

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 IPR2023-00427

Patent 9,143,561

PATENT OWNER'S SUR-REPLY TO PETITIONERS' REPLY



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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	Declaration of Dr. Prashant Shenoy
2014	Curriculum Vitae of Dr. Prashant Shenoy
2015	Selected Excerpts from Microsoft Computer Dictionary, Fifth Edition (2002)
2016	Declaration of L. Roman Rachuba
2017	Reserved
2018	Official Transcript of Deposition of Heidi L. Keefe taken on June 20, 2023 in IPR2023-00427, IPR2023-00429, IPR2023-00430, IPR2023-00431, IPR2023-00432, IPR2023-00433
2019	Official Transcript of 35 U.S.C. § 101 Motions Day Hearing held on December 20, 2022 in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB (D.I. 68)
2020	Joint Initial Case Management Conference Statement filed in <i>Topia Technology, Inc. v. Dropbox, Inc.</i> , C.A. No. 23-62-JSC and <i>Topia Technology, Inc. v. Box, Inc.</i> , C.A. No. 23-63-JSC (D.I. 94)

2021	Egnyte's Memorandum of Law in Support of Motion for Judgement on the Pleadings that Plaintiff's Asserted Patents are Invalid Under 35 U.S.C. § 101 filed in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB (D.I. 40)
2022	Selected Excerpts from "Computer Networks – A Systems Approach (3rd Ed.) (2003) by Larry L. Peterson and Bruce S. Davie"
2023	Selected Excerpts from "Computer Networks – A Systems Approach (4th Ed.) (2007) by Larry L. Peterson and Bruce S. Davie"
2024	Deposition Transcript of Dr. Ravin Balakrishnan, Ph.D. (dated October 27, 2023)
2025	Declaration of Dr. Prashant Shenoy, Ph.D.
2026	Declaration of L. Roman Rachuba
2027	Protective Order in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB, D.I. 32
2028	Whitt Email to Rachuba August 24, 2023
2029	Topia's Subpoenas to Cooley, Heidi Keefe, Box and Dropbox and Responses from Cooley, Keefe and Box in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB
2030	Lowell Email to Mason February 12, 2024
2031	Rachuba Email to Whitt June 8, 2023
2032	Declaration of L. Roman Rachuba
2033	Deposition Transcript of Dr. Ravin Balakrishnan, Ph.D. (dated March 5, 2024)

2034	Amended Scheduling Order from <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB, D.I. 233
2035	Deposition Transcript of Dr. Prashant Shenoy, Ph.D. (dated February 8, 2024)
2036	Declaration of L. Roman Rachuba

I. Introduction

Patent Owner Topia Technology, Inc. (“Patent Owner” or “PO”) submits this Sur-Reply to Petitioners’ Reply (Paper No. 37) of U.S. Patent No. 9,143,561 (“the ’561 Patent,” EX1001) filed by Box, Inc., and Dropbox, Inc., (“Petitioners”). The Board should reject Petitioners’ IPR challenge at least because Petitioners (1) fail to name all real parties in interest, and (2) fail to establish a reasonable likelihood that any challenged claim is obvious over the prior art.

II. Egnyte is a Time-Barred RPI/Privy

Ms. Keefe prepared the Petition *while representing Egnyte* in its effort to invalidate the patent for the benefit of *both* Petitioners and Egnyte,¹ acknowledging that Egnyte did not waive conflict protections and that she “owe[d] a duty of zealous advocacy” to Egnyte. EX2018, 184:20-21; 185:15-21; *see* USPTO R. Prof’l Conduct 11.107 (prohibiting representation if it involves a concurrent conflict of interest). Therefore, *Egnyte had the opportunity to, and indeed exercised its ability to control the strategy of pursuing, drafting, and filing the IPR petition through common*

¹ Heidi Keefe began representing Egnyte in fall 2022, months before the Petition (Paper 3) was filed. EX2018, 41:6-10. She did not attempt to withdraw her unrestricted *pro hac* admission until July, 2023.

counsel, Ms. Keefe. See Radware, Inc. v. F5 Networks, Inc., IPR2017-01249, Paper 10, 5 (PTAB 2019).

Application of the factors in *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 10 (PTAB Oct. 2. 2020) (precedential) (“*AIT II*”), necessitate immediate dismissal for failing to name time-barred Egnyte as an RPI/privy. *Atlanta Gas Light Co. v. Bennett Regul. Guards, Inc.*, IPR2013-00453, Paper 88 (PTAB Jan. 6, 2015); *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1050 (Fed. Cir. 2017).

