

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,

Petitioner

v.

TOPIA TECHNOLOGY, INC.,

Patent Owner

Case IPR2022-00782

Patent 10,067,942

PATENT OWNER'S PRELIMINARY RESPONSE

PURSUANT TO 37 C.F.R. § 42.107(a)

TABLE OF CONTENTS

I. INTRODUCTION.....	1
II. ARGUMENT	6
A. The Board Should Exercise Its Authority and Deny Institution Because <i>Fintiv</i> Factors Weigh Heavily in Favor of Denying Institution	6
1. Whether a Stay Exists or Is Likely To Be Granted If A Proceeding Is Instituted	11
2. Proximity of the District Court’s Trial Date to the Board’s Projected Statutory Deadline for a Final Written Decision	13
3. Investment In the Parallel Proceeding By The Court And The Parties	16
4. Overlap Between Issues Raised In the Petition And in The Parallel Proceeding	17
5. Whether Unified Patents and the Defendant(s) In the Parallel Proceeding(s) Are The Same Party	19
6. Other Circumstances That Impact the Board’s Exercise of Discretion, Including the Merits	20
B. The Board Should Exercise Its Authority and Deny Institution Under 35 U.S.C § 325(d)	21
1. The Board Should Exercise Its Discretion Under § 325(d) To Deny Institution Because Similar Prior Art or Arguments Were Previously Considered By the Patent Office During Prosecution	22
2. The Board Should Exercise Its Discretion Under § 325(d) To Deny Institution Because the Petitioner Fails To Establish A Prima Facie Case of Obviousness	42

IPR2022-00782
U.S. Patent No. 10,067,942

3. The Board Should Exercise Its Discretion Under § 325(d) To Deny
Institution Because the Petition Fails To Properly Address Every
Limitation Of The Challenged Claims44

III. CONCLUSION47

TABLE OF AUTHORITIES

CASES

<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469 (PTAB Feb. 13, 2020)	12, 13, 14, 36
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019 (PTAB Mar. 20, 2020)	9, 10, 12, 15, 17, 18, 20
<i>Applications in Internet Time, LLC v. RPX Corp.,</i> 897 F.3d 1336 (Fed. Cir. 2018)	19
<i>Becton, Dickinson and Co. v. B. Braun Melsungen AG,</i> IPR2017-01586 (PTAB Dec. 15, 2017)	21, 22, 23
<i>Canadian Solar Inc. v. The Solaria Corporation,</i> IPR2021-00095 (PTAB May 26, 2021)	16
<i>Cuozzo Speed Techs., LLC v. Lee,</i> 136 S. Ct. 2131, 2140 (2016)	8, 21
<i>Daiichi Sankyo, Inc. v. Seagen Inc.,</i> PGR2021-00042 (PTAB June 24, 2021)	12
<i>General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha,</i> IPR2016-01357 (PTAB Sept. 6, 2017)	9
<i>Harmonic Inc. v. Avid Tech., Inc.,</i> 815 F.3d 1356 (Fed. Cir. 2016)	21
<i>Hospitality Core Servs. LLC v. Nomadix, Inc.,</i> IPR2016-00052 (PTAB Apr. 27, 2016)	2
<i>In re Kumar,</i> 418 F.3d 1361 (Fed. Cir. 2005)	3, 43

IPR2022-00782
U.S. Patent No. 10,067,942

<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006)	42, 43, 44
<i>Innogenetics. N.V. v. Abbott Labs</i> , 512 F.3d 1363 (Fed. Cir. 2008))	43
<i>KSR Inf I, Co, v. Teleflex Inc</i> , 550 U.S. 398 (2007)	42, 43, 44
<i>Neil Ziegman, N.P.Z. v. Stephens</i> , IPR2015-01860 (PTAB Feb. 24, 2016)	2
<i>NHK Spring Co., Ltd. v. Intri-plex Technologies</i> , IPR2018-00752 (PTAB Sept. 12, 2018)	9
<i>RPX Corp. v. Applications in Internet Time, LLC</i> , IPR2015-01750 (PTAB Oct. 2, 2020)	19
<i>Sand Rev’n II LLC v. Cont’l Intermodal Grp. – Trucking LLC</i> , IPR2019-01393 (PTAB June 16, 2020)	18
<i>SAS Institute v. Iancu</i> , 138 S. Ct. 1348, 1351, (2018)	8
<i>Sotera Wireless, Inc., v. Masimo Corp.</i> , IPR2020-01019 (PTAB Dec. 1, 2020)	18
<i>Unified Patents LLC v. Micropairing Technologies LLC</i> , IPR2021-01557 (PTAB Apr. 12, 2022)	19, 20

STATUTES

35 U.S.C. § 325	2, 21, 22, 24, 42, 44
35 U.S.C. § 314	4, 8, 12, 13, 21, 24, 44

IPR2022-00782
U.S. Patent No. 10,067,942

35 U.S.C. § 316	10, 13
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OTHER SOURCES

37 C.F.R. § 42.108(c)	20
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TABLE OF EXHIBITS

Exhibit	Description
2001	U.S. Patent Publication 2007/0180084 to Mohanty et al. (“Mohanty”)
2002	European Patent Publication EP 1130511 to Multer et al. (“Multer”)
2003	“Anti-Troll” Claims on Unified Patents Website (www.unifiedpatents.com)
2004	Preliminary Invalidity Contentions by Defendants [REDACTED] [REDACTED] in the Western District of Texas lawsuits
2005	Membership agreement between Unified Patents [REDACTED]. ¹
2006	USPTO Memorandum on Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation
2007	Judge Albright Grant Rate for Motions to Stay Proceedings Pending IPR (Docket Navigator Motion Success Rate)

¹ This Exhibit contains Unified Patents’s confidential information permitted under an agreement between Topia with Unified Patents to be filed only under seal. Unified Patents has indicated that it will file a related motion to seal and will submit a redacted version as applicable.

IPR2022-00782
U.S. Patent No. 10,067,942

2008	Judge Albright Statement on Granting Stays Pending Inter Partes Review (https://www.law360.com/articles/1381597/albright-says-he-ll-very-rarely-put-cases-on-hold-for-ptab)
2009	<i>Topia Technology, Inc. v. Box, Inc., et al.</i> , Scheduling Order in Western District of Texas
2010	<i>Topia Technology, Inc. v. Dropbox, Inc., et al.</i> , Scheduling Order in Western District of Texas
2011	<i>Topia Technology, Inc. v. Egnyte, Inc.</i> , Scheduling Order in District of Delaware
2012	U.S. District Courts--Combined Civil and Criminal Federal Court Management Statistics (December 31, 2021)
2013	Membership agreement between Unified Patents and [REDACTED] ²
2014	Unified Patents's Webpage Posting (https://www.unifiedpatents.com/insights/2022/4/15/topia-technology-patent-challenged?fbclid=IwAR2HP_a-JGpnKuw_VkWJCcKM3lml-AyhTGwB69uNZFLHVfAR2yh8Fv-5n8)
2015	Reserved

² This Exhibit contains Unified Patents's confidential information permitted under an agreement between Topia with Unified Patents to be filed only under seal. Unified Patents has indicated that it will file a related motion to seal and will submit a redacted version as applicable.

IPR2022-00782
U.S. Patent No. 10,067,942

2016	U.S. District Courts--Combined Civil and Criminal Federal Court Management Statistics (March 31, 2022)
2017	Reserved
2018	Reserved
2019	File History of U.S. Patent Publication 2006/0101064 to Strong et al. ("Strong File History")
2020	Declaration of L. Roman Rachuba

Patent Owner Topia Technology, Inc. (“Topia” or “Patent Owner”) submits this Response to the Petition (Paper No. 1) seeking denial of institution of *inter partes* review of claims 1, 3-6, 10, and 12-15 (“the Challenged Claims”) of U.S. Patent No. 10,067,942 (“the ’942 Patent,” EX1001), filed by Unified Patents, LLC (“Unified Patents” or “Petitioner”).

