

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 No. IPR2023-00432
U.S. Patent No. 10,754,823

**PETITIONER’S PRELIMINARY REPLY TO
PATENT OWNER’S PRELIMINARY RESPONSE (“POPR”)¹**

¹ This Reply was authorized by the Board’s Order of June 1, 2023 (Paper 8).

The Petitions in IPR2023-00427, IPR2023-00429, IPR2023-00430, IPR2023-00431, IPR2023-00432, and IPR2023-00433 (“IPRs”) should be instituted because Egnyte, Inc. (“Egnyte”) is not a real party in interest (“RPI”) or privy of Petitioners and the *Fintiv* and *General Plastic* factors support institution.

I. Egnyte Is Not an RPI or Privy of Petitioners

The *AIT II* factors support institution. See POPR, 7-8 (listing factors).² Regarding factor (a), it is undisputed that Petitioners do not have business models designed to file patent challenges on behalf of other entities. POPR, 16. *ecobee Technologies ULC v. Causam Enterprises, Inc.*, IPR2022-01339, Paper 20, 12-14 (PTAB 2023) (granting institution in view of, *inter alia*, no evidence suggesting petitioner's business model was intended to benefit an alleged unnamed RPI).

For factors (b) and (c), there is no evidence that “Egnyte's interests have directly shaped the invalidity grounds raised in the Petition.” POPR, 14. To the contrary, Petitioners independently prepared, funded, and filed the IPRs for their own benefit, without considering Egnyte's interests and with no input from Egnyte. EX1029, ¶¶ 12-13, 20;³ EX2001, 8:19-21 (“We weren't involved in the preparation of the IPRs by the Box and Dropbox defendants in the other case.”), 9:1-3 (“[W]e

² All citations are to the POPR for IPR2023-00427 (Paper 7).

³ EX1029, Decl. of Heidi L. Keefe in Support of Petitioners' Preliminary Reply.

didn't have any opportunity to even consider what references would be asserted in those IPRs."), 11:16-19 ("[W]e haven't actually contributed to any of the expenses, any of the briefing, [or] any of the claim charting in the IPR process[.]"), 22:13-19 (noting Egnyte's intent to rely upon non-printed publication art, which would not overlap with these IPRs). In the district court litigations, Petitioners served their invalidity contentions *before* Egnyte, and *Egnyte* independently chose to copy *Petitioners'* invalidity contentions. EX2004, 179; EX2003, 180; EX1029, ¶¶ 8-9, 11. There has been no overlap between Ms. Keefe's representations in the IPRs and Egnyte's district court litigation. EX1029, ¶ 22; EX2001, 11:19-21 ("Ms. [J]Keefe's representation was solely for purposes of the 101 hearing[.]"); 35 U.S.C. § 311.⁴

For factors (d), (h), and (i), Petitioners and Egnyte are competitors, share no board members, and had no pre-filing communications regarding the potential content of Petitioners' IPR petitions. POPR, 8; EX1029, ¶ 23; *ecobee*, 11 (finding

⁴ PO misleadingly quotes Judge Burke from the Egnyte district court case as having stated: "it's about as close as you can get in terms of coordinating and understanding, et cetera, as you might." POPR, 5 (quoting EX2001, 11:10-12). In fact, he merely paraphrased what he understood to be *PO's* argument. EX2001, 11:3-12 ("But I guess *the other side is saying* . . . it's about as close as you can get in terms of coordinating and understanding, et cetera, as you might.") (emphasis added).

no RPI relationship in view of, *inter alia*, “no communications regarding the filing of the instant Petition”). Petitioners and Egnyte did not collaborate in any way in developing Petitioners’ IPRs. EX1029, ¶¶ 6, 23. In fact, the JDA expressly excludes any IPR work from its scope. EX1030, § 2.5;⁵ EX1029, ¶¶ 6, 25. PO speculates that Egnyte “financed at least a share of the collaborative invalidity contentions that are a basis for this Petition” (POPR, 9), but the parties’ litigation work merely resulted in identifying a large set of dozens of publicly available references. EX1029, ¶ 7. When preparing the instant Petitions, Petitioners and their expert *independently* (1) selected the five specific references for IPR challenges, (2) developed obviousness arguments for the mappings and motivations to combine these references, and (3) paid for all work and other costs related to preparing and filing the IPRs. None of this IPR-specific work appears in any litigation invalidity contentions, and Egnyte had no knowledge or input regarding any of this IPR-specific work. EX1029, ¶¶ 12-13, 17, 19-21, 23, 25.

