

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 PRELIMINARY RESPONSE

PURSUANT TO 37 C.F.R. § 42.107(a)

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE PETITION MUST BE DISMISSED FOR NOT INCLUDING ALL RPIS AND FOR FAIRNESS AND JUDICIAL ECONOMY	1
	A. Facts	2
	B. Petitioners Failed To Identify Egnyte As An RPI	4
	1. Egnyte Is An RPI Of Petition	6
	2. Failure To Name All RPIS Is Fatal To The Petition	15
	C. The Board Should Exercise Its Authority And Deny Institution In View Of <i>Fintiv</i> And Judicial Economy	16
	1. Whether A Stay Exists Or Is Likely To Be Granted	18
	2. Proximity Of The District Court’s Trial Date	18
	3. Investment In the Parallel Proceeding	19
	4. Overlap Between Issues Raised In The Petition	20
	5. Whether Petitioners And The Defendant(s) In the Parallel Proceeding(s) Are The Same Party	21
	6. Other Circumstances That Impact The Board’s Exercise Of Discretion, Including The Merits	23
	D. The <i>General Plastic</i> Factors Weigh Heavily In Favor of Denying Institution	24
	1. Whether The Same Petitioner Previously Filed A Petition Directed To The Same Claims Of The Same Patent	24
	2. Whether at The Time Of Filing Of The First Petition The Petitioner Knew Of The Prior Art Asserted In The Second Petition or Should Have Known Of It	27

3. Whether At The Time Of Filing Of The Second Petition The Petitioner Already Received The Patent Owner’s Preliminary Response or the Board’s Institution Decision In The First Petition ...	27
4. The Length Of Time That Elapsed Between The Time The Petitioner Learned Of the Prior Art Asserted In The Second Petition And The Filing Of The Second Petition.....	28
5. Whether The Petitioner Provides Adequate Explanation For The Time Elapsed Between The Filings Of Multiple Petitions Directed to the Same Claims Of The Same Patent	28
6-7. The Finite Resources Of The Board; And The Requirement Under 35 U.S.C. §316(a)(11) To Issue A Final Determination Not Later Than 1 Year After the Date On Which The Director Notices Institution of Review	28
III. PETITIONERS HAVE NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CLAIM.....	29
A. The Board Should Deny Institution Under § 325(d) Because the Same Prior Art was Previously Considered by the Office	29
B. Petitioners Have Failed to Establish a Reasonable Likelihood of Prevailing on Ground 1 Because the Prior Art Fails to Disclose Several Expressly Recited Features of the Claims	33
1. Sigurdsson does not disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”	34
2. Shappell does not disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”	37
3. Rao does not disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”	38

4. Sigurdsson does not disclose “automatically transfer, based on the first priority being greater than the second priority, the first metadata over a network to a second client device associated with the user” ...	40
5. The terms “automatically transferring” and “based on the first priority being greater than the second priority” must be given proper and full weight	43
6. HTTP Client/Server architecture structurally requires a request then response based approach	45
7. Shappell does not cure the deficiencies of Sigurdsson	46
8. Sigurdsson does not disclose automatically transferring the copy of the first file to the second client device associated with the user responsive to receiving the copy of the first file from the first client device.....	48
C. Petitioners Have Failed to Establish a Reasonable Likelihood of Prevailing on Ground 2 Because the Prior Art Fails to Disclose Several Expressly Recited Features of the Claims	
1. Brown, Shappell, and Rao do not disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file” and “automatically transfer, based on the first priority being greater than the second priority, the first metadata over a network to a second client device associated with the user”	52
2. Brown does not disclose automatic transfer of the first metadata or automatic transfer of the file to the receiving client because it adopts HTTP Client/Server architecture that structurally requires a request then response based approach	55
3. Hesselink teaches a pull-based HTTP server system and thus fails teach automatic file transfer by the server	58
4. Hesselink and Brown fail to motivate the combination because Hesselink’s peer-to-peer embodiment cannot be modified to teach	

“automatic transfer” of the modified file from the server to a client device.....	59
5. Neither Shappell nor Rao nor discloses “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”	60
IV. CONCLUSION.....	61

TABLE OF AUTHORITIES

Cases

<i>Agilent Tech., Inc. v. Waters Tech. Corp.</i> , IPR2019-01131, Paper 12, 13-14, (PTAB 2019).....	8, 9
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB 2020) (precedential)	17
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11, 2 (PTAB 2020) (precedential)	passim
<i>Applications in Internet Time, LLC v. RPX Corp.</i> , 897 F.3d 1336, 1349 (Fed. Cir. 2018) (<i>AIT I</i>)..	6, 11, 12, 15
<i>Canadian Solar Inc. v. The Solaria Corporation</i> , IPR2021-00095, Paper 12, 11 (PTAB 2021)	20
<i>Cisco Systems, Inc. v. Estech Systems, Inc.</i> , IPR2021-00329, Paper 13, 14 (PTAB 2021)	22
<i>Commscope Inc., v. TQ Delta, LLC</i> , IPR2022-00352, Paper 13, 9 (PTAB 2022).....	6
<i>CommScope Techs. LLC v. Dali Wireless, Inc.</i> IPR2022-01242, Paper 23, 3 and 5 (PTAB 2023) (precedential)	23
<i>Daiichi Sankyo, Inc. v. Seagen Inc.</i> , PGR2021-00030, Paper 11, 17 (PTAB 2021).....	22
<i>Google, LLC. v. Personalized Media Comm., LLC.</i> , IPR2020-00723, Paper 22, 7 (PTAB 2020)	18
<i>Johnson Health Tech, Co. Ltd. v. Icon Health & Fitness, Inc.</i> , IPR2014-01242, Paper 16, 15 (PTAB 2015)	10
<i>NHK Spring Co. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (PTAB 2018) (precedential).....	2
<i>NHK Spring Co., Ltd. v. Intri-plex Technologies</i> , IPR2018-00752, Paper 8 (PTAB 2018) (precedential)	17
<i>Paramount Home Entm't, Inc. v. Nissim Corp.</i> , IPR2014-00961, Paper No. 11, 9 (PTAB 2014).....	9
<i>PayPal, Inc. v. PersonalWeb Technologies, LLC</i> , IPR2019-01111, Paper No. 27, 25 (PTAB 2019).....	12
<i>Pfenex, Inc. v. Glaxosmithkline Biologicals SA</i> , IPR2019-01478, Paper 9, 15 (PTAB 2020).....	29
<i>Power Integrations, Inc. v. Semiconductor Components Indus., LLC</i> , 926 F.3d 1306, 1316 (Fed. Cir. 2019)	12
<i>Radware, Inc. v. F5 Networks, Inc.</i> , IPR2017-01249, Paper 10, 5 (PTAB 2019)	10
<i>Rovi Guides, Inc. v. Vidal</i> , No. 2020-1994, 2022 U.S. App. LEXIS 10465 (Fed. Cir. Apr. 19, 2022)	43
<i>RPX Corp. v. Applications in Internet Time, LLC</i> , IPR2015-01750, Paper 128, 5 (PTAB Oct. 2, 2020) (precedential) (<i>AIT II</i>)	passim
<i>Sand Rev'n II LLC v. Cont'l Intermodal Grp. – Trucking LLC</i> , IPR2019-01393, Paper 24, 7 (PTAB 2020) (informative)	21
<i>See Code200, UAB v. Bright Data, Ltd.</i> , IPR2022-00861 & IPR2022-00862, Paper 18, 5 (PTAB 2022) (precedential)	24
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential). 20, 21	
<i>Stryker Corp. v. KFx Medical, LLC</i> , IPR2019-00817, Paper 10, 27–28 (PTAB 2019).....	22
<i>Trimble Inc. v. Perdiemco LLC</i> , 802 Fed. Appx. 556, 558 (Fed. Cir. 2020).....	9
<i>United Fire Protection Corp. v. Engineered Corrosion Sol'ns, LLC</i> , IPR2018-00991, Paper 10, 11 (PTAB 2018)	26, 27
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i> , IPR2019-00062, -00063, -00084, Paper 11, 2 (Apr. 2, 2019) (precentral).....	26
<i>Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.</i> , IPR2017-00651, Paper 152, 6 (PTAB 2019) (precedential)	6

<i>Volkswagen Group of America, Inc. v. Arigna Technology Ltd.</i> , IPR2021-01263, Paper 16, 12 (PTAB 2022)	15
<i>Wi-Fi One, LLC v. Broadcom Corp.</i> , 887 F.3d 1329, 1336 (Fed. Cir. 2018)	6
<i>Zoll Lifecore Corp. v. Philips Elec. N.A. Corp.</i> , IPR2013-00615, Paper 15, 15 (PTAB 2014)	10

Statutes

35 U.S.C. §312(a)(2)	4
35 U.S.C. §314(b)	18
35 U.S.C. §315(b)	1, 4, 15
35 U.S.C. §316(a)(11)	18

Other Authorities

Trial Practice Guide	7, 29
USPTO R. Prof'l Conduct 11.107	9

Regulations

37 C.F.R. §42.108(c)	23
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TABLE OF EXHIBITS

Exhibit	Description
2001	Hearing Transcript and Order Denying Defendant Egnyte’s Motion to Stay in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB
2002	Screenshot of Egnyte Inc.’s Webpage, captured May 8, 2023: https://www.egnyte.com/dropbox-replacement
2003	Defendant Egnyte’s invalidity contentions in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB
2004	Defendants’ joint invalidity contentions in <i>Topia Technology, Inc. v. Box, Inc., SailPoint Technologies Holdings, Inc., and Vistra, Inc.</i> , 6:20-cv-01175-ADA and <i>Topia Technology, Inc. v. Dropbox, Inc., SailPoint Technologies Holdings, Inc., and Clear Channel Outdoor Holdings, Inc.</i> , 6:21-cv- 001373-ADA
2005	Scheduling Order in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB
2006	Scheduling Order in <i>Topia Technology, Inc. v. Box, Inc., SailPoint Technologies Holdings, Inc., and Vistra, Inc.</i> , 6:20-cv-01175-ADA and <i>Topia Technology, Inc. v. Dropbox, Inc., SailPoint Technologies Holdings, Inc., and Clear Channel Outdoor Holdings, Inc.</i> , 6:21-cv-001373-ADA
2007	USPTO Memo regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (“Fintiv Memo”)

2008	<i>Pro Hac Vice</i> Motion for Heidi Keefe filed by Defendant Egnyte in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB, D.I. 61 (and screenshot of Minute Order granting motion)
2009	Motion to stay filed by Defendant in <i>Topia Technology, Inc. v. Box, Inc.</i> , 3:23-cv-00063-JSC
2010	<i>Unified Patents LLC v. Justservice.net LLC</i> , IPR2020-01258, Exhibit 2017 (PTAB 2022)
2011	<i>Unified Patents LLC v. Topia Technology, Inc.</i> , IPR2022-00782, Paper 8 (PTAB 2022)
2012	Proof of service for complaint filed against Egnyte in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB
2013	Reserved
2014	Curriculum Vitae of Dr. Prashant Shenoy
2015	Selected Excerpts from Microsoft Computer Dictionary, Fifth Edition (2002)
2016	Declaration of L. Roman Rachuba
2017	Declaration of Dr. Prashant Shenoy

I. INTRODUCTION

The Board should decline to institute *inter partes* review of U.S. Patent No. 10,754,823 (“the ’823 Patent”) at least because Petitioners (1) fail to establish a reasonable likelihood that any challenged claim is obvious over the prior art, (2) rely on the same or substantially the same prior art that were previously presented to the Office, (3) fail to name all real parties in interest, and (4) risk wasting significant Board and judicial resources because trial on the ’823 Patent is scheduled before any final written decision will issue.