I. INTRODUCTION

Petitioner Unified Patents Inc. asks this Board to institute an *inter partes* review of one single patent - U.S. Patent No. 10,067,942 – out of six that have been asserted against [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] seek to burden the PTAB and the district courts with duplicative challenges to the validity of the asserted patents in serial proceedings. The Board should deny the Petition for *Inter Partes Review* (“Petition”) for each of several independent reasons.

IPR2022-00782
U.S. Patent No. 10,067,942

First, the Petition simply repackages arguments already considered and rejected by the United States Patent and Trademark Office (“the Office” or “the Patent Office” or “USPTO”) during prosecution. The Board has discretion to “reject the petition ... because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d); *see Hospitality Core Servs. LLC v. Nomadix, Inc.*, IPR 2016-00052, Paper 8, at *8 (PTAB Apr. 27, 2016); *Neil Ziegman, N.P.Z. v. Stephens*, IPR2015-01860, Paper 11, at *4-6 (PTAB Feb. 24, 2016).

The Strong³ and Hamidi⁴ references relied upon by Unified Patents describe file synchronization through a technique that transmits changes or differences to a file, also known as “delta synchronization,” which is fundamentally different and inconsistent with the core architectural features described and claimed in the ’942 patent. This fundamental difference was already considered and recognized by the Examiner in allowing the ’942 Patent. Both Strong and Hamidi are cumulative of the Mohanty reference⁵ asserted by the Examiner and distinguished by the Applicants during prosecution (EX1002, at 117 and 182). Both references are

³ U.S. Patent Publication 2006/0101064, EX1006, Strong.

⁴ U.S. Patent Publication 2004/0267697, EX1008, Hamidi.

⁵ U.S. Patent Publication 2007/0180084, EX2001, Mohanty.

IPR2022-00782
U.S. Patent No. 10,067,942

cumulative of the Multer reference⁶, also considered by the Patent Office in the application of the parent patent (EX1010). The Board should decline Unified Patents' request for a rehash of the prosecution record.

Rather than pointing to specific modifications to the asserted references that could be made in an enabling manner, Unified Patents merely resorts to broad generalized suggestions and conclusory statements. Modifying the core delta synchronization feature as used in the primary references with suggestions from secondary references, as suggested by United Patents, would render the systems suggested in the primary references unworkable without fundamentally changing the core architecture in a way unexplained by Unified Patents. *See In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005) ("Although published subject matter is 'prior art' for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must enable a person of ordinary skill to make and use the invention.") The architecture described and claimed in the '942 patent is the result of fundamental research and development efforts in the area of complex network file management by Patent Owner Topia Technology, Inc., efforts that Unified Patents attempts to erase by generalized assertions that are untethered to the disclosures of the references. Because Unified Patents has not shown a basis

⁶ European Patent Publication EP 1130511 to Multer et al., EX2002.

for combination of either primary references with Ellman or Brezak in an enabling manner to arrive at the claimed invention, the Petition should be denied.

Second, the Board's discretion to deny institution under 35 U.S.C. § 314(a) under the *Fintiv* factors compels denial here, where (1) no stay exists or is likely to be granted; (2) trial is set to begin in the Western District of Texas in December, 2023, within a few weeks of the Board's statutory deadline in November, 2023 in this case (of course, any follow-on petitions will push the ultimate resolution of all asserted patents in the PTAB far beyond the trial date in Texas); (3) the courts and the parties in the parallel proceeding lawsuits will have invested significant time and effort; (4) overlap between the IPR and the district court actions weighs against institution because the petition asks the Board to review the same patent claims, based on the same prior art, that are at issue in one of the six patents in the district court cases; [REDACTED]; [REDACTED]; and (6) the merits of the Petition are neither *compelling* nor *meritorious*. EX2006.

Far from being a troll or NPE that Unified Patents' business model purportedly targets, Patent Owner Topia has existed as an engineering/software solutions company far longer than Box and Dropbox. Topia was founded by its current CEO Ms. Janine Terrano in 1999. Since its founding, Topia has developed critical technologies and provided essential products related to document

IPR2022-00782
U.S. Patent No. 10,067,942

management in complex and secure network environments to the U.S. government as a contractor to numerous federal departments and agencies including the U.S. Army, U.S. Air Force, TSA, and FAA for most of the past two decades. In order to meet the requirements of these government and other commercial clients, Topia developed computer network architecture for securely moving and managing data in complex distributed environments. Each of Topia's customers requires security coupled with strict performance metrics – challenges met by Topia's innovative solutions, patented technologies, and seasoned engineering team. As just one example, using its technology covered by the patents at issue, Topia was able to provide its secure solution “Troop Skoot” for combat troops in Iraq to securely communicate with families back home, sending documents and pictures without compromising the stringent security requirements of the U.S. military. In short, for the past 23 years, file and data management in a distributed environment has been and continues to be the focus of Topia's research, development, and innovation.

Consistent with its core business, as extensively discussed in the Background section, the '942 patent provides innovative solutions to problems found in the file management and synchronization fields. Topia's experience in this technology provided insight into the need for techniques and innovation scalable and workable even with encryption data compression and separation. The innovations described and claimed in the '942 patent are the direct result of the

company's research and development efforts in this complex technological field.

II. ARGUMENT

A. The Board Should Exercise Its Authority and Deny Institution Because *Fintiv* Factors Weigh Heavily in Favor of Denying Institution

Unified Patents provides a paid service to its subscribed members by filing IPR petitions against patents that are harmful to their members while attempting to shield their members from estoppel that would preclude the members from raising validity defenses in district court lawsuits if the members themselves had filed the petitions. On its website, Unified Patents tout themselves as “[t]he ONLY entity that DETERS abusive NPEs (aka Patent Trolls) and NEVER pays.” EX2003 (emphasis in original).

Topia is not an NPE or a troll. Therefore, even granting Unified Patents the benefit of its own alleged “calling,” its Petition here can only be understood as part of a strategy to assist their paid members, [REDACTED]

[REDACTED]⁷ As explained below, the '942 patent is only one of a group of six patents, sharing a common specification, that are at issue in Topia's lawsuits against Box and

⁷ Unified Patents's webpage improperly identifies Topia as an NPE, maligning its reputation, and linking its filing to the Box and Dropbox litigations. EX2014.

IPR2022-00782
U.S. Patent No. 10,067,942

Dropbox. Attempting to invalidate one patent among the six in the family will not impact the pending lawsuits. The strategic objective behind Unified Patents' Petition against only one of six asserted Topia patents is to launch a trial balloon and reveal Topia's arguments in defense of its patent and the Board's analysis in its decision on whether to institute trial before follow-on petitions are filed by Unified Patents [REDACTED]. In other words, Unified Patents' strategy is an attempt to have multiple bites at the apple and an end-run-around the deleterious effects of the estoppel that attaches to the parties in an IPR proceeding. PTAB trials were never intended to be exploited in this way. The Board therefore should exercise its discretion not to institute review.

The '942 patent for which Unified Patents seeks review is only one of six related patents that Patent Owner Topia is currently asserting in the following three pending U.S. district court proceedings:⁸

⁸ The six asserted patents are U.S. Patent Nos. 9,143,561, 10,067,942 (at issue in this proceeding), 10,289,607, 10,642,787, 10,754,823, and 11,003,622. The '942, the '607, the '787, and the '823 patents are continuations of the '561 patent and, therefore, all six patents share the same specification.