Factor (a): [REDACTED]

[REDACTED] This was a *quid pro quo* attempt to circumvent the statutory bar, whereby Petitioners pursued an IPR while Egnyte challenged the patents in district court, with the potential for a second bite at the apple. EX2018 77:23-78:3 and 79:11-12.

Factors (b) and (c): Petitioners’ and Egnyte’s interests in the IPR are identical. Petitioners’ self-serving statement that the IPRs were prepared and filed “without considering” the interests and input of Egnyte (Reply, 2) is not credible and flatly undermined by Ms. Keefe’s acknowledged obligation to zealously advocate for Egnyte. EX2018, 184:4-5. Ms. Keefe’s repeated claims of privilege over her

communications with Egnyte regarding the scope of her representation only underscore her dual representation. EX2018, 55:7-56:24.

Petitioners' denial of overlap in Ms. Keefe's concurrent representations is plainly false, since the overlap is undisputed, including the critical period involving the drafting and filing of the Petition. EX2018, 41:6-10. Moreover, her concurrent representations involved overlapping legal issues. In district court, she represented Egnyte on § 101 invalidity that involved (1) claim construction (and other characterizations of the patent) that implicate Petitioners' and Egnyte's products² and (2) obviousness. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018) (§ 101 analysis involves a determination of whether a claim element is well-understood, routine and conventional). Furthermore, Ms. Keefe's statement that her representation of Egnyte was "narrow" should be viewed with skepticism. Apart from the fact that the representation overlapped in time and scope, it is self-serving and conflicts with the Rule that "[a] practitioner shall not act as advocate at a

² While the ID credited Ms. Keefe's testimony that Petitioners' and Egnyte's products are different (ID, 12), they nonetheless all infringe the same patents. Ms. Keefe necessarily considered any differences between the products in her representation of Egnyte, to ensure that Egnyte's products would not be implicated by Petitioners' IPR positions.

proceeding before a tribunal in which the practitioner is likely to be a necessary witness.”) USPTO R. Prof'l Conduct 11.307; *see Siguel v. Allstate Life Ins. Co.*, 1995 U.S. App. LEXIS 4666, *19 (1st Cir. 1995) (“The concern is over the credibility of a lawyer who also appears as a witness and a judge assesses credibility just as the jury does.”)

Factor (d): Petitioners do not dispute that “Egnyte has a long history with [Ms. Keefe’s law firm,] Cooley. Cooley has been Egnyte’s long-time corporate counsel.” EX2001, 10:6-8. Petitioners offer no rebuttal to the fact that Ms. Keefe admitted into entering an off-the-record agreement with Egnyte’s other counsel to begin representing Egnyte during the § 101 motion proceedings – the terms of which she conceals under a claim of privilege. EX2018, 122:13-21, 96:1-5; 58:16-19, 61:6-65:12; 84:8-13 and 47:6-20.

That Petitioners and Egnyte are business competitors is also of no moment. Here, the interests are aligned, so much so that Box and Dropbox – fierce competitors – agreed to be co-petitioners under common lead counsel, Ms. Keefe.

To Patent Owner’s knowledge, this is the first time since *AIT II*, that a Petitioner chose to not name a third party accused of infringement in district court on the same patent at issue in the petition as an RPI/privy, after sharing identical counsel while the petition was being drafted and filed. In *Adobe Inc. v. Rah Color*

Technologies LLC, IPR2019-00629, Paper 35 at 12–13 (PTAB Sept. 4, 2019) unlike in the instant case, there was no evidence that the unnamed RPI/privy was time-barred under § 315(b) and [REDACTED]

[REDACTED]

Both *FPUSA, LLC v. M-ILLC*, IPR2016-00213, Paper 45, 11 (PTAB Mar. 20, 2017) and *Aruze Gaming Macau, Ltd. v. MGT Gaming, Inc.*, IPR2014-01288, Paper 13, 19-20 (PTAB Feb. 20, 2015) are pre *AIT II* cases, and did not involve the same attorney preparing and filing an IPR Petition while representing another third party in an infringement suit on the same patent at issue.