II. THE PETITION MUST BE DISMISSED FOR NOT INCLUDING ALL RPIS AND FOR FAIRNESS AND JUDICIAL ECONOMY

Petitioners’ failure to name all real parties-in-interest (“RPis”), including time-barred Egnyte, Inc. (“Egnyte”), necessitates denial of institution under 35 U.S.C. §315(b). Additionally, the Board should exercise its discretion to deny under 35 U.S.C. §314(a) “because institution of a trial at the PTAB would be an inefficient use of Board resources in light of the ‘advanced state’ of the parallel district court litigation in which the petitioner had raised the same invalidity challenges” and would reward Petitioners’ gamesmanship in their invalidity defense strategy. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 2 (PTAB 2020) (precedential) (“Fintiv”) (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*,

IPR2018-00752, Paper 8 (PTAB 2018) (precedential). Moreover, Petitioners' late-filed follow-on Petition severely prejudices Patent Owner, who was forced to disclose its validity positions in its Preliminary Reply to Unified Patents LLC's ("Unified") Petition for *inter partes* review of related U.S. Patent No. 10,067,942 ("the '942 Patent"), wherein at least Petitioner Dropbox Inc. ("Dropbox") was an unnamed RPI. *Unified Patents LLC. v. Topia Technology, Inc.*, IPR2022-00782 (PTAB 2022).¹

A. Facts

Patent Owner Topia filed suit against Petitioners Box, Inc. ("Box") and Dropbox in the Western District of Texas ("WDTX") in December, 2021.² The Complaints were served January 5, 2022. In January, 2023, both cases were transferred to the Northern District of California ("NDCA"). Topia also filed suit against Egnyte in December, 2021, in Delaware, asserting the same patents as those asserted against Box and Dropbox.³ Service on Egnyte was effected December 27, 2021. The instant Petition was filed January 4, 2023, one day before one-year time deadline. *See* § 315(b). But the instant Petition was filed **more** than

¹ Following a joint motion to terminate the proceedings, the Board did not have an opportunity to fully consider whether Dropbox was an unnamed RPI of Unified in IPR2022-00782.

² The cases against Box and Dropbox are *Topia Technology, Inc. v. Box, Inc., SailPoint Technologies Holdings, Inc., and Vistra, Inc.*, 6:20-cv-01175-ADA and *Topia Technology, Inc. v. Dropbox, Inc., SailPoint Technologies Holdings, Inc., and Clear Channel Outdoor Holdings, Inc.*, 6:21-cv-001373-ADA.

³ *Topia Technology, Inc. v. Egnyte, Inc.*, C.A. No. 21-1821-CJB.

one year after the Complaint was served on Egnyte in Delaware. As shown below, Egnyte is joined at the hip to Box and Dropbox both in the district court litigations and in this IPR and is a real party-in-interest in this proceeding. Because the present Petition was filed more than one year after Egnyte was served with a Complaint, the Petition is time-barred and should be dismissed. The following supporting facts are undisputed:

- Egnyte has been time-barred from filing an IPR since before the instant Petition was filed;
- Trial with Egnyte will occur prior to any final written decision resulting from this Petition;
- Petitioners and Egnyte are parties to a joint defense agreement to further their goal of invalidating the '823 and related Patents;
- Petitioners' lead counsel for this Petition, Heidi Keefe of Cooley LLP, also represents Egnyte and Petitioner Box, Inc. ("Box") in district court proceedings involving the '823 patent and its related patents;
- Egnyte has a "long history" with Cooley LLP;
- Months before the filing of this Petition, Box (through Ms. Keefe as lead litigation counsel), Dropbox, and Egnyte prepared and served identical invalidity contentions in their respective district court cases;

- The lead grounds of these invalidity contentions are the same as in the instant Petition;
- Ms. Keefe argued Egnyte’s only substantive motion in District Court, an unsuccessful invalidity challenge on December 20, 2022, while simultaneously working (and merely two weeks later) executing the current IPR Petition filed January 4, 2023;
- Neither Petitioners nor Egnyte agree to be bound by a *Sotera* disclaimer regarding the grounds in this Petition; and
- Egnyte filed an unsuccessful motion to stay its district court case based on the instant Petition by Box and Dropbox.

These facts are expanded upon in the discussions below.

B. Petitioners Failed To Identify Egnyte As An RPI

Inter partes review petitions are required under 35 U.S.C. §312(a)(2) to identify all RPIs. Further, §315(b) precludes institution where, as here, “the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party-in-interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” *Id.* The facts demonstrate that Egnyte is both an RPI to this Petition and a privy of Petitioners. Pet., 1.

For over 17 months, Petitioners and Egnyte have been intertwined with respect to not only this Petition, but also the co-pending litigations which involve

the '823 Patent and its five related patents⁴ (together, the “Asserted Patents”) because: (a) they share litigation counsel in all forums where the Asserted Patents are at issue, including the instant proceeding in which Ms. Keefe is lead counsel (*see e.g.*, EX2008 and EX2009); (b) they are pursuing a single and unified invalidity defense strategy in all forums; and (c) they are parties to a joint defense agreement (“the Agreement”) (EX2001, 9:17-19, 10:9-10). Indeed, the collaborating Defendants have submitted *identical* invalidity contentions, of which the grounds in the Petition overlap. *C.f.* EX2003 (Egnyte contentions), and EX2004 (Petitioners’ contentions), both at 19 and 69. As Judge Burke stated in Egnyte’s Delaware case: “it’s about as close as you can get in terms of coordinating and understanding, et cetera, as you might.” EX2001, 11:10-12.

Likewise, both Petitioners and Egnyte (who clearly desires *inter partes* review of the '823 Patent) stand to directly benefit by previewing Patent Owner’s arguments.

⁴ Topia asserts the '823 Patent and five related patents (U.S. Patent Nos. 10,289,607; 11,003,622; 10,642,787; 9,143,561; and 10,067,942) (together “the Asserted Patents”) against Petitioners and Egnyte, respectively in *Topia Technology, Inc. v. Box, Inc.*, 3:32-cv-00063LB and *Topia Technology, Inc. v. Dropbox, Inc.* 3:23-cv-00062AGT (both cases transferred from W.D. Texas to N.D. Cal. in January 2023), and *Topia Technology, Inc. v. Egnyte, Inc.*, C.A. No. 21-1821-CJB (filed December 27, 2021 in D. Del.). All six patents have been petitioned for *inter partes* review by Petitioners.

1. Egnyte Is An RPI Of Petition

The determination of RPIs “should ‘sweep[]’ broadly.” *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128, 5 (PTAB 2020) (precedential) (*AIT II*) (citing *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1349 (Fed. Cir. 2018) (*AIT I*)). “Whether a non-party is a real party in interest is a ‘highly fact-dependent question.’” *AIT II*, 7 (quoting *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152, 6 (PTAB 2019) (precedential). “[T]he focus of the real-party-in-interest inquiry is on the patentability of the [challenged] claims . . . , **bearing in mind who will benefit** from having those claims canceled or invalidated.” *AIT II*, 5 (emphasis added). “To decide whether a party other than the petitioner is the real party-in-interest, the Board seeks to determine whether some party other than the petitioner is the ‘party or parties at whose behest the petition has been filed.’” *Commscope Inc., v. TQ Delta, LLC*, IPR2022-00352, Paper 13, 9 (PTAB 2022) (citing *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1336 (Fed. Cir. 2018). In performing this analysis, the Board considers the following factors, however, the analytical approach must remain “flexible [and] take[] into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *AIT II*, 2 (citing *AIT I*, 1351). Egnyte is unquestionably “a clear

beneficiary that has a preexisting, established relationship with the petitioner[s].”

AIT II, 2. On balance, the factors weigh heavily in favor of Egnyte being an RPI.

Petitioners’ Relationship With Egnyte (Factor (d))

Egnyte and Petitioners share a close relationship for purposes of this proceeding and the related litigations, and have demonstrated a high degree of coordination in all forums. This Petition is the latest effort of Petitioners’ and Egnyte’s unified invalidity strategy. Petitioners and Egnyte are parties to the Agreement, at least with respect to the related litigations. Petitioners and Egnyte share “materials related to [the] common defenses, like non-infringement, [and] invalidity”) EX2001, 9:21-23. Trial Practice Guide (“TPG”), 17 (Explaining that membership in a joint defense agreement is relevant to the RPI inquiry.)

Petitioners’ selected prior art challenge grounds are the progeny of Egnyte’s invalidity contentions served September 2022 in the parallel district court proceeding, months before the instant Petition was filed. EX2003, 19, 69. Indeed, Egnyte’s invalidity contentions are themselves *identical* to Petitioners’ invalidity contentions served in their district court proceedings. EX2004, 19, 69. Presumably, Egnyte financed at least a share of the collaborative invalidity contentions that are a basis for this Petition. Put plainly, Petitioners and Egnyte are pursuing a single patent invalidity strategy across multiple forums. Their interests are not merely aligned, but are one.

