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IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

TOPIA TECHNOLOGY, INC., Plaintiff, v. DROPBOX, INC., Defendants.	Case No. 3:23-cv-00062-JSC **JOINT INITIAL CASE MANAGEMENT CONFERENCE STATEMENT** Date: February 9, 2023 Location: Zoom Webinar, 1:30 p.m. Judge: Jacqueline Scott Corley

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Under Federal Rule of Civil Procedure 26(f), Civil Local Rule 16-9, Patent Local Rule 2-1(b), and the Standing Order for All Judges of the Northern District of California for Contents of Joint Case Management Statement, Plaintiff Topia Technology, Inc. ("Topia" or "Plaintiff") and Defendant Dropbox, Inc. ("Dropbox") submit this Joint Initial Case Management Conference Statement.

The parties met and conferred on February 2, 2023, under Fed. R. Civ. P. 26(f).

I. Jurisdiction and Service

This action arises under 35 U.S.C. § 271. The Court has subject matter jurisdiction. No issues exist regarding personal jurisdiction, and no party remains to be served.

II. Facts

A. Brief Chronology

Plaintiff's Statement: Plaintiff Topia was founded by Ms. Janine Terrano in 1999, who remains its CEO today. Since its founding, Topia has developed and patented critical technologies and provided essential products related to document management in complex and secure network environments.

Joint Statement: Topia filed this case on December 29, 2021, in the Western District of Texas, claiming infringement by Dropbox of six patents.[1] On January 8, 2022, Topia amended its complaint. (Docket No. 8). On March 11, 2022, Dropbox answered the amended complaint. (Docket No. 21). Topia has also filed suits against Box, Inc. ("Box") and Egnyte, Inc., alleging infringement of the patents-in-suit.[2]

Petitions for *inter partes* review ("IPRs") have been filed against all asserted claims of the

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[1] U.S. Patent No. 9,143,561 ("the '561 Patent"), U.S. Patent No. 10,067,942 (the "'942 Patent"), U.S. Patent No. 10,289,607 (the "'607 Patent"), U.S. Patent No. 10,642,787 (the "'787 Patent"), U.S. Patent No. 10,754,823 (the "'823 Patent"), U.S. Patent No. 11,003,622 (the "'622 Patent") (collectively "the patents-in-suit").

[2] *See Topia Technology, Inc. v. Box, Inc.*, No. 6:21-cv-01372 (W.D. Tex.), filed December 29, 2021, transferred to the Northern District of California as Case No. 3:23-cv-00063 on January 6, 2023; *Topia Technology, Inc. v. Egnyte, Inc.*, No. 1:21-cv-01821 (D. Del.), filed December 27, 2021.

patents-in-suit (the "Asserted Claims").[3]

In the Egnyte litigation, Egnyte filed a motion alleging that the patents-in-suit are invalid under 35 U.S.C. § 101.[4] The Court has conditionally granted that motion as to two of the six patents in suit, while allowing Topia to move to amend the pleadings, after which the Court will reconsider this issue.

Topia served infringement contentions on April 28, 2022. Dropbox served invalidity contentions on July 14, 2022.

On September 1, 2022, Dropbox filed its opening claim construction brief. (Docket No. 44). On September 22, 2022, Plaintiff filed its responsive claim construction brief. (Docket No. 40). On October 6, 2022, Dropbox filed its reply claim construction brief. (Docket No. 51). A *Markman* hearing was originally set for January 4, 2023, in the Western District of Texas. (Docket No. 52).

Dropbox filed an opposed motion to, *inter alia,* transfer Topia's claims against Dropbox to the Northern District of California on July 25, 2022. (Docket No. 42). Judge Albright granted Dropbox's motion to transfer the day before the scheduled *Markman* hearing, on January 3, 2023, (Docket No. 73) and cancelled the *Markman* hearing. (Docket No. 72).

B. Principal Factual Issues in Dispute

The parties are aware of the following principal factual issues in dispute: (1) Whether the asserted patent claims are valid and enforceable; (2) Whether Dropbox infringed the asserted claims of the patents-in-suit; (3) The appropriate damages for any infringement;

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[3] On April 15, 2022, Unified Patents, LLC filed an IPR against the '942 Patent. The PTAB instituted the IPR on November 17, 2022. That IPR challenges all asserted claims from the '942 Patent. Oral argument, if requested, will occur on August 22, 2023. On January 4 and 5, 2023, Box, Inc. and Dropbox filed IPR petitions challenging all 56 asserted claims across the six patents-in-suit.