Factors (e), (f), and (g): As an accused infringer, it is indisputable that Egnyte has an interest in and directly benefits from Petitioners' IPR, even more so because, when the Petition was filed, Egnyte itself was time-barred from pursuing its own Petition — a consideration taken into account in its decision to not file its own IPR Petition. Moreover, with recent scheduling changes, trial in the Delaware Egnyte case is now scheduled to occur months *after* the Board's expected final written decision. EX2034, 2.

Factor (i): Ms. Keefe admits to communicating with Egnyte regarding the parallel litigations, but refused to elaborate on these communications on the basis of privilege. EX2018, 55:7-56:24; *AIT II*, 30 (discussions of pending litigations weigh

in favor of an RPI finding); *c.f.* Petitioners' cited *Ecobee Techs. ULC v. Causam Enters., Inc.*, IPR2022-01339, Paper 20, 11 (PTAB Mar. 22, 2023) (Finding of no RPI where there was no shared counsel, no JDA, no self-serving testimony by Petitioners' counsel, no evidence of sharing legal resources, no time bar issues, and no evidence that the unnamed RPI/privy assisted in preparing shared invalidity contentions or identifying references of the IPR Petition).

Finally, Petitioners misrepresent the record on Patent Owner's and Judge Burke's positions in Delaware on Egnyte's RPI/privy status by wrongly implying that *Patentee* argued Egnyte should not be an RPI. Reply 3. To be clear, Patent Owner has never taken this position, and Judge Burke, looking at the relationship with Petitioners and Egnyte recognized the remarkable closeness of those entities on his own accord. EX.2001, 10:17-11:13; 39:16-18.

III. Petitioners Fail to Prove that the Challenged Claims Are Unpatentable

A. Overview

In contravention to the Trial Practice Guide, Petitioners submit a new argument in their Reply based on a construction of the term "automatically transfer" that Petitioners could have presented in their Petition. *See Consolidated Trial Practice Guide*, 42-45 73 (Nov. 2019). To be sure, Petitioners did not even

address claim construction in their Reply to the POPR, in which PO explained that the “automatically transferring” limitation requires the modified first electronic file to be transferred to the third electronic device “without a request for the missing content from the third electronic device.” *See* POPR (Paper 007) at 44. Accordingly, the Board should disregard Petitioners’ new arguments based on their belated claim construction. Nonetheless, should the Board consider Petitioners’ new arguments, Petitioners’ arguments fail on the merits for the reasons argued below.

1. The Plain Meaning of The First Application “Automatically Transferring” to the Third Electronic Device

Nothing in the intrinsic evidence compels construing “**automatically**” beyond its plain and ordinary meaning **within the context of the claim**. *Phillips*, 415 F.3d at 1313. *See ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (“... the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of [the] terms”). Petitioners’ assertion that PO has construed “automatically” transferring files as prohibiting “any intervening steps between storing the ‘modified first electronic file’ at the ‘first electronic device’ and ‘automatically’ transferring the file to a ‘third electronic device’” is simply incorrect and misleading. Reply, 4. Petitioners, not PO, puts forth an erroneous construction of “automatically transferring”

arguing that it means transferring by a system as opposed to being transferred manually by a human user. *Id.*, 5 Such a construction makes the term “automatically” superfluous as the claim language expressly recites the electronic devices that are transferring and receiving the files. *See Wasica Fin. GmbH v. Cont’l Automotive Systems, Inc.*, 853 F.3d 1272, 1288 n.10 (Fed. Cir. 2017) (“It is highly disfavored to construe terms in a way that renders them void, meaningless, or superfluous.”); *see also, Rovi Guides, Inc. v. Vidal*, No. 2020-1994, 2022 U.S. App. LEXIS 10465 (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.”). Elements [1b] and [1c] expressly state that the first electronic device receives files automatically transferred from the second and third applications. If “automatically” merely means the files are transferred by the system instead of by a human user, then the term “automatically” would add nothing to the claim since the claim expressly states that the second and third applications transfer the files. Similarly, elements [1d] and [1e] expressly recite the first application transferring files to the third and second electronic

devices, respectively. Adopting Petitioners' construction would be error as it would render the term "automatically" meaningless in the claims.

