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. IPR2023-00427

U.S. Patent No. 9,143,561

PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO MODIFY THE PROTECTIVE ORDER

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U.S. v. Akula,
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35 U.S.C. § 315 4

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List of Exhibits

Exhibit No.	Description of Document
1001	U.S. Patent No. 9,143,561 ("'561" or "'561 patent")
1002	U.S. Patent No. 10,067,942 ("'942" or "'942 patent")
1003	U.S. Patent No. 10,289,607 ("'607" or "'607 patent")
1004	U.S. Patent No. 10,642,787 ("'787" or "'787 patent")
1005	U.S. Patent No. 10,754,823 ("'823" or "'823 patent")
1006	U.S. Patent No. 11,003,622 ("'622" or "'622 patent")
1007	Prosecution History of the '561 Patent
1008	Prosecution History of the '942 Patent
1009	Prosecution History of the '607 Patent
1010	Prosecution History of the '787 Patent
1011	Prosecution History of the '823 Patent
1012	Prosecution History of the '622 Patent
1013	Case No. IPR2022-00782, Paper No. 1, Petition for IPR
1014	Case No. IPR2022-00782, Paper No. 17, Decision Granting Institution of IPR (Redacted – Public Version)
1015	U.S. Provisional Patent Application No. 60/986,896 ("'896 provisional")
1016	U.S. Patent Application Publication No. 2007/0174246 A1 to Johann Tomas Sigurdsson, et al. ("Sigurdsson")
1017	File History of U.S. Patent Application Publication No. 2007/0174246 A1 to Johann Tomas Sigurdsson, et al. ("Sigurdsson File History")
1018	U.S. Patent No. 7,734,690 B2 to George P. Moromisato, et al. ("Moromisato")
1019	U.S. Patent Application Publication No. 2006/0190506 A1 to Rajesh M. Rao, et al. ("Rao")
1020	U.S. Patent Application Publication No. 2005/0091289 A1 to Michael Shappell, et al. ("Shappell")
1021	Microsoft Computer Dictionary (5th ed. 2002) (excerpts)
1022	Jim Boyce, *Microsoft Outlook Version 2002 Inside Out* (2001) ("Boyce") (excerpts)
1023	European Patent Application Publication No. EP 1,621,990 A2 to Kitamaru, et al. ("Kitamaru")
1024	U.S. Patent No. 5,923,325 to Ronald Jason Barber and Edwin Joseph Selker ("Barber")
1025	U.S. Patent No. 7,035,847 B2 to David K. Brown, et al. ("Brown")

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1026	U.S. Patent Application Publication No. 2005/0120082 A1 to Lambertus Hesselink, et al. ("Hesselink")
1027	*Topia Technology, Inc. v. Box, Inc.*, Case No. 6:21-cv-1372-ADA, D.I. 60 (Joint Claim Construction Chart)
1028	Opening Declaration of Dr. Ravin Balakrishnan
1029	Declaration of Heidi L. Keefe in Support of Petitioners' Preliminary Reply (HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY)
1030	Joint Defense and Information Sharing Agreement ("JDA") (HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY)
1031	Complaint, *Topia Technology, Inc. v. Egnyte, Inc.*, Case No. 1:21-cv-01821 (D. Del. Dec. 27, 2021), Dkt. No. 1 ("Egnyte complaint")
1032	Complaint for Patent Infringement, *Topia Technology, Inc. v. Box, Inc.*, Case No. 6:21-cv-01372 (W.D. Tex. Dec. 29, 2021), Dkt. No. 1 ("Box complaint")
1033	Complaint for Patent Infringement, *Topia Technology, Inc. v. Dropbox, Inc.*, Case No. 6:21-cv-01373 (W.D. Tex. Dec. 29, 2021), Dkt. No. 1 ("Dropbox complaint")
1034	Correspondence dated May 26, 2023
1035	Case No. IPR2022-00782, Paper No. 31, Termination
1036	Biography of Lowell Mead
1037	Declaration of Lowell Mead ISO Motion for Pro Hac Vice Admission
1038	Biography of Reuben Chen
1039	Declaration of Reuben Chen ISO Motion for Pro Hac Vice Admission
1040	Microsoft Computer Dictionary (5th ed.) (excerpt)
1041	RFC 2616, Hypertext Transfer Protocol – HTTP/1.1 (June 1999), https://web.archive.org/web/20040614145003/https://www.ietf.org/rfc/rfc2616.txt ("IETF HTTP/1.1")
1042	International Patent Application Publication No. WO 02/065359 A1 to Hepworth, et al. ("Hepworth")
1043	U.S. Patent No. 5,416,842 to Aziz ("Aziz")
1044	U.S. Patent No. 6,654,746 to Wong, et al. ("Wong")
1045	Transcript from the February 8, 2024 Deposition of Prashant Shenoy

