfer entire files, instead of just changes files, in light of Ellman’s teachings.” *Id.* at 59. According to Petitioner, “[l]ike Hamidi, Ellman teaches a system in which files are synchronized between one or more computers; unlike Hamidi, copies of the entire file are used for synchronization.” *Id.* (quoting Ex. 1009, 12:23–13:7) (citing Ex. 1009, 2:7–28, 11:20–28, 12:4–12, 13:16–19, 23:4–14, 14:20–15:2). According to Petitioner, “Ellman’s system uses timestamps to identify the most recent version, so tracking changes is not necessarily required.” *Id.* (citing Ex. 1009, 8:12–26, 2:20–28, 13:4–9, 23:9–14).

Rationale for Combining Hamidi with Ellman

Petitioner contends that the combined method of Hamidi and Ellman “would transfer entire files between devices instead of a changes file.” Pet. 59. According to Petitioner, “[a] POSA would have been motivated to modify Hamidi in light of Ellman’s disclosure for two reasons” because Ellman expressly discloses “to a POSA that a variation of its system ‘supports the storage and distribution of entire files instead of change files’” and because “the proposed combination would have simply been a matter of combining prior art elements . . . according to known method . . . to yield predictable results.” *Id.* at 59–60 (citing Ex. 1008 ¶ 55; Ex. 1005 ¶ 88) (emphasis omitted). Petitioner further contends that

Hamidi itself recognizes that the transferring and storage of entire files was known in the art, and instead proposes the use of change files as one improvement, among others. A POSA would have appreciated that the proposed combination would have been consistent with the principal operation of Hamidi’s

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system, as transferring entire files would have been particularly appropriate where a user desired to synchronize devices for working remotely, an application contemplated by Hamidi, because one would rarely use different computers simultaneously. Further, the proposed combination would circumvent the drawbacks of a “wasteful” mirror server because files would still only be stored temporarily, as discussed regarding limitations 10.7 and 10.8.

A POSA would have had a reasonable expectation of success in making the combination, which would have required the application of well-known techniques in file storage systems, as noted in Hamidi itself. Further, Ellman references transferring files through a network server, so a POSA would have expected success in implementing its teachings on a centralized system.

Id. at 60–61 (citing Ex. 1009, 17:12–17; Ex. 1005 ¶¶ 89–92; Ex. 1008 ¶¶ 4, 5, 35, 37). Petitioner also contends that

[a] POSA would have been motivated to make such a combination at least because the prior art provides express motivation or suggestion to combine—Ellman explains that its system allows a user to synchronize files between multiple devices to work remotely, an application recognized by Hamidi. Further, such a combination would have simply been a matter of combining prior art elements (Hamidi’s central file distribution system and Ellman’s bi-directional synchronization techniques) according to known methods (Ellman’s method of synchronization using file timestamps) to yield predictable results. Further, a POSA would have had a reasonable expectation of success in making the combination, at least because Hamidi already implies bi-directional file synchronization, and Ellman references transferring files through a network server.

Id. at 70 (citing Ex. 1009, 1:14–2:28, 17:12–17; Ex. 1008 ¶¶ 4, 5; Ex. 1005 ¶¶ 95–98). Petitioner still further contends that, “[c]ombined with Ellman, Hamidi’s system would employ the bi-directional transfer of entire file copies and, therefore, would implement updates by overwriting older files

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instead of having client software programs follow instructions in a changes file.” *Id.* at 54 (citing Pet. § IV.C.3).

[10.2] “determining whether the first electronic device is in communication with a third electronic device;”

According to Petitioner, “Hamidi discloses that ECD server 201 (i.e., the first electronic device) determines whether it is connected to another client device, such as desktop computer 203, over a network (determining whether the [sic] is in communication with a third electronic device), such as by querying the client computers.” Pet. 61 (emphasis omitted). “Hamidi’s ECD server 201 ‘is notified when a client computer is connected to the network.’” *Id.* (citing Ex. 1008 ¶¶ 38, 39) (emphasis omitted); *see id.* at 62–64.

[10.3] “automatically sending, via the first application, the modified first electronic file copy to a third application at the third electronic device responsive to the determination that the first electronic device is in communication with the third electronic device and responsive to receiving the modified first electronic file copy from the second electronic device;”

Petitioner contends that

Hamidi discloses that the software running on the ECD server 201 will automatically send (i.e., automatically sending, via the first application) a changes file to the software of a receiving client device, such as desktop 203, (i.e., to a third application at the third electronic device) upon a confirmation response to a query to the receiving client device (i.e., responsive to the determination that the first electronic device is in communication with the third electronic device) and upon receiving the changes file from the originating client device, such as laptop 202 (i.e., responsive to receiving the changes file from the second electronic device):

The ECD server . . . queries the client computer to automatically copy the changes file to a storage

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medium of the ECD server 201. The ECD server 201 then queries other client computers that are authorized to maintain a copy of the network storage file. The authorized client computers that are in communication with the ECD server 201 then request a copy of the changes file. These client computers use the changes file to modify their copy
....