- *Topia Technology, Inc. v. Box Inc., Sailpoint Technologies Holdings, Inc., and Vistra Corp.* (No. 6:21-cv-01372) in the Western District of Texas
- *Topia Technology, Inc. v. Dropox Inc., Sailpoint Technologies Holdings, Inc., and Clear Channel Outdoor Holdings, Inc.*, (No. 6:21–CV–01373) in the Western District of Texas
- *Topia Technology, Inc. v. Egnyte, Inc.* (No. 1:21-cv-01821-MN) in the District of Delaware.

None of these lawsuits have been stayed, nor has any defendant requested a stay pending a decision or resolution of an IPR. Discovery is already underway in each of the three district court litigations, and the grounds raised by Petitioner, Unified Patents, rely on references that all the defendants in the Western District of Texas lawsuits have identified in their preliminary invalidity contentions (EX2004, at 7), including Defendants Box, Inc. and Dropbox, Inc., [REDACTED] [REDACTED]. EX2005 and EX2013.⁹

The Board has the discretion to deny institution under 35 U.S.C. § 314(a). *SAS Institute v. Iancu*, 138 S. Ct. 1348, 1351, (2018). *See also Cuozzo Speed*

⁹ Defendant's preliminary invalidity contentions in the District of Delaware lawsuit are due September 2, 2022.

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.”)

The Board considers the presence and status of parallel district court litigation in determining institution. *NHK Spring Co., Ltd. v. Intri-plex Technologies*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential), and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“Fintiv”); *see also General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (“[W]e recognize that an objective of the AIA is to provide an effective and efficient alternative to district court litigation.”).

Fintiv sets forth a non-exhaustive list of factors that balance system efficiency and fairness considerations when considering discretionary denial.

Fintiv, IPR2020-00019, Paper 11 at 5–6. The factors 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;
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.

Id.

There is some overlap among these factors, and some facts may be relevant to more than one factor. Therefore, in evaluating the factors, the Board takes a holistic view of whether denying or instituting review serves the efficiency and integrity of the system. *See* Consolidated Trial Practice Guide November 2019 (“TPG”) at 58 (quoting 35 U.S.C. § 316(b)). Additionally, the *Fintiv* factors should be considered in view of the guidance provided in the June 21, 2022 Memo regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation. (“USPTO Interim Procedure”). *See* EX2006. In sum, the USPTO Interim Procedure provides that the PTAB will not deny instituting an IPR or PGR under *Fintiv*: (i) when a petition presents compelling evidence of unpatentability; (ii) when a request for denial under *Fintiv* is based on a parallel ITC proceeding; or (iii) where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or

IPR2022-00782
U.S. Patent No. 10,067,942

any grounds that could have reasonably been raised in the petition. *See* USPTO Interim Procedure at 9. Further, when the PTAB applies *Fintiv* factor two, the PTAB will consider the speed with which the district court case may come to trial and be resolved. *Id.*

Discretionary denial is warranted here because institution would be an inefficient duplication of multiple parallel district court litigations and would permit the true real parties-in-interest to use this Petition as a consequence-free trial balloon for arguments and evidence that will be used in the district court litigations and follow-on Petitions for the six patents asserted in the district court litigations, including the '942 Patent.

1. *Whether a Stay Exists or Is Likely To Be Granted If A Proceeding Is Instituted*

No stay has been issued in any of the parallel litigations. While some defendants in the Western District of Texas lawsuits have filed motions for severance and stay of the claims against them while the lawsuit proceeds against the other defendants, none of the defendants have requested a stay pending a

IPR2022-00782
U.S. Patent No. 10,067,942

decision on an IPR proceeding with respect to any asserted patent.¹⁰ Moreover, there is no reason to believe that a stay will be granted, especially since only one of the six asserted patents is being challenged in the Unified Patents' Petition. Further, Judge Albright, the presiding judge in both of the Texas cases, has only granted 5 of 14 contested motions for stay pending IPR since 2019. *See* EX2007. (Docket Navigator Motion Success Rate). Additionally, Judge Albright has publicly stated that he will very rarely grant stays pending *Inter Partes Review*. EX2008.

Given that there is no evidence that a stay will be requested in Delaware, or that the Western District of Texas would enter a stay, even if review were instituted, this factor weighs in favor of denying institution under 35 U.S.C. § 314(a). *See Fintiv*, IPR2020-00019, Paper 11 at 12 (A denial of a motion to stay, absent any indication that the district court will reconsider if a PTAB trial is instituted "sometimes weigh[s] in favor of exercising authority to deny

¹⁰ The defendants in the Western District of Texas lawsuits have filed motions to stay claims only against co-defendants SailPoint, Vistra and Clear Channel, while the lawsuits continue against Box and Dropbox. Box and Dropbox have filed motions to transfer the lawsuits to the Northern District of California, but not to stay the lawsuits against them.

institution.”); *see also Daiichi Sankyo, Inc. v. Seagen Inc.*, PGR2021-00042, Paper 12 at 14 (PTAB June 24, 2021) (finding this factor neutral because the record lacked sufficient evidence to suggest that a stay had been given or would be granted in the future in view of lack of request for stay and Petitioner’s assertion that it would seek a stay upon institution).

2. *Proximity of the District Court’s Trial Date to the Board’s Projected Statutory Deadline for a Final Written Decision*

Trials in both of the Western District of Texas cases are scheduled for early December 2023¹¹, which is roughly contemporaneous with the August 20, 2023 deadline for the potential final written decision from any review that may result from the instant Petition. *See* 35 U.S.C. §§ 314(b) and 316(a)(11) (providing that the final written decision must be issued 1 year after notice of institution, which shall occur within three months of the filing of the preliminary response). Trial in the District of Delaware litigation would follow in July 2024. EX2011.

¹¹ Trial in case No. 6:21-cv-01372 (Box Inc., Sailpoint Technologies Holdings, Inc., and Vistra Corp.) is set forth December 11, 2023. EX2009. Trial in case No. 6:21-CV-01373 (Dropox Inc., Sailpoint Technologies Holdings, Inc., and Clear Channel Outdoor Holdings, Inc.) is set forth December 18, 2023. EX2010.

IPR2022-00782
U.S. Patent No. 10,067,942

Topia filed its complaints in the Western District of Texas on December 29, 2021 and served Defendants days later. For the calendar years 2016-2020, the median time from filing to trial in the Western District of Texas was 21.3 months. For the 2021 calendar year, that increased to 25.5 months. EX2012, at 37. Topia filed its complaint in the District of Delaware on December 27, 2021. For the calendar years 2016-2020, the median time from filing to trial in Delaware was 27.5 months. For the 2021 calendar year, that increased to 36.5 months. EX2012, at 14.

Presumably, the increased median docket time in 2021 in both districts was due to a backlog created by the Covid-19 pandemic. As of March 31, 2022 (the most recent data available as of the filing of this preliminary response), the median time to trial for civil actions in the District of Delaware dropped to 36.3 months. That downward trend suggests that district courts are working back toward their lower month average. EX2016, at 14.

The average time from filing to disposition for civil cases for the in the Western District of Texas is 8.5 months, for the past twelve months ending on March 31, 2022 (the most recent data available as of the filing of this preliminary response), and up from the 7.3 month average for the past six calendar years. EX2016, at 37.

In the District of Delaware, the average time from filing to disposition for civil cases is only 7.9 months, for the past twelve months ending on March 31, 2022 (the most recent data available as of the filing of this preliminary response). EX2016, at 14; *See* EX2006, at 8 (“Where the parties rely on time-to-trial statistics, the PTAB will also consider additional supporting factors such as the number of cases before the judge in the parallel litigation and the speed and availability of other case dispositions.”)

There is no reason to believe any of the litigations will be delayed.

