

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOX, INC., and DROPBOX, INC.,

Petitioners

v.

TOPIA TECHNOLOGY, INC.,

Patent Owner

Case IPR2023-00432

Patent 10,754,823

**PATENT OWNER'S SUR-REPLY TO PETITIONERS' PRELIMINARY
REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE (POPR)¹**

¹ This Reply was authorized by the Board's Order of June 1, 2023 (Paper 7).

I. Egnyte is in Privity with Petitioners and an RPI of the Petitions

In the midst of preparing the Petitions, lead counsel Ms. Keefe orchestrated a back-room, off-the-books deal to represent long time Cooley client Egnyte in furtherance of a three-part master plan to circumvent the IPR statutory time bar and estoppel provisions: Plan (A) Egnyte's early § 101 attack via a Rule 12(c) motion; Plan (B) Petitioners' IPRs; and Plan (C) Egnyte's continued prior art attacks on any grounds including those raised in the IPRs. POPR, 9; EX2001, 10:5-7; EX2018 122:13-21; 96:1-5 [REDACTED]; [REDACTED]; 58:16-19; 61:6-65:12. Under this plan, success at any stage, by any party, would mutually benefit all parties to the JDA. If under these circumstances the Board does not find that Egnyte is an RPI and in privity with Petitioners, there is a real risk that future co-defendants will use this playbook to avoid the statutory provisions that exist to prevent such gamesmanship. Key to this master plan is Ms. Keefe, a seasoned patent litigator, who zealously advocated simultaneously for Petitioners and Egnyte. As Judge Burke acknowledged, "it's about as close as you can get in terms of coordinating and understanding, *et cetera*." EX2001, 11:10-15².

² Contrary to Petitioners' allegation, context from the transcript makes clear that Judge Burke was not merely parroting Patent Owner's argument, as conceded by Egnyte's counsel ("I hear what *Your Honor* is saying") (emphasis added).

Petitioners and Egnyte carefully avoided creating a paper trail to conceal their coordinated efforts at taking multiple shots at invalidating the patents. For example no written records exist limiting the scope of Ms. Keefe's representation of Egnyte in Delaware. To the contrary, Ms. Keefe is admitted to the Delaware Court via an unrestricted *Pro Hac Vice* (PHV) motion. EX2008; EX2018 84:8-13 ("Document speaks for itself"); 47:6-20 ("Q. Okay. Do documents exist that outline the scope of your representation of Egnyte? A. No. Q. Do emails exist . . . ? A. No."). Despite her admission that she "wish[ed she] had" withdrawn her PHV, Ms. Keefe remains counsel of record and never informed the court, *or Egnyte*, that her representation was restricted. *Id.* 88:18-21; 174:7-9; 48:24-49:7; 106:14-22. Only now does Ms. Keefe claim that her off-the-books discussion with Egnyte's other outside counsel limited the scope of her representation, but she refused to elaborate on any such discussions through selective assertions of privilege. *Id.* 47:12-20; 47:22-25; and 55:25-56:24. In fact, Ms. Keefe was introduced as the face of Egnyte to argue the merits of its first and only in-person hearing. EX2019 100:7-12. Even if Ms. Keefe's representation were limited to § 101 invalidity, that issue remains alive in the Delaware Court. EX2020, 4. Further, Ms. Keefe's continued representation in connection with the § 101 motion substantially overlaps with her representation of Petitioners in the IPRs, at least because "[t]he question of whether a claim element [] is well-understood, routine and conventional . . . is a question of fact." *Berkheimer*

v. HP Inc., 881 F.3d 1360, 1368 (Fed. Cir. 2018).³ Her representation of Egnyte continues, and Ms. Keefe confirms that there are no documents terminating that representation. EX2018 92:23-93:2.

Egnyte's intimate relationship with Petitioners does not stop at shared counsel. Ms. Keefe confirmed that Petitioners' and Egnyte's interests were never adverse during her joint representation; to the contrary they are mutually interested in invalidating the Asserted Patents. *Id.* 185:19-21; 168:25-169:2; and 130:17-18.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. Petitioners would directly benefit from Ms. Keefe's co-representation,

³ Ms. Keefe's attempted to distinguish her work on § 103 in the IPRs from that on Egnyte's § 101 motion by articulating that § 101 relates to "unenforceability" while § 103 relates to "invalidity". *See* EX2018, 169:9-17. But even Ms. Keefe's client Egnyte uses the phrase "invalid" with respect to § 101, and the CAFC makes no such a distinction. EX2021, 20; *see e.g., Versata Dev. Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1330 (Fed. Cir. 2015).

either by invalidating the Asserted Patents on prior art grounds in the IPRs or if Egnyte is successful in district court under § 101. *Id.* 58:11-25. It is beyond any argument that Ms. Keefe appeared in the § 101 hearing to benefit both Egnyte and Petitioners — [REDACTED]

[REDACTED]

[REDACTED]

Additionally Egnyte assisted in identifying the grounds in Petitioners' and Egnyte's identical invalidity contentions, and despite initially testifying to the contrary, Ms. Keefe confirms that these grounds are not "inconsistent or contradictory" with the grounds in the Petitions. EX1029 ¶10; EX2018 157:12-25. Indeed, Egnyte may have even found the references which formed the invalidity grounds in the Petitions. EX1029 ¶7; EX2018 150:6-8 (Q. [I]s it possible that Egnyte identified prior art references? A. It's possible.) 123:20-129:16 (Ms. Keefe refusing to elaborate based on a claim of privilege).