[4] *See Topia Technology, Inc. v. Egnyte, Inc.*, No. 1:21-cv-01821-CJB (Docket No. 39). The Court held a hearing on the motion on December 20, 2022 and granted-in-part Egnyte's motion, finding the '561 and '942 Patents ineligible under § 101. (See Docket No. 68).

(4) Whether any infringement is willful; and (5) Whether any other forms of relief are due to any party.

III. Principal Legal Issues in Dispute

The parties are aware of the following principal legal issues in dispute:

1. The proper construction of patent claim terms.

2. Whether the claims of the patents-in-suit are invalid for failure to satisfy one or more requirements of 35 U.S.C. §§ 100 et seq., including §§ 101, 102, 103, 112, and 116;

3. Whether by reason of prior art and/or statements and representations made to the United States Patent and Trademark Office during prosecution of the applications that led to the patents-in-suit are so limited that no claim can be construed as covering any Dropbox product or service;

4. Whether Topia is barred from recovering any pre-lawsuit claim for damages for failure to comply with 35 U.S.C. §§ 286, 287;

5. Whether Topia's claims for patent infringement are precluded to the extent that any accused functionality or acts are located or performed outside of the United States;

6. Whether Topia's claims are barred, in whole or in part, by the doctrines of waiver, estoppel, acquiescence, unclean hands, and/or implied license.

7. Whether this case is exceptional under 35 U.S.C. § 285;

8. Whether any other forms of relief are due to any party.

IV. Motions

Administrative Motion to Relate Cases: Pursuant to Civil Local Rules 3-12 and 7-11, Dropbox has moved the Court to relate *Topia Technology, Inc. v. Box, Inc.*, Case No. 3:23-cv-00063-TLT ("Box Action") to this Action. (Docket No. 92). Dropbox has respectfully requested that both actions, once related, be assigned to Judge Corley, as the Dropbox Action is the lower numbered suit. In addition, Dropbox has requested that the Court continue the February 9, 2023, Case Management Conference until after the two actions are related. Having now had time to consider Dropbox's position and consult with its client, Topia is in agreement with this motion.

Other Motions: The parties anticipate they will seek entry of a protective order governing confidentiality in this action.

Dropbox plans to file a motion to stay the case in light of the IPR petitions it has filed against all of the Asserted Claims of the patents-in-suit and the pending IPR filed by a third party against one of the six patents-in-suit.

Dropbox plans to file motions under 35 U.S.C. § 101, which it contends invalidates all of the Asserted Claims of the patents in suit. The parties are also working to resolve issues related to unanswered discovery served on Topia prior to transfer, which may result in motion practice.

V. Amendment of Pleadings

The parties continue to investigate their claims and will amend the pleadings if appropriate. They propose the Court allow amendment of pleadings under Rule 15 until March 1, 2023, with any later amendment requiring good cause under Rule 16.

VI. Evidence Preservation

The parties have reviewed the Guidelines Relating to the Discovery of Electronically Stored Information and have met and conferred under Fed. R. Civ. P. 26(f) regarding reasonable and proportionate steps taken to preserve evidence relevant to the issues reasonably evident here.

VII. Disclosures

The parties have already exchanged initial disclosures.

VIII. Discovery

The parties conducted discovery on issues relevant to the motion to transfer in the Western District of Texas. Dropbox served merits discovery on Topia before the case was transferred. The parties anticipate that the scope of discovery will address the disputed legal and factual issues set forth above.

Subject to the Court's approval, the parties propose the following discovery limitations:

A. Interrogatories: The default number of 25 interrogatories per side provided for by the Federal Rules of Civil Procedure are sufficient for this case.

B. Requests for Admission: 40 per side, except regarding authenticity

C. Requests for Production: unlimited

D. Fact Depositions: 70 hours of deposition time per side, including examination, redirect, and cross-examination of adverse, Rule 30(b)(6), third-party, and a party's own witnesses, with a presumptive limit of 7 hours of deposition time for any deponent under Rule 30(b)(1) or Rule 45. If any deposition requires an interpreter, the time would be doubled and the hours counted against the limit would be halved.

E. Expert Depositions: 7 hours of examination for each expert report. For example, if an expert prepares reports on validity and infringement, they will sit for two days of deposition, each including 7 hours of examination.

F. Electronic Discovery: The parties have reviewed the Guidelines Relating to the Discovery of Electronically Stored Information ("ESI Guidelines"), and further confirm that they have met and conferred regarding the issue. The parties will notify the Court if they believe discovery of ESI is necessary in this case.

IX. Class Action

This is not a class action.

X. Related Cases

There is a related case in this District, *Topia Technology, Inc. v. Box, Inc. et al.,* Civ. Act. No. 3:23-cv-00063-TLT, with a case management conference set for April 6, 2023, and a related case pending against Egnyte in Delaware, *Topia Technology, Inc. v. Egnyte, Inc.*, Civ. Act. No. 1:21-cv-01821-CJB.