In sum, this factor does not militate in favor of institution neutral and warrants consideration of other dispositive factors that favor denial of institution. Importantly, regardless of the proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision, any final written decision would apply to only one of six patents asserted in the pending lawsuits. *See Fintiv*, IPR2020-00019, Paper 11 at 9 (“If the court’s trial date is at or around the same time as the projected statutory deadline or even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors discussed herein, such as the resources that have been invested in the parallel proceeding.”)

3. *Investment In the Parallel Proceeding By The Court And The Parties*

Under the third factor, the Board is to “consider[] the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, IPR2020-00019, Paper 11 at 9.

Not only are the trials close in time to the Board’s statutory deadline for a final written decision if the IPR is instituted, but by the time the Board’s institution decision is due on this Petition, in each of the Western District of Texas cases, fact discovery will have begun and claim construction will have been fully briefed and argued (if not decided). The Parties have already served preliminary infringement and invalidity contentions. EX2009-EX2010. Likewise, in the District of Delaware, discovery is already well underway, and initial contentions will have been served. Additionally, briefing has already begun on Defendant’s 35 U.S.C. § 101 motion and the Parties have invested significant time and resources in preparing over 50 pages of briefings that cover all six related patents. The briefing on the § 101 motion will be completed prior to the Board’s decision on institution. EX2011.

Discovery has already begun in all three litigations, and the Court in each litigation is already considering substantive motions — Defendants’ motions for transfer, severance, and stay in the Western District of Texas, and Defendant’s 35 U.S.C. § 101 motion for judgment on the pleadings in the District of Delaware. No. 6:21-cv-01372 (ECF Nos. 43-44); No. 6:21-CV-01373 (ECF Nos. 42-43); No.

1:21-cv-01821-MN (ECF Nos. 40-46). *See Canadian Solar Inc. v. The Solaria Corporation*, IPR2021-00095, Paper 12, 11 (PTAB May 26, 2021) (Finding that “significant discovery” in a parallel ITC investigation weighed “in favor of exercising [the Board’s] discretion to deny institution.”)

The parties’ substantial investment in the three district court litigations, including the work done to date as well as that which will be completed by the time an institution is due, favors denial of institution.

4. *Overlap Between Issues Raised In the Petition And in The Parallel Proceeding*

Under the fourth factor, as the Board found in *Fintiv*, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *See Fintiv*, IPR2020-00019, Paper 11 at 12. The parallel District Court litigations will decide all the issues in the Petition and more with respect to the ’942 Patent, as well as the five related other asserted patents.

All three invalidity grounds raised in the Petition – obviousness of claims 1, 3, 4, 10, 12, and 13 over Strong and Brezak, obviousness of claims 5-6 and 14-15 over Strong, Brezak, and Hamidi, and obviousness of claims 1, 3, 5-6, 10, 12, and 14-15 over Hamidi and Ellman and Hamidi, Ellman, and Brezak are based on the same prior art raised the defendants’ jointly filed preliminary invalidity contentions

IPR2022-00782
U.S. Patent No. 10,067,942

in the Western District of Texas lawsuits. EX2004. The testimony of Unified Patents' expert Dr. Long will likely be coextensive with expert testimony to be

[REDACTED]

Unified Patents has not attempted to mitigate any concerns of potentially conflicting decisions and duplicative efforts by filing a stipulation or offering to file a stipulation not to pursue the same grounds as in the Petition or any grounds that could have reasonably been raised in the Petition. *See Sand Rev'n II LLC v. Cont'l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (designated informative July 13, 2020); *see Sotera Wireless, Inc., v. Masimo Corp.*, IPR2020-01019, Paper 12 at 17 (PTAB Dec. 1, 2020) (precedential). Given that the Petition is directed toward only one of the six patents asserted in the pending three lawsuits against the same claims for that patent and based on the same references as in at least the preliminary invalidity contentions in the Western District of Texas lawsuits, and since Petitioner has not sought to mitigate any of these concerns, this factor favors denial of institution. *See, e.g., Fintiv*, IPR2020-00019, Paper 11 at 18 (weighing Factor 4 in favor of denial of institution based on “concerns of inefficiency and the possibility of conflicting decisions”).

5. Whether Unified Patents and the Defendant(s) In the Parallel Proceeding(s) Are The Same Party

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Moreover, all named defendants in the parallel litigations will benefit from Unified Patents' Petition and any subsequent filings and decisions related thereto, at least by reviewing Patent Owner's responses. *See Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1348 (Fed. Cir. 2018) ("the focus of the real-party-in-interest inquiry is on the patentability of the claims challenged in the IPR petition, bearing in mind who will benefit from having those claims canceled or invalidated.") The Petition against only one of six patents is a trial balloon designed to reveal a roadmap for the Defendants in the pending lawsuits for potential following petitions and an end-run-around the one year statutory estoppel following service of the complaint. This unfair advantage would be especially acute if the IPR is instituted.

IPR2022-00782
U.S. Patent No. 10,067,942

At least since its decision in *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 (PTAB Oct. 2, 2020) (precedential), the Board has not yet had the opportunity to decide, in a final written decision, whether, Unified Patents' members, who were not named as real parties-in-interest by Unified Patents, *but who were being contemporaneously sued in district court for infringement on the same patent at issue*, qualify as real parties-in-interest for the purpose of the *inter partes* review. See *Unified Patents LLC v. Micropairing Technologies LLC*, IPR2021-01557, Paper 15 (PTAB Apr. 12, 2022). [REDACTED] [REDACTED] are real parties-in-interest of Unified Patents, and as such, this factor favors denial of institution. See *Fintiv*, IPR2020-00019, Paper 11 at 15.¹²

6. *Other Circumstances That Impact the Board's Exercise of Discretion, Including the Merits*

The Board is to consider the merits of a petitioner's challenge when determining whether to institute a post-grant proceeding in view of parallel district court litigation. EX2006, at 4. As explained in more detail below in Section II.B, the Petitioner has failed to meet its burden under 37 C.F.R. § 42.108(c) of

¹² Should the Board institute a trial, Patent Owner will seek discovery from Petitioner related to the issue of the real party in interest.

IPR2022-00782
U.S. Patent No. 10,067,942

establishing a reasonable likelihood of success that any of the challenged claims are unpatentable, let alone a compelling case.

Additionally, Unified Patents only challenges a single patent of the six patents asserted in the three pending lawsuits. Expending the Board's resources in adjudicating only a subset of issues involving only the '942 Patent when three separate district court cases will proceed at least with respect to the other five related patents would not only be inefficient for the Board, but also each of the three district courts and the parties to these lawsuits.

Thus, taken together, this factor favors denial of institution as well.

B. The Board Should Exercise Its Authority and Deny Institution Under 35 U.S.C § 325(d)

The Board has the discretion to deny institution of an *inter partes review* under 35 U.S.C. §§ 314(a) and 325(d); *see also Cuozzo*, 136 S. Ct. at 2140 (“[T]he agency’s decision to deny a petition is a matter committed to the Office’s discretion.”); *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.”).

Discretionary denial is warranted here for two independent and important reasons.

First, *Becton Dickinson* compels denial of institution under 35 U.S.C. § 325(d) because the references cited in the Petition are substantially the same as

IPR2022-00782
U.S. Patent No. 10,067,942

prior art which was already considered by the Patent Office. *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, No. IPR2017-01586, Paper 8 at 17-20 (PTAB Dec. 15, 2017); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020). In *Becton, Dickinson*, the Board listed “the similarities and material differences between the asserted art and the prior art involved during examination” and “the cumulative nature of the asserted art and the prior art evaluated during examination” as one of a non-exhaustive list of factors when determining whether to exercise its discretion under § 325(d). *Becton, Dickinson*, IPR2017-01586, Paper 8 at 17-18.