Considering element [1d], for example, when "automatically transferred" is given its plain and ordinary meaning, consistent with the claim language and the specification, a POSA would understand it to mean that the first application transfers a modified file to the third electronic device without the third electronic device requesting the modified file. EX2025 ¶¶94, 105. This construction not only gives meaning to the term "automatically," it is consistent with the specification which describes the synchronization application 380, running on server 230, monitoring the user's device and if the device is in communication with the server, it transfers the modified file to the user device. EX1001 8:34-46. No request from the user's device (the third electronic device) is needed as the synchronization application 380 on the server 230 pushes the file to the user's device. EX2025 ¶¶94, 105, EX2013 ¶48, 50.

Petitioners mischaracterize PO's statement that the patent "provides a user-centric computer network architecture for file synchronization[.]" Patent Owner's Response ("POR"), 7, Reply, 6. As Dr. Shenoy testified, the phrase "a user-centric architecture" is used to explain the *goal* of the system, which is "to perform full file synchronization across these multiple devices that are associated with the user." EX2035, 28:15-22. This, however, does not limit the actual claim language.

As Dr. Shenoy testified, “if you read what the claim actually says, Claim 1 says, it says that the first electronic device, and specifically the application that's running on the device, is performing the automatic transfer.” EX2035, 129:5-11

Moreover, the plain and ordinary meaning of the term “automatically” within the context of the claim does not “prohibit any intervening steps” as misrepresented by the Petitioners. Reply, 4. The issue is not whether the claim prohibits intervening steps, but rather whether the first electronic device (e.g., server) initiates the transfer of the modified file from the server to the client without the client requesting the modified file – a plain and ordinary construction supported by the '561 patent.

For example, the '561 patent states that “the synch application 380 monitors a set of user devices to which the file 370 should be transferred to effect file synchronization.” EX1001 8:32-46. It does this by “poll[ing] the device 280 to determine whether the device 280 is in communication with the server 230” and “[i]f the device 280 is in communication with the server 230, **the synch application 380 transfers** the file 370 to the device 280[.]” *Id.* (emphasis added). This is done without a request from the device 280 for the modified file. Accordingly, “automatically transfer” in element [1d] means that the first electronic device automatically transfers the modified file to the third electronic

device as opposed to the third electronic device requesting the modified file. EX2025, ¶214. The intrinsic evidence supports this meaning.

The fact that claims 1 and 8 are open-ended “comprising” claims does not alter the plain meaning of “automatically” in [1d] to be from the point of view of the first electronic device, in particular, the first electronic device which initiates the transfer of the modified file. Petitioners’ confuse responding to a poll for determining if devices are communicating with making a request to transfer a modified file. The device’s response to the synchronization application’s poll is not a request to transfer a modified file. Reply, 7. As such, the correct construction of “automatically transferring” does not exclude all communication between a client and server as Petitioners mistakenly assert, but rather has the server transfer the modified file without the client requesting it.

Furthermore, the relationship between claims 1 and 4 of the ’561 patent does not negate the interpretation of “automatically” to be from the point of view of the first electronic device. While claim 4 requires the “first application” on the first electronic device to “store the modified first electronic file copy to the memory device associated with the first electronic device when the third electronic device is not in communication with the first electronic device,” this does not change the fact that **the first electronic device initiates the transfer operation** as recited in claim 1.

2. “Automatically” Transferring Files By The First Electronic Device Excludes Pull-Based File Transfers.

For at least the reasons above, claims 1 and 8 require **the first electronic device** to **automatically transfer** the modified first electronic file copy to the third electronic device, i.e., **the first electronic device** initiates the **transfer** of the modified first electronic file copy to the third electronic device. Accordingly, any synchronization mechanism that is initiated by a request by a client device for a specific file, also referred to as “a pull-based” mechanism must be excluded.

Petitioners misread the '561 patent to incorrectly conclude that the patent contemplates that automatic file transfers may be interchangeably “push” or “pull.” Reply, 8. The '561 patent, at 10:33-43, merely describes “an alternative to the approach described with reference to FIG. 3, wherein **the transfer clients 310, 320 function to ‘push’** modified or created files to the synch application 380,” It goes on to describe an alternative embodiment in which “the synch application 380 may instead function to periodically ‘pull’ or otherwise actively retrieve such files from the transfer clients 310, 320.” (Emphasis added). Far from explaining that “push” and “pull” approaches are interchangeable, the specification at most discloses an unclaimed alternative embodiment in which **the synch application 380 may pull** modified or created files from **the transfer clients 310, 320**. This

portion of the patent neither teaches nor suggests the transfer clients 310, 320 pulling the modified or created files from the server 230.

