NON-PUBLIC VERSION – PROTECTIVE ORDER MATERIAL

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Paper 64
Dated: August 1, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOX, INC. and DROPBOX, INC.,
Petitioner,

v.

TOPIA TECHNOLOGY, INC.,
Patent Owner.

IPR2023-00427
Patent 9,143,561 B2

Before THOMAS L. GIANNETTI, CHARLES J. BOUDREAU, and JOHN R. KENNY, *Administrative Patent Judges.*

GIANNETTI, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)
Granting Motion to Seal
37 C.F.R. § 42.14

I. INTRODUCTION

Box, Inc. and Dropbox, Inc. ("Petitioner") filed a Petition (Paper 3, "Pet.") requesting *inter partes* review of claims 1, 3, 4, 8, 10, and 11 (the "challenged claims") of U.S. Patent No. 9,143,561 B2 (Ex. 1001, "the '561 patent"). Topia Technology, Inc. ("Patent Owner") filed a Preliminary Response (Paper 7, "Prelim. Resp."). With our authorization, Petitioner filed a Preliminary Reply to Patent Owner's Preliminary Response (Paper 10, "Prelim. Reply"), and Patent Owner filed a Preliminary Sur-reply to Petitioner's Preliminary Reply (Paper 14, "Prelim. Sur-reply").[1]

We determined that the Petition established a reasonable likelihood that Petitioner would prevail with respect to at least one claim, and we instituted *inter partes* review as to all challenged claims of the '561 patent and all grounds of unpatentability asserted in the Petition. Paper 17 ("Institution Dec.").

Following institution of the trial, Patent Owner filed a Response. (Paper 30, "PO Resp."), Petitioner filed a Reply (Paper 37, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 49, "PO Sur-reply").

A consolidated oral hearing with IPR2023-00433 was held on May 22, 2024. A transcript of the hearing is part of the record. Paper 62 ("Hearing Tr.").

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision issued pursuant to 35 U.S.C. § 318(a). For the reasons we

[1] Several documents cited have been filed under seal. Unless otherwise specified, our citations refer to the sealed versions of these documents. Public versions of the sealed documents are available in the case file on P-TACTS.

discuss below, we determine that Petitioner has proven by a preponderance of the evidence that claims 1, 3, 4, 8, 10, and 11 of the '561 patent are unpatentable.

II. BACKGROUND

A. Related Matters

The parties identify the following district court proceedings involving the '561 patent:

> *Topia Technology, Inc. v. Box, Inc.*, 6:21-cv-01372-ADA (W.D. Tex.)[2]
>
> *Topia Technology, Inc. v. Dropbox, Inc., SailPoint Technologies Holdings, Inc., and Clear Channel Outdoor Holdings, Inc.*, 6:21-cv-01373-ADA (W.D. Tex.)
>
> *Topia Technology, Inc. v. Egnyte, Inc.*, 1:21-cv-01821-CJB (D. Del.)
>
> *Topia Technology, Inc. v. Box, Inc., SailPoint Technologies Holdings, Inc., and Vistra, Inc.*, 6:20-cv-01175-ADA (W.D. Tex.)
>
> *Topia Technology, Inc. v. Box, Inc.*, 3:23-cv-00063-LB (N.D. Cal.)
>
> *Topia Technology, Inc. v. Dropbox, Inc.*, 3:23-cv-00062-AGT (N.D. Cal.)

Pet. 2; Paper 5, 1.

The parties identify the following related patents: U.S. Patent Nos. 10,067,942; 10,642,787; 10,289,607; 10,754,823; and 11,003,622. Pet. 3; Paper 5, 2.

The parties identify the following *inter partes* review proceedings involving the related patents: IPR2022-00782, IPR2023-00429, IPR2023-

[2] This case was transferred to the Northern District of California. *See* Ex. 2020, 2–3.

00430, IPR2023-00431, IPR2023-00432, and IPR2023-00433. Pet. 3; Paper 5, 3.

B. Real Parties-in-Interest

Petitioner identifies Box, Inc. and Dropbox, Inc. as the real parties-in-interest. Pet. 2. Petitioner states that "[t]he other defendants in the pending litigations, Vistra Corp., SailPoint Technologies Holdings, Inc., Clear Channel Outdoor Holdings, Inc., and Egnyte, Inc., are not real-parties-in-interest and have had no involvement with this proceeding but are identified here in the interest of over-inclusion." *Id.* Patent Owner contests this identification and contends that Petitioner fails to name Egnyte, Inc. ("Egnyte") as a real party-in-interest. PO Resp. 1. We further discuss this issue in Section III, *infra*.