1. *The Board Should Exercise Its Discretion Under § 325(d) To Deny Institution Because Similar Prior Art or Arguments Were Previously Considered By the Patent Office During Prosecution*

When exercising discretion under § 325(d), the Board “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.” 35 U.S.C. § 325(d). This petition 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.

The Board uses a two-part framework when determining whether to exercise its discretion under § 325(d). The first question asks: “whether the same or

IPR2022-00782
U.S. Patent No. 10,067,942

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.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. If either condition of the first part of the framework is satisfied, then the second question asks: “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.” *Id.*

Under the second part of the framework, “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.* The two-part framework articulated in *Advanced Bionics* employs the factors provided in *Becton, Dickinson*, in a slightly reorganized fashion. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 9-10, and n.10. These factors include:

- (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;
- (d) the extent of the overlap between the arguments made during examination and the manner in which a petitioner relies on the prior art or a patent owner distinguishes the prior art;

(e) whether a petitioner has pointed out sufficiently how the Office erred in evaluating 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, IPR2017-01586, Paper 8 at 17-18. Factors (a), (b), and (d) are relevant to the first question of whether the same or substantially the same art or arguments were previously presented. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9-10. Factors (c), (e), and (f) relate to the second question of “whether the petitioner has demonstrated a material error by the Office.” *Id.* at 10-11.

In this case, United Patents presents references and arguments that are similar in nature to the references and arguments that were previously considered by the Patent Office, and as such, there is substantial overlap between the arguments made during examination and the manner in which Unified Patents relies on the prior art and how the patent owner distinguishes the prior art. For example, in its four Grounds of Obviousness in this Petition, Unified Patents relies on Strong as a primary reference in Grounds 1 and 2, relies on Hamidi as a primary reference in Grounds 3 and 4, and relies on Hamidi as a secondary reference in Ground 2. However, both Strong and Hamidi are cumulative of references considered and distinguished by the Patent Office during prosecution, as discussed in detail below

in Section II.B.1(i)-(iv). Accordingly, the Board should exercise its discretion under 35 U.S.C. §§ 314(a) and 325(d) not to institute *inter partes* review.

i. Strong is Cumulative of Mohanty Which Was Previously Considered and Distinguished by the Patent Office

Unified Patents relies on Strong in Ground 1 and Ground 2 of its four Grounds of Obviousness. As related to the Petition, Strong is similar to the reference previously presented and analyzed by the Patent Office. *See, e.g.,* EX1002, at 182 (Examiner's reasons for allowance expressly stating that Mohanty does not disclose, make obvious, or otherwise suggest the structure of the claimed features), and at 153 (Patent Owner's remarks on patentability of the claimed features over Mohanty). Therefore, the Board should exercise its discretion here to deny institution because Ground 1 and Ground 2 of the Petition, which are based on Strong, are only cumulative of previously presented art and arguments.

During prosecution of the '942 Patent, in the first Office Action dated December 18, 2017, the Examiner rejected the claims as being anticipated by Mohanty (EX2001, at 117). Mohanty discloses a network management system that provides for weighted merging of changes, with the merge rules defined during configuration. *See, e.g.,* EX2001, Mohanty, at [0032]. Mohanty also 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

IPR2022-00782
U.S. Patent No. 10,067,942

flexible synchronization rules, and discloses in paragraph [0045] that the synchronization rules generally provide for a real-time propagation of *changes to files*. See EX2001, Mohanty, at [0009] and [0045]. 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 [0044].

The 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. EX1002, at 117-118.