Moreover, Box and Egnyte share litigation counsel, including Ms. Keefe, in their respective cases. Ms. Keefe also serves as lead counsel for this Petition (and every IPR brought by Petitioners against the Asserted Patents), representing both Petitioners. Egnyte also has “a long history” with Ms. Keefe’s law firm Cooley, LLP. EX2001, 10:5-7; EX2008 and EX2009. As the Board is aware, common counsel is relevant to the RPI inquiry and tends to weigh in favor of finding that an unnamed third party is an RPI. *Agilent Tech., Inc. v. Waters Tech. Corp.*, IPR2019-01131, Paper 12, 13-14, (PTAB 2019)

Petitioners selected their counsel for this Petition with full knowledge that she simultaneously represents Egnyte in a parallel district court litigation, has intimate knowledge of Egnyte’s interests and attendant invalidity strategies, and is ethically constrained by these interests and strategies in any relevant forum. While preparing the present Petition, Ms. Keefe also represented Egnyte in the Delaware action where she argued Egnyte’s only substantive motion to date—a §101 invalidity motion on the Asserted Patents. Ms. Keefe, carries this ethical obligation while proceeding to work simultaneously on two projects with the same goal of invalidating the Asserted Patents. As counsel to all parties, Ms. Keefe cannot advocate on behalf of Box and Dropbox in the Petition without also ensuring that positions she takes are in the interest of Egnyte. As counsel to Egnyte she continues to have an ethical obligation to zealously advocate Egnyte’s interests in

all proceedings. This proceeding is no exception. *Trimble Inc. v. Perdiemco LLC*, 802 Fed. Appx. 556, 558 (Fed. Cir. 2020) (“A lawyer shall not, without informed written consent from each client . . . , represent a client if the representation is directly adverse to another client in the same or a separate matter.” (quoting Cal. R. of Prof'l Conduct 1.7(a)); *see also* USPTO R. Prof'l Conduct 11.107. It is unreasonable to think that Ms. Keefe can build a separating wall in her own mind and not let the left side of her brain influence the right side. Ms. Keefe's obligation necessitates that Petitioners control and execute their instant IPR strategy at the behest of Petitioners *and Egnyte*. To be clear, given Ms. Keefe's ethical obligations, Petitioners cannot take positions adverse to Egnyte's interests in this proceeding. *See* EX2001, 11:10-12 (“The Court: [I]t's about as close as you can get in terms of coordinating and understanding, et cetera, as you might.”).

Ms. Keefe's dual role as counsel both to Petitioners and to Egnyte is probative of the fact that Egnyte is an RPI .. *Agilent Tech.*, 13-14 (“[I]n addition, Agilent and ProZyme share common counsel in the civil actions. Thus, we agree with Patent Owner that the totality of circumstances ‘strongly suggests a centrality of decision making and a coordinated strategy for defending against Patent Owner's infringement claims.’”) (citing *Paramount Home Entm't, Inc. v. Nissim Corp.*, IPR2014-00961, Paper No. 11, 9 (PTAB 2014) (finding that shared counsel may be relevant to the RPI inquiry); *Zoll Lifecore Corp. v. Philips Elec. N.A.*

Corp., IPR2013-00615, Paper 15, 15 (PTAB 2014) (“While common counsel alone is not dispositive of control, we are persuaded that Petitioner's actions[, including “receiv[ing] legal counsel from the same legal representative”,] have blurred sufficiently the lines of corporate separation with its parent.”); *Johnson Health Tech, Co. Ltd. v. Icon Health & Fitness, Inc.*, IPR2014-01242, Paper 16, 15 (PTAB 2015) (“JHT's control over JHTNA is further evidenced by the fact that the same attorneys representing JHTNA in the Utah Action also represented JHT in the reexam and currently represent both JHT and JHTNA in this inter partes review.”); *Radware, Inc. v. F5 Networks, Inc.*, IPR2017-01249, Paper 10, 5 (PTAB 2019) (“The following additional considerations, together with the aforementioned indicators of corporate blurring, suggest that Radware, Ltd. has control, or the opportunity to control, the *inter partes* review before us: (1) Petitioner and Radware Ltd’s history of litigating together against Patent Owner; and (2) Petitioner and Radware, Ltd.’s shared litigation counsel Fabio Marino, who also serves as Petitioner’s lead counsel for the Petition before us.”).

The totality of circumstances, including shared counsel and materials, the Agreement, and the identical invalidity contentions, demonstrate Petitioners’ and Egnyte’s “preexisting, established relationship” (*AIT II*, 2) in executing a single, unified patent invalidity strategy. This factor weighs heavily in favor of Egnyte being considered an RPI, especially given the Federal Circuit’s directive to

interpret “real-party-in-interest” “broadly” and “expansively.” *AIT I*, 897 F.3d, 1349.

Egnyte’s Interest And Benefit From The IPR (Factor (e))

Egnyte is accused of infringing the ’823 Patent and therefore has a self-evident interest in this invalidity challenge. Furthermore, the Petition relies upon grounds that derive from Egnyte’s previously-served invalidity contentions, identical to Petitioners’ in their respective cases and recycled in the Petition. EX2003 and EX2004, 19 and 69. This is not surprising, since Egnyte was time-barred from seeking its own *inter partes* review. Thus, Egnyte is a clear and direct beneficiary.

Despite this collaborative work, Egnyte has refused to be bound by any estoppel stemming from this IPR. *See* EX2001, 22:12-18. Without the Board’s intervention, Egnyte will be free to raise the identical invalidity grounds actually raised in this Petition and more, with the further benefit of previewing Patent Owner’s responsive arguments and overall strategies. Indeed, all parties to the Agreement will be able to benefit from repeated and refined invalidity arguments that Egnyte can raise in District Court. These benefits to Egnyte are in addition to any favorable final written decision. EX2001, 15:8-11 (The Court: “There could certainly be some benefit to [Egnyte] were those IPRs to work out in a certain way, because they involved the same patents.”). Accordingly, this factor weighs heavily

in favor of Egnyte being considered an RPI. *AIT II*, 24-25 (“[W]e agree with Patent Owner that, because of the pending litigation, the invalidation of the challenged patents would provide a benefit to Salesforce, supporting a conclusion that Salesforce is an RPI in these proceedings.”).

Petitioners’ Explanation Of Their Own Interest (Factor (b)) And Whether And Under What Circumstances Petitioners Take Egnyte’s Interest Into Account (Factor (c))

As Petitioners are accused of infringing the ’823 Patent, they certainly have an interest in this invalidity challenge. This interest, however, does not negate Egnyte’s interests and their role in this proceeding. *PayPal, Inc. v. PersonalWeb Technologies, LLC*, IPR2019-01111, Paper No. 27, 25 (PTAB 2019) (“[I]n drafting §315(b), Congress ‘chose language that bars petitions where proxies or privies would benefit from an instituted IPR, even where the petitioning party might separately have its own interest in initiating an IPR.’ [] Thus, representing their own interests in addition to those of Amazon’s does not negate a finding [of] a privity [relationship].”) (citing *Power Integrations, Inc. v. Semiconductor Components Indus., LLC*, 926 F.3d 1306, 1316 (Fed. Cir. 2019) and *AIT I*, 1347.

Egnyte’s interests have directly shaped the invalidity grounds raised in the Petition. The Petition’s grounds were first raised in the collaborative invalidity contentions of the joint defense parties—including Egnyte. As Egnyte’s invalidity contentions necessarily take Egnyte’s interests into account, and Petitioners’

invalidity contentions are identical to Egnyte's, the Petition's grounds from this collaborative work product ultimately flow—at least in part—from Egnyte's interests.

Egnyte's interests are also represented by Petitioners' choice of lead counsel in this *inter partes* review—Ms. Keefe—who also represents Egnyte in Delaware. Petitioners are necessarily constrained by Egnyte's interests in this proceeding, as discussed above with reference to Factor (d).

Whether Petitioners Can Be Said To Be Representing Egnyte's Interest (Factor (f))

Petitioners' and Egnyte's interests are 100% aligned in their unified invalidity defense strategy, and both Petitioners and Egnyte have an interest in previewing Patent Owner's strategies and arguments in defending the Asserted Patents. If the IPR is instituted, Egnyte will be able to argue the exact same grounds raised in the Petition, all with the further benefit of conferring and strategizing with Petitioners, pursuant to the Agreement, to analyze Patent Owner's responsive arguments. Petitioners represent Egnyte's interests in executing, ***via common counsel***, a unified invalidity strategy that includes filing IPR petitions that Egnyte could not as a time-barred party. Thus, this factor weighs heavily in favor of Egnyte being considered an RPI. *AIT II*, 25 (“[I]t stands to reason that RPX inevitably represented Salesforce's interests, and provided benefit to Salesforce, by filing IPR petitions challenging the same patents asserted against

Salesforce in infringement litigation, in a manner that Salesforce itself could not do as a §315(b) barred party.”)

Egnyte Desired IPR Review (Factor (g))

The fact that the '823 Patent is being asserted against Egnyte, who failed to timely file or join an IPR attacking the same patent, is “persuasive evidence that [Egnyte] would have been interested in Board review of the patentability of the claims in the patents asserted against it in litigation, supporting a conclusion that [Egnyte] is an RPI in these proceedings.” *AIT II*, 27.

Communications Between Petitioners And Egnyte (Factor (i))

Communications between Petitioners and Egnyte (or through counsel) is evidenced by their collaborative efforts in the common invalidity contentions from which the Petition’s grounds are sampled. Moreover, Petitioners and Egnyte are parties to the Agreement and share common litigation counsel, who is also lead counsel to this Petition.

“Even if [Egnyte] did not directly discuss filing an IPR, the discussions of litigation are naturally tied to possible defenses, of which an IPR challenge is one. The discussion of pending litigation by [Patent Owner] against [Egnyte] by [Petitioners], who subsequently filed an IPR, weighs in favor of finding that [Egnyte is] an interested party. Such communications need not expressly involve a request by [Egnyte] for [Petitioners] to file an IPR petition.” *AIT II*, 30.

This factor weighs in favor of Egnyte being considered an RPI.

Petitioners' Business Model (Factor (a))

Neither Petitioner is a member-group organization structured to file IPR challenges, as was petitioner RPX in *AIT I*. However, Petitioners and Egnyte are closely intertwined and are parties to the Agreement, which evidences a privity relationship that the business model factor examines. *See AIT I*, 897 F.3d 1363 (“[I]f the extent of the legal obligations between the parties... is such that the parties share a high degree of commonality of proprietary or financial interest, privity is established and §315(b) bars the institution of the IPR petitions.”); *Volkswagen Group of America, Inc. v. Arigna Technology Ltd.*, IPR2021-01263, Paper 16, 12 (PTAB 2022) (“Moreover, unlike in *AIT Remand*, where petitioner was a defensive patent aggregation entity, the issues of control and funding, in this case, carry less weight in view of the evidence of Conti/Volkswagen's assertions to the two district courts, the nature of their relationship, and the degree to which Conti stands to benefit from Volkswagen's filing of the Petition.”).