Patent Owner identifies Topia Technology, Inc. as the real party-in-interest. Paper 5, 1.

C. The '561 Patent (Ex. 1001)

The '561 patent is titled "Architecture for Management of Digital Files Across Distributed Network." Ex. 1001, (54). The '561 patent relates to sharing files between electronic devices and aims to improve file transfer and synchronization between a user's multiple computing devices. *Id.* at 1:16–30, 4:41–46. Figure 2 of the '561 patent is reproduced below.

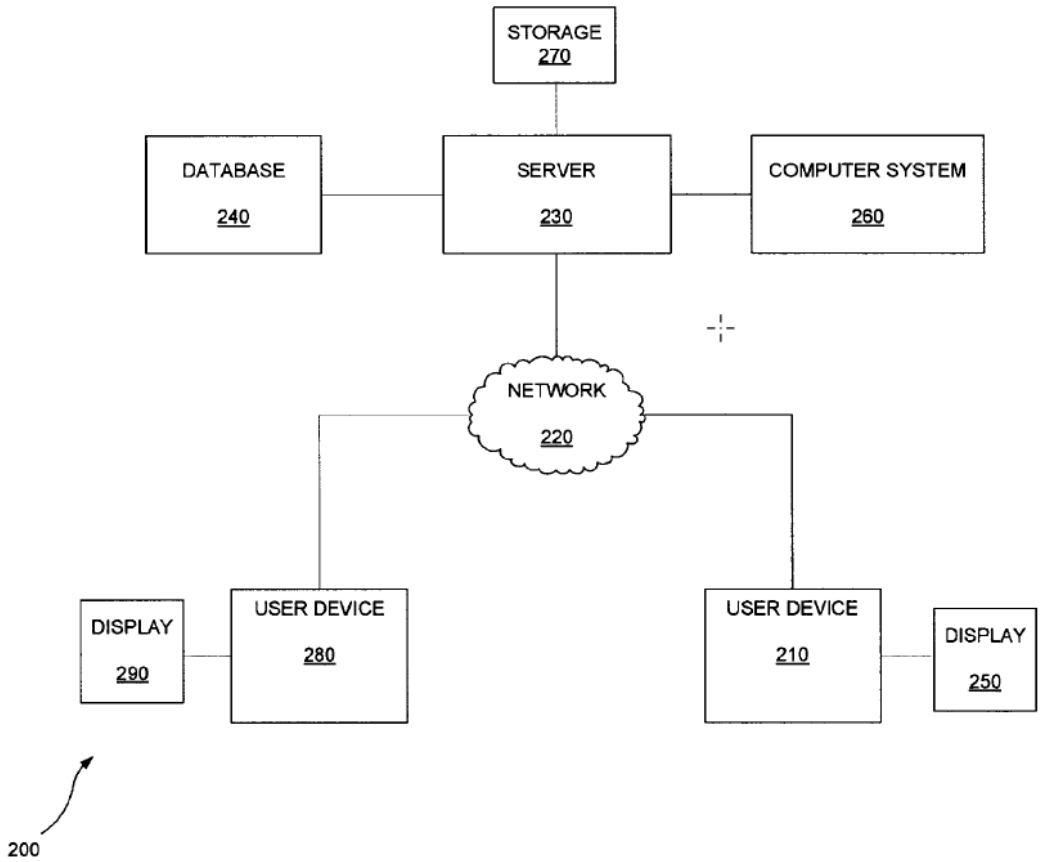

FIG. 2

Figure 2 shows computer network system 200 including electronic user devices 210, 280, such as personal computers or workstations, that are linked via network 220 (e.g., the Internet) to an electronic device or system, such as server 230. *Id.* at 7:14–20. Applications running on one or more user devices 210, 280 can cooperate in two-way communication with server 230 and one or more applications running on server 230. *Id.* at 7:36–41. A file-transfer and/or synchronization application installed on user devices 210, 280 having a user interface allows a user to view, access, and/or organize files to be synched among the user devices. *Id.* at 7:52–8:2.