Contrary to PO’s assertions, Ms. Keefe does not have any “intimate knowledge of Egnyte’s interests and attendant invalidity strategies” (POPR, 9), aside

⁵ EX1030, Joint Defense and Information Sharing Agreement (“JDA”). The JDA confirms that Egnyte has not controlled, funded, or otherwise participated in the IPRs. EX1030, § 2.5; EX1029, ¶¶ 6, 12, 20, 23, 25.

from a discrete § 101 motion that is not at issue in the IPRs. EX1029, ¶ 24. The IPRs were not controlled by Egnyte in any way, and Petitioners did not file the IPRs at the behest of Egnyte. *Id.*, ¶ 25. *Adobe Inc. v. Rah Color Technologies LLC*, IPR2019-00629, Paper 35, 12-13 (PTAB 2019) (sharing common counsel is not enough to show control of an IPR where, as here, the alleged unnamed RPI and petitioner are accused of infringement by different products, given petitioner has an independent reason to file IPR(s)); *FPUSA, LLC v. M-I LLC*, IPR2016-00213, Paper 45, 11 (PTAB 2017) (“As Petitioner correctly notes, previous Board decisions have rejected arguments that a non-party was a real party-in-interest due to its use of common counsel with a petitioner in a related district court case.”); *Aruze Gaming Macau, Ltd. v. MGT Gaming, Inc.*, IPR2014-01288, Paper 13, 19-20 (PTAB 2015) (“[T]he appearance of common counsel, without more, does not prove substantial control.”) (quoting *Perez v. Volvo Car Corp.*, 247 F.3d 303, 311 (1st Cir. 2001)); *ecobee*, 12 (finding no RPI relationship because, *inter alia*, the parties were “sued separately and independently for their own products”); *e.g.*, EX1031, ¶¶ 15-24 (Egnyte complaint); EX1032, ¶¶ 25-37 (Box complaint); EX1033, ¶¶ 25-36 (Dropbox complaint); EX1029, ¶ 14.

For factors (e), (f), and (g), PO argues that Egnyte “has a self-evident interest” in the IPRs (POPR, 12), but in fact it is self-evident that Egnyte had no interest in filing these IPRs. Indeed, as PO notes, Egnyte’s § 315(b) one-year time bar lapsed

a week before the IPRs were filed, which Egnyte would not have allowed to occur if it were involved with the IPRs. This fact alone demonstrates that Egnyte has no control over these IPRs and the Petitions were not filed at Egnyte's "behest." *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018). Nor do these IPRs otherwise serve Egnyte's interests. As PO itself acknowledges, "trial with Egnyte" in the district court "will occur prior to any hypothetical final written decision resulting from this Petition." POPR, 3, 22. Furthermore, Egnyte will not materially benefit from PO's disclosure of validity positions in these IPRs, which will necessarily be limited only to the references asserted in the IPRs and not the other 24 prior art references asserted in Egnyte's invalidity contentions. *See* EX2003, 7-8. In addition, Egnyte could serve contention interrogatories in district court to obtain the same information. *See* POPR, 19 (noting fact discovery remains open in the Egnyte litigation until September 2023).

There is no privity relationship between Egnyte and Petitioners arising from the JDA or any other agreement. EX1029, ¶¶ 6, 26. And there is no evidence to support PO's assertion that Egnyte is a privy of Petitioners. POPR, 4, 6, 16-17, 24. Egnyte has not agreed to be bound by any legal proceeding involving Petitioners, and Petitioners have not agreed to be bound by any legal proceeding involving Egnyte. *Taylor v. Sturgell*, 553 U.S. 880, 894-95 (2008). There is also no other pre-existing, legal relationship between Egnyte and Petitioners to support a finding of

privity. *Id.* at 894. (“Qualifying relationships include . . . preceding and succeeding owners of property, bailee and bailor, and assignee and assignor.”).

