

**Box, Inc. and Dropbox,
Inc.,
v.
Topia Technology, Inc.,
Patent Owner**

IPR2023-00427 & IPR2023-00433

Patent Owner's Demonstratives (Grounds 1 & 2)

May 22, 2024 Oral Hearing

Syllabus

I. Overview of Patents

II. Common Issues

III. Ground 1:

- Obviousness of Challenged Claims over Sigurdsson in Combination with Shappel
 - Challenged Claims:
 - '561 Patent: claims 1, 3, 4, 8, 10 and 11
 - '942 Patent: claims 1, 3, 4, 10, 12 and 13
 - References:
 - U.S. Patent Application Publication No. 2007/0174246 to Sigurdsson
 - U.S. Patent Application Publication No. 2005/0091289 to Shappel

IV. Ground 2:

- Obviousness of Challenged Claims over Brown in Combination with Hesselink
 - Challenged Claims:
 - '561 Patent: claims 1, 3, 4, 8, 10 and 11
 - '942 Patent: claims 1, 3, 4, 10, 12 and 13
 - References:
 - U.S. Patent No. 7,035,847 to Brown
 - U.S. Patent Application Publication No. 2005/0120082 to Hesselink

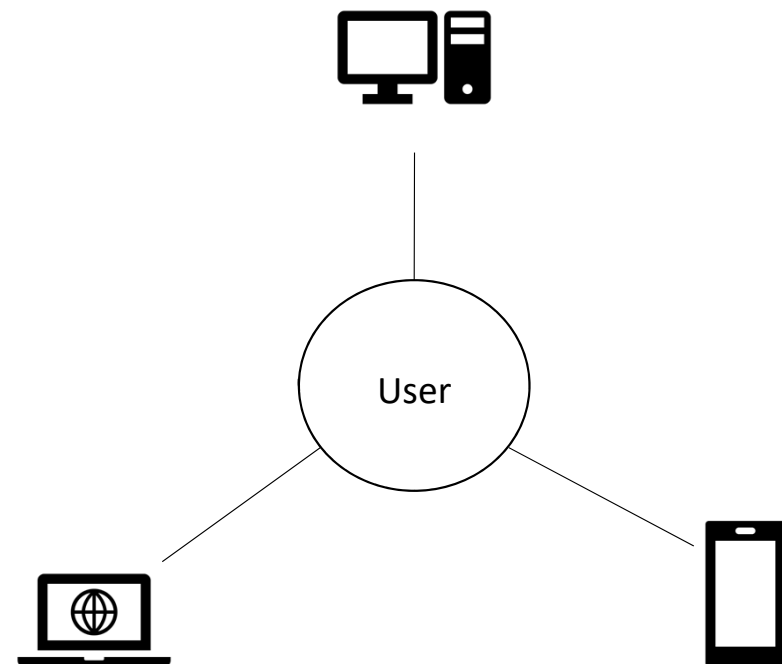
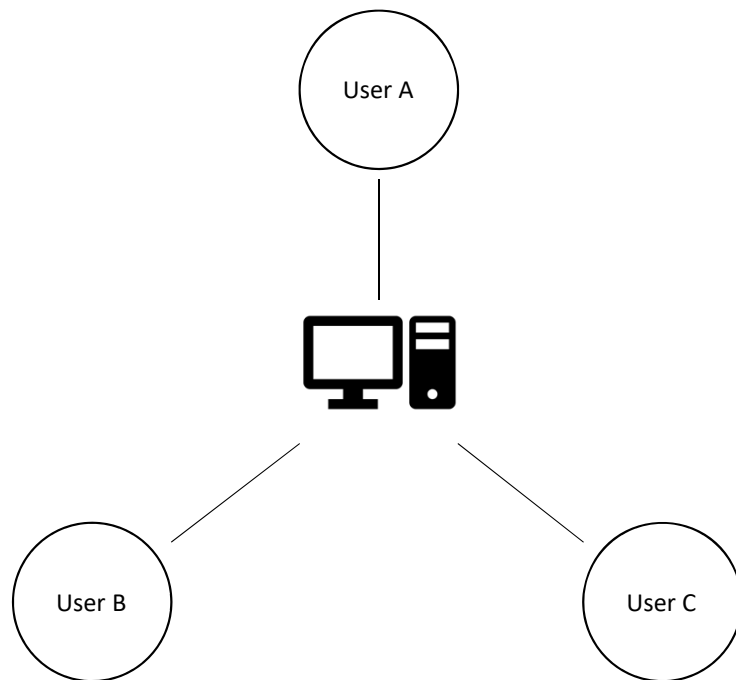
* Citations to the record are made to papers in IPR2023-00427 for U.S. Patent No. 9,143,561 ("the '561 Patent") unless otherwise indicated.

Computer Environment 15 Years Ago Versus Now

In the 2007-2008 timeframe:

- Recent proliferation of a user's electronic devices. (EX1001, 1:25-30)
- File management not integrated with applications. (EX1001, 2:4-7)
- Applications at the time were written to access files locally stored. (EX1001, 2:46-48)
- Mobile networks often slow or unstable leading to intermittent or no access to remotely stored files or long latency in accessing file. (EX1001, 3:20-25, 8:60-65)
- Prevalent electronic devices at the time, such as 3Com Palm® devices or Blackberry® devices synchronized by placing the device in a cradle connected to a personal computer. (EX1007, 158; see EP Patent No. 1130511, ¶[0005], cited in '561 Patent, Final Office Action dated Dec. 3, 2013)