2. *Failure To Name All RPIs Is Fatal To The Petition*

Egnyte was served with a complaint alleging infringement of the '823 Patent on December 27, 2021, over one year before the January 4, 2023 filing date of this Petition. As a result, and because Egnyte is an RPI, the Petition must be dismissed pursuant to §315(b).

C. The Board Should Exercise Its Authority And Deny Institution In View Of *Fintiv* And Judicial Economy

Petitioners’ and Egnyte’s attempt to circumvent efficiency and fairness safeguards in disregard of the requirements for RPI disclosure will waste significant Board and court resources on this and the related IPR petitions for the Asserted Patents.⁵ While the district court cases against Petitioners are stayed pending an institution decision, the Delaware court expressly denied Egnyte’s motion to stay, finding that Egnyte made a deliberate choice to pursue a §101 challenge as opposed to filing an IPR petition. EX2001, 19-20 . This same litigation will have proceeded to trial by the time the Board issues any hypothetical final written decision stemming from this petition. The Delaware court will decide the same issues raised in this Petition and more, given that Egnyte refuses to be bound by any estoppel agreement. EX2005, 20; EX2001, 8:22-23(Egnyte’s Counsel: “we don't think it's right that Egnyte should have to agree or be bound by any estoppel provisions[.]”) Petitioners also did not submit a *Sotera* stipulation. Instead, Petitioners only claim to “not pursue invalidity in litigation based on any *instituted* ground,” further demonstrating their gamesmanship and strategy to avoid estoppel provisions. Pet., 5.

⁵ The IPRs on the other related Asserted Patents are: IPR2023-00433; IPR2023-00429; IPR2023-00430; IPR2023-00431; and IPR2023-00427.

Moreover, significant resources have been expended by Patent Owner, Petitioners, unnamed RPI Egnyte, and the judicial system. In Delaware, infringement contentions have been exchanged, briefing on claim construction is nearly complete (only Egnyte's sur-reply remains outstanding), and substantial document production is complete. Fact discovery will close in September. EX2005, 19. With respect to Petitioners, prior to the respective cases being transferred to the NDCA, in the WDTX, the parties fully briefed claim construction, and exchanged contentions (Petitioners' invalidity contentions in the WDTX are identical to Egnyte's in the Delaware). EX2006; EX2003, EX2004. Discovery is on-going in the NDCA.

In determining whether to deny institution, the Board is to consider the presence and status of parallel district court litigation. *NHK Spring Co., Ltd. v. Intri-plex Technologies*, IPR2018-00752, Paper 8, 11 (PTAB 2018) (precedential), and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB 2020) (precedential) ("Fintiv"). *Fintiv* sets forth a non-exhaustive list of factors discussed below that balance system efficiency and fairness considerations when considering discretionary denial. The *Fintiv* factors should be considered in view of guidance provided in the June 21, 2022 Memo regarding Post-Grant Proceedings with Parallel District Court Litigation. ("*Fintiv* Memo"). See EX2007.

Discretionary denial is warranted here because institution would be an inefficient duplication of multiple parallel district court litigations and would unjustly reward Egnyte's and Petitioners' circumvention of the Rules to use this Petition as a consequence-free trial balloon for arguments and evidence that will be used in their District Court litigations involving the Asserted Patents, including the '823 Patent.

1. Whether A Stay Exists Or Is Likely To Be Granted

Though the NDCA cases against Petitioners are stayed pending an institution decision, the Delaware Court has explicitly denied Egnyte's motion to stay. EX2001, 53:22-54:2. This factor weighs against institution. *See Fintiv*, 12.

2. Proximity Of The District Court's Trial Date

Trial with Egnyte in the Delaware Court is scheduled for July 22, 2024, weeks before the August 9, 2024 deadline for when any final written decision would be due should this trial be instituted. *See* 35 U.S.C. §§314(b) and 316(a)(11). There is no reason to believe that trial will be delayed, particularly as the Delaware court has expressly denied Egnyte's stay motion.

The NDCA cases do not yet have a trial date.

Given that at least the trial in the Delaware court will proceed before the expected final written decision date, this factor favors denial. *Google, LLC. v. Personalized Media Comm., LLC.*, IPR2020-00723, Paper 22, 7 (PTAB 2020).

3. Investment In the Parallel Proceeding

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*, 9.

Patent Owner, Petitioners, unnamed RPI Egnyte, the NDCA and the Delaware court have all spent significant resources on the Asserted Patents including the '823 Patent.

In the NDCA, both parties already exchanged their first set of document requests and interrogatories. Prior to the respective cases being transferred to the NDCA, the parties fully briefed claim construction, exchanged contentions, and argued Petitioners' motions to transfer from the WDTX. The Parties have been litigating for over seventeen months. EX2012; EX2006.

In Delaware, substantial document production is complete, claim construction is nearly fully briefed, contentions have been exchanged, and the parties have completed arguments on Egnyte's unsuccessful §101 motion. EX2001, 51(The Court: “[W]e are almost half way through this case, a case that was filed, after all, about 15 months ago. I say that not only because nearly all of document-related fact discovery has occurred and because we're on the cusp of the Markman process proceeding to a hearing, it's also because the Court, at defendant's invitation,

invested a significant amount of time in the early section 101 motions process in this case and made a decision on that front.”)

The parties’ substantial investment in the three district court litigations favors denial of institution. *See Canadian Solar Inc. v. The Solaria Corporation*, IPR2021-00095, Paper 12, 11 (PTAB 2021).

4. Overlap Between Issues Raised In The Petition

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*, 12.

Issues related to each of the Asserted Patents, including the ’823 Patent, are raised in three different tribunals. Petitioners already set forth the grounds raised in this Petition in their invalidity contentions. EX2004, 19, 69. Egnyte is pursuing the exact same invalidity grounds, which evidences a single, unified invalidity strategy. EX2003, 19, 69 (contentions are identical to Petitioners’).

Additionally, Petitioners and Egnyte refuse to mitigate concerns of potentially conflicting decisions and duplicative efforts by failing to submit a stipulation in the District court proceedings or elsewhere per *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential). Pet., 6 (Petitioners only agreed to “not pursue invalidity in litigation based on any

instituted ground” in the Petition. Petitioners were silent with respect to any ground that reasonably could have been raised.) These circumstances evidence Petitioners’ scheme and favor denial of institution. *See Sand Rev’n II LLC v. Cont’l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24, 7 (PTAB 2020) (informative); *Sotera*, 19; *Fintiv*, 18 (weighing Factor 4 in favor of denial of institution based on “concerns of inefficiency and the possibility of conflicting decisions”).

5. *Whether Petitioners And The Defendant(s) In the Parallel Proceeding(s) Are The Same Party*

Petitioners are the respective defendants in the NDCA. Unnamed RPI Egnyte is the defendant in Delaware. As explained above, with respect to Egnyte, the Delaware court will decide the same issues raised in this Petition and more, given that Egnyte refuses to be bound by any estoppel agreement. Substantial work, including claim construction, §101 motion practice, substantial document production, and contention exchanges have been completed in the Delaware case. Trial is scheduled weeks before any hypothetical final written decision will issue. *Fintiv*, 14 (“Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.”) Petitioners have not addressed the Egnyte litigation in the Petition. *Id.* (“An

unrelated petitioner should, therefore, address any other district court or Federal Circuit proceedings involving the challenged patent to discuss why addressing the same or substantially the same issues would not be duplicative of the prior case even if the petition is brought by a different party.”) (citing *Stryker Corp. v. KFx Medical, LLC*, IPR2019-00817, Paper 10, 27–28 (PTAB 2019) (considering a jury verdict of no invalidity, based in part on evidence of secondary considerations, weighed in favor of denying institution where the unrelated petitioner failed to address this evidence in the petition)).

In addition to the specific circumstances and the overlap of issues with the Egnyte litigation, Petitioners’ close relationship also makes this factor weigh in favor of the Board exercising its discretion to deny institution. *Daiichi Sankyo, Inc. v. Seagen Inc.*, PGR2021-00030, Paper 11, 17 (PTAB 2021) (“Given that the real parties in interest in this proceeding are parties to the Texas Litigation, we determine that this factor on balance weighs in favor of discretionary denial.”); *Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00329, Paper 13, 14 (PTAB 2021) (finding that factor 5 weighs in favor of denial of institution where, though Petitioner was not a party to the infringement litigation, Patent Owner provided evidence, including evidence of common counsel, that Petitioner “direct[ed] and control[ed] defense of [the] proceedings, including the invalidity challenges presented therein.”). This factor favors denial.

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 proceeding in view of parallel litigation. EX2007, 4. As explained below in Section III, Petitioners have failed to meet their burden under 37 C.F.R. §42.108(c) of establishing a reasonable likelihood of success that any of the challenged claims are unpatentable, let alone a compelling case. *CommScope Techs. LLC v. Dali Wireless, Inc.* IPR2022-01242, Paper 23, 3 and 5 (PTAB 2023) (precedential) ("As the Guidance Memo and my precedential decision in *OpenSky* make clear, the compelling merits standard is a higher standard than the standard for institution set by statute.") ("[T]he Board must provide reasoning sufficient to allow the parties to challenge that finding and sufficient to allow for review of the Board's decision.").

Petitioner's dubious arguments, its disregard for the RPI disclosure requirement, the significant risk of wasting judicial and Board resources, and Petitioners' use of a previous IPR as a roadmap for this Petition (see Section II.D, below), all point to this additional factor as favoring denial.

In sum, each of the *Fintiv* factors weigh in favor of denying institution, and the Board should exercise its discretion accordingly.

D. The *General Plastic* Factors Weigh Heavily In Favor of Denying Institution

The Petition is a follow-on of IPR2022-00782 (the “’782 IPR”), filed by Unified on the ’942 Patent, related to the ’823 Patent. The majority of the factors in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB 2017) (precedential) weigh heavily in favor of denying institution.