B. Ground 1: The Challenged Claims Would Not Have Been Obvious in View of Sigurdsson in Combination with Shappell.

1. Combination of Sigurdsson and Shappell Does Not Disclose or Render Obvious “Automatically” Transferring Files From Server To Client.

a. Sigurdsson Does Not Disclose Its Server “Automatically” Transferring Files Under the Plain and Ordinary Meaning Within The Context of the Claim.

When “automatically” transferring files is given its plain and ordinary meaning in the context of the claim, Sigurdsson simply does not teach the claimed automated transfer limitations. Particularly, Sigurdsson does not teach or suggest transferring a specific file “automatically” **by the first electronic device** (e.g., a server) without receiving a request from a client device for the specific file.

b. Under PO’s Proper Claim Construction, Sigurdsson Does Not Teach or Suggest “Automatically” Transferring Files.

Petitioners’ wrongly assert that PO did not point out errors in the Board’s preliminary determination concerning Sigurdsson supposedly teaching or suggesting automatic transfer from the perspective of the first electronic device. Reply, 10. POR, at least at pages 12-19, explains why there is no such teaching or suggestion.

Petitioners generally repeat that “the transfer from Server 106 to Client C in the last sentence of ¶68 occurs automatically.” Reply, 10-13. However, Petitioners continue to ignore the explanation in Sigurdsson on how Server 106 actually transfers content to a client device.

Sigurdsson uses the term “automatically” fifteen times, none of which is with respect to the transfer of a file from Server 106 to a client device. PO does not dispute whether Sigurdsson can transmit the content to the remaining client peers. EX1016, ¶68. However, the issue is *how* Sigurdsson transmits the content to the remaining client peers. In every explanation on how the content is transmitted, Sigurdsson *repeatedly* emphasizes that the client device (both while online and returning online) initiates the transfer of the content (*see* FIG. 2, 212, 218; FIG. 3, 310; FIG. 6, 612, 620; FIG. 7, 710; FIG. 8, 810). Considering the reference as a whole, instead of focusing on a single conclusory sentence of ¶68, a POSA would have understood Sigurdsson requiring the client device to initiate the transfer of content. EX2025, ¶¶41-47, 53, 54. Even in a scenario in which Client B 104 is online, Sigurdsson discloses that Client B104 requests Server 106 for new content stored on Server 106 but not yet received by Client B 104. EX1016, FIG. 2, ¶¶37-41; EX2025, ¶¶59, 60, 68, 69. As such, Sigurdsson cannot and does not teach or suggest **the first electronic device automatically transferring** the modified second electronic file copy to the second electronic device.

Petitioners and Dr. Balakrishnan wrongly state that because each user device includes an HTTPS client/server, Sigurdsson's server must also include "an HTTPS client that can push data to user devices." Reply, 11 and EX1046, ¶¶35-36.

First, there is no support for this conclusory statement. In FIG. 3, Sigurdsson discloses that each Client A and Client B has an HTTPS Client/Server component (326, 356). Tellingly, however, the Server 106 in FIG. 3 of Sigurdsson does not have the HTTPS Client/Server component. According to Sigurdsson, the HTTPS client is needed at the client devices to act as a client to track web access. EX1016, ¶47. However, there is no suggestion in Sigurdsson that the server tracks web access. Therefore, Sigurdsson cannot and does not disclose a server having "an HTTPS client that can push data to user devices."

Even if Server 106 were to include "an HTTPS client," Sigurdsson still fails to teach or suggest that Server 106 initiates the transfer of the content to the client devices. Rather, Sigurdsson requires the client device to initiate the transfer of content by performing a request for a specific missing file.

Petitioner's expert Dr. Balakrishnan confirmed that HTTP PUSH-based application was not available in Version 1 of HTTP protocol used at the time of Sigurdsson. EX2033, 136:9-137:10 ("They clearly saw that omission later on and fixed it in Version 2"). Thus, Sigurdsson cannot and does not teach or suggest that the Server 106 pushes a file to the client devices.

Petitioners attempt to minimize the express teaching of the HTTP/HTTPS protocol in Sigurdsson by alleging that Sigurdsson suggests “to push a modified file from an HTTPS client in Server 106 to an HTTPS server in a client device.” Reply, 12. This simply is not the case since the term “protocol” appears only once in Sigurdsson, in paragraph [0047], which refers to “a hypertext transfer protocol secure (HTTPS) Client/server 326.” Sigurdsson stops there, and is silent about using other protocols to transfer files to implement an automatic file transfer by the server.