User-Centric Architecture



EX2013, ¶128

User-Centric Architecture

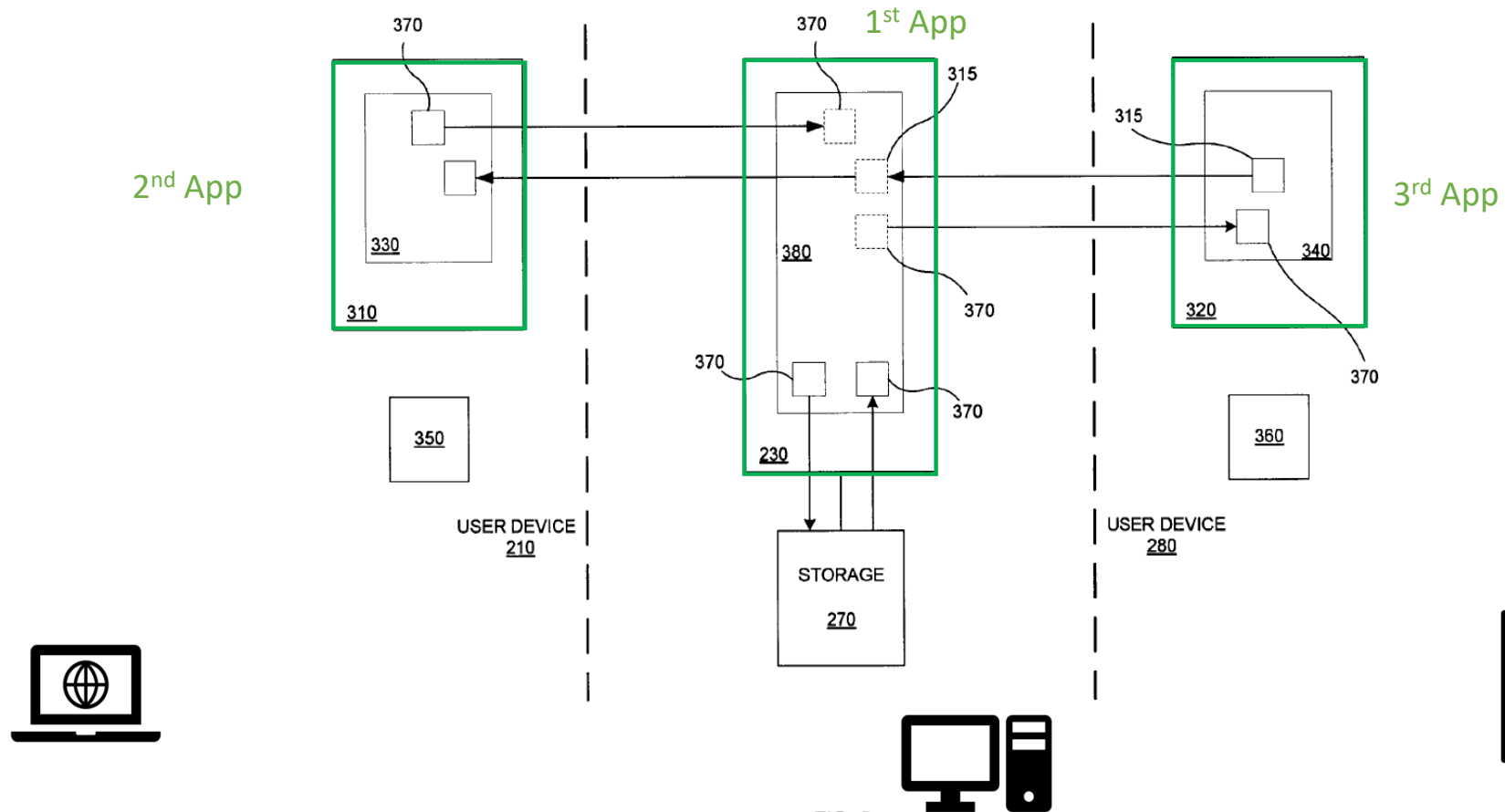


FIG. 3

EX1001

Computer Network Architecture Transferring Modified Files

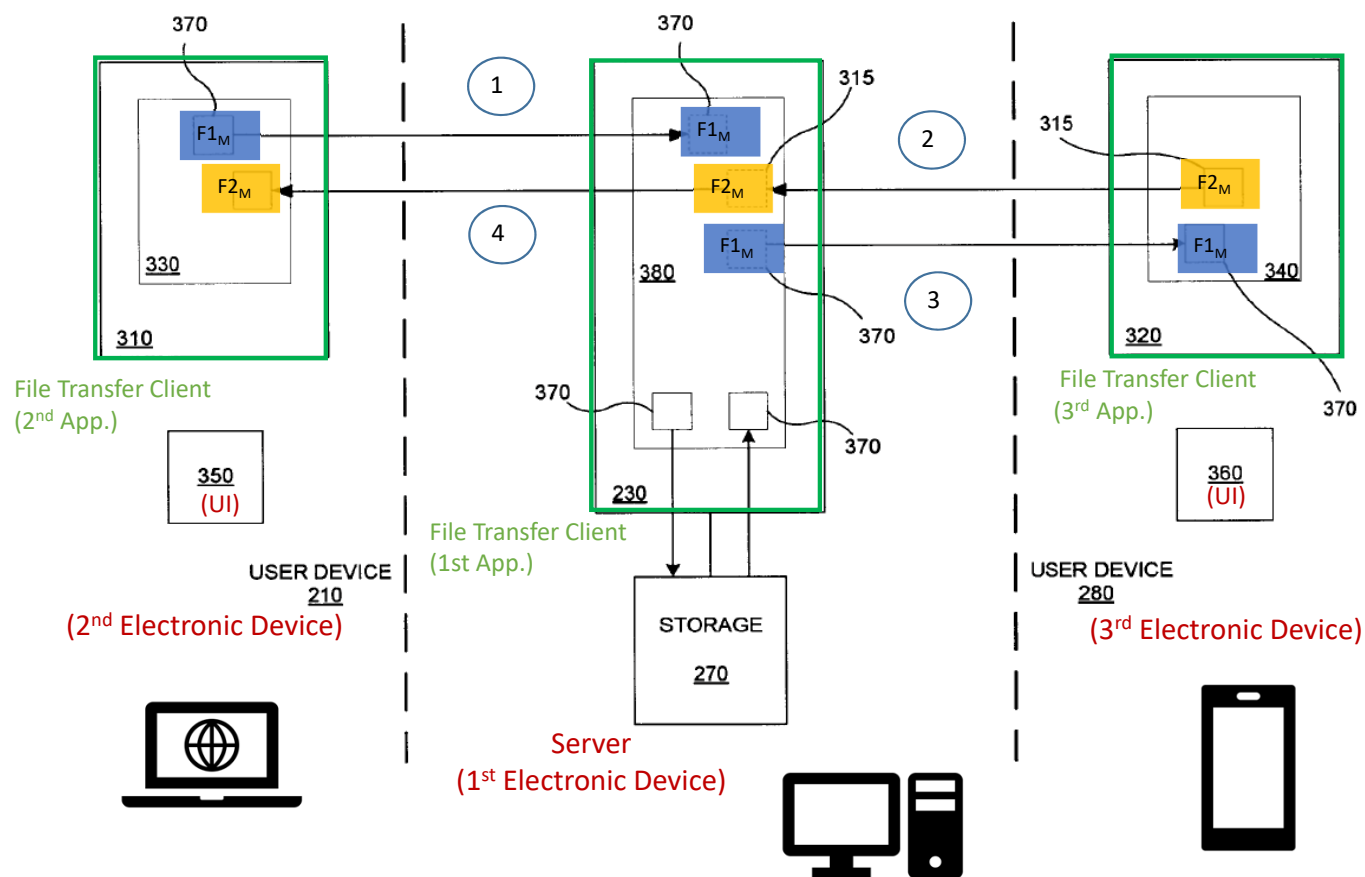


FIG. 3

EX1001

Claim 1 of '561 Patent

1. A system, comprising:

a first electronic device (**server**) configured to selectively execute a first application (230), the first electronic device (**server**) being in communication with a second electronic device (**user device 210**) and a third electronic device (**user device 280**), each associated with user wherein the first electronic device (**server**) is configured to:

- 1 receive from a second application (310) executable on the second electronic device (**user device 210**) a copy of a first electronic file (F1_M 370) automatically transferred from the second application (310) when the user modifies a content of the first electronic file; and
- 2 wherein the first electronic device (**server**) is further configured to receive from a third application (320) executable on the third electronic device (**user device 280**) a copy of a second electronic file (F2_M 315) automatically transferred from the third application (320) when the user modifies a content of the second electronic file; and

- 3 wherein the first application (230) is further configured to automatically transfer the modified first electronic file copy (F1_M 370) to the third electronic device (**user device 280**) to replace an older version of the first electronic file stored on the third electronic device (**user device 280**) with the modified first electronic file copy (F1_M 370) having the content modified by the user; and

- 4 automatically transfer the modified second electronic file copy (F2_M 315) to the second electronic device (**user device 210**) to replace an older version of the second electronic file stored on the second electronic device (**user device 210**) with the modified second electronic file (F2_M 315) copy having the content modified by the user;

wherein the second application (310) automatically transfers the copy of the modified first electronic file (F1_M 370) to the first electronic device (**server**) upon determining that a save operation has been performed on the modified first electronic file (F1_M 370).