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1046	Reply Declaration of Ravin Balakrishnan, Ph.D.
1047	Email exchange between counsel for Petitioners and counsel for Patent Owner
1048	Objections served by Dropbox Inc. on November 11, 2023 to subpoena served by Patent Owner Topia Technology, Inc.

I. INTRODUCTION

Patent Owner ("PO") fails to establish good cause to modify the agreed Protective Order to permit materials to be used in the Delaware litigation against Egnyte. Paper 44 ("Mot."). PO does not demonstrate any new compelling need in the litigation for this material. Instead, PO's true agenda is to use the material for the improper purpose of attempting to invade privilege. PO's purported justification—to permit the Delaware court to evaluate whether Egnyte is an RPI bound by IPR estoppel—is a false pretext. Indeed, PO successfully persuaded the Delaware court in March 2023 that Egnyte is not an RPI bound by IPR estoppel to avoid a stay pending IPR. In these IPRs, Petitioners relied upon the agreed terms of the Protective Order to protect sensitive and confidential information. Those stipulated terms should be respected and maintained. PO's motion should be denied.

II. RELEVANT BACKGROUND

A. Petitioners Relied on the Agreed Protective Order When Providing Sensitive Confidential Information.

The issues at hand first arose after PO speculated in its May 9, 2023 POPRs that Egnyte is an RPI, based in part on the fact that Petitioners' counsel Ms. Heidi Keefe had argued one § 101 motion hearing for Egnyte in its Delaware litigation. To negate PO's speculation, Petitioners provided a confidential declaration from Ms. Keefe testifying that Egnyte has no connection to these IPRs and her representation of Egnyte was limited solely to arguing that one motion hearing. Ex. 1029.

Before filing the declaration on June 8, 2023, Petitioners conferred with PO and filed an agreed and unopposed Protective Order that expressly prohibits sealed material in this proceeding from being used outside of this proceeding. Paper 9, Appendix A. When Ms. Keefe was deposed on June 20, 2023, Petitioners relied on the Protective Order to protect the sealed portions of the deposition that PO now seeks to unseal. PO asked numerous questions about sensitive and confidential client and joint-defense relationships. *E.g.*, Ex. 2018, 52:4-12, 57:22-59:1, 61:6-62:2, 62:19-63:22, 64:7-67:16, 68:1-13, 68:24-73:13, 76:15-77:3, 105:1-106:1, 139:15-140:18, 144:3-146:24, 146:25-147:4, 160:9-19, 162:20-163:9, 163:23-164:21. In reliance on the Protective Order prohibiting confidential discovery from being used outside these IPRs, and to negate PO's speculation that Egnyte was involved with these IPRs, fulsome answers were provided to those questions on the condition that PO would not argue waiver. *See id*. PO **consented** to sealing those confidential portions of the transcript pursuant to the Protective Order. Paper 13.

The record, including Ms. Keefe's sworn testimony, negated PO's speculation that Egnyte might have been involved in filing these IPRs. Egnyte was never an RPI. The Board correctly determined at institution that the record does not support an RPI finding. Paper 17 at 8-16. Nothing has changed since then to disturb that finding. Petitioners already rebutted PO's incorrect and misleading assertions attempting to create an RPI issue. Paper 10 at 2, n.4. Tellingly, in the many months

since institution in August 2023, PO has not sought any additional discovery in these IPRs on the issue of whether Egnyte is an RPI.