The Petitioners improperly attempt to diminish the crux of the invention of Sigurdsson to enable peer-to-peer content sharing and synchronization using a combination of peer to-peer and “drop box” techniques (EX1016, ¶62; EX2025, ¶¶59, 60), and allege that Sigurdsson does not require clients to use a peer-to-peer model when source and destination clients are online instead of a client-server model. Reply, 13.

Nevertheless, even if client-server techniques are used for clients that already are online, Sigurdsson still fails to teach or suggest that Server 106 initiates the transfer of the content to the client devices. Rather, Sigurdsson requires the client device to initiate the transfer of content by performing a request for a file. EX1016, FIG. 2, ¶¶37-40; EX2025, ¶¶59, 60, 68, 69.

c. Sigurdsson in View of Shappell Does Not Render Obvious Sigurdsson's Server "Automatically" Transferring Files.

Contrary to Petitioners' assertions, PO pointed out the reasons why it would not have been obvious to modify Sigurdsson by Shappell to disclose the features of "automatically" transferring files as claimed. Reply, 14 and POR, 36-39.

Petitioner's incorrectly repeat that Shappell's "automatic replication" feature teaches the claimed "automatic" transfer of a modified file to all connected member machines that previously obtained a copy of the file. Reply, 14-15.

As discussed above, claim 1 of the '561 patent requires a first electronic device (e.g., a server) to **"automatically" transfer a modified file**. On the other hand, since Shappell expressly and repeatedly discounts the use of a server by specifically requiring a server-less shared space, it would not have been obvious to modify Server 106 (allegedly corresponding to the claimed a first electronic device) in Sigurdsson with features from Shappell to **"automatically" transfer a modified file**. EX2025, ¶85

2. It Would Have Not Been Obvious to Combine Sigurdsson with Shappell.

Petitioners falsely state that "PO cites nothing in Shappell that criticizes, discredits, or otherwise discourages using a server." Reply, 15-16.

To the contrary, PO highlighted the numerous instances where Shappell discounts the use of a server by specifically requiring a server-less shared space. POR, 36-39. For example, in the Abstract, in the opening paragraph, and in the first paragraph of the summary of the invention section, Shappell describes that the invention is directed to a system and method for sharing files in a **server-less**, secured shared space. EX1020, Abstract, ¶¶1,7. In this regard, the plain meaning of the term “server-less” is “without a server”.

Even if Shappell discloses that a remote computer 49 may be a server (EX1020, ¶37), Shappell does not teach or suggest that this remote computer 49 or the server “**automatically**” **transfers a modified file** as recited in the ‘561 patent.

The issue is not *merely* whether Shappell discloses “a server”. Instead, the issue here is whether Shappell discloses a server initiating an automatic transfer of the modified file to **a same user**.

While FIG. 1 of Shappell illustrates a general computing environment showing the remote computing device 49, Shappell is completely silent about using the remote computing device 49 or the server to initiate an automatic transfer of the modified file to a same user.

Moreover, Shappell discloses that “[e]ach user device will typically be used by or associated **with a different user**” and “[t]he invention has its greatest benefits when applied to **small groups**.” EX1020, ¶40. Therefore, Shappell further cannot

and does not teach or suggest an automatic transfer of the modified file to a **same user**.

Additionally, Sigurdsson discloses two architectures that operate separately, for example, “peer-to-peer techniques can be used by clients that currently are online to share the content directly between clients,” and “the server can be used as a drop box for the content” to supply that content to an offline client once it comes online again. EX1016, ¶62. However, there is nothing in Sigurdsson or Shappell to suggest that client server architecture of Sigurdsson can be replaced by another server-less peer-to-peer architecture of Shappell. EX2025, ¶¶79-88. As such, a POSA would not have modified the teachings of Sigurdsson with the teachings of Shappell.

C. Ground 2: The Challenged Claims Would Not Have Been Obvious in View of Brown in Combination with Hesselink

1. Brown in View of Hesselink Fails to Disclose and Render Obvious Automatic Transfer of a Modified File From a Source Client Through a Server to a Destination Client

a. Brown Does Not Disclose Its Server “Automatically” Transferring Files Under the Plain and Ordinary Meaning.