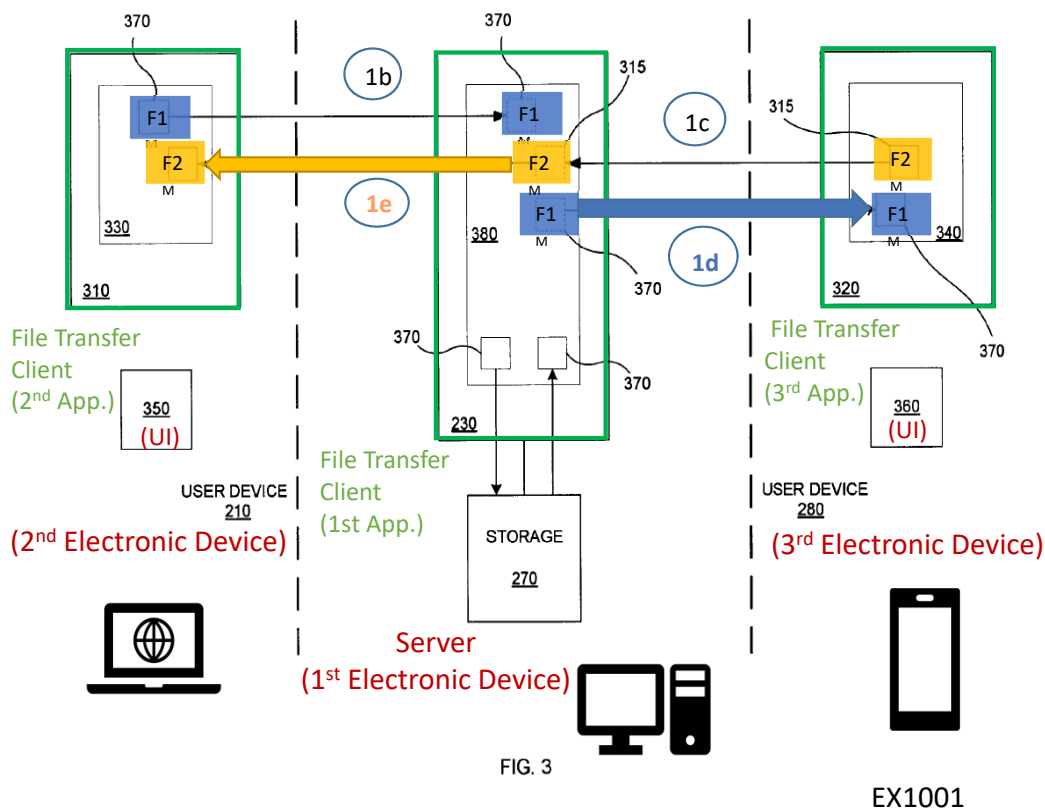


FIG. 3

EX1001

- Claim 1:
- [1pre] A system, comprising:
- [1a] a first electronic device configured to selectively execute a first application, the first electronic device being in communication with a second electronic device and a third electronic device, each associated with a user wherein the first electronic device is configured to:
- [1b] receive from a second application executable on the second electronic device a copy of a first electronic file automatically transferred from the second application when the user modifies a content of the first electronic file; and
- [1c] wherein the first electronic device is further configured to receive from a third application executable on the third electronic device a copy of a second electronic file automatically transferred from the third application when the user modifies a content of the second electronic file; and
- [1d] wherein the first application is further configured to automatically transfer the modified first electronic file copy to the third electronic device to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user; and
- [1e] automatically transfer the modified second electronic file copy to the second electronic device to replace an older version of the second electronic file stored on the second electronic device with the modified second electronic file copy having the content modified by the user;
- [1f] wherein the second application automatically transfers the copy of the modified first electronic file to the first electronic device upon determining that a save operation has been performed on the modified first electronic file.

Issues Common with Grounds 1 and 2

- Petitioners did not raise claim construction of any term in their Petitions.
 - "Petitioners do not believe express claim construction is presently necessary." (Pet., 7)
- The Board acknowledged, in its Decision on Institution, that no term needed claim construction.
 - "Neither party proposes claim constructions for our consideration." (DI, 24)
- In the Reply, Petitioners' propose a claim construction for the first time for the term "automatically":
 - Petitioners argue that "the patent uses the term 'automatically' with its plain and ordinary meaning to indicate that files are transferred 'automatically' by a system as opposed to being transferred 'manually' by a human user from one device to another." (Rep., 5)
 - This newly proposed construction is contrary to the plain and ordinary meaning in the clear context of the claim language. (POSR, 7-9)

Plain and Ordinary Meaning within the Context of the Claim

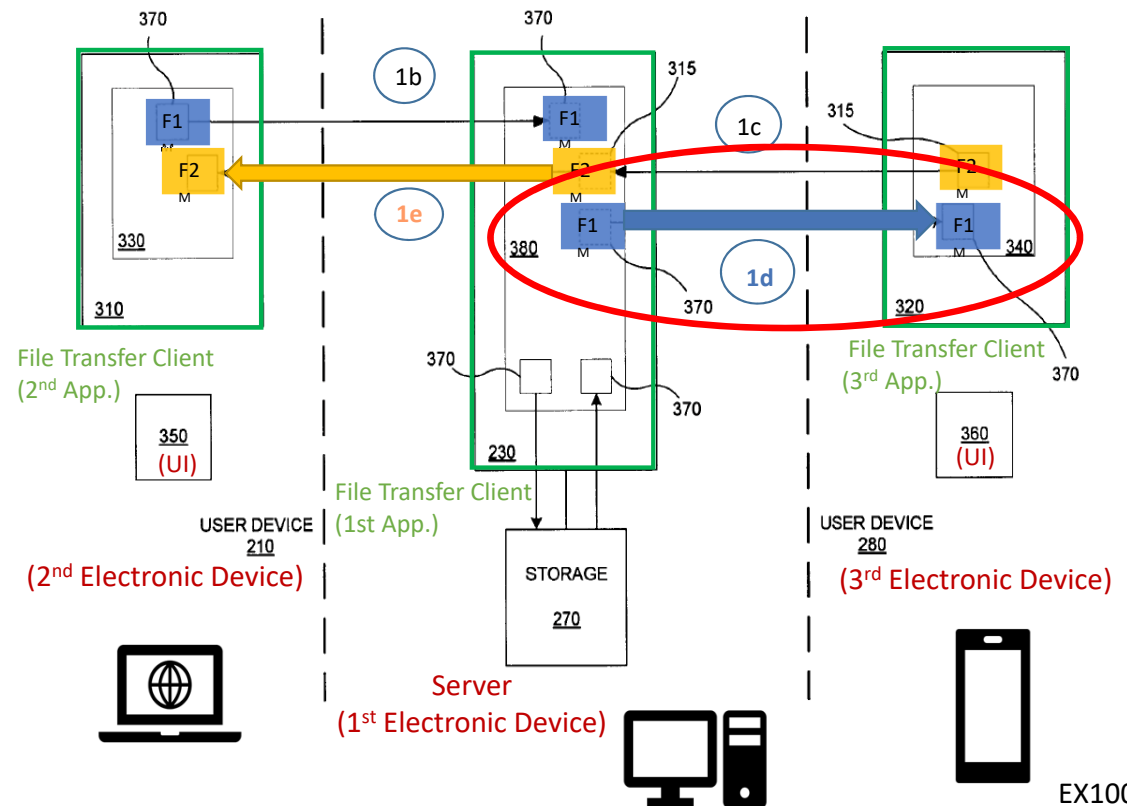
- Nothing in the intrinsic evidence compels construing “**automatically**” beyond its plain and ordinary meaning **within the context of the claim**.
 - "... the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of [the] terms." *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003).
 - “It is highly disfavored to construe terms in a way that renders them void, meaningless, or superfluous.” *Wasica Fin. GmbH v. Cont’l Automotive Systems, Inc.*, 853 F.3d 1272, 1288 n.10 (Fed. Cir. 2017).
 - "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." *Rovi Guides, Inc. v. Vidal*, No. 2020-1994, 2022 U.S. App. LEXIS 10465 (Fed. Cir. Apr. 19, 2022).

(POSR, 7-8)

Plain and Ordinary Meaning within the Context of the Claim

- The First Application “Automatically Transferring” to the Third Electronic Device (POSR, 7-8)

[1d] wherein the first application is further configured to automatically transfer the modified first electronic file copy to the third electronic device to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user.



Plain and Ordinary Meaning within the Context of the Claim

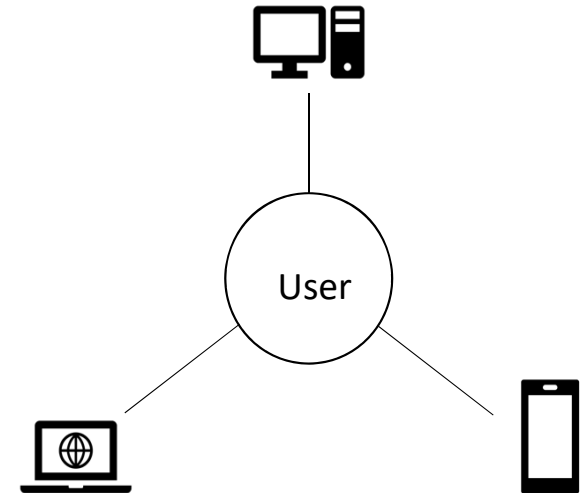
- The term "automatically transfer" means that the first application transfers a modified file to the third electronic device without the third electronic device requesting the modified file. (POSR, 9)
 - "The 'automatic transfer' feature of the asserted claims should not be considered in isolation but must be considered in connection with the specific arrangement of first, second and third applications running on three different electronic devices, including the server between the multiple devices to be synchronized. It is the use of these application programs and their arrangement that made possible the "automatic transfer" to another device (i.e., without the another device requesting it) associated with the same user." – Dr. Shenoy (EX2025, ¶ 117; see also ¶ 214)
 - "The focus of the '561 Patent is to provide a user-centric computer network architecture for file synchronization, where a server automatically receives a modified file from one device associated with a user when the user modifies the file and the server automatically transfers it (i.e., without a request from the client for the modified file). – Dr. Shenoy (EX2025, ¶ 94)
 - In FIG. 3 of the '561 Patent, 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. (POSR, 9)

Petitioners' Construction Makes “Automatically” Superfluous

- Claim language expressly recites the applications/electronic devices that are transferring and receiving the files (POSR., 8-9)
 - [1b] receive from a second application executable on the second electronic device a copy of a first electronic file **automatically transferred from the second application** when the user modifies a content of the first electronic file;
 - [1c] wherein the first electronic device is further configured to receive from a third application executable on the third electronic device a copy of a second electronic file **automatically transferred from the third application** when the user modifies a content of the second electronic file;
 - [1d] wherein **the first application is further configured to automatically transfer** the modified first electronic file copy to the third electronic device to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user; and
 - [1e] **automatically transfer** the modified second electronic file copy to the second electronic device to replace an older version of the second electronic file stored on the second electronic device with the modified second electronic file copy having the content modified by the user;
 - [1f] wherein **the second application automatically transfers** the copy of the modified first electronic file to the first electronic device upon determining that a save operation has been performed on the modified first electronic file.