The above facts, when viewed through the lens of the *AIT II* factors, demonstrate that Egnyte is an RPI and/or in privity with Petitioners. Its collusion through identical counsel is unprecedented. Regarding *factor (a)*, as described

above, [REDACTED]

[REDACTED]

Regarding *factors (b) and (c)*, given the foregoing facts there can be no question that Petitioners and Egnyte took each other's interests into account and that their common counsel, Ms. Keefe, maintains an ethical obligation to zealously represent both Petitioners and Egnyte's invalidity efforts. Further, Ms. Keefe admits that Egnyte may have identified the prior art relied on in the instant Petitions. EX2018 150:6-8.

Relevant to *factor (d)*, as the Delaware Court recognized, Petitioners' relationship with Egnyte is "as close as you can get". EX2001, 11:10-15. Petitioners and Egnyte share identical counsel, who suggested and indeed did argue invalidity on Egnyte's behalf [REDACTED] for the mutual benefit of Petitioners and Egnyte, all the while appraising herself of knowledge and facts relevant to

⁴ EX2018 163:23-164:1. Despite her inability to remember basic facts such as [REDACTED], or even her billable rate, Ms. Keefe expects the Board to trust her recollection regarding an oral agreement with Egnyte's other outside counsel about the scope of her representation. EX2018 164:12-21; 59:16-20; 73:17-74:3; and 47:6-25.

invalidation of the Asserted Patents. [REDACTED] [REDACTED]
[REDACTED]

Asahi Glass Co., Ltd. v. Toledo Eng'g Co., 505 F. Supp. 2d 423, 434-435 (N.D. Ohio 2007) (existence of a JDA demonstrates privity); *Crown Equip. Corp. v. Toyota Material Handling*, 2005 U.S. Dist. LEXIS 22211, 2005 WL 2454116, at *4 (N.D. Ohio) (a joint defense agreement, shared counsel, and a non-party's control over expert retention all supported a finding of privity). To the extent Ms. Keefe asserts that the JDA evidences a lack of privity or an RPI relationship, these self-serving statements can be ignored just like Petitioners have ignored other JDA provisions relating to, *e.g.*, intent to jointly participate in this IPR proceeding. EX1029 ¶6. Likewise, Ms. Keefe's assertion that Petitioners and Egnyte are competitors is irrelevant given that Box and Dropbox are renowned fierce competitors yet are co-petitioners here with the same lead counsel. EX2018 174:25-176:10.

Relevant to *factors (e), (f), and (g)*, it is undisputed that Egnyte has an interest in and would *directly* benefit from an IPR invalidation decision. Consistent with her ethical duties to Egnyte as a zealous advocate and highly experienced patent practitioner, Ms. Keefe would have had to consider and inform Egnyte of the option to file IPRs on the Asserted Patents by the one year bar date of December 27, 2022, just one week following her appearance in the § 101 hearing. The decision not to file a petition for IPR by Egnyte would plainly be in the interest of all parties under

the strategic plan. Petitioners took Egnyte's invalidation interest into account given that Egnyte is time-barred from filing an IPR petition under § 315(b), but would not be precluded from asserting the same grounds (and more) in Delaware, inuring to the benefit of both Petitioners and Egnyte.

Factor (h) is not relevant to the analysis. *AIT II*, 28-29. (“Mr. Robertson’s role on the board . . . does not weigh for or against finding [] an RPI.”)

With respect to **factor (i)**, through the JDA and their identical counsel, Petitioners and Egnyte discussed invalidation strategy and references. It is irrelevant whether they explicitly discussed filing IPRs. *AIT II*, 30.

Contrary to Petitioners’ assertions regarding Egnyte’s statements in the stay hearing, Patent Owner *never* argued that Egnyte “is not a party or privy”. Rather, Patent Owner represented that “*there may well be yet an RPI issue . . . that Topia reserves the right to pursue . . .*” EX2001, 39:16-19. Patent Owner explained that because Egnyte refuses to agree to estoppel, *if* the Board does not find it to be an RPI or in privity, Egnyte would be permitted to raise the same grounds Petitioners raise. *Id.*, 36:21-37: 6 This remains a serious concern and unaddressed by Petitioners.

II. The *Fintiv* Factors Support Denial of Institution

In *Sotera*, the Board declined to exercise discretion under § 314(a) in view of Petitioner’s stipulation filed in district court agreeing not to pursue grounds that were raised or could have been raised. Here, Petitioners did not file a stipulation in district

court or the PTAB, but instead submitted an informal email only after Patent Owner highlighted their initial and woefully deficient stipulation.

Even if properly submitted, Petitioners new stipulation does not ‘mitigate[] concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB,’ under *Fintiv* factor 4. *Sotera*, 18; *see* EX2007, 7. Neither the *Sotera* Court nor the *Fintiv* Memo contemplated the present circumstances where an unnamed RPI and privy of Petitioners is, absent intervention, free to raise Petitioners’ same (and more) invalidity contentions. *See* EX2003, and EX2004, at 19 and 69; EX2005, 20; EX2018 129:21-130:7. Petitioners fail to address any of the remaining *Fintiv* factors. *See* POPR 14-20.

III. The *General Plastic* Factors Weigh In Favor of Denial

Ms. Keefe confirmed she read Unified’s Petition, evidencing reliance, and has argued Egnyte’s position that the Asserted Patents, “are all directed to the abstract idea of synchronizing multiple versions of a file” evidencing a belief that Unified’s arguments are applicable to all the Asserted Patents. EX2018 183:1-8; EX2021, 15.

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Respectfully submitted,

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Patent Owner's Sur-Reply to Petitioners'
Preliminary Reply to POPR

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the attached Patent Owner's Sur-Reply to Petitioner's Preliminary Reply to Patent Owner's Preliminary Response (POPR) is being served by electronic mail on the following counsel of record:

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