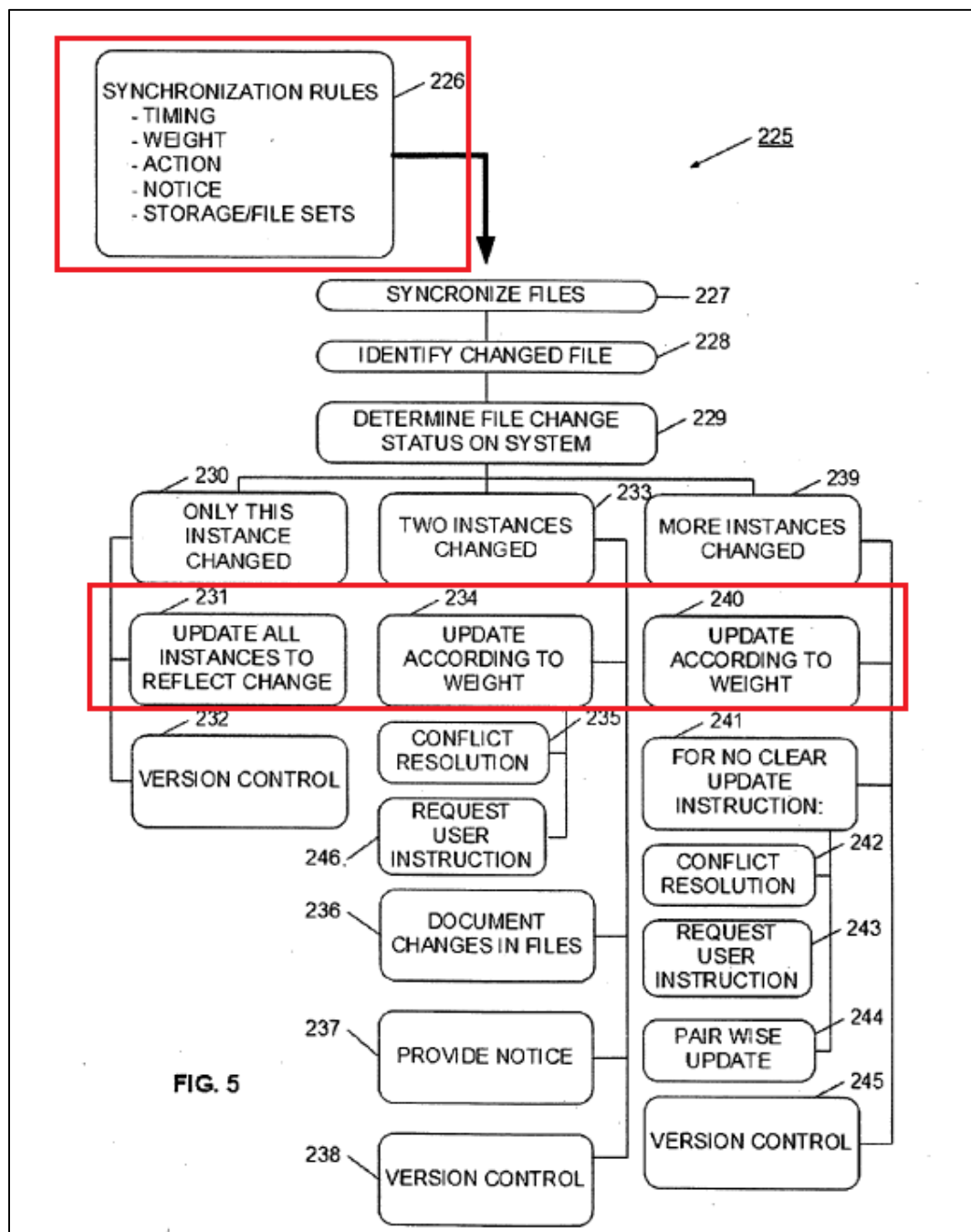


FIG. 5

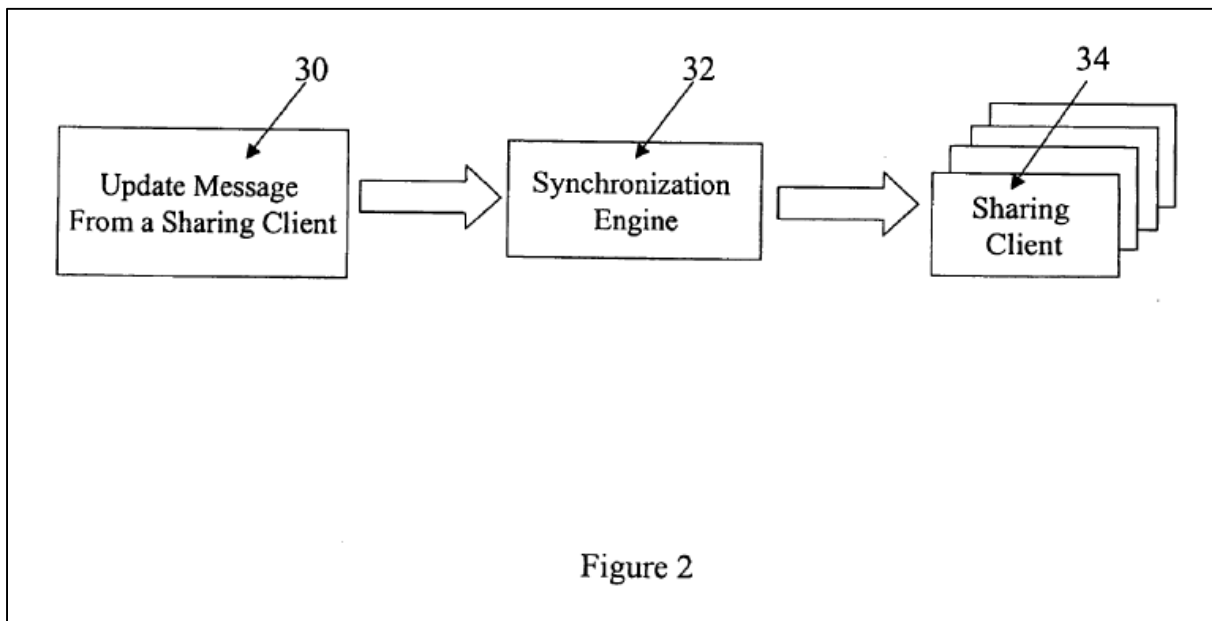
Mohanty (EX2001), FIG. 5 (annotated).

In response, Patent Owner argued that Mohanty merely provides for weighted merging of changes so as to provide file synchronization and that 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. EX1002, at 153. In view of this argument, and the claim amendments made on February 13, 2018 and April 12, 2018, the Examiner fully considered and evaluated Mohanty and concluded that the claims are allowable over Mohanty. EX1002, at 182.

There are no material differences between Strong and Mohanty evaluated during prosecution. Specifically, 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) to a plurality of sharing clients when at least one of the sharing clients updates or changes one of said files. *See* EX1006, Strong, *Abstract*. Strong at FIG. 2 and paragraph [0027] further discloses:

[I]f 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.



Strong (EX1006), FIG. 2.

As noted above, 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. *See* EX1006, Strong, at [0027]. The 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. *Id.*

Unified Patents argues 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. This is a mischaracterization of Strong. Paper No. 1, at 15-17. Sending an actual data object or an entire object is a completely different concept from sending an entire electronic file. Unified Patents

IPR2022-00782
U.S. Patent No. 10,067,942

boldly and intentionally ignores the fact that Strong is completely silent as to sending an electronic file. All 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. *See* EX1006, Strong, at [0027]. 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.

This aspect is further evidenced by the prosecution history of Strong. *See, e.g.,* EX2019, Strong File History, at 43 (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.

The rejection is respectfully traversed. 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 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] 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.

Strong File History (EX2019) at 43

Strong therefore discloses no more, in fact much less, than Mohanty as relates to the claimed feature of “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.” Strong is entirely cumulative of the art (e.g., Mohanty) previously presented to and evaluated by the Patent Office for this same claim feature.

*ii. Strong is Cumulative of Multer Which was Previously
Considered by the Patent Office*

Strong is cumulative of another reference that was previously considered by the Patent Office during prosecution. The '942 Patent is a child of U.S. Patent No. 9,143,561 ("the '561 Patent"), and Multer (EX2002) was relied upon during prosecution of '561 Patent to reject the claims of the '561 Patent. EX1010, at 229. Multer was considered and made of record by the Examiner during prosecution of the '942 Patent. *See, e.g.,* EX1002, at 257 (Examiner initialing that Multer was considered).

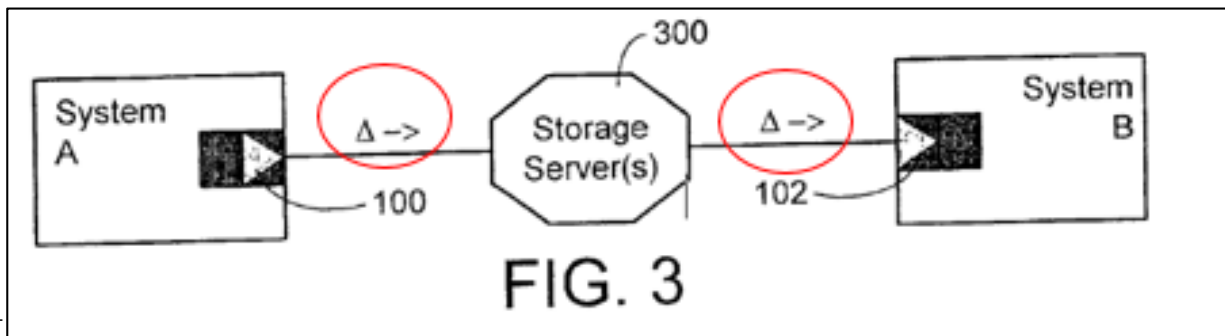
Specifically, during prosecution of '561 Patent, in the Office Action dated December 3, 2013, Multer was relied upon as teaching "a copy of a first electronic file automatically transferred from the second application subsequent to the user modifying the first electronic file" and "a copy of a second electronic file, automatically transferred from the third application, subsequent to the user modifying the second electronic file" EX1010, at 229

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.**" For example, in paragraphs [0030]-[0031], Multer discloses that 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. *See* EX2002, Multer, at 5.

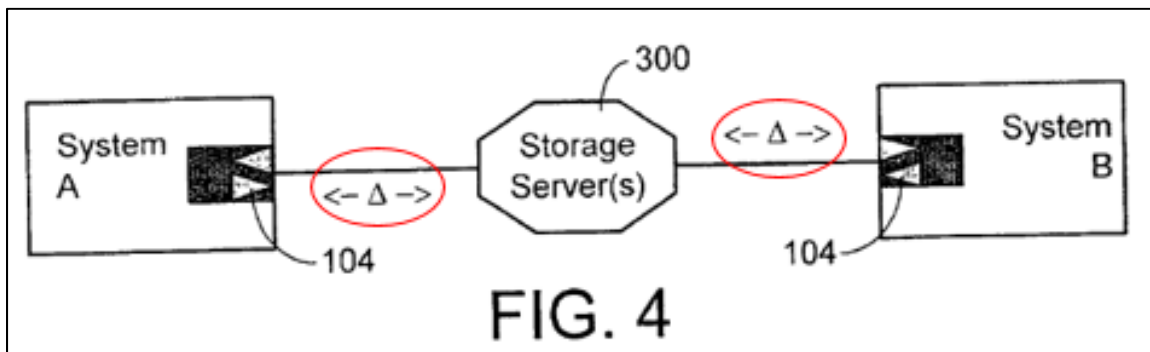
During the prosecution of the '561 Patent, the Examiner relied upon paragraph [0033]-[0034], [0055] and FIG. 3-5 of Multer for teaching “a copy of a first electronic file automatically transferred” from the second application...” EX1010, at 156 and 229.

Multer in paragraph [0033] discloses that a storage server 300 (see annotated FIG. 3 below) is adapted to receive **differencing information Δ** from the receiver 100 and provide it to the transmitter 102. *See* EX2002, Multer, at 5.