B. PO Seeks These Materials to Improperly Invade Privilege.

After Ms. Keefe's testimony confirmed the absence of any factual basis for PO's RPI speculation, PO sought to use that testimony in the district court litigation solely for the purpose of improperly attempting to invade privilege. Specifically, on July 27, 2023, PO emailed to Petitioners a request to use the sealed Keefe declaration (Ex. 1029) and deposition transcript (Ex. 2018) in the Delaware Egnyte litigation. Ex. 1047. Petitioners responded: "So that we can better understand Topia's request, can you please explain specifically for what purpose or purposes Topia would be seeking to use these protected materials in the Egnyte district court litigation?" *Id*. PO replied: "***Topia intends to rely on the documents to show that Ms. Keefe has waived Egnyte's joint defense privilege by describing conversations she had with Egnyte's other outside counsel regarding the scope of her representation and Egnyte's invalidity strategies***." *Id*. (emphasis added). Topia made no mention of any alleged RPI issue. The sole reason PO sought to use these materials in the litigation was to attempt to invade privilege. Eight months later, during the March 12, 2024 hearing when the Board asked PO's counsel (the same counsel who sent the above-quoted email) whether PO planned to use these materials to argue for a privilege waiver, counsel's response was highly misleading at best.

C. PO Successfully Argued to the Delaware Court that Egnyte Was Not an RPI To Avoid a Stay Pending IPR.

PO now raises the pretext that it seeks these materials to support an argument in the Delaware court that Egnyte is an RPI subject to estoppel under 35 U.S.C. § 315 despite PO's prior representations and successful argument to the contrary to avoid a stay in Delaware. Indeed, PO's motion here is conspicuously devoid of any proof that PO has argued to the Delaware court that Egnyte is an RPI subject to estoppel. On the contrary, PO successfully argued the opposite position to the Delaware court. After these IPRs were filed, Egnyte on January 26, 2023 moved to stay its district court case pending IPR. At the motion hearing on March 6, 2023, PO's primary argument that defeated Egnyte's motion to stay was that Egnyte is not an RPI/privy that is subject to IPR estoppel and "refuses to be bound" by IPR estoppel. Ex. 2001, 36:21-37:11. The district court expressly relied on this absence of IPR estoppel in denying Egnyte's motion to stay. *Id.*, 50:12-51:4. Indeed, the Board may apply judicial estoppel to bind PO to its prior successful position. *See* Paper 10 at 6.

D. PO Could Seek Discovery Directly from Egnyte, the Defendant in Delaware, But PO's Position in Delaware Foreclosed Relevance.

PO proclaims that it seeks "information on Heidi Keefe's representation of Egnyte for use in the Delaware case" (Mot. at 4) but makes no effort to show that it has sought such information from Egnyte, the defendant in Delaware. Petitioners and their counsel are not parties to the Delaware case and are not relevant witnesses

on any claim or defense in that case. As such, after PO served subpoenas to Petitioners and their counsel (Mot. at 4), the subpoena recipients served meritorious objections to PO's improper and harassing discovery requests. PO incorrectly asserts that Dropbox did not yet respond to PO's subpoena, but Dropbox served objections to that subpoena in November 2023. Ex. 1048.

For convenient reference, the following chart summarizes relevant dates.