1. Whether The Same Petitioner Previously Filed A Petition Directed To The Same Claims Of The Same Patent

The ’782 IPR challenged claims 1, 3-6, 10, and 12-15 of the related ’942 Patent. While Unified challenged different claims on a different patent, there are similarities between the ’942 Patent and the related ’823 Patent, making the previously raised grounds also relevant to the grounds raised herein. Petitioners were able to select, craft, and tailor the arguments in instant Petition by using the earlier filed documents in the ’782 IPR as a roadmap, e.g., by selecting different prior art. *See Code200, UAB v. Bright Data, Ltd.*, IPR2022-00861 & IPR2022-00862, Paper 18, 5 (PTAB 2022) (precedential)

Patent Owner maintains the position set forth in the ’782 IPR that membership in a Unified technology group evidences an RPI relationship with Unified’s Petition. *See e.g.*, EX2011, 20. At least Petitioner Dropbox is a member of Unified. EX2010, 7. Unified members pay member dues to Unified in exchange

for Unified filing IPR petitions on its member's behalf. Petitioners are also beneficiaries of the '782 IPR, and have already gained significant strategic advantage in this proceeding and the related litigations by previewing Patent Owner's arguments.

Though the Board declined to decide the issue before termination at request of the parties, public records make clear that at least Petitioner Dropbox was an RPI of the '782 IPR through its membership in Unified's "cloud zone" technology group, and further evidenced by Unified strategically filing an IPR on only one of the six Asserted Patents in litigation. Having achieved the strategic objective of exposing Patent Owner's arguments in a preliminary response and patent owner response, Unified agreed to have the IPR terminated, avoiding risking its members from being estopped following a final written decision. *See Unified Patents v. MemoryWeb*, IPR2021-01413, Paper 67, 3-4 (PTAB 2023) (finding Unified members Apple and Samsung RPIs under similar circumstances, but initially declining to decide the RPI issue at institution because facts were not "fully developed" and because "there was no allegation that [unnamed RPIs] were subject to a time bar or estoppel that would preclude *this proceeding*." (emphasis in original). With the benefit of Patent Owner's arguments, Dropbox and Box proceeded to file their joint Petitions on the asserted Patents. Such gamesmanship creates an unfair playing field to launch repeated attacks on the validity of Patent

Owner's patents and frustrates the purpose of the Congressional intent for which the AIA was designed. H.R. Rep. No. 112–98, at 48 (2011).

Even if Unified membership is not deemed sufficient to establish Petitioner Dropbox's RPI relationship with Unified, such a finding does not preclude *General Plastic's* applicability. *General Plastic*, 10; *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, -00063, -00084, Paper 11, 2 (Apr. 2, 2019) (precentral) (“[A]pplication of the *General Plastic* factors is not limited solely to instances where multiple petitions are filed by the same petitioner.”); *United Fire Protection Corp. v. Engineered Corrosion Sol'ns, LLC*, IPR2018-00991, Paper 10 (PTAB 2018) .

Again, ignoring at least Dropbox's close relationship with Unified under this and the other *General Plastic* factors would frustrate Congress's intent to have the IPR process “not [] be used as [a] tool[] for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent,” and “[d]oing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation.” H.R. Rep. No. 112–98, at 48 (2011). This factor weighs in favor of denial.

2. Whether at The Time Of Filing Of The First Petition The Petitioner Knew Of The Prior Art Asserted In The Second Petition or Should Have Known Of It

Unified filed its Petition in the ‘782 IPR on April 15, 2022. Petitioners first set forth the grounds for this Petition (and also repeated Unified’s grounds) in their preliminary infringement contentions in the WDTX three months later. EX2004, 19, 69. At the very latest, Petitioners were aware of the instant grounds three months following Unified’s Petition. Petitioners waited an additional five months to file the instant Petition, and offer no explanation for their delay. This factor weighs in favor of denial. *General Plastic*, 10.

3. Whether At The Time Of Filing Of The Second Petition The Petitioner Already Received The Patent Owner’s Preliminary Response or the Board’s Institution Decision In The First Petition

The instant Petition was filed on January 4, 2023, almost five months after Patent Owner filed its Preliminary Response in the ‘782 IPR in August 2023, and almost two months after the Board issued its institution decision in November 2020. Petitioners have offered no explanation for their delay in filing. Thus, this factor strongly weighs in favor of denying institution. *United Fire Protection*, 15 (“Here, the circumstances show that the availability of Patent Owner's arguments and the Board's findings and conclusions of law in the 136 IPR provided substantial potential benefit to Petitioner to tailor its arguments. In view of the

above, Factor 3 weighs strongly in favor of invoking our discretion to deny institution.”)

4. The Length Of Time That Elapsed Between The Time The Petitioner Learned Of the Prior Art Asserted In The Second Petition And The Filing Of The Second Petition

As explained above Petitioners knew of the asserted prior art at least as of July 2022, nearly six full months before the instant Petition was filed, but potentially much earlier if the Board finds that at least Dropbox is an RPI of Unified. This factor strongly weighs in favor of denial of institution. *General Plastic*, 11 (“Petitioner provided no explanation in its Petition or in its Reply to Patent Owner’s Preliminary Response of any unexpected circumstances that prompted the new prior art searches, or for the delay.”)

5. Whether The Petitioner Provides Adequate Explanation For The Time Elapsed Between The Filings Of Multiple Petitions Directed to the Same Claims Of The Same Patent

Petitioners provide no explanation whatsoever for the time elapsed between filings. This factor strongly weighs in favor of denial of institution. *General Plastic*, 11.

6-7. The Finite Resources Of The Board; And The Requirement Under 35 U.S.C. §316(a)(11) To Issue A Final Determination Not Later Than 1 Year After the Date On Which The Director Notices Institution of Review

Any potential final written decision would not issue until after trial is completed in Delaware. Institution would be a waste of judicial resources. *General*

Plastic, 10-11; *Pfenex, Inc. v. Glaxosmithkline Biologicals SA*, IPR2019-01478, Paper 9, 15 (PTAB 2020) (“In general, having multiple petitions challenging the same patent, especially when not filed at or around the same time, as in this case, is inefficient and tends to waste resources.”); *TPG*, 58.

In summary, the factors weigh in favor of denying institution, and the Board should exercise its discretion accordingly.

III. PETITIONERS HAVE NOT SHOWN A REASONABLE LIKELIHOOD OF PREVAILING WITH RESPECT TO ANY CLAIM

A. The Board Should Deny Institution Under § 325(d) Because the Same Prior Art was Previously Considered by the Office

35 U.S.C. § 325(d) provides that the Director may not institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential). The Board in *Advanced Bionics* used the following two-part framework: “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” (*Id.*, 8). Previously presented art includes art

made of record by the examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent. (*Id.*, 7–8).

The Board should exercise its discretion to deny institution of *inter partes* review because under both grounds Petitioners rely on art the examiner has already considered in the parent application to the ‘823 Patent, and hence, has considered in the ‘823 Patent. See MPEP 609.02 II.A.2 (“The examiner will consider information which has been considered by the Office in a parent application”)

Under Ground 1, Petitioners rely primarily on Sigurdsson (US 2007/01742246) as the primary reference in Petitioners’ obviousness argument. Pet., 8. Sigurdsson not only was cited by the examiner in the parent application (which issued as US11,003,622), but each of the independent claims in that patent was rejected in view of Sigurdsson.⁶ Ex. 1012, 128-132. In allowing all independent claims the examiner stated as the reason for allowance:

In view of applicant's amendment, remarks (12/14/2020), the prior art of Mohanty, US Pub. No. 2007/0180084, **Sigurdsson, US Pub. No. 2007/0174246** and Yeager et al., US Pub. No. 2004/0088348 do not disclose, make obvious or otherwise suggest the structure of applicant's

⁶ The examiner for the ‘622 Patent, primary examiner S. Channavaijala, is the same examiner who examined the application for the ‘823 Patent.

"automatically transfer, based on the first priority being greater than the second priority, the first metadata to the second client device such that the first metadata is transferred to the second client device prior to the copy of the first file being transferred to the second client device", in claim 1, 12, 18.

Id., 60 (emphasis added).

This feature the examiner identified as missing from Sigurdsson substantially corresponds to feature [1d], and somewhat similarly to features [8c] and [13c], of the ‘823 Patent.⁷ Instead of identifying which references teach this claimed feature, Petitioners gloss over specific claim features by addressing three of them together (“Therefore, for convenience, the Petition will address the interrelated ‘priority’-related limitations of [1c], [1d], [1h], and [1i] together.” Pet., 18.) In addressing this mix of features Petitioner asserts that Sigurdsson alone teaches all these features, including feature [1d] which the examiner in essence called out as missing from Sigurdsson. Pet., 19-21. Petitioner also asserts an alternative argument that “Sigurdsson does not expressly describe assigning priority values to metadata”, and cites Shappell and Rao for teaching this missing limitation. Pet., 22. But this feature of priority being assigned to metadata appears in feature [1c], not in feature [1d] which the examiner identified as missing from

⁷ For the Board’s convenience and ease of reference, the claim element numbers used in the Petition are referenced throughout this document.

Sigurdsson. Accordingly, the art Petitioners rely on for Ground 1 is substantially the same art presented to the Office.

Petitioners fail to demonstrate any material error made by the examiner in treating the Sigurdsson reference. In fact, Petitioners barely mention that Sigurdsson was even cited by the examiner. Pet., 8.

For these reasons and the reasons set forth below as to why Petitioners have failed to establish a reasonable likelihood of success of prevailing on Ground 1, the Board should exercise its discretion not to institute based on Ground 1.

Under Ground 2, Petitioners rely on Brown (US 7,035,847) as the primary reference in Petitioners' obviousness argument. Pet., 8. The Board should exercise its discretion to deny institution because Brown was previously considered by the examiner who granted the '823 Patent over this reference. (EX1011, p. 265).

Petitioners fail to demonstrate any material error made by the examiner in treating the Brown reference. In fact, Petitioners do not even mention that Brown was cited "If ... the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review." *Advanced Bionics*, Paper 6, 8-9.

Furthermore, the Board should exercise its discretion to deny institution of *inter partes* review because Brown, relied on by Petitioners in Ground 2, was

previously considered by the examiner who decided to grant the '823 Patent over this reference. (EX1011, p. 265). Moreover, Petitioners fail to demonstrate *any* material error made by the examiner in treating the Brown reference. “If ... the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Advanced Bionics*, Paper 6, 8-9.