Petitioners’ reply arguments are based on its erroneous construction of “automatically transferring” a file, as discussed in III.A.1-2, and by mischaracterizing PO’s assertion of the plain and ordinary meaning of the term. Reply, 18-19.

Brown unequivocally states that a synchronization process is **initiated by the client device, not the server**. EX1025, 5:14-17. Brown further states that the client, not the server, determines what update should be made to that client. Id., 9:4-6, 10:44-48.

Petitioners fail to show – and cannot show – that Brown teaches a server's transfer of a modified file without a client requesting the file. EX2025, ¶¶94, 96-100, 108-111. Petitioner's admit as much by pointing out that "Brown's synchronization process on laptop client 135 would begin by checking whether the server has any updates, including updates from other client devices, such as desktop client 130." Pet. 55.

b. Under The Proper Claim Construction, Brown in view of Hesselink Does Not Render Obvious Brown's Server "Automatically" Transferring Files.

Petitioners' argument that Brown's server modified by Hesselink to immediately push a modified file to another user device, satisfies PO's interpretation of "automatically" transferring a file simply is not correct. Reply, 19. Petitioners ignore the difference between automatic transfer and an immediate transfer, tacitly equating the two. Id. The challenged claims do not recite immediate transfer, but automatic transfer (that is, without a client's request), of a modified file. EX2025, ¶94. Accordingly, even if Brown were modified by Hesselink to "immediately" transfer the file, as asserted in the Petition, the

combination still does not “automatically transfer” the file as required by at least elements [1d] and [1e] since the record is devoid of evidence that “immediately” transferring the file does not involve a client requesting the file.

In attempting to argue that Brown teaches a server “pushing” information, Petitioners pluck out of context a mere mention of a need to “push” information, urging that “Brown expressly teaches its server pushes changes to syncing clients.” Reply, 20 citing Brown 5:36-38. But this portion of Brown does not describe an “automatic transfer” as it is part of a synchronization process that is initiated **by the client** to determine if a file has changed. EX1025, 5:14-40 (“The synchronization process in initiated by a client SA when it makes a sync poll to the server”)

Contrary to Petitioners’ arguments, Brown criticizes, discredits, or discourages the server’s automatically transferring a modified file. Brown aims to “minimize the amount of data transmitted” and therefore preferably teaches to upload or download only the parts of files that have changed. EX1025, 3:29-33, 11:54-12:12. To implement this, Brown’s client must perform a hash function to determine if the number of changes to the file satisfy a threshold. Is so, only the portion of the file that changed is transmitted. Id., 11:64-12:51. As such, Brown’s file transfer is contingent on the result of the client performing a hash function, and therefore, the file transfer is not automatic.

Acknowledging the deficiencies of the HTTP request/response process, Petitioners attempt to impermissibly expand the instituted grounds arguing that protocols other than HTTP can be used for file transfer. Reply, 21. As such, these arguments should be given no weight.

2. Brown In View Of Hesselink Fails To Disclose And Render Obvious Automatic Transfer Of A Modified File To Another Device “Associated With A User”

Petitioners strain to read Hesselink's disclosures about connection servers, security servers, and network enabled devices as all being associated with the same user. Reply, 22. According to Petitioners' expert, Dr. Balakrishnan, to be associated with a device a user must be able to access and login to the device. EX2033, 177:12-25. There is no evidence in the record that a user of a client computer (12) would log into Hesselink's connection servers (14) or security server (58). So even under Petitioners' view of being associated with a user, Hesselink does not teach or suggest it's connection servers and security servers are associated with the user of the client computer.

3. Brown's Disclosure Fails to Support Obviousness.

Petitioners again fail to consider Brown's teachings as a whole in relying on Brown's mention of directories with changes that need to be pushed. Reply, 23, citing EX1025, 5:36-38. As discussed at III.C.1.b, this “need to push” changes Brown

mentions is part of a synchronization process that is initiated by the client requesting the changes. This is not an “automatic transfer”.

Petitioners also argue their proposed modification to Brown's server would not frustrate Brown's desire to minimize the load on the server because Brown's clients still would perform *some* functions in the modified system. Reply, 23.

Petitioners confuse the issue here. The issue is whether Brown's purpose of minimizing the load on the server would have provided a rationale for a POSA to make the *proposed combination/modification*. To avoid an increase in the server's load, Brown teaches transferring only a block of the file that is changed, instead of transferring the entire file, under a certain condition. *Id.*, 12:12-51. Thus, Brown clearly discourages and therefore teaches away from automatically transferring an entire modified file.