XI. Relief

Topia asks the Court to enter judgment against Dropbox and provide the following relief:

1. Declaring that Dropbox infringed the patents-in-suit;

2. Awarding Topia its damages suffered as a result of Dropbox's infringement of the patents-in-suit, including pre-judgement and post- judgement interest and supplemental damages for any continuing post-verdict or post- judgement infringement with an accounting as needed;

3. An order enjoining Dropbox, its officers, agents, employees, attorneys, and all other persons or entities acting in concert, participation, or in privity with one or more of them, and their successors and assigns, from infringing the patents-in-suit;

4. Declaring that this is an exceptional case and awarding Topia its reasonable attorneys' fees and costs in this action, as provided by 35 U.S.C. § 285;

5. A judgment, declaration, or order that Dropbox's infringement is willful and increasing damages under 35 U.S.C. § 284;

6. Awarding Topia its costs, attorney's fees, expenses, and interest; and

7. Granting Topia such further relief as may be requested and as the Court finds appropriate.

Dropbox asks the Court to enter:

8. A judgment dismissing Plaintiff's Amended Complaint against Dropbox with prejudice;

9. A judgment in favor of Dropbox on all Counterclaims;

10. A declaration that Dropbox has not infringed, contributed to infringement of, or induced others to infringe, any valid claim of the patents-in-suit;

11. A declaration that the claims of the patents-in-suit are invalid;

12. A declaration that this case is exceptional and an award of Dropbox's reasonable costs and expenses of litigation including attorneys' fees and expert witness fees;

13. A judgment barring Plaintiffs ability to enforce the patents-in-suit in equity; and

14. Such other and further relief as this Court may deem just and proper.

XII. Settlement and ADR

All parties remain open to discussion of settlement but have not yet agreed to any formal process for mediation or arbitration. However, Dropbox and Topia are interested in a magistrate led settlement conference.

XIII. Consent to Magistrate Judge for All Purposes

All parties did not consent to a magistrate judge conducting all further proceedings.

XIV. Other References

This action is not suitable for reference to binding arbitration, a special master, or the Judicial Panel on Multidistrict Litigation.

XV. Narrowing of Issues

The parties are currently unable to narrow any issues by agreement or otherwise, but may be able to do so after fact discovery and claim construction.

XVI. Expedited Schedule

The procedure in General Order No. 64 Attachment A is not appropriate in this action.

XVII. Scheduling

Topia's Position: This case has already been through a full contention exchange and *Markman* briefing, and was scheduled for a *Markman* hearing on January 4, 2023, which was cancelled on January 3, 2023. It would accordingly ensure a speedy and efficient determination of this matter for this Court to conduct a *Markman* hearing in this matter at its earliest convenience without further briefing. The parties can then use the Court's claim constructions to focus their exchange of information as set forth in the Patent Local Rules of this Court. Dropbox's proposal to woodenly follow the Local Rules and duplicate all of the efforts leading up to the point is simply a defense tactic to greatly delay this case and increase its costs.

Dropbox's Position: The new case schedule should be based on the NDCA Patent Local Rules. Because the requirements of the NDCA Patent Local Rules differ from the rules in WDTX, Topia will need to amend its disclosure of infringement contentions to comply

with NDCA, PLR 3-1 and 2. Per NDCA, PLR 3-3, invalidity contentions will follow 45 days later.

Depending on the nature of the changes to Topia's disclosure of infringement contentions, there may be additional claims terms that need to be construed, which could necessitate additional claim construction briefing.

Parties' Positions: A table summarizing the areas of agreement and disagreement between the parties across the entire schedule for this matter is included as Exhibit A.

XVIII. Trial

This case will be tried to a jury. The parties anticipate a trial length of no more than two weeks, including jury selection.

XIX. Disclosure of Non-Party Interested Entities

The Parties filed individual statements pursuant to Civ. L.R. 3-15.

Topia filed its Certificate of Interested Entities on July 15, 2023 (Docket No. 81) disclosing that the following persons, associations of persons, firms, partnerships, corporations (including parent corporations) or other entities have a financial interest in the subject matter in controversy or in a party to the proceeding: (1) Topia Technology Inc. – Plaintiff; (2) Sughrue Mion PLLC – Plaintiff's Counsel; and (3) Burford Capital Ltd. – Capital Provider.

Dropbox filed its Certificate of Interested Entities or Persons on January 25, 2023 (Docket No. 85), disclosing that pursuant to Civil L.R. 3-15, Dropbox has no conflict or interest (other than the named parties) to report.