B. Petitioners Have Failed to Establish a Reasonable Likelihood of Prevailing on Ground 1 Because the Prior Art Fails to Disclose Several Expressly Recited Features of the Claims

Ground 1 of the Petition must fail because Sigurdsson in view of Shappell and Rao does not disclose several claimed features, including, for example, a server system caused to:

- 1) receive from the first client device, first metadata associated with the updated version of the first file , the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file (e.g., [1c], [8b] and [13b]), and
- 2) automatically transfer, based on the first priority being greater than the second priority, the first metadata to a second client device (e.g., [1d], [8c], [13c]), and

- 3) automatically transfer the copy of the second file to the first client device associated with the user responsive to receiving the copy of the second file from the second client device (e.g., [3c], [10c] and [15c]).

Instead of considering the disclosure of the references, as a whole, or even the full description of the relied-upon embodiment(s) in the references, the Petition relies on select sentences taken out of context while ignoring the principal structure and operations taught by the references.

1. Sigurdsson does not disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”

Claim 1, feature [1c] of the ‘823 Patent recites that “**the first metadata [is] assigned a first priority greater than a second priority assigned to the copy of the first file.**” Claims 8 [8b] and 13 [13b] include similar claim language. Moreover, claim features [1i], [8h] and [13h] recite, in some variation, “**assign greater priority to metadata associated with files than priority assigned to the files.**” For an alleged teaching of this features, the Petition relies on the “priority algorithm” in Sigurdsson at Sigurdsson, ¶¶58-60, 72; Balakrishnan, ¶¶170, 173. Pet., 16-31.

Petitioners mischaracterize the “priority algorithm” in Sigurdsson as prioritizing metadata over content. For example, the “priority algorithm” in Sigurdsson is for prioritizing between the content that is to be synchronized and not,

as Petitioners contend, for prioritizing between metadata and the content. (EX2017, ¶78). Sigurdsson does not teach or suggest “**the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file**”.

Specifically, in ¶58, Sigurdsson discloses three data items, which include (1) a very large document such as a maintenance manual, (2) data from digital camera, and (3) a small office memo. Nowhere does Sigurdsson teach or suggest that such data items would encompass a file and its metadata. (EX2017, ¶78).

Moreover, Sigurdsson discloses that, although the server 106 can receive content for all three data items in the order that the user accessed them, the server 106 can also deal with the data items by assigning them priorities. For instance, the server 106 can handle the higher priority data items first, and save the lower priority data items for later. (EX2017, ¶78). As such, Sigurdsson at most discloses assigning priorities between the different data items that are to be synchronized. However, Sigurdsson is silent about assigning priority to metadata, much less assigning the first metadata a first priority greater than a second priority assigned to the copy of the first file.

Petitioners attempt to make up for Sigurdsson’s deficiencies with respect to the “priority algorithm” feature by citing to FIG. 6, steps 612, 614 and 616 of Sigurdsson for allegedly showing a second teaching of prioritization of metadata. Pet., 21. However, considering the teachings of Sigurdsson as a whole, FIG. 6 shows

a request-response sequence between a client and server, not a priority assignment. Sigurdsson discloses that the server receives a request for a list of missing content from a client (Client C) (612) and passes a missing content list to the client (Client C) (616) in response to an express request for a list of missing content from the client. ¶¶ 69-73. (EX2017, ¶79). As such, the list of missing content is only provided in response to a request from the client, but there is no assignment of priority by the server. (EX2017, ¶79).

Petitioners' assertion that Sigurdsson FIG. 6 teaches prioritizing metadata also ignores the express language of the claim and takes the feature out of context. Feature [1c] does not recite "the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file" in isolation. In claim feature [1c] "the first metadata being assigned a first priority" refers to the metadata "receive[d], over a network, from the first client device." Petitioner asserts that passing the "list of missing content" from the server 106 to Client C in step 616 in response to Client C's request for missing content in step 612 teaches configuring the server 106 to "prioritize transmitting the first metadata received from the first client device to the second client device before transmitting the file." Pet., 21. But this sequence disclosed in Sigurdsson also includes step 614 in which server 106 "determines the content missing from the third client" at the time Client C requests the list of missing content. Sigurdsson, FIG. 6, ¶70. (EX2017, ¶79). Thus, even

accepting for the sake of argument that Petitioners' assertion that priority is assigned when Client C requests the server for missing data, Sigurdsson, alone or in combination with Shappell and/or Rao, does not satisfy all the limitations of the claim. This is because under Petitioners' argument, metadata received from the first device cannot have been assigned a priority either before or upon its receipt at the server, since Sigurdsson's so-called priority is assigned only when Client C submits a request to the server for missing content.

Therefore, even in this scenario asserted by Petitioners (Pet., 21; Balakrishnan, ¶173), Sigurdsson does not teach or suggest assigning the first metadata a first priority greater than a second priority assigned to the copy of the first file in the context of features [1c], [8b] and [13b].

For at least these reasons, Sigurdsson does not teach or suggest that "the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file."

2. Shappell does not disclose "the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file"

The Petition, at pages 24-27, further relies on Shappell (¶¶76, 81, FIG. 19) for an alleged motivation for "the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file."

Shappell is completely silent about a priority being assigned to the first metadata or the copy of the first file. In particular, in cited FIG. 19, Shappell at most discloses “creating metadata for update to shared file” (1904) and “publishing metadata to other group members” (1906). (EX2017, ¶101).

However, there is no mention of a priority being assigned to the metadata. No other teaching in Shappell discloses a priority being assigned to the metadata. (EX2017, ¶101). Therefore, Shappell cannot and does not teach or suggest “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”.

3. *Rao does not disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”*

Petitioners attempt to use Rao to fill in for the lack of relevant disclosure found in Sigurdsson and Shappell. Rao does not cure those deficiencies. Rao discloses metadata associated with raw data in a database and not metadata associated with a file. Petitioners admit as much in arguing that “Rao teaches client/synchronization in two phases: first metadata, and then raw file data.” (Pet., 9). This statement is based on ¶ 63 of Rao, which at most addresses how **raw data** and metadata are synchronized in “phases.”

Accordingly, Rao is non-analogous to the field of the ‘823 patent because of its focus on synchronizing raw data in a database rather than on synchronizing files

between clients. For this reason, with its focus on raw data, Rao cannot be used alone or in combination with other references to attack the challenged claims, all of which are directed to synchronizing files between clients.

In addition, Rao is non-analogous to the other references with which Petitioner seeks to combine it for the missing disclosure cited above. Rao discloses metadata associated with raw data in a database and not metadata associated with a file. Rao, ¶63. Sigurdsson’s “priority algorithm” focuses on prioritizing between the content that is to be synchronized and not for prioritizing between metadata and the content. (EX2017, ¶78). Shappell does not address priority at all and discloses only “creating metadata for update to shared file” (1904) and “publishing metadata to other group members” (1906). (EX2017, ¶101). Brown fails to disclose the features related to automatically transferring the first metadata or the copy of the first file that is modified, and because Brown aims to minimize the load on the server processor (such that as many synchronization operations as possible are performed by the client), Brown cannot be modified to use a server-push mechanism. Finally, Hesselink teaches a pull-based HTTP server system and thus fails to teach automatic file transfer by the server. Accordingly, these non-analogous references cannot be combined, and Petitioner has failed to show a motivation to combine them.

4. *Sigurdsson does not disclose “automatically transfer, based on the first priority being greater than the second priority, the first metadata over a network to a second client device associated with the user”*

The plain language of the challenged claims specify that the server system automatically transfers the first metadata over a network to a second client device associated with the user. According to the claims of the ‘823 Patent, it is the server system that “automatically transfers” the first metadata over a network to a second client device associated with the user. Sigurdsson discloses anything but a server automatically transferring the first metadata.

To the contrary, Sigurdsson discloses a system, in which, a receiving device (i.e., a Client C 406) requests for a list of missing content. Only in response to the server receiving the request for the list from Client C does it transmit that list of missing content (cited at page 21 of the Petition for allegedly including metadata) to Client C. (FIG. 6, ¶¶69-73 (EX2017, ¶81). Therefore, in Sigurdsson, the server (*allegedly* corresponding to the claimed server system) does not automatically transfer the first metadata to the receiving device, such as Client C, since it only transfers the list of missing content when the receiving device expressly requests a list. (EX2017, ¶81).

The Petition confusingly combines element [1d] with other separately recited elements (e.g., [1c], [1h] and [1i]). Pet., 18. Thus, the Petition does not specifically point out where Sigurdsson discloses **automatically transferring the first**

metadata. Instead, the Petition and Dr. Balakrishnan improperly conflate the “automatically transfer” features and the “assignment of priority” feature (see Section III.B.1-3 discussed above). Pet., 20 and Balakrishnan, 169. As such, Petitioners’ analysis is lacking, as it fails to show each and every element of the claimed features including, the server system being caused to “**automatically transfer**, based on the first priority being greater than the second priority, **the first metadata** over a network to a second client device associated with the user.”

The Petition ignores the claim as a whole by asserting that the meaning of causing “a server system to: ... **automatically transfer**, based on the first priority being greater than the second priority, the first metadata,” refers to the transfer occurring “not user-manually.” Pet., 19. The claim refers to the server automatically transferring, with no mention of user intervention.

The “automatic transfer” feature in the claims of the ‘823 Patent refers to the automatic aspect from a server’s point of view (that is, the server system automatically transferring the first metadata). As such, the issue here is not *merely* whether Sigurdsson discloses a “not user-manual” synchronization as mischaracterized by Petitioners (Pet., 18). Instead, the issue is whether Sigurdsson discloses a **server system** that **automatically transfers** the first metadata to the second client device. It does not.

Not only does Sigurdsson fail to teach or suggest that a server **automatically transfers** the first metadata to the second client device, it also fails to teach that such a transfer is “**based on the first priority being greater than the second priority.**” Sigurdsson, in FIG. 6 discloses a sequence diagram of a request/response based mixed peer-to-peer and client/server architecture, including a server, and clients A, B, and C. In FIG. 6, the server in Sigurdsson provides a **list** of missing content only in response to a request for such a list from a client (e.g., “Client C” at steps 612 and 616). (EX2017, ¶82).

That is, in FIG. 6, client/server structure and operation of Sigurdsson requires an explicit request for a list of missing content from the client device (“Client C”) to the server, before the server provides the list of missing content to the client device, which is neither an “**automatically transfer**” by the server nor “**based on the first priority being greater than the second priority**”. (EX2017, ¶83).

Specifically, it is only after going through this sequence of Client C expressly requesting the server for list of any missing content, and the server determining the content missing from the third client, the server responds by passing the list of missing content to Client C. (EX2017, ¶84). As such, Sigurdsson does not teach or suggest that the server 106 **automatically transfers** the list of missing content (allegedly including the first metadata) to the Client C 406 “**based on the first priority being greater than the second priority**”. (EX2017, ¶84).