In fact, PO’s main argument that defeated Egnyte’s motion to stay in district court was that Egnyte “refuses to be bound” by IPR estoppel because Egnyte is *not* a party or privy of the IPRs—exactly the opposite of PO’s argument to the Board now. *See* EX2001, 36:21-37:11. The district court relied on that argument in denying the motion. *Id.*, 50:12-51:4. The Board has discretion to apply judicial estoppel to bind PO to its prior position, given that: (1) PO’s position in the IPRs is “clearly inconsistent” with its position before Judge Burke; (2) PO persuaded the district court to deny Egnyte’s motion based its prior position; and (3) PO now seeks to assert an inconsistent position that would “derive an unfair advantage or impose an unfair detriment” on Petitioners “if not estopped.” *New Hampshire v. Maine*, 532 U.S. 742, 750-51 (2001); *Data Gen. Corp. v. Johnson*, 78 F.3d 1556, 1565 (Fed. Cir. 1996) (affirming board applying judicial estoppel: “[W]here a party successfully urges a particular position in a legal proceeding, it is estopped from taking a contrary position in a subsequent proceeding where its interests have changed.”).

II. The *Fintiv* Factors Favor Institution

Petitioners have now submitted a binding *Sotera* stipulation that negates any argument against institution under *Fintiv*. EX1034 (correspondence dated May 26, 2023). EX2007, 3; *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper

12, 18-19 (PTAB 2020) (precedential); 35 U.S.C. § 315(d); *Samsung Elec. Co. v. G+ Comms., LLC*, IPR2023-00171, Paper 10, 10 (PTAB 2023).

III. The *General Plastic* Factors Favor Institution

The *General Plastic* factors favor institution. See POPR, 29-30 (listing factors). These are Petitioners' first IPR petitions challenging the patents (factor 1), and "an unrelated Petitioner presenting some new reference[s] . . . weighs against denying institution under § 314(a) quite heavily" (factor 2). *LG Elecs., Inc. v. Bell N. Research, LLC*, IPR2020-00319, Paper 15, 15 (PTAB 2020). Petitioners are not strategically staging successive petitions after obtaining a roadmap from prior proceedings. Instead, they present completely different art than did the instituted but now-terminated Unified Patents ("Unified") petition (factor 3). The Board generally does not deny institution under *General Plastic* where, as here, the current and prior petitioners are different and there is no significant relationship between them. See *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, at 9-10 (PTAB 2019) (precedential). Petitioners received no prior notice of Unified's petition, did not know it was going to be filed or what it would contain, and did not rely upon it to prepare their Petitions in any way. EX2010, ¶¶ 3-20; EX1029, ¶ 27. Under these circumstances, mere general membership in Unified does not support denial. "Board decisions have routinely determined Factor 1 does not weigh in favor of exercising discretion to deny institution when Unified was the earlier challenger

and the Petitioner in the second Petition was a member of Unified.” *Tesla, Inc. v. Charge Fusion Technologies, LLC*, IPR2023-00062, Paper 13, 9 (PTAB 2023).

Furthermore, while Unified's prior petition challenged only certain claims of U.S. Patent No. 10,067,942 (“'942 patent”), Petitioners now challenge six of PO's patents (factors 4 and 5). Moreover, the fact that one petition challenges the same patent as the prior petition would not unduly tax the Board's resources (factors 6 and 7) because *the Unified IPR was terminated* before a final written decision. EX1035 (order terminating Unified IPR); *Siemens Gamesa Renewable Energy, Inc. v. General Electric Co.*, IPR2022-01479, Paper 11, 12-13 (PTAB 2023) (“[A]lthough we instituted trial in the 1563 IPR, we terminated that proceeding without issuing a final written decision [B]ecause this is Petitioner's first challenge of the claims of the '985 patent in a post grant proceeding and no other challenge by a third party has been decided on the merits, the policy concerns of *General Plastic* do not apply and we need not address the remaining *General Plastic* factor[s].”). As the Director recently stated in precedential guidance, “‘allowing [a petitioner] the opportunity to pursue a decision on the merits’ in a second-filed petition, when the first-filed petition was not evaluated on the merits, ‘best balances the desires to improve patent quality and patent-system efficiency against the potential for abuse of the review process by repeated attacks on patents.’” *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18, 4-5 (PTAB 2022) (precedential) (citation omitted).

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. § 42.6, that a complete copy of the attached **PETITIONER'S PRELIMINARY REPLY**, and related documents, are being served via electronic mail upon counsel of record for the Patent Owner as follows:

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