4. The Petition Relies on Hesselink's Peer-to-Peer Architecture, and Hesselink Teaches Away From Client/Server Architectures.

Petitioners allege that they do not rely on Hesselink's peer-to-peer architecture. Reply, 24. However, a prior art reference must be considered as a whole and Hesselink's embodiments relied upon by Petitioners are directed solely to a peer-to-peer system. *Pet.*, 56-57, citing EX1026, ¶¶183, 197.

The mere mention of a “file server” or “connection server” in Hesselink does not change its peer-to-peer implementation to a client/server model. The “file

server” appears only once in Hesselink as an example of a peer (i.e., any of computers 72, 74, and 76). EX1026, ¶122. The “connection server” is used in Hesselink to address a security concern in a peer-to-peer environment. Id., ¶123. The connection server 14 is not a centralized and dedicated server to control a synchronization process, whereas in Hesselink, each of computers 72, 74, and 76 controls its synchronization process. Id.

Furthermore, PO explains in detail that FIG. 8 of Hesselink discusses data transfer operations of a connection server, which are based on a client's HTTP request. POR, 49-52. Petitioners provide no rebuttal or comments on this point. Even if Hesselink could somehow form a “client-1/connection server 14/client-2” arrangement as alleged by Petitioners (Reply, 25), such an arrangement still would structurally require a request from the client (i.e., the request-response based mechanism).

Petitioners state “Hesselink's examples of storing family photos in 'some unknown location' with 'unknown' security or requiring a costly 'dedicated private network' do not disparage client/server models generally.” Reply, 25. However, the relevant focus is that Hesselink is concerned about using a client/server model and therefore chose a peer-to-peer system instead. EX1026, ¶¶6-10. EX2025, ¶¶132-135. Thus, a POSA would not have looked to Hesselink's peer-to-peer system to modify Brown's server. EX2025, ¶132.

Petitioners also state that Hesselink's security concerns do not apply to systems with "secure ways of storing things" like Brown. Id. But this position ignores the express teaching in Brown that encryption is necessary for security reasons (*see* EX1025, 8:41-42) and that is exactly the reason Hesselink discourages the use of a server. EX1026, ¶21. Further, Hesselink's teachings of the advantages of not using an intermediary as a server cannot be ignored. Id., ¶205.

Hesselink's peer-to-peer subscription system also teaches using a "delta synchronization" technique that sends only changes to a file which is fundamentally different from transferring a modified file. Hesselink explicitly teaches away from transmitting the entire file in order to achieve reduction in bandwidth requirement and latency improvement. Id., ¶¶135, 140, 193. So a POSA would not have modified Brown based on Hesselink to reach claim 1 since the combination would only transfer file changes and not the entire file. Accordingly, Brown in view of Hesselink cannot disclose or render obvious the automatic transfer of a modified file.

IV. CONCLUSION

For at least the foregoing reasons, the IPR challenge to the asserted claims should be rejected.

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Respectfully submitted,

/ Raja Saliba /

Raja N. Saliba (Reg. No. 43,078)

Chidambaram S. Iyer (Reg. No. 43,355)

Michael R. Dzwonczyk (Reg. No. 36,787)

L. Roman Rachuba (Reg. No. 75,180)

Sughrue Mion, PLLC

Telephone: (202) 293-7060

Facsimile: (202) 293-7860

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Respectfully submitted,

/ Raja Saliba /

Raja N. Saliba (Reg. No. 43,078)

Chidambara S. Iyer (Reg. No. 43,355)

Michael R. Dzwonczyk (Reg. No. 36,787)

L. Roman Rachuba (Reg. No. 75,180)

Sughrue Mion, PLLC

Telephone: (202) 293-7060

Facsimile: (202) 293-7860

CERTIFICATE OF SERVICE

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

Heidi L. Keefe
Reuben H. Chen
Lowell D. Mead
Samuel K. Whitt
Cooley LLP
1299 Pennsylvania Ave NW Suite 700
Washington, DC 200004
hkeefe@cooley.com
rchen@cooley.com
lmead@cooley.com
swhitt@cooley.com

/Soo Jin Hur/
Soo Jin Hur

Date: April 2, 2024