For the reasons set for above, Sigurdsson does not teach or suggest “**automatically transfer, based on** the first priority being greater than the second priority, **the first metadata** over a network to a second client device associated with the user.”

5. The terms “automatically transferring” and “based on the first priority being greater than the second priority” must be given proper and full weight

The requirements of “**automatically transfer**” and “**based on the first priority being greater than the second priority**” cannot be ignored. *See, e.g., Rovi Guides, Inc. v. Vidal*, No. 2020-1994, 2022 U.S. App. LEXIS 10465, at *5-6 (Fed. Cir. Apr. 19, 2022) (“The available-to-a-user limitation requires the claimed system be configured to check whether an archived program is available to a specific user. A broader construction, which would only require the system be configured to check whether an archived program exists, would render the ‘to the user’ language meaningless ... So the ‘to a user’ phrase in claim 1, presumably, must add something more. Indeed, the system must not only check whether an archived copy exists; it must ensure the specific user has access to that copy”).

In *Rovi Guides*, in overruling the PTAB which found the claims obvious, the Federal Circuit held that all terms included in the claim must be considered since each term must add something more. Applying the same rationale, the terms

“**automatically transfer**” and “**based on the first priority being greater than the second priority**” each must add something in the claimed feature.

The “**automatically transfer**” and “**based on the first priority being greater than the second priority**” limitations require the claimed system to not *merely* have the first metadata end up at the second client device, but requires the server system to **automatically transfer** the first metadata **based on the first priority being greater than the second priority** without a request for a list of missing content from the second client device.

Since Sigurdsson discloses that the server only transfers the list of missing content *when requested* by the second client device, the transfer of the list of missing content to the second client device by the server in Sigurdsson is based on a request from the second client device and not automatically based on the first priority being greater than the second priority. (EX2017, ¶85).

For the reasons set for above, when the terms “**automatically transfer**” and “**based on the first priority being greater than the second priority**” are given full and proper weight as required, Sigurdsson does not teach or suggest “**automatically transfer, based on the first priority being greater than the second priority, the first metadata** over a network to a second client device associated with the user.”

6. *HTTP Client/Server architecture structurally requires a request then response based approach*

In FIG. 3, Sigurdsson discloses that the client devices 102 and 104 are implemented as a hypertext transfer protocol secure (HTTPS) client/server structure (*i.e.*, HTTPS Client/Server 256 and HTTPS Client/Server 356). (EX2017, ¶86).

HTTP (Hypertext Transfer Protocol) is a protocol used to carry requests from a browser to a Web server and to transport pages from Web servers back to the requesting browser. (EX2015, p.259), Moreover, a HTTP server is server software that uses the HTTP protocol to serve up HTML documents and any associated files and scripts when requested by a client, such as a Web browser (EX2015, p. 260). An important feature of an HTTP/HTTPS server is that the HTTP/HTTPS server waits for incoming client requests and for each request the HTTP/HTTPS server responds by providing the requested information or performing a requested task. (EX2017, ¶87). Since the HTTP protocol is a request-response protocol, where clients send HTTP requests to the server and the server sends HTTP responses after processing each request, the HTTP protocol does not support a functionality where the server can automatically send data to a client without the client making requests for data. (EX2017, ¶87).

Thus, in FIG. 3, Sigurdsson requires a HTTPS server system based on an HTTP request/response process for data transfer between the client and the server.

(EX2017, ¶88). Therefore, Sigurdsson not only fails to disclose the features of “**automatically transfer[ring]**, based on the first priority being greater than the second priority, **the first metadata** ... to a second client device associated with the user”, it would not have been obvious to replace the principal structure (i.e., the server system based on an HTTP request/response process) taught by Sigurdsson with the automatically transfer of the first metadata without any client request to satisfy the claim features. (EX2017, ¶88).

7. *Shappell does not cure the deficiencies of Sigurdsson*

Shappell is directed to “a **peer-to-peer network environment** to facilitate network communications among group members.” (¶7). Specifically, Shappell discloses, a computer implemented method and system enable users to share files in a **server-less** shared space. Abstract. (EX2017, ¶100)

Here, Shappell *expressly* teaches away from using a server. Accordingly, even if, assuming *arguendo*, Sigurdsson were to be modified based on Shappell, the modified structure still fails to teach or suggest the **server system** caused to “**automatically transfer**, based on the first priority being greater than the second priority, **the first metadata** ... to a second client device associated with the user.”

Moreover, according to the claim language, the first metadata is transferred to **the second client device associated with a same user associated with the first client device**, in view of the recitation of “receive, over a network, a copy of a first

file from a first client device **associated with a user**” and “**automatically transfer**, based on the first priority being greater than the second priority, **the first metadata** ... to a second client device associated with the [same] user.”

As discussed above, in *Rovi Guides*, the Federal Circuit reasoned that the phrase “to a user” must add something more. Similarly, the **associated with the user** limitation, particularly the same user, requires automatically transferring the first metadata **to the second client device [associated with the same user]**. An interpretation, which would only require the system to publish the metadata to all other group members would render the “to the user” language meaningless.

In FIG. 19, step 1906, Shappell discloses publishing the metadata to **all other group members**. This is different from the claimed features of automatically transferring the first metadata **to the second client device associated with the same user**, since “other” group members would be understood to refer members other than the user associated with the second device. (EX2017, ¶101). Therefore, Shappell does not teach or suggest “automatically transferring the first metadata **to the second client device associated with the same user**.”

8. *Sigurdsson does not disclose automatically transferring the copy of the first file to the second client device associated with the user responsive to receiving the copy of the first file from the first client device*

The plain language of the challenged claims further specify that the server system automatically transfers the copy of the first file to the second client device responsive to receiving the copy of the first file from the first client device (e.g., 3[c], [10c] and [15c]).

According to claim 3, it is the server system that “automatically transfers” the copy of the second file to the first client device. Sigurdsson discloses anything but a server automatically transferring a copy of a second file.

To the contrary, Sigurdsson discloses a system, in which, a receiving device (i.e., a Client C 406) performs several operations before requesting a copy of missing content. Much of Sigurdsson discusses client devices requesting such missing content from other client devices, in a peer-to-peer arrangement. See Abstract. Sigurdsson describes an embodiment in which Client C obtains missing content from a server 106. But that embodiment requires Client C to expressly request the missing content. Only in response to the server receiving the request from Client C does it transmit that content to Client C. (FIGS. 4, 6, ¶¶71-75, 80 (EX2017, ¶91). Therefore, in Sigurdsson, the server (*allegedly* corresponding to the claimed server system) does not automatically transfer a copy of the file to the receiving device,

such as Client C, since it only transfers the missing content when the receiving device expressly requests it. (EX2017, ¶91).

For an alleged teaching of claim [3c], the Petition through Dr. Balakrishnan (Balakrishnan, ¶224) relies on Sigurdsson, FIGS. 5, 6, ¶¶50-55, 72-74, 79-80. Pet., 42-43. The Petition ignores the claim as a whole by asserting that the meaning of causing “a server system to: ... automatically transfer, over a network, the copy of the first file to the second client device,” refers to the transfer occurring “with no user intervention.” Pet., 43. The claim refers to the server automatically transferring, with no mention of user intervention. Petitioners, instead of relying on the intrinsic evidence, rely on Sigurdsson’s qualified use of the term “automatically” when discussing file transfers from a user’s perspective. (Sigurdsson, ¶26).

The “automatic transfer” feature in the claims of the ‘823 Patent refers to the automatic aspect from a server’s point of view (that is, the server system automatically transferring the copy of the second file). (EX2017, ¶92). As such, the issue here is not *merely* whether Sigurdsson discloses a “no user intervention” synchronization as mischaracterized by Petitioners (Pet., 42-43). Instead, the issue is whether Sigurdsson discloses a **server system that automatically transfers** the copy of the second file to the first client device. It does not.

Not only does Sigurdsson fail to teach or suggest that a server “**automatically transfer** the copy of the second file to the first client device”, it also fails to teach

that such a transfer is “responsive to ... **(ii) receiving the copy of the second file from the second client device.**” Sigurdsson’s transfer to Client C is the result of Client C requesting the transfer. (EX2017, ¶93). Sigurdsson, in FIG. 6 discloses a server that provides missing content only in response to a request from a client (e.g., “Client C” at steps 612 and 620). (EX2017, ¶93).

Specifically, it is only after going through this sequence of Client C expressly requesting the server for any missing content, Client C determining where it can obtain that missing content, and then requesting the content from the server, the server responds by transferring the content to Client C. (EX2017, ¶95). As such, Sigurdsson does not teach or suggest that the server 106 automatically transfers the content 410 to the Client C 406 responsive to receiving the content 410 from Client A 402. (EX2017, ¶95).

Moreover, the Petition’s reliance on FIG. 5 of Sigurdsson is misplaced because FIG. 5 and the related text provides only a general description without disclosing several of the claimed features including the “**automatically transfer the copy of the second file to the first client device**”, “responsive to ... **(ii) receiving the copy of the second file from the second client device**” as discussed above. In fact, the disclosure in FIG. 5 simply summarizes the request-based file transfer approach from FIG. 6 discussed above in detail. (EX2017, ¶97).

Furthermore, the requirements of “**automatically transfer**” and “**responsive to receiving the copy of the first file from the first client device**” cannot be ignored for the same rationale based on *Rovi Guides* discussed in section III.B.5.

In addition, as discussed above in section III.B.6, Sigurdsson is directed to a HTTPS server system based on an HTTP request/response process for data transfer between the client and the server as illustrated in FIG. 3. (EX2017, ¶43). Therefore, Sigurdsson not only fails to disclose the features of “**automatically transfer the copy of the second file to the first client device**”, it would not have been obvious to replace the principal structure (i.e., the server system based on an HTTP request/response process) taught by Sigurdsson with the automatically transfer of a copy of the file to a client without any client request to satisfy the claim features. (EX2017, ¶98).