Date	Event	Venue
January 4, 2023	IPR petition filed	PTAB
January 26, 2023	Egnyte files motion to stay Delaware case	D. Del.
March 6, 2023	PO persuades Delaware court to deny motion to stay on the basis that Egnyte will not be bound by estoppel	D. Del.
May 9, 2023	PO files POPR speculating that Egnyte is an RPI	PTAB
June 8, 2023	Petitioners file Keefe Declaration and Unopposed Motion to Seal and for Entry of Agreed Protective Order to rebut PO's RPI speculation	PTAB
June 20, 2023	Deposition of Ms. Keefe	PTAB
August 4, 2023	Decision granting institution of IPR	PTAB
August 8, 2023	PO advises Petitioners that PO seeks to use sealed testimony of Ms. Keefe in Delaware litigation solely "to show that Ms. Keefe has waived Egnyte's joint defense privilege"	PTAB
March 6, 2024	PO requests conference call to seek leave to file motion to modify protective order	PTAB

III. THE BOARD SHOULD DENY PO'S MOTION.

PO fails to carry its burden to demonstrate "good cause" to modify the Protective Order to permit use of the confidential sealed materials in the Delaware litigation. 37 C.F.R. § 42.54. Whether under the factors applied by courts or under any other reasonable standard, PO fails to prove good cause to grant its motion.

A. PO's Motion Should Be Denied Because PO Fails to Demonstrate Relevance of the Materials to the Delaware Egnyte Litigation.

The Board should deny PO's motion because PO fails to demonstrate any specific relevance of these materials to the Delaware litigation. *See*, *e.g.*, *Blum v. Merrill Lynch Pierce Fenner & Smith Inc.*, 712 F.3d 1349, 1354-55 (9th Cir. 2013) (cited at Mot. at 5) (before modifying a protective order "the collateral litigant must demonstrate the relevance of the protected discovery to the collateral proceedings and its general discoverability therein") (citation omitted). When PO originally raised this request to Petitioners, the only reason PO stated to seek these materials was to argue a waiver of privilege. Ex. 1047. PO admits it still plans to rely on the materials to argue privilege waiver. Mot. at 8. PO now alleges that its "one single" purpose for its motion is to adduce discovery on "Egnyte's RPI/privy status" in the Delaware case. *Id.* at 7. But there is no evidence that PO has stated to the Delaware court that PO contends Egnyte is an RPI barred by IPR estoppel. On the contrary, to avoid a stay of litigation, PO persuaded the Delaware court that Egnyte is <u>not</u> bound by IPR estoppel. Ex. 2001, 36:21-37:11, 50:12-51:4. As such, the Board

should give no credence to PO's unsupported claim about PO's intended use of these materials. Because the record does not support PO's alleged "one single" purpose for PO's motion (Mot. at 7), PO's motion should be denied on this basis alone.

Furthermore, even if it were shown that PO were advancing a claim in the Delaware case that Egnyte is an RPI bound by IPR estoppel (which PO has not shown), PO fails to demonstrate that the specific portions of confidential discovery material it seeks to disclose from this proceeding have any relevance to support such a claim. As the Board already determined at institution based on a review of this same testimony by Ms. Keefe, nothing in that testimony supports a finding that Egnyte is an RPI that was involved in filing these IPRs. *See* Paper 17 at 9-12.

B. PO's Motion Should Be Denied Because PO Seeks to Use the Sealed Information for an Improper Purpose.

The Board should deny PO's motion for the additional reason that PO improperly seeks to use the information for the improper purpose of attempting to invade attorney-client and joint defense privileges. *Cf.* Mot. at 5 (addressing whether information is sought "for a legitimate purpose or an improper purpose") (citation omitted). This consideration weighs heavily against PO's motion. PO's sole stated reason for originally seeking these materials was to argue a privilege waiver. Ex. 1047. PO admits that it still plans to rely on the materials to argue a waiver of privilege. Mot. at 8. But attempting to invade attorney-client and joint-defense privileges is not an appropriate and legitimate purpose to negate the agreed-

upon terms of the Protective Order that Petitioners and Ms. Keefe relied upon. PO does not cite any authority supporting use of sealed confidential materials from a PTAB proceeding for the purpose of attempting to invade privilege in a district court litigation.

C. PO's Motion Should Be Denied Because the Protective Order Terms Were Agreed and Do Not Permit Use Outside These IPRs.

PO's motion should be denied for the additional reasons that (1) the Protective Order and motions to seal were agreed and consented without any provision permitting modification for use of materials in unrelated litigation, and (2) PO could have foreseen any desire to use the materials in its pending Delaware litigation but did not propose or negotiate any provision that would permit such usage.