Petitioners Confound User-Centric

- Petitioners mischaracterize PO's statement that the patent "provides a user centric computer network architecture for file synchronization." (Rep., 6).
- "User centric" explains the goal of the system, but does not limit the actual claim language. (POSR, 9-10).
 - "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."
 - Dr. Shenoy (EX2045, 28:15-22).
 - "These server-centric improvements for providing the most current version of a file to a user still had problems. Id., 1:40-61. These problems frustrated the **goal of providing customers with a seamless environment in which a user could use any one of a variety of the user's electronic devices to access the most current version of the user's file.** Id.
 - Dr. Shenoy (EX2013, ¶28).



Plain and Ordinary Meaning

- Petitioners mischaracterize PO's position on the plain and ordinary meaning as requiring "prohibit any intervening steps" and (Rep., 6)
- Term “automatically” within the context of the claim does not “prohibit any intervening steps” (EX1001 8:32-46; POSR, 9-10)
 - The issue is not whether the claim prohibits intervening steps. (POSR, 9-10)
 - Instead, the issue is 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. (POSR, 9-10)
- 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 (POSR, 11).
- Claim 4: The system of claim 3, wherein the first application is configured 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.

Issues Common with '561 Patent & '942 Patent

'561 patent:

wherein the first application is further configured to **automatically transfer the modified first electronic file copy to the third electronic device** to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user.

Element [1d]

'942 patent:

automatically send, via the first application, the modified first electronic file copy to a third application at the third electronic device responsive to the determination that the first electronic device is in communication with the third electronic device and **responsive to receiving the modified first electronic file copy from the second electronic device.**

Element [1d]

Ground 1: The Asserted Combination

- Petitioners rely on Sigurdsson for disclosing all the elements of the challenged claims of the '561 Patent, except for:
 - **"to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user."** See element [1d].
 - **"to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user."** See element [1e].

(Pet. 14-22, 31-34)
- Petitioners rely on Shappel for supplying this limitation missing from Sigurdsson. (Pet. 26-31)
- Petitioners rely on arguments from claims 1, 3, and 4 for claims 8, 10 and 11. (Pet. 35-38)

Ground 1: The Institution Decision

- Claim element [1d]:

wherein **the first application is further configured to automatically transfer the modified first electronic file copy to the third electronic device** to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user;

- The Petitioners rely of FIG. 6 and paras. 66-80 of Sigurdsson for disclosing that "the '**first application**' (Synchronization Manager 332) is configured to '**automatically transfer the modified first electronic file copy**' (updated copy of the modified maintenance manual) to a '**third electronic device**' (Client C). (Balakrishnan, ¶¶520-533.)" (Pet. 23-26, emphasis in original)
- The Board, in agreeing with Petitioners, rests its position on Sigurdsson teaching automatically transferring a modified file based on an alternative embodiment in step 606. But Sigurdsson does not describe how this alternative embodiment accomplishes the transfer. (DI 33-37, citing Prelim. Resp. 35-47)

Ground 1: Prior Art References Must be Considered as a Whole

- The teachings of a prior art references must be considered as a whole. It is error to "stitch together an obviousness finding from discrete portions of prior art references without considering the references as a whole." *In re Enhanced Security Research, LLC*, 739 F.3d 1347, 1355 (Fed. Cir. 2014).
- "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238 (CCPA 1965).

Ground 1: Sigurdsson as a Whole

- When the teachings of Sigurdsson are considered as a whole, a POSA would understand that the statement in Sigurdsson paras. 68 and 80, regarding the alternative embodiment, merely refers to **what** the "server" does – the "server" transmits content to client peers. But paras. 68 and 80 do not teach or suggest **how** the server transfers the updated file to the third electronic device. (POR, 15-16)

[0068] An alternative embodiment of step 606 bypasses the second client and sends the data directly to the server, as shown by the dashed line pointing from the step 606 to the step 610. For example, referring to FIG. 4, the Client X Content 410 can be sent directly to the Server 106, thus bypassing the Client B 104. The Server 106 can then transmit the content to the remaining client peers, such as the Clients B and C.

EX1016, ¶ 68

[0080] In step 626, the server sends the missing content to the third client. For example, referring to FIG. 4, the Server 106 sends the Client X Content 410 to the Client C 406.

EX1016, ¶ 80

Ground 1: Sigurdsson as a Whole

- How Sigurdsson transfers the file:
 - FIG. 2: 218, paragraph [0040]
 - FIG. 3: 310, paragraph [0046]
 - FIG. 6: 620, paragraphs [0075] and [0079]
 - FIG. 7: 710, paragraphs [0085] and [0086]
 - FIG. 8: 810, paragraphs [0095] and [0096]