Pet. 65–66 (citing Ex. 1008 ¶¶ 17, 39, 40, 45, 50, Fig. 2). Petitioner further contends that “a POSA would have been motivated to modify, and would have reasonably expected success in modifying, Hamidi to have the ECD server receive and transfer entire files.” *Id.* at 67–68.

[10.4] “receiving, via the first application, a copy of a modified second electronic file from the third application at the third electronic device associated with the user, wherein the modified second electronic file copy is automatically received from the third application responsive to the user modifying a content of the second electronic file;”

[10.5] “determining whether the first electronic device is in communication with the second electronic device; and”

[10.6] “automatically sending, via the first application, the modified second electronic file copy to the second application at the second electronic device responsive to the determination that the first electronic device is in communication with the second electronic device and responsive to receiving the modified second electronic file copy from the third electronic device,”

According to Petitioner,

Elements 10.4 through 10.6 reiterate the synchronization steps of elements 10.1 through 10.3, but for a second file in the reverse direction: from the third application at the third electronic device (e.g., client software at desktop 203) to the first application at the first electronic device (i.e., ECD server 201) and then on to the second application at the second electronic device (e.g., client software on laptop 202).

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For the same reasons discussed regarding elements 10.1 through 10.3, these limitations are taught by the combination of Hamidi and Ellman. Hamidi discloses that each of the client devices are equipped with the software for sending and receiving updates to and from ECD server 201.

Pet. 68–69 (citing Ex. 1008 ¶¶ 38–40, code (57), Fig. 2; Ex. 1005 ¶ 94) (emphasis omitted).

Petitioner further contends that “[l]ikewise, Ellman’s system performs two-way synchronization; that is, changes updated on a user’s office computer are synced to their home computer, and vice versa, such that the user’s two computers may both send files to and receive files from one another.” *Id.* at 69 (citing Ex. 1009, 2:20–28, 12:1–5).

According to Petitioner, “[t]o the extent Hamidi does not expressly disclose that its synchronization steps bi-directional, such would have been obvious over the combination of Hamidi and Ellman, which, as previously discussed, discloses bi-directional synchronization by selecting the most recent file of two computers.” *Id.* at 70 (citing Pet. §§ IV.C.1, IV.C.4).

[10.7] “wherein, responsive to sending the modified first electronic file copy to the third electronic device, an older version of the first electronic file stored on the third electronic device is automatically caused to be replaced with the modified first electronic file copy such that the modified first electronic file copy is stored on the third electronic device in lieu of the older version of the first electronic file, and”

Petitioner contends “Hamidi discloses that client computers that receive a changes file will ‘modify their copy of the network storage file thereby generating the new version of the network storage file.’” Pet. 71 (citing Ex. 1008 ¶ 39) (emphasis omitted). According to Petitioner,

[a]s modified by Ellman, Hamidi’s system would transfer the entire file instead of a changes file, in which case, upon the

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new file being sent to the receiving client device (responsive to sending the modified first electronic file copy to the third electronic device), the new version would “overwrite” the old version of the file, thereby replacing it (i.e., an older version of the first electronic file stored on the third electronic device is automatically caused to be replaced with the modified first electronic file copy) such that the new version is stored instead of the older version (i.e., such that the modified first electronic file copy is stored on the third electronic device in lieu of the older version of the first electronic file):

When the user synchronize files, pcTELECOMMUTE copies the file from his office or home PC, depending on which is newer. pcTELECOMMUTE compares the date and time of both files and overwrites the older file with the newer file.

Id. (citing Ex. 1009, 13:4–9; 23:4–14; 8:20–26; Ex. 1005 ¶ 86, n.15

(Dr. Long noting Ellman’s use of the term “overwrite,” observing it as one known technique to replace files prior to 2007)) (emphasis omitted).

[10.8] “wherein, responsive to sending the modified second electronic file copy to the second electronic device, an older version of the second electronic file stored on the second electronic device is automatically caused to be replaced with the modified second electronic file copy such that the modified second electronic file copy is stored on the second electronic device in lieu of the older version of the second electronic file.”

Petitioner contends that “[e]lement 10.8 is like element 10.7, but for the second file originating from the third device (desktop 203) and sent to the second device (laptop 202) via the first device (ECD server 201).”

Pet. 72. According to Petitioner, “[f]or the reasons discussed regarding elements 10.4–10.7, this limitation is obvious over Hamidi in view of Ellman.” *Id.* Petitioner further contends that, “[a]s mentioned regarding elements 10.4–10.6, Hamidi and Ellman disclose features that apply to each

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of the user's devices; thus, a POSA would have appreciated that the reciprocal nature of the combination would apply to the replacement of the modified second file copy." *Id.* at 72–73 (citing Ex. 1005 ¶¶ 96–98) (emphasis omitted).