It is well-settled that if a protective order "was stipulated to by the Parties, this will weigh against its modification." *U.S. v. Akula*, No. 21-98, 2023 WL 4037789, at *2 (E.D. La. May 24, 2023) (citation omitted); *Murata Mfg. Co. v. Bel Fuse, Inc.*, 234 F.R.D. 175, 179 (N.D. Ill. 2006) (protective orders are "more difficult to modify or vacate when the parties have stipulated to them") (citation omitted). The Protective Order terms here were fully agreed and do not contain any provision that would permit any party to seek to use protected materials outside of this proceeding.

Furthermore, as PO acknowledges, courts consider "the foreseeability, at the time of issuance of the order, of the modification requested." Mot. at 5 (citing cases). "[I]n looking at foreseeability, a party's oversight in not negotiating a provision in a

protective order considering a matter which should have been reasonably foreseeable at the time of the agreement has been held not to constitute good cause for relief from the protective order." *Akula*, 2023 WL 4037789, at *2 (quoting *Murata*, 234 F.R.D. at 180) (internal quotations omitted). Here, at the time the agreed Protective Order was entered in June 2023, PO had already raised its RPI speculation in its May 2023 POPRs and had already successfully persuaded the Delaware court in March 2023 that Egnyte was not an RPI bound by estoppel. PO does not argue that anything relevant has changed since that time. PO's current position was equally foreseeable to PO at that time. Thus, if PO wanted to reserve the right to seek to modify the Protective Order to use confidential materials from this proceeding in the Delaware litigation, it could have and should have negotiated a provision contemplating such usage—in which case Petitioners would have been on notice to proceed accordingly in limiting the confidential and sensitive information provided under the Protective Order. Fundamental fairness and the interests of justice compel denying PO's motion. *Akula*, 2023 WL 4037789, at *2.

D. PO's Motion Should Be Denied Because Petitioners Materially Relied Upon the Agreed Protective Order Terms.

As a further reason to deny PO's motion, in agreeing to disclose confidential and sensitive information in this proceeding, Petitioners relied upon the protections of the Protective Order that prohibit any use outside this proceeding of protected materials. *Cf.* Mot. at 5 (considering reliance on protective order).

All of these issues were caused by PO's speculation in its POPRs that Egnyte might have been involved with these IPRs, in part because Ms. Keefe argued one motion hearing for Egnyte in the Delaware case. To rebut PO's speculative assertions about the scope of Ms. Keefe's representation of Egnyte, Petitioners had no choice but to explain that Ms. Keefe's representation of Egnyte was limited to that one hearing and Egnyte has not been involved in these IPRs. Ex. 1029.

The agreed Protective Order was entered to protect the confidential contents of Ms. Keefe's declaration. Similarly, when PO questioned Ms. Keefe at deposition, answers were provided about sensitive attorney-client relationships and joint-defense communications—answers that would not have been provided without the agreed Protective Order. *See* Ex. 2018, 52:4-12, 57:22-59:1, 61:6-62:2, 62:19-63:22, 64:7-67:16, 68:1-13, 68:24-73:13, 76:15-77:3, 105:1-106:1, 139:15-140:18, 144:3-146:24, 146:25-147:4, 160:9-19, 162:20-163:9. PO consented to the filing under seal of the deposition transcript (Ex. 2018) with no objection.

Under these circumstances, it would be highly inequitable and unjust to permit PO to pull the rug out from under Petitioners after they relied upon the agreed Protective Order and consented under-seal filings—all of which was necessitated by PO's baseless speculation that Egnyte was an RPI to these IPRs.

IV. CONCLUSION

For the reasons stated herein, the Board should deny PO's motion.

Dated: April 5, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. §42.6, that a complete copy of the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO MODIFY THE PROTECTIVE ORDER** and related documents are being served via electronic mail on the 5th day of April 2024, upon Patent Owner by serving its counsel of record below via email to:

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