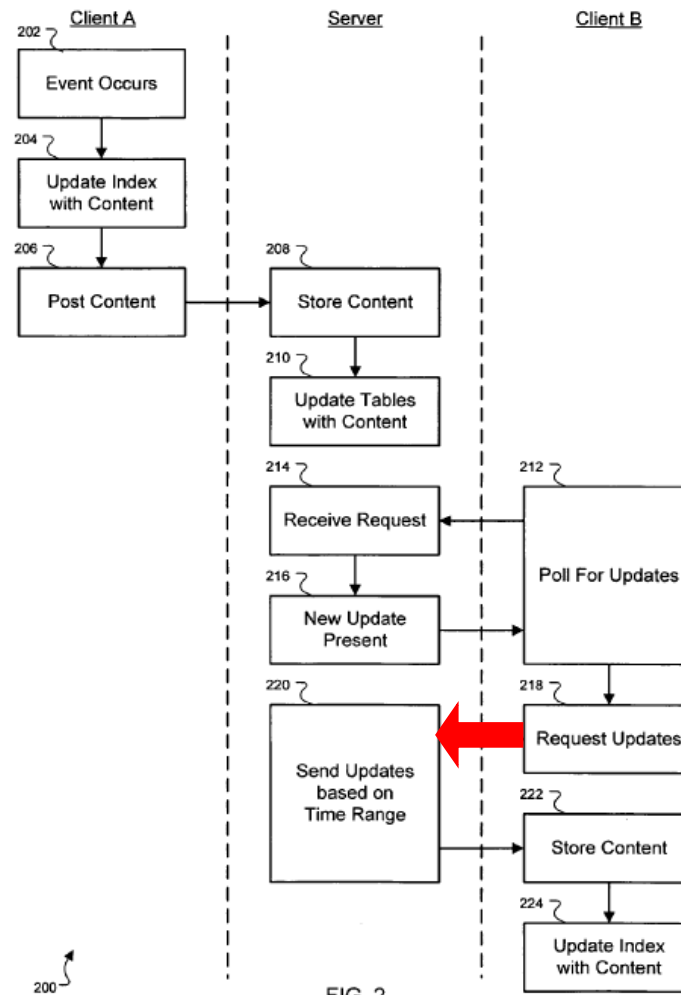


FIG. 2

EX1016

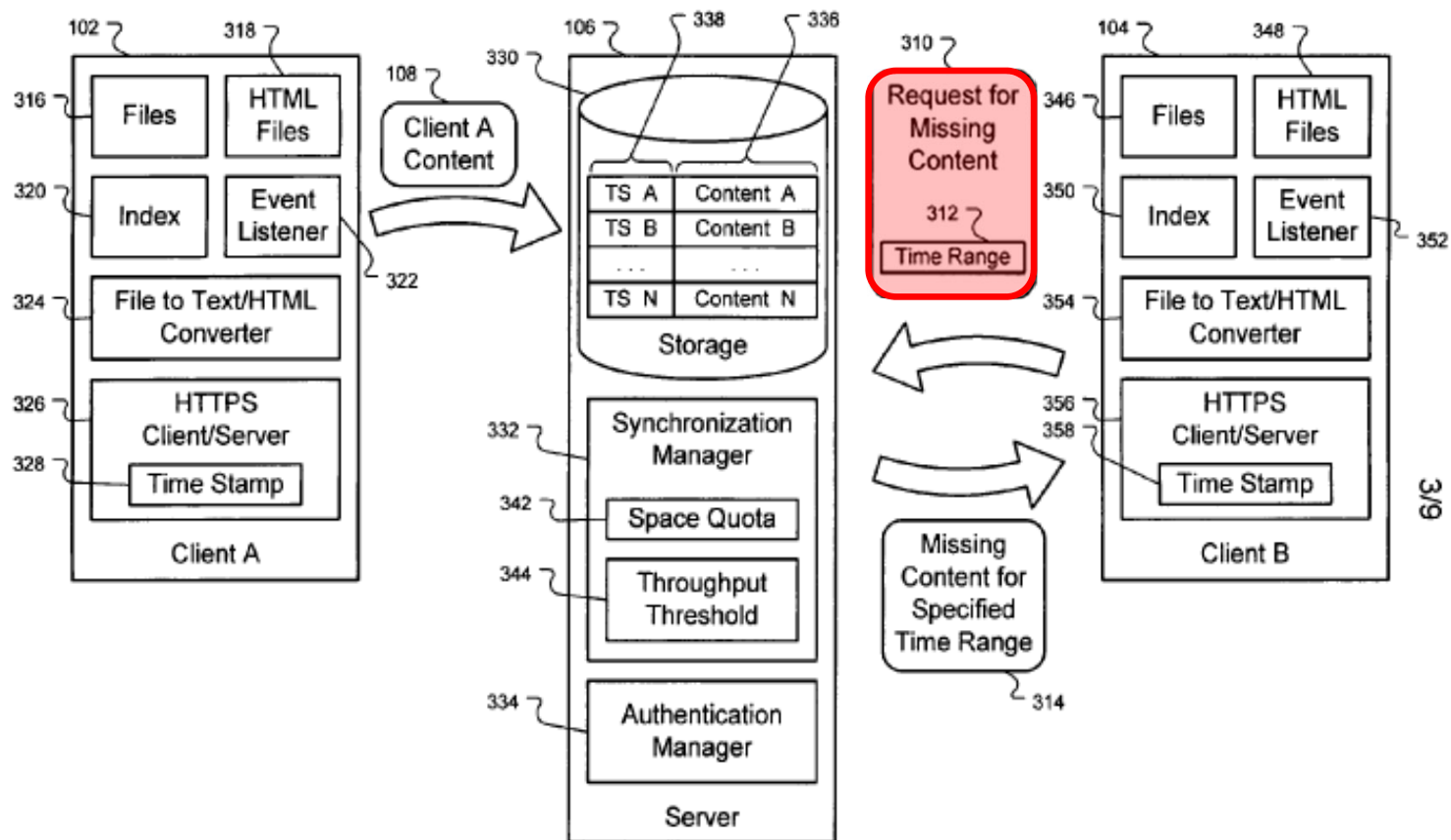
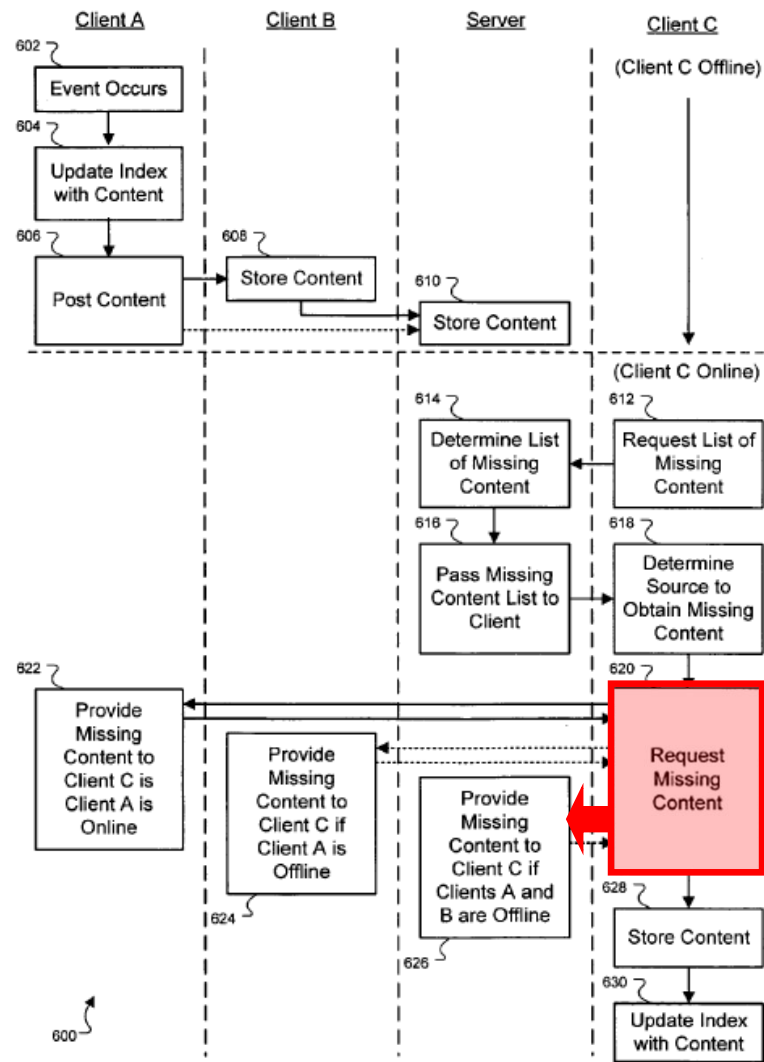