Multer (EX2002), FIG. 3 (annotated).

Further, Multer in paragraph [0034] discloses difference information Δ passed to and from System A through synchronizer 104 to and from the storage server 300 at a first point in time, and to and from System B at a second point in time. *See* EX2001, Mohanty, at 5.



Multer (EX2002), FIG. 4 (annotated).

In response, Patent Owner argued that (emphasis added):

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.**” As described in the cited paragraphs of [0030-0031], for example, 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. In the different embodiments of [0033] and [0034], for example, the common storage server is utilized for either one way or two way synchronization. Despite these disclosures, Applicant notes that nothing in the combination of McBride and Multer discloses the transfers as specifically recited by the system as configured.

EX1010, at 266-267.

Thus, Patent Owner made the distinction that claim 1 of '561 Patent was patentable over McBride¹³ and Multer at least because nothing in Multer discloses such automatic receipt of such files when the user modifies the files. *See* EX1010, at 266-267.

In view of this argument, and the claim amendments made on April 3, 2014 and April 10, 2014, the Examiner analyzed the Multer reference and agreed that the claims are allowable over Multer, by issuing a Notice of Allowability dated November 21, 2014. *See* EX1010, at 331.

During prosecution of the '942 patent, the Examiner did not see a proper basis to reject the claimed features of the '942 patent over the Multer reference. This is consistent with the fact that, as shown in EX1010, at 266-267, 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. As such, an anticipation or an obviousness rejection based upon the disclosure of Multer, of the patented claims directed to “receive ... **a copy of a modified first electronic file** ... responsive to the user modifying a content of the first electronic file” would have been improper.

¹³ U.S. Patent Publication 2002/0087588.

There are no material differences between Strong and Multer evaluated during prosecution of the '561 patent (i.e., the parent application). Specifically, as discussed above, 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. For at least the reasons discussed above, Strong is cumulative of the reference (e.g., Multer) that was already considered by the Patent Office.

iii. Hamidi is Cumulative of Mohanty Which was Previously Considered and Distinguished by the Patent Office

Unified Patents relies on Hamidi in Grounds 2-4 of its four Grounds of Obviousness. For similar reasons explained above at Section II.B.1(i) with respect to Strong, Hamidi is cumulative of Mohanty, which was considered and distinguished by the patent Examiner during prosecution. *See, e.g.*, EX1002, at 108 (Examiner's reasons for allowance expressly stating that Mohanty does not disclose, make obvious, or otherwise suggest the structure of the claimed features), 167-168 (Patent Owner's remarks on patentability of the claimed features over Mohanty). Therefore, the Board should exercise its discretion here to deny institution because Ground 3 and Ground 4 of the Petition, which are based on Hamidi, are merely cumulative of previously presented art and arguments.

As discussed above, Mohanty discloses a network management system, which has an architecture that is fundamentally different from the claims of the '942 patent. Mainly, Mohanty discloses a network management system that provides for weighted **merging of changes**. *See, e.g.,* EX2001, Mohanty, at [0032]. Mohanty also 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**. 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. *See* EX2011, at 12 and 15.

There are no material differences between Hamidi and Mohanty evaluated during prosecution of the '942 Patent. Specifically, similar to 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. *See* EX1008, Hamidi, *Abstract*.

For example, Hamidi is directed to a computer network for distributing files between client computers. According to Hamidi, a first enterprise cloned server receives a **change file indicative of changes** that have occurred to the network

storage file. The change file is then provided to at least one of a client computer proximate the first enterprise cloned server and another enterprise cloned server in communication with the first enterprise cloned server. *See* EX1008, Hamidi, *Abstract*.

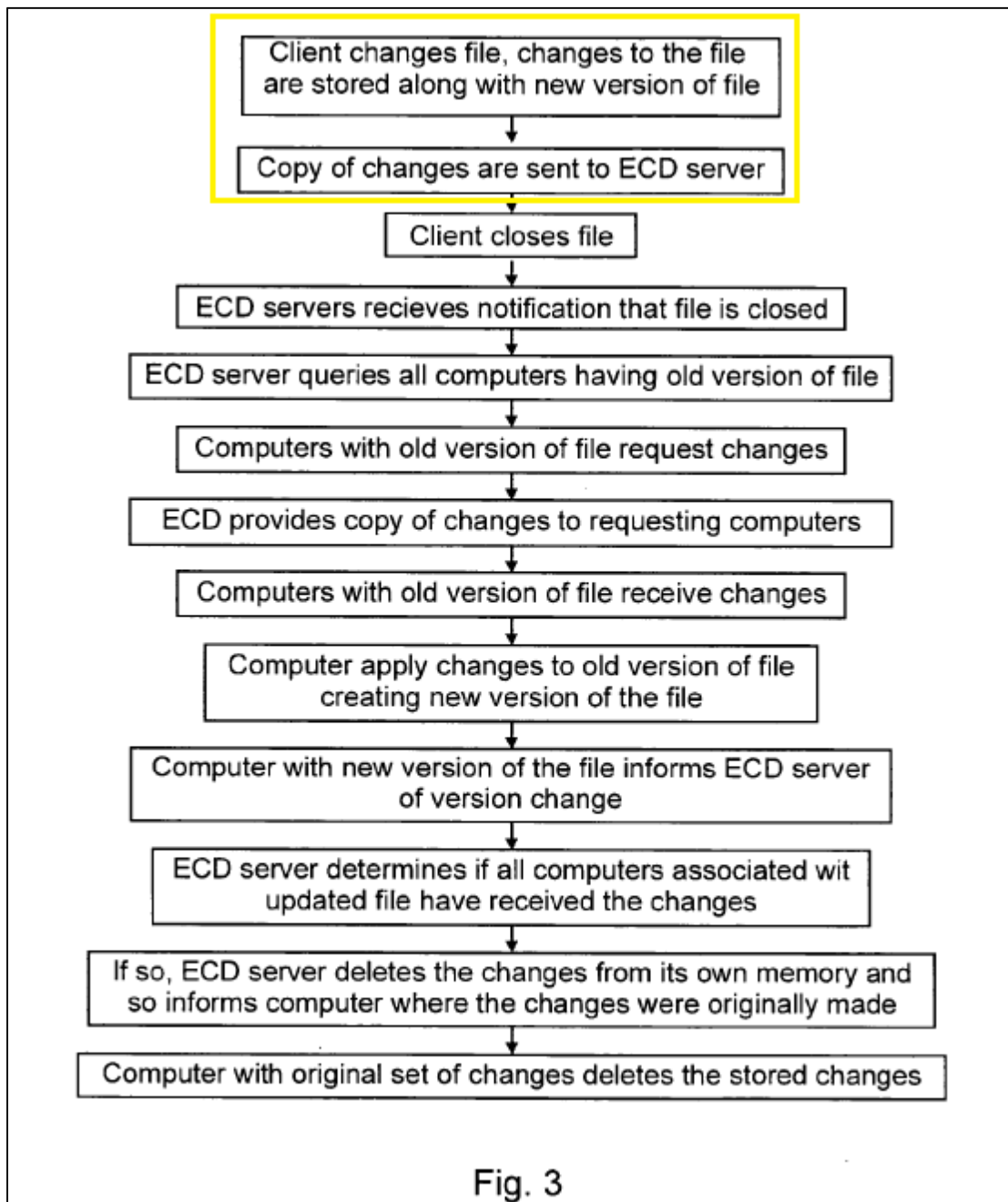
Specifically, as relied on by Unified Patents in its petition on pages 48, 52, 55, 56, 61, 66, 68, 71, 78 and 79, Hamidi discloses the following:

[0039] ... When a network storage file is saved it is stored on the hard disc drive of the computer that saved it along with **a changes file** that stores **all of the changes** that have been made from the previous version of the network storage file to the saved version. ... The **changes file** is generated ... 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 of the network storage file ... If a client computer that normally maintains a copy of the network storage file is not accessible then the ECD server 201 maintains a copy of **the changes file** ... The client computer that made the changes ... maintain a copy of the changes **file** until the ECD server 201 notifies the client computer that all of the client computers authorized to maintain a copy of the network storage file have applied the **changes file**. ...