Regarding Shappel, as discussed above in section III.B.7, Shappell *expressly* teaches away from using a server, and therefore, even if, assuming *arguendo*, Sigurdsson were to be modified based on Shappell, the modified structure still fails to teach or suggest the server system caused to “**automatically transfer the copy of the second file to the first client device**”, “responsive to ... **receiving the copy of the second file from the second client device.**”

For the reasons set for above, the combination of Sigurdsson and Shappel does not teach or suggest the server system caused to “**automatically transfer the copy**

of the second file to the first client device” “responsive to ... **(ii) receiving the copy of the second file from the second client device.**”

C. Petitioners Have Failed to Establish a Reasonable Likelihood of Prevailing on Ground 2 Because the Prior Art Fails to Disclose Several Expressly Recited Features of the Claims

Ground 2 of the Petition must fail because Brown in view of Hesselink, Shappell, and Rao does not disclose several claimed features, for example, claims [1c], [8b], and [13b], claims [1d], [8c], and [13c], and claims [3c], [10c] and [15c].

1. Brown, Shappell, and Rao do not disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file” and “automatically transfer, based on the first priority being greater than the second priority, the first metadata over a network to a second client device associated with the user”

Petitioners argue that Brown describes that the originating “first client device” sends to the server “CSI” (Brown, 10:9-10) and “parent directory SID,” and “file name,” *id.*, 15:38-40, 5:50-52), which allegedly corresponds to metadata for a modified file, prior to the modified file being uploaded, citing *id.*, 13:57-62 and Fig. 8A (step 805), 14:5-6 and Fig. 8B (step 850), Figs. 11A-C and 15:30-54 (step 1115 and step 1120). Pet., 55-56.

However, the client sync index (“CSI”) in Brown merely refers to a value indicating whether the client directory is up to date (“If the SSI value matches the CSI value passed in by the polling client, the client is up to date with the current state of its server account.”; Brown, 5:17-19). The CSI received from a client is

not “associated with the updated version” of the file that is generated from the user modifying the content of the file, as recited in claims [1c], [8b], and [13b]. Also, in Brown, the CSI is included in the sync poll call from the client Synchronization Application (SA) to the server, and the server returns its server sync index (SSI) back to the client in response. That is, the CSI as disclosed in Brown is merely a sync call requesting the server’s SSI so that the client can decide whether the CSI matches with the SSI (that is, whether the client directory is up to date). (EX2017, ¶62).

As noted above, Petitioners also rely upon step 1115 of FIG. 11A of Brown, which discloses that the client sends the SID, the parent directory SID, and the file name to the server, and argue that this portion allegedly teaches “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file” in claim [1c]. However, the SID, the parent directory SID, and the file name are transmitted to the server only for the purpose of locating, if any, a previous version of the file is on the server, at step 1117 in FIG. 11B. If there is no previous version of the file on the server, then at step 1120, *the file and the client metadata item* are uploaded to the server. (EX2017, ¶63).

Petitioners, apparently with regards to claim [1d], cite to the server synchronization data (“SSD”) in Brown as the metadata that the server first transfers to the receiving client before the server transfers a copy of the modified

file to that receiving client. Pet., 56. However, the SSD contains server metadata items for any items with file sync index (FSIs) greater than the CSI passed in by the receiving client's sync poll call. Brown, 8:53-61. That is, the SSD can be generated *only after the CSI is received* from the receiving client's sync poll call. This is also consistent with Brown's disclosure that the SSD is generated responsive to a client sync index (CSI) received from the client. Brown, claims 9-10. (EX2017, ¶64).

Further, because the SSD needs to include server metadata items for any items that are updated from the last sync call (that is, any items with FSIs greater than the client's current CS), Brown necessarily requires the client metadata received at step 1120 in FIG. 111B in order to generate the SSD. (EX2017, ¶64).

Thus, the "SSD" of Brown cannot teach "the first metadata that is *automatically* transferred to a second client device *based on the first priority being greater than the second priority.*"

Therefore, Petitioners' position with respect to Brown regarding claims [1c] and [1d] cannot be supported because their interpretations of Brown regarding claims [1c] and [1d] conflict with each other.

2. Brown does not disclose automatic transfer of the first metadata or automatic transfer of the file to the receiving client because it adopts HTTP Client/Server architecture that structurally requires a request then response based approach

As discussed above at section III.C.1, in Brown, the client SA needs to poll the server to check if there are any changes in the client's directory, and if the client's directory is not up to date, the client then requests server synchronization data (SSD) to learn about the new changes that have been made at server 105. ("If the CSI matches the server account's SSI value, then the client is up to date with the server. Otherwise **the client SA requests server synchronization data (SSD).**"; Brown, 8:51-53). (EX2017, ¶65).

If server 105 has changes that client 130 lacks, server 105 then "sends the SSD to client 130 (in response to a request for the SSD by the client), informing the client of the pertinent changes, as shown in box 415." Brown, 10:19-21. Based on the SSD received from the server, "the client SA updates the client's directory and metadata to match the server state." Brown, 8:62-63. (EX2017, ¶65). That is, in Brown, the SSD are transmitted to the client device **upon the request received from the client**. (EX2017, ¶65). *See e.g.*, Brown, 10:18-27 (the server sends the SSD to client 130 **in response to a request for the SSD by the client**).

Furthermore, Brown teaches a HTTP server, which uses a client-pull architecture and does not perform functions "automatically" without client

requests. Brown, 4:12-15 (“[C]ommunication between the clients and server 105 is tunneled within the hypertext transport protocol (HTTP).”).

As discussed above in section III.B.6, the HTTP protocol is a request-response protocol, and the HTTP servers use the client-pull architecture, where clients send HTTP requests to the server and the server sends HTTP responses after processing each request. The HTTP protocol does not support push-based functionality where the server can automatically send data to a client without the client making requests for data. (EX2017, ¶67).

Because Brown requires a HTTP server system based on an HTTP request/response process for synchronization, Brown fails to disclose the features related to automatically transferring the first metadata, as recited in claims [1d], [8c], and [13c], or automatically transferring the copy of the second file that is modified, as recited in claims [3c], [10c] and [15c].

Furthermore, it would not have been obvious to replace the principal structure (*i.e.*, “the pull-based HTTP server”) of Brown with a push-based server that automatically pushes data, such as a file or metadata, to a client without any client request. Specifically, a POSA would not have found it obvious to replace the pull-based HTTP server taught by Brown with a push-based server that automatically pushes data to a client without any client request. Neither Petitioners provide any rationale for making such replacement. In fact, a fundamental feature

of an HTTP architecture, namely, providing a service in response to a request from a client teaches away from an “automatic” provision of a service without any client request. (EX2017, ¶69).

Moreover, Brown discloses at 3:17-28: “The client/server architecture is designed to **minimize the load on the server processor** in order to maximize server scalability. To that end, as many processor-intensive operations as possible, such as ... **synchronization itself, are performed by the client SA**. Also, the **polling mechanism used by the client SA** to determine if the client is synchronized with the server is designed to **require minimal processing on the server** when the client and server are in sync.” Thus, because Brown aims to minimize the load on the server processor and uses a pull-based architecture, a POSA would not have been motivated to modify Brown to reach a server-push mechanism. (EX2017, ¶70). It is well settled that if the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references cannot be relied upon to render the claims prima facie obvious. *See In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

3. Hesselink teaches a pull-based HTTP server system and thus fails teach automatic file transfer by the server

Regarding claim [3c], Petitioners argue that a POSA would have been motivated to combine Brown with Hesselink “to automatically transmit modified files to connected clients as soon as file updates occur.” Pet., 69. However, just like in Brown, Hesselink uses a pull mechanism in its file synchronization process. That is, in Hesselink, the client must initiate a request for any update to the connection server. (EX2017, ¶71).

A data transfer process based on this client pull mechanism is described in detail at Hesselink, ¶109:

... Data from the device(s) 18 a-18 n that are destined for client computer(s) 12 a-12 n are posted to the connection server 14 a-14 n **using an HTTP request** as previously described. Receiving the HTTP request, the connection server 14 a-14 n then temporarily stores or buffers any data from the request in its memory (i.e., the sending buffer). The **next time an HTTP request comes from client computer 12 a-12 n** ... the connection server 14 a-14 n retrieves the data from the sending buffer and sends the data to client computer 12 a-12 n ... **along with the response for the HTTP request.**

This HTTP request/response process for data transfer between the client and the connection server is illustrated in FIG. 8 of Hesselink. *See e.g.*, event 890 in

which “**an HTTP response** is sent to client computer 12 a-12 n by connection server 14 a-14 n,” and “[i]f any data was present in the connection server sending buffer for client computer 12 a-12 n, this data is **embedded within the HTTP response.**” Thus, Hesselink is precisely focused on a data transfer process based on client pull, which is implemented by clients sending HTTP requests to the server to request the data. This is the opposite to the server initiating data push to a client. (EX2017, ¶73).

4. Hesselink and Brown fail to motivate the combination because Hesselink’s peer-to-peer embodiment cannot be modified to teach “automatic transfer” of the modified file from the server to a client device

Petitioners admit that Hesselink uses peer-to-peer but assert that a POSA would not have been dissuaded to apply Hesselink to a client-server system because “Hesselink does not categorically disparage client/server models and contemplates that each synchronized computer can be a “file server,” citing Hesselink, ¶¶23-34, 122. However, the mere mention of a “file server” that may implement any of computers 72, 74 and 76 in FIG. 11 of Hesselink, ¶122 by no means implicates, let alone render obvious, Hesselink’s applicability to a client/server model. The computers 72, 74 and 76 are part of the peer-to-peer architecture and remain as peers (*i.e.*, nodes between which a direct link is provided) regardless of whether any of these computers can be a “file server.”

There is nothing that suggests in Hesselink that the “file server” implements file synchronization between computers 72, 74, and 76 based on a client/server architecture. (EX2017, ¶74). Further, while Hesselink mentions a connection server, the connection server merely serves as a pipeline or conduit in the peer-to-peer system. (EX2017, ¶74).

Moreover, a peer-to-peer network allows computer hardware and software to communicate between peers. Unlike a client-server architecture, there is no central server for processing requests in a peer-to-peer architecture. A peer-to-peer based file synchronization is entirely different from the client-server system because each node is the one that processes the query from another node to decide whether to grant or deny it and thus each node should have the capability to access and manage information of other nodes. A POSA would not have been motivated to combine the teachings of Brown and Hesselink because these two references teach fundamentally different architectures and are incompatible. (EX2017, ¶75).

5. Neither Shappell nor Rao nor discloses “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”

For the reasons as discussed above in sections III.B.2 and III.B.3 in Ground 1, Shappell and Rao fail to disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file,” as recited in [1c], [8b] and [13b].

IV. CONCLUSION

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

Date: MAY 15, 2023

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 13,983 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

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