FIG. 3

EX1016



EX1016

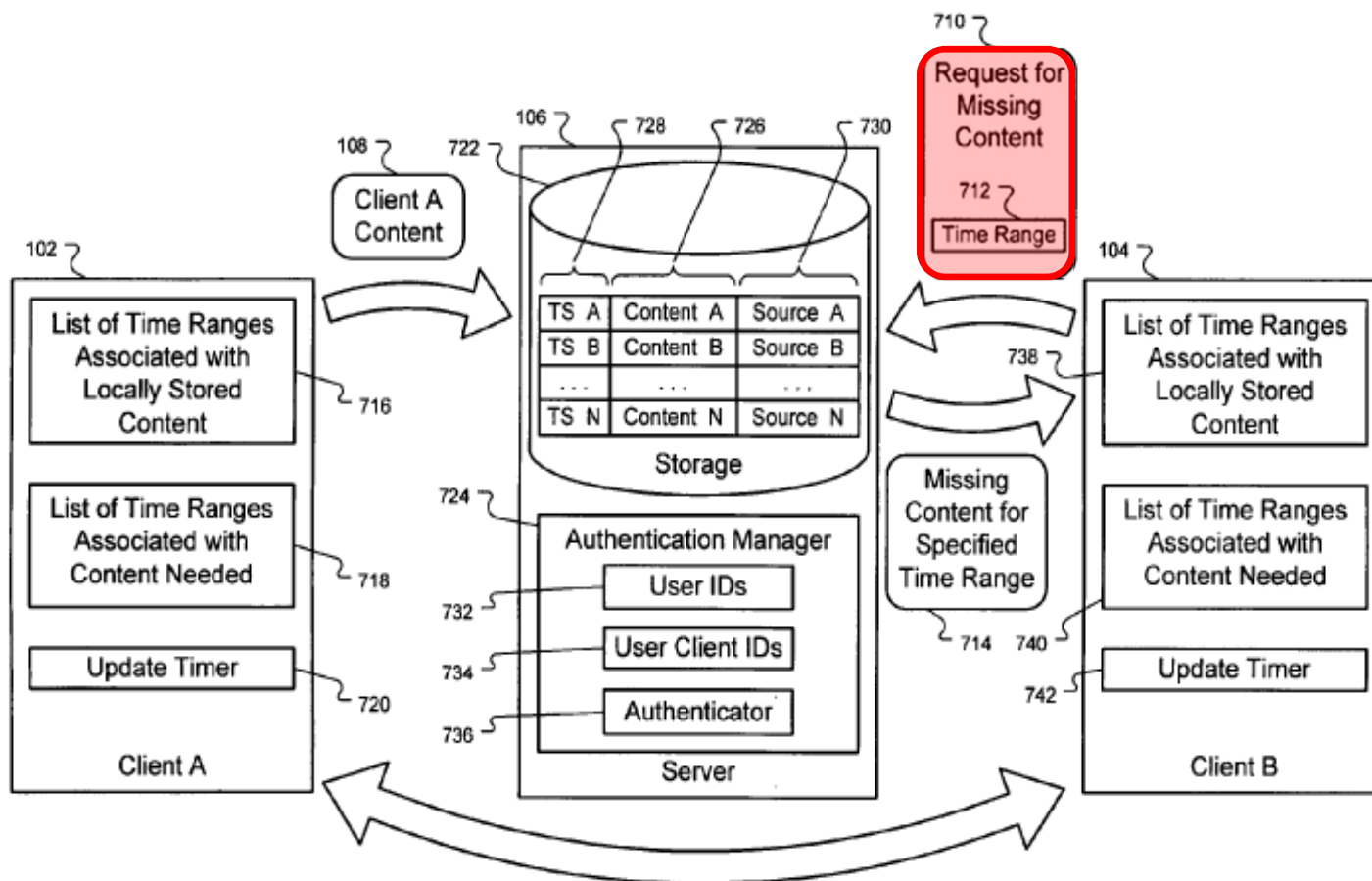


FIG. 7

EX1016

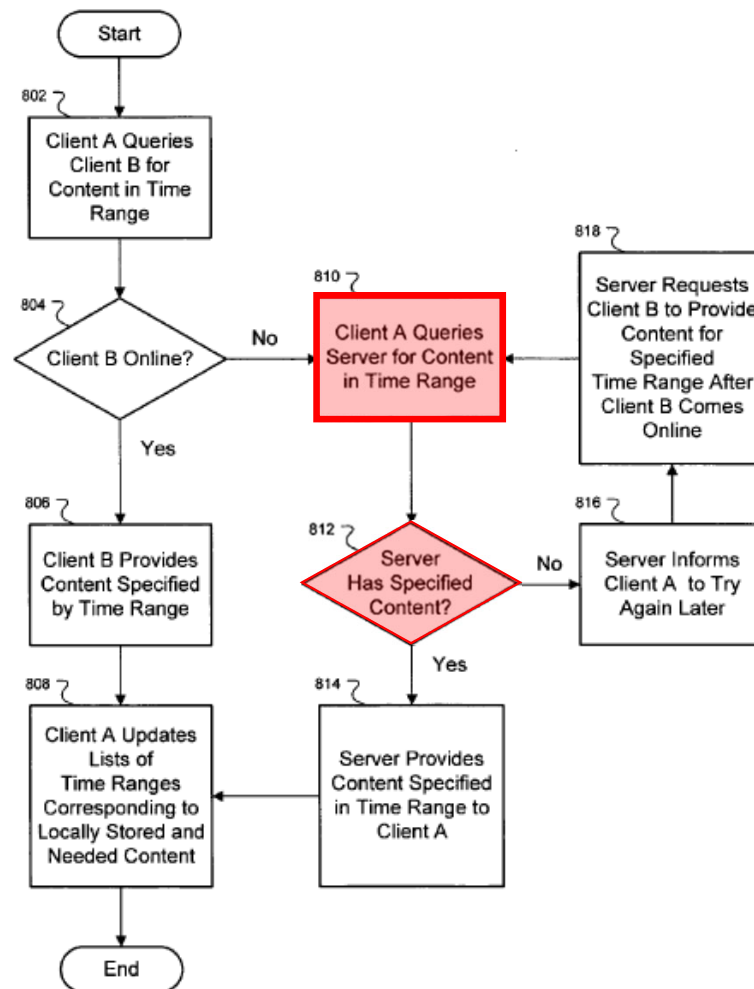


FIG. 8

EX1016

Ground 1: Sigurdsson as a Whole

- How Sigurdsson transfers the file:
- Using a **Request-Response** mechanism
- In every explanation on how the content is transmitted, Sigurdsson repeats that the client device (both while online and returning online) initiates the transfer of the content. (POSR, 14)
 - "Specifically, considering the disclosure of Sigurdsson as a whole, Sigurdsson requires a server to receive a request from a client device before the server transmits missing content to the client device."
 - Dr. Shenoy (EX2025, ¶ 40)

Ground 1: Sigurdsson at Paragraph [0068]

- PO does not dispute whether the server 106 in para. [0068] of Sigurdsson can transmit the content to the remaining client peers. The issue is how Sigurdsson transmits the content. (POSR, 14)
- The crux of Sigurdsson is to enable peer-to-peer content sharing and synchronization using a combination of peer to-peer and “drop box” techniques. (POSR, 16, EX1016, FIG. 4, ¶62)
 - "A POSA would understand that Sigurdsson at ¶ 68 discloses that the alternative embodiment of step 606 is part of the overall sequence for handling synchronization when a client is offline when a transfer of content is to take place. As Sigurdsson explains, with the peer-to-peer and server architecture of Fig. 4 '**[t]he peer-to-peer techniques can be used by clients that are currently online to share the content directly between clients**' and “the server can be used as a drop box for the content until the offline client comes online again.” EX1016, at ¶61.” – Dr. Shenoy (EX2025, ¶ 47)

Ground 1: Sigurdsson at Paragraph [0068]

- Even if a client-server technique is used for clients that already are online, Sigurdsson fails to teach or suggest that Server 106 initiates the transfer of the content to the client devices. (POSR, 16)
 - "The alternate embodiment of step 606 described in ¶68, shown by the dashed line between Client A in step 606 and the Server in step 610, merely concerns how the content can be transferred from Client A directly to the Server without first going through Client B... it in no way teaches or suggests that Server 106 automatically transfers the content to a client." (EX2025, ¶46).
 - As shown in FIG. 2, 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).

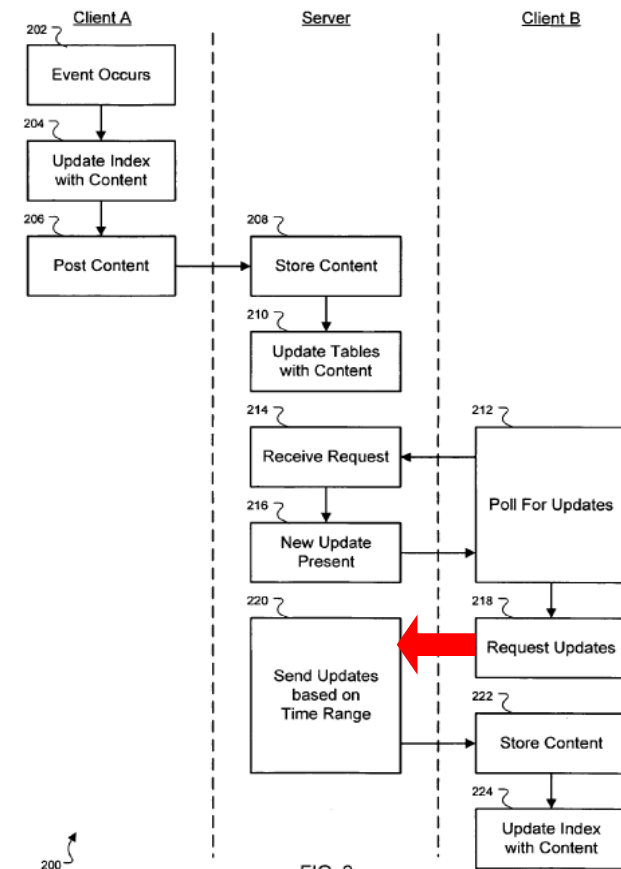


FIG. 2

EX1016

Ground 1: Sigurdsson at Paragraph [0080]

- Improper to consider the statement "the Server 106 sends the Client X Content 410 to Client C 406" in para. [0080] of Sigurdsson in isolation. (POR, 17-18)
 - "Similarly, step 626, discussed in ¶80, also is part of the sequence of Fig. 6 which concerns an offline client coming online. EX1016, at ¶21. Step 626 is performed to "Provide Missing Content to Client C if Clients A and B are Offline." Id., at Fig. 6 Step 626. This concerns when *both* the first and second clients are offline "at the time of the third client's request for missing content." Id., at ¶79. Petitioners and the Board rely on the statement in ¶80 that "the Server 106 sends the Client X Content 410 to Client C 406," for teaching or suggesting that Server 106 automatically transfers the content to Client C. **But this statement cannot be considered in isolation without considering the teachings of the whole reference.**" – Dr. Shenoy (EX2025, ¶ 40)