[0042] ... The ECD server 201 ... queries the client computer to automatically **copy the changes file** to a storage medium of the ECD server 201. ... The ECD server 201 keeps a copy of the **changes file** until all client computers that normally maintain a copy of the network storage file receive the **changes file**. ...

EX1008, Hamidi, at [0039] – [0042].

Here, the key feature in these cited portions of Hamidi is the use of **change files**, which only store the **changes** that have been made from the previous version of the network storage file to the saved version. *See, e.g., id.*, at [0040] (stating “[t]hus, if a user is modifying a network storage file using a word processor and saving the network storage file at regular intervals then changes files indicative of **each set of changes** to the network storage file made **between each instance** of saving the network storage file are optionally uploaded to the ECD server 201 as these changes files are generated.”).



Hamidi (EX1008) FIG. 3 (annotated).

For at least the reasons discussed above, Hamidi is cumulative of Mohanty that was already considered and distinguished by the Patent Office.

*iv. Hamidi Cumulative of Multer Which was Previously
Considered by the Patent Office*

As discussed above, in Section II.B.2(ii), 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.**” In particular, in paragraphs [0030]-[0031], 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. *See* EX2002, Multer, at [0030]-[0031].

Again, during prosecution of the '942 patent, the Examiner did not see a proper basis to reject the claimed features of the '942 patent over the Multer reference. This is consistent with the fact that, as discussed in EX1010, at 131-136, the Multer reference, like Hamidi, is directed to “difference” or “change” information having an architecture that is fundamentally different from the claims of the '942 patent. As such, an anticipation or an obviousness rejection based upon its disclosure, of the patented claims directed to “receive ... **a copy of a modified first electronic file** ... responsive to the user modifying a content of the first electronic file” would have been improper.

There are no material differences between Hamidi and Multer evaluated during prosecution of the '561 patent (i.e., the parent application). Specifically, as discussed above, Hamidi discloses that a first enterprise cloned server receives a **change file** indicative of changes that have occurred to the network storage file. The **change file** is then provided to at least one of a client computer proximate the first enterprise cloned server and another enterprise cloned server in communication with the first enterprise cloned server. *See* EX1008, Hamidi, *Abstract*.

For at least the reasons discussed above, Hamidi is cumulative of the reference (e.g., Multer) that was already considered and distinguished by the Patent Office.

2. *The Board Should Exercise Its Discretion Under § 325(d) To Deny Institution Because the Petitioner Fails To Establish A Prima Facie Case of Obviousness*

Unified Patents 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.” Paper No. 1, at page 59

Absent a reasoned analysis and evidentiary support, Unified Patents has failed to provide a prima facie case of obviousness. In order to support combining Hamidi with Ellman, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Inf 1, Co, v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed.

Cir. 2006)). *See also Innogenetics, N.V. v, Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008) (“We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.

Specifically, Unified Patents’ rationale for combining Hamidi with Ellman is conclusory, and is deficient in evidentiary support, “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *KSR*, 550 U.S. at 418 (quoting *In re Kahn*, 441 F.3d at 988). *See also In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005) (“Although published subject matter is ‘prior art’ for all that it discloses, in order to render an invention unpatentable for obviousness, the prior art must enable a person of ordinary skill to make and use the invention”).

The mere fact that both Hamidi and Ellman discuss data synchronization does not establish a prima facie case of obviousness, or that it would have been obvious to combine the applied art. While Unified Patents further asserts that a person of ordinary skill in the art would have been motivated to modify Hamidi in light of Ellman’s disclosure, the provided reasons are merely conclusory as well. In particular, 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.

IPR2022-00782
U.S. Patent No. 10,067,942

It is a fundamental principle of law set forth by the Supreme Court in *KSR*, that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Here, Unified Patents’ arguments amount to no more than conclusory statements without sufficiently articulated reasoning to support its obviousness challenge.

For at least the reasons discussed above, the Petitioner has not established a prima facie case of obviousness.

3. *The Board Should Exercise Its Discretion Under § 325(d) To Deny Institution Because the Petition Fails To Properly Address Every Limitation Of The Challenged Claims*

The Petition fails to establish a reasonable likelihood of prevailing, 35 U.S.C. § 314(a), because it fails to properly show the presence of all elements of the challenged claims in the prior art. Specifically, all independent claims of the ’942 patent (i.e., claims 1 and 10) require “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; determining whether the first electronic device is in communication with the second electronic device; and automatically sending,

IPR2022-00782
U.S. Patent No. 10,067,942

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.” These features are referred to as elements 10.4, 10.5 and 10.6 in the Petition. *See* Paper No. 1, at 68.

In its Petition, Unified Patents states that “[f]or the same reasons discussed regarding elements 10.1 through 10.3, these limitations are taught by the combination of Hamidi and Ellman.” *See* Paper No. 1, at 68. However, 10.1, 10.2 and 10.3 are not identical to 10.4, 10.5 and 10.6. In an attempt to remedy this deficiency, Unified Patents summarily concludes that the “two-way synchronization” or “bi-directional synchronization” in Ellman would disclose elements 10.4, 10.5 and 10.6. *See id.*

Moreover, Unified Patents suggests that Topia failed to provide the Examiner with relevant information about bi-directionality of file synchronization from the PCT Counterpart (EX1003). *See id.*, at 5.

To the contrary, on February 2, 2009, (within **two month** of the Search Report issued on December 14, 2008 in the PCT Counterpart), Topia provided the Examiner, in an Information Disclosure Statement, the references (20050091316 to Ponce et al., 20070180084 to Mohanty and 20020026478 to Rodgers et al.) cited in the Search

IPR2022-00782
U.S. Patent No. 10,067,942

Report. *See* EX1010, at 345-347. Moreover, along with the Information Disclosure Statement, Topia submitted a Certification Statement stating “That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. *See* 37 CFR 1.97(e)(1).” *See id.*

As shown above, 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.

In fact, taking into consideration the numerous prior art available at the time of the prosecution, the Examiner identified the novelty in elements 10.4-10.6 and suggested to the Patent Owner for allowance. Specifically, the Examiner examined elements 10.4-10.6 on their own merits and found them to have novelty in combination with the other limitations of the independent claims. EX1002, at 108 (“These features, together with the other limitations of the independent claims are novel and non-obvious over the prior art of record”).

Petitioner has not shown – and cannot show – that the Examiner made material error in his consideration of prior art. *See Advanced Bionics*, IPR2019-01469, Paper No. 6, at 9 (“[i]f reasonable minds can disagree regarding the purported treatment of

IPR2022-00782
U.S. Patent No. 10,067,942

the art or arguments, it cannot be said that the Office erred in a manner material to patentability.”)

Thus, the Petitioner’s request to revisit the same issues previously and clearly considered and rejected the Patent Office is unwarranted.

III. CONCLUSION

For at least the foregoing reasons, the Petition should be denied in its entirety, and no *inter partes* review should be instituted.

Date: AUGUST 22, 2022

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), Patent Owner hereby certifies that the present paper contains 9,888 words (as counted by the “Word Count” feature of Microsoft WordTM). This word count excludes the table of contents, table of authorities, table of exhibits, certificate of word count, and certificate of service.

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the attached Patent Owner Preliminary Response is being served by electronic mail on the following counsel of record:

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