Patent Owner's Arguments

Patent Owner presents several arguments with respect to 35 U.S.C. § 325(d) that relate to the merits of Petitioner's challenges. We address them here. Patent Owner argues that Petitioner "acknowledges the deficient teachings of Hamidi, and relies on Ellman as states that '[i]t would have been obvious to modify Hamidi to transfer entire files, instead of just changes files, in light of Ellman's teachings.'" Prelim. Resp. 42 (citing Pet. 59). We observe that Petitioner's challenge is more nuanced—Petitioner argues that "[a] POSA would have been motivated to modify Hamidi in light of Ellman's disclosure for two reasons" because "Hamidi provides express motivation to combine, explaining that it would be 'apparent' to a POSA that a variation of its system 'supports the storage and distribution of entire files instead of change files'" and argues that "Ellman's disclosure simply confirms this and teaches specific methods of sharing entire files in a manner applicable to Hamidi's system and methods." Pet. 59–60 (citing Ex. 1008 ¶ 55; Ex. 1005 ¶ 88) (emphasis omitted). Petitioner's contention is supported by Hamidi's express disclosure that "it will be apparent to one of skill in the art that a variation of the system according to either of the first and second embodiments of the invention *supports the storage and distribution of entire files instead of change files*," as set forth above. Ex. 1008 ¶ 55 (emphasis added). As such, Patent Owner's argument is unavailing at this stage of the proceeding.

Patent Owner further contends that “Unified Patents’ rationale for combining Hamidi with Ellman is conclusory, and is deficient in evidentiary support.” Prelim. Resp. 43. Specifically, Patent Owner contends that “Petitioner fails to provide any reasoning or explanation as to how the structure of Hamidi would actually be modified to include the teachings of Ellman.” *Id.* We disagree that Petitioner does not provide any persuasive reasoning or explanation. *See, e.g.*, Pet. 54, 59–61, 70 (Petitioner setting forth reasons for combining Hamidi and Ellman). Patent Owner’s argument appears to be premised on requiring Ellman to be bodily incorporated in Hamidi. However, “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *see also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the *teachings* of references does not involve an ability to combine their specific structures.”).

Patent Owner argues that limitations “10.1, 10.2 and 10.3 are not identical to 10.4, 10.5 and 10.6” and that “[i]n an attempt to remedy this deficiency, [Petitioner] summarily concludes that the ‘two-way synchronization’ or ‘bi-directional synchronization’ in Ellman would disclose elements 10.4, 10.5 and 10.6.” Prelim. Resp. 45. Patent Owner sets forth these arguments with respect to what Patent Owner characterizes as Petitioner’s suggestion that “[Patent Owner] failed to provide the Examiner

with relevant information about bi-directionality of file synchronization from the PCT Counterpart (EX1003).” *Id.* (citing Pet. 5). Patent Owner represents that “the Examiner was aware of the ‘bi-directional’ or ‘two way synchronization’ reference, but rejected them as being insufficient to reject the claims of the ’942 patent.” *Id.* at 46. Even if we were to accept this representation, that does not undermine Petitioner’s obviousness analysis based in part on Ellman’s teaching of two-way synchronization, which is sufficient for institution.

Conclusion

For the foregoing reasons, we are persuaded that the cited portions of Hamidi and Ellman and Dr. Long’s testimony support Petitioner’s contentions. Accordingly, we are persuaded Petitioner sufficiently demonstrates a reasonable likelihood of prevailing with respect to its obviousness challenge to independent claim 10 applying Hamidi and Ellman, at this stage of the proceeding.

2. Independent Claim 1 and Dependent Claims 3, 5, 6, 10, 12, 14, and 15

As we preliminarily conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its obviousness challenge to independent claim 10 applying Hamidi and Ellman, we institute review on all challenged claims on all grounds set forth in the Petition, including Petitioner’s challenge to claims 1, 3, 5, 6, 12, 14, and 15 based on Hamidi and Ellman, and its challenge to claims 1, 3, 5, 6, 10, 12, 14, and 15 based on Hamidi, Ellman, and Brezak. *See* 35 C.F.R. § 42.108(a).

IV. CONCLUSION

After considering the evidence and arguments presented in the current record, we determine that Petitioner has demonstrated a reasonable

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likelihood of success in proving that at least one of the challenged claims of the '942 patent is unpatentable. We are not persuaded to exercise our discretion to deny institution of trial under either § 314(a) or § 325(d). We therefore institute trial on all challenged claims and grounds raised in the Petition.

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. Any final determination will be based on the record developed during trial. We place Patent Owner on express notice that any argument not asserted in a timely-filed Response to the Petition, or in another manner permitted during trial, shall be deemed waived, even if that argument was presented in the Preliminary Response.

V. ORDER

In consideration of the foregoing, it is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1, 3–6, 10, and 12–15 of the '942 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '942 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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