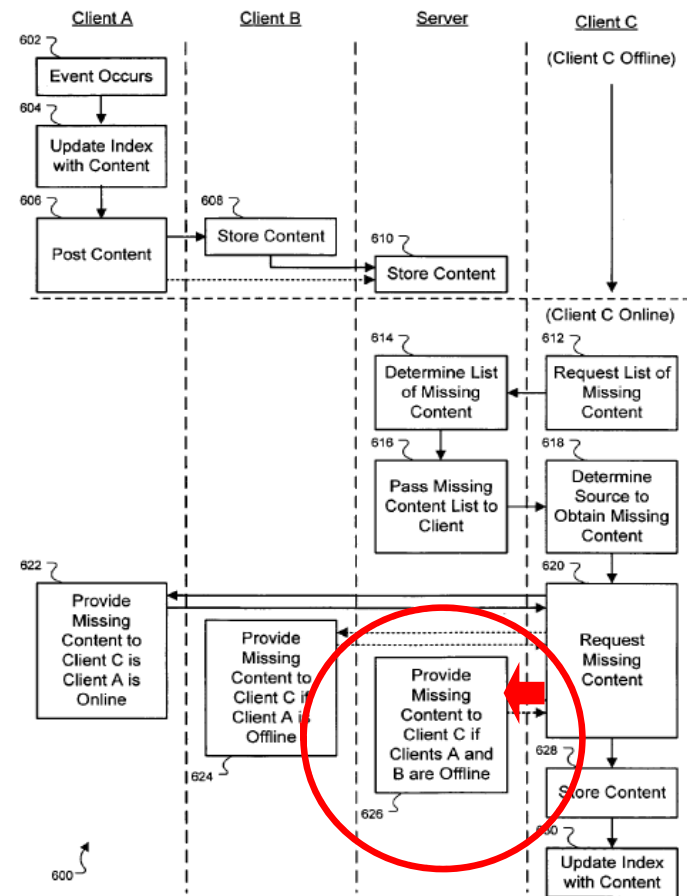


FIG. 6

EX1016

Ground 1: Not Obvious to Combine Sigurdsson with Shappell

- Shappell proposes a system for sharing files of different users in a **server-less** shared space. Abstract. (EX1020, Abstract, ¶¶[0001], [0007], [0046]; EX2025, ¶ 84-85)
- Shappell **teaches away** from using a server. (EX2025, ¶ 84-85)
 - “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path that was taken by the applicant.” *Spectralytics Inc. v. Cordis Corp.*, 649 F.3d 1336, 1343 (Fed. Cir. 2011).
 - A prior art reference must be considered as a whole. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).
- Sigurdsson proposes a system with a client/server mechanism. (EX1016, FIGS. 4, 6); EX2025, ¶ 88-89)
- Not obvious to modify or replace the server/client mechanism of Sigurdsson with a **server-less** shared space of Shappell. – Dr. Shenoy (EX2025, ¶ 88)
 - 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. *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

Ground 1: The Combination Fails to Teach Element [1d]

- Shappel does not disclose that the first application is further configured to **automatically transfer** the modified first electronic file copy to the third electronic device **to replace an older version** of the first electronic file stored on **the third electronic device** with the modified first electronic file copy having the content modified by the user. (POR, 39-42)
- Shappell, when considered as a whole, unambiguously teaches a peer-to-peer system for sharing files **among group members**. (POR, 41)
- Shappell simply does not teach or suggest a server sending the file to a specific device “associated with the user.” (POR, 42, EX2025, 90-93)

Ground 1: The Combination Fails to Teach Similar Claim Elements

- Similarly, the asserted Sigurdsson/Shappel combination also fails to teach all the limitations of claim element [1e]. (POR, 12)
- The asserted Sigurdsson/Shappel combination fails to render claim 8 unpatentable. Elements [8c] and [8d) are not taught for reasons similar to claim 1 elements [1d] and [1e]. (POR, 12)

Ground 1: '942 Patent

- The Sigurdsson/Shappel combination does not render the challenged claims of the '942 patent unpatentable for similar reasons that it does not render the challenged claims of the '561 patent unpatentable.
- The "automatically send" features of '942 patent claim elements [1d] and [1g], and [10c] and [10f], for purposes of this proceeding, are not satisfied for similar reasons that the "automatically transfer" features of '561 claim elements [1d] and [1e], and [8c] and [8d] are not satisfied by the asserted Sigurdsson/Shappel combination.

'942 POR, *passim*
'942 POSR, *passim*

Ground 2

- Obviousness of Challenged Claims over Brown in combination with Hesselink
 - Challenged Claims:
 - '561 Patent: claims 1, 3, 4, 8, 10 and 11
 - '942 Patent: claims 1, 3, 4, 10, 12 and 13
 - References:
 - U.S. Patent No. 7,035,847 to Brown
 - U.S. Patent Application Publication No. 2005/0120082 to Hesselink

'561 Pet. (Paper 3), 5

'942 Pet. (Paper 3), 4

* Citations to the record are made to papers in IPR2023-00427 for U.S. Patent No. 9,143,561 ("the '561 Patent") unless otherwise indicated.

Ground 2: The Asserted Combination

- Petitioner relies on Hesselink to supply features missing in Brown for most of the elements of the challenged claims of the '561 Patent:
 - Elements [1b] and [1c]: Automatically transferring a modified file "**when the user modifies a content of the first electronic file.**" (Pet., 43-45, 52-54)
 - Element [1d]: "**Automatically**" transfer the modified first electronic file copy from the first application to the third electronic device; (Pet. 55) and
Element [1e]: "**Automatically**" transfer the modified second electronic file copy from the first application to the second electronic device. (Pet. 57)
 - Element [1f] : Automatically transferring the copy of the modified first electronic file to the first electronic device "**upon determining that a save operation has been performed on the modified first electronic file.**" (Pet. 58-59)
 - Claim 4 : "**[S]tore 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.**" (Pet. 60-63)
- Petitioner relies on the arguments for claims 1, 3, and 4 to support the challenge to claims 8, 10 and 11. ('561 Pet. 63-64)

Ground 2: Claim 1 Element [1d]

- Claim element [1d]:

wherein **the first application is further configured to automatically transfer the modified first electronic file copy to the third electronic device** to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user;