XX. Professional Conduct

All attorneys of record have reviewed the Guidelines for Professional Conduct for the Northern District of California.

XXI. Other Matters that Facilitate Just, Speedy, Inexpensive Disposition

A. PLR 2-1(b)(2)—Scope and Timing of Claim Construction Discovery

The parties will evaluate whether any claim construction discovery is necessary after the exchange of preliminary claim constructions and extrinsic evidence.

B. PLR 2-1(b)(3)—Proposed Format of Claim Construction Hearing

The parties request a hearing before the Court regarding the patent claim terms addressed in the completed *Markman* briefing. The parties believe 30 minutes for each side will be sufficient. The parties are amenable to this hearing via Zoom.

C. **PLR 2-1(b)(4)—How Parties Intend to Educate the Court on Technology**

If the Court deems it necessary, the parties will present the Court with a technology tutorial. The parties believe a video tutorial of 30 minutes per side is sufficient and would allow the Court to view the material at its convenience, and review the material as needed.

D. **PLR 2-1(b)(5)—Non-Binding, Good-Faith Estimate of Damages Range**

Topia's Position: Topia is unable to provide any estimate of damages without discovery of sales of the infringing products, their profitability, and any licenses Dropbox may have entered into relating to the infringing products, all of which will most likely need to be considered by an expert witness to provide lost profits and/or a reasonable royalty opinion. Topia accordingly does not believe it can provide such an estimate until it has at least secured such discovery as well as retained an expert witness in this area.

Dropbox's Position: PLR 3-8 requires Topia to identify each of the categories of damages it is seeking for the asserted infringement, as well as its theories of recovery, factual support for those theories, and computations of damages within each category, including: (1) lost profits; (2) price erosion; (3) convoyed or collateral sales; (4) reasonable royalty; and (5) any other form of damages. Topia can comply with this requirement even if it does not know the precise volume of sales of the infringing products.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 2, 2023

By: */s/ Benjamin A. Katzenellenbogen*
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ATTESTATION

I, Benjamin A. Katzenellenbogen, am the ECF user whose user ID and password authorized the filing of this Document. Under Civil L.R. 5-1(i)(3), I attest that all signatories to this document have concurred in this filing.

Dated: February 2, 2023 */s/ Benjamin A. Katzenellenbogen*

CERTIFICATE OF SERVICE

I hereby certify that on February 2, 2023, JOINT INITIAL CASE MANAGEMENT CONFERENCE was served to all counsel of record electronically or by another manner authorized by Federal Rule of Civil Procedure 5(b)(2).

/s/ Estefania Munoz
Estefania Munoz

EXHIBIT A

Event	Topia's Proposed Date	Dropbox's Proposed Date
Initial Case Management Conference	Thursday, February 9, 2023 (Dropbox and Topia request that the hearing be reset after this case is consolidated with the related case against Box, Inc.)	Same
Initial disclosures	Already completed	Same
Disclosure of infringement contentions; Plaintiff's initial production (Pat. Loc. R. 3-1 and 3-2)	Two weeks following the Court's Claim Construction	Four weeks after the ICMC
Defendant's invalidity contentions; Defendant's initial production (Pat. Loc. R. 3-3)	Four weeks following the Court's Claim Construction	45 days after disclosure of infringement contentions
Plaintiff's damages contentions (Pat. Loc. R. 3-8)	Thursday, June 1, 2023	50 days after Defendant's invalidity contentions
Defendant's responsive damages contentions (Pat. Loc. R. 3-9)	Thursday, July 13, 2023	30 days after Plaintiff's damages contentions
Exchange of proposed terms for construction (Pat. Loc. R. 4-1)	Already completed	14 days after service of invalidity Contentions
Exchange of Preliminary Claim Constructions and Extrinsic Evidence (Pat. Loc. R. 4-2)	Already completed	21 days after the exchange of the lists pursuant to Patent L.R. 4-1
Joint Claim Construction and Prehearing Statement and Expert Reports (Pat. Loc. R. 4-3)	Already completed	60 days after service of invalidity Contentions
Opening Claim Construction Brief (Pat. Loc. R. 4-5)	Already completed	45 days after serving and filing the Joint Claim Construction and Prehearing Statement
Responsive Claim Construction Brief (Pat. Loc. R. 4-5)	Already completed	14 days after service of an opening brief
Reply Claim Construction Brief (Pat. Loc. R. 4-5)	Already completed	7 days after service of a responsive brief
Claim construction hearing	At the Court's convenience	Same
Case Management Conference to set further deadlines	Subject to the Court's availability, the first Thursday at least two weeks after the Court's claim construction order	Same