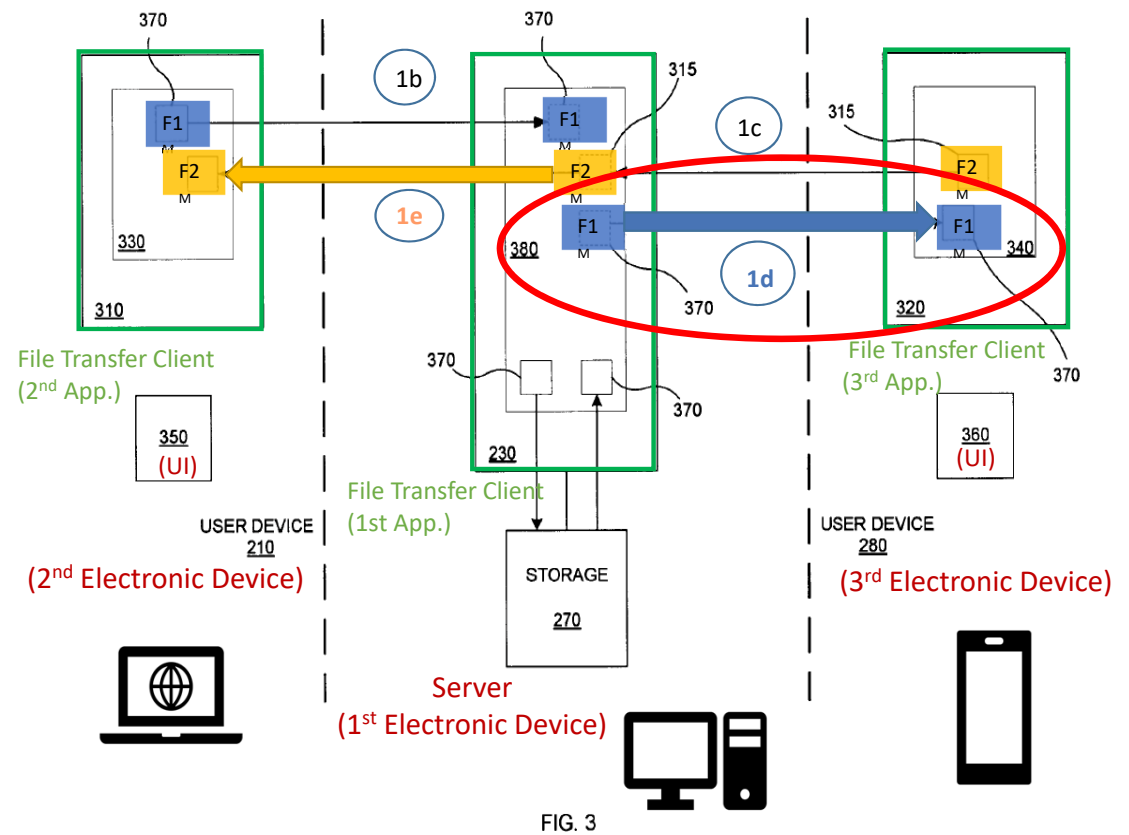


FIG. 3

EX1001

Ground 2: The Institution Decision

- Claim element [1d]:
wherein **the first application is further configured to automatically transfer the modified first electronic file copy to the third electronic device** to replace an older version of the first electronic file stored on the third electronic device with the modified first electronic file copy having the content modified by the user;
- Petitioner relies of Hesselink ¶ [0183] "to automatically forward updated files from server 105 to synchronizing clients as soon as file updates are received at server 105." (Pet., 56)
- The Board disagreed with PO's argument that "[j]ust like in Brown, Hesselink uses a pull mechanism in its file synchronization process," asserting that it is not consistent with the record and citing Hesselink ¶ 183. (DI 43, citing Prelim. Resp. 56-59)

[0183] As noted above, when data is updated, such as when a file is edited, for example, the system may be configured to automatically update all or some designated subset of computers on the network as soon as the update has been performed at one location. Computers that are offline

EX1026, Hesselink ¶ 183

Ground 2: The Combination Fails to Teach Element [1d]

- Petitioners' interpretation of "automatically" ignores the express language of element [1d].
 - The claim element is written **from the perspective of "the first application"** (e.g., the server) as it is "configured to automatically transfer the modified first electronic file copy to the third electronic device." (POR, 45)
 - The correct interpretation is that the first application transfers the modified first electronic file copy to the third electronic device without the third electronic device requesting the modified file. (POSR, 9, citing EX2025 ¶¶94, 105)
- Petitioners agree that the transfer of a modified file from the server to a client, in the asserted combination, begins with the client requesting the modified file.
 - "Thus, it would have been obvious 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. (Brown, 10:18-27; Balakrishnan, ¶898)." (Pet., 55)
- Thus, the combination does not satisfy "the first application ... automatically transfer[ring]" the modified file to the client. (POR, 43)

Ground 2: The Combination Fails to Teach Element [1d]

- Even if Brown were modified based on Hesselink, as asserted in the Petition and in the Institution Decision, the combination would not satisfy element [1d].
 - Hesselink ¶ [0183] is relied on for providing a reason to modify Brown to automatically forward an update as soon as the file updates transfer. (Pet. 56, DI 43)
 - The correct interpretation is that the first application transfers the modified first electronic file copy to the third electronic device **without the third electronic device requesting the modified file**. (POSR, 9, citing EX2025 ¶¶94, 105)
- Petitioners agree that the transfer of a modified file from the server to a client, in the asserted combination, **begins with the client requesting the modified file**.
 - "Thus, it would have been obvious 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. (Brown, 10:18-27; Balakrishnan, ¶ 898)." (Pet., 55)

Ground 2: The Combination Fails to Teach Element [1d]

- Prior Art References Must be Considered as a Whole
 - "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238 (CCPA 1965).
 - The teachings of a prior art references must be considered as a whole. It is error to "stitch together an obviousness finding from discrete portions of prior art references without considering the references as a whole." *In re Enhanced Security Research, LLC*, 739 F.3d 1347, 1355 (Fed. Cir. 2014).

Ground 2: The Combination Fails to Teach Element [1d]

- Petitioners fail to consider the teachings of Brown as a whole as it expressly teaches **minimizing the load on the server**. POSA would not modify Brown to have the server automatically transfer the modified file.

- **As many synchronization operations as possible are performed by the client.** (EX2025, ¶125)

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 message digest computation and comparison, data encryption and decryption, and synchronization itself, are performed by the client SA. Also, the

(EX1025, 3:17-22)

- Brown also aims to **"minimized the amount of data transmitted"** (POR 47-52)

The client/server architecture is also designed to minimize the amount of data transmitted on the wire during the synchronization process. Preferably, only the parts of files that have changed are uploaded or downloaded when synchronizing files. The architecture also includes algorithms to

(EX1025, 3:29-33)

Ground 2: The Combination Fails to Teach Element [1d]

- Brown transfers only changes to a file to **minimize the amount of data transferred**. To determine which portions of the file changed Brown has **the client, not the server**, performs this process which involves performing a hash function. (POR, 44; POSR, 21)

FIG. 6 shows an example hash function used by the client of FIG. 1 to reduce the amount of information transmitted between the client and server, according to an embodiment of the invention. In FIG. 6, hash function 605 is used to
40 calculate the message digests of the MDA. Hash function
(EX1025, 12:37-41)

- Considering Brown as a whole, a POSA would not have changed Brown's client-server arrangement, as Petitioners assert, to have the server push the modified file to the client, since this would fundamentally change the operation of Brown's system. (POSR, 21; EX2025, ¶ 126)
- Petitioners also ignore Brown's teachings concerning transferring only modifications to a file. A POSA would not have modified Brown to transfer an entire modified file instead of transferring only the changes to the file. (POSR, 21, 23)

Ground 2: The Combination Fails to Teach Element [1d]

- Petitioners also fail to consider the teachings of Hesselink as a whole.
 - Hesselink [0183] neither teaches nor suggests that a server is configured to automatically update other computers on the network, only that "**the system**" is configured to do so. (POR 46)

[0183] As noted above, when data is updated, such as when a file is edited, for example, the system may be configured to automatically update all or some designated subset of computers on the network as soon as the update has been performed at one location. Computers that are offline

EX1026, Hesselink ¶ 183

- Petitioners' pick and choose general system-level statements in Hesselink ignoring more specific teachings of the client requesting the modified content from the server. (POR 47-52)
- Hesselink does not discuss a push-based file transfer from a server, it only discusses pull-based synchronization throughout its disclosure, such as in Figs. 4 and 8. (EX2025, 51; POR, 47)

Ground 2: The Combination Fails to Teach Element [1d]

- Petitioners argue that by modifying Brown based on Hesselink ¶ [0183] to "immediately" transfer a modified file from Brown's server to the client, rather than waiting until the client polls for an update, somehow equates to automatically transferring the file. (Rep., 20)
- The challenged claims to not recite "**immediate**" transfer of the modified file, but rather recite the first application being configured to "**automatically** transfer the modified file."
- Even if Brown were modified by Hesselink to "immediately" transfer a modified file, the combination would not "automatically transfer" the file. (POSR, 21)
- No evidence in the record that "immediately" transferring the file does not involve a client requesting the file. (POSR, 21)

Ground 2: The Combination Fails to Teach Similar Claim Elements

- Similarly, the asserted Brown/Hesselink combination also fails to teach all the limitations of claim element [1e].
- The asserted Brown/Hesselink combination fails to render claim 8 unpatentable. Elements [8c] and [8d) are not taught for reasons similar to claim 1 elements [1d] and [1e]. (POR, 11-12)

Ground 2: '942 Patent

- The Brown/Hesselink combination does not render the challenged claims of the '942 patent unpatentable for similar reasons that it does not render the challenged claims of the '561 patent unpatentable.
- The "automatically send" features of '942 patent claim elements [1d] and [1g], and [10c] and [10f], for purposes of this proceeding, are not satisfied for similar reasons that the "automatically transfer" features of '561 claim elements [1d] and [1e], and [8c] and [8d] are not satisfied by the asserted Brown/Hesselink combination.

'942 POR, *passim*
'942 POSR, *passim*