In operation, a file that the user desires to be synched or shared is uploaded by user device 210 and received by server 230. Ex. 1001, 8:3–5, 8:19–31. Server 230 stores the received file to storage 270 if destination user device 280 is offline or otherwise temporarily not in communication with server 230. *Id.* at 8:12–15, 8:32–50. Upon resuming communication with destination user device 280, server 230 transfers the temporarily stored file to user device 280, whereupon the previous version of the file on user device 280 is replaced with the latest version of the file modified on user device 210. *Id.* at 8:15–18, 8:38–46. A similar reverse-direction synchronization process may be performed with regard to a file modified on user device 280 and synchronized to user device 210. *Id.* at 8:50–54.

D. Illustrative Claim

The Petition challenges claims 1, 3, 4, 8, 10, and 11, of which claims 1 and 8 are independent. Claim 1 is illustrative of the claimed subject matter and is reproduced below:[3]

> 1. [preamble] 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

[3] References provided by Petitioner appear in square brackets. *See* Pet. App. A.

[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.

Ex. 1001, 10:47–11:9.

E. Prior Art References and Other Evidence

Petitioner relies on the following references (Pet. 5):

1. U.S. Patent Application Publication 2007/0174246 A1 (Filed January 25, 2006) (Ex. 1016, "Sigurdsson");

2. U.S. Patent Application Publication 2005/0091289 A1 (Published April 28, 2005) (Ex. 1020, "Shappell");

3. U.S. Patent 7,035,847 B2 (Issued April 25, 2006) (Ex. 1025, "Brown"); and

4. U.S. Patent Application Publication 2005/0120082 A1 (Published June 2, 2005) (Ex. 1026, "Hesselink").

In addition to these references, Petitioner relies on a Declaration of Dr. Ravin Balakrishnan. Ex. 1028 ("Balakrishnan Decl."). Petitioner submits also a Reply Declaration by Dr. Balakrishnan. Ex. 1046. ("Balakrishnan Reply Decl."). Patent Owner has submitted a declaration of Prashant Shenoy, Ph.D. (Ex. 2013, "Shenoy I Decl.") and a second declaration of Dr. Shenoy (Ex. 2025, "Shenoy II Decl."). The parties have also submitted transcripts of the depositions of Dr. Balakrishnan and Dr. Shenoy. Exs. 1045 ("Shenoy Dep."), 2033 ("Balakrishnan Dep.").

F. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability. Pet. 5.

Claim(s) Challenged	35 U.S.C. §[4]	Reference(s)/Basis
1, 3, 4, 8, 10, 11	103(a)	Sigurdsson, Shappell
1, 3, 4, 8, 10, 11	103(a)	Brown, Hesselink

III. ALLEGED FAILURE TO NAME A REAL PARTY-IN-INTEREST

Patent Owner contends that Egnyte, the defendant in *Topia Technology, Inc. v. Egnyte, Inc.*, 1:21-cv-01821-CJB (D. Del.) (the "Egnyte Litigation"), should have been named in the Petition as a real party-in-interest. PO Resp. 1. Patent Owner asserts that because Egnyte is "time-barred under 35 U.S.C. § 315(b)," this *inter partes* review "should therefore be terminated." *Id.*

[4] Because the earliest application from which the '561 patent issued was filed before March 16, 2013, the pre-AIA ("America Invents Act") version of § 103 applies. Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284, 285–88 (2011).

In its Preliminary Response, Patent Owner contended that "[t]he facts demonstrate that Egnyte is both an RPI to this petition and a privy of Petitioner[]." Prelim. Resp. 4. Patent Owner argued that "[f]or over 17 months, Petitioner[] and Egnyte have been intertwined with respect to not only this Petition, but also the co-pending litigations which involve the '561 Patent and its five related patents." *Id.* at 5 (footnote omitted). Patent Owner relied mainly on the alleged facts that Petitioner and Egnyte "share litigation counsel," specifically, Ms. Heidi L. Keefe, a partner at the law firm Cooley LLP and lead counsel in this proceeding, and further, that Petitioner and Egnyte "are pursuing a single and unified invalidity defense strategy in all forums." *Id.* Patent Owner asserted also that Egnyte and Petitioner "are parties to a joint defense agreement" and "have submitted *identical* invalidity contentions, of which the grounds in the Petition overlap." *Id.*

In its Preliminary Reply, Petitioner responded that "Egnyte is not an RPI or privy" of Petitioner. Prelim. Reply 1–6. With this paper, Petitioner submitted declaration testimony from Ms. Keefe. Ex. 1029 ("Keefe Decl."). Ms. Keefe testified that her involvement in the Egnyte Litigation was limited to arguing a motion to dismiss based on 35 U.S.C. § 101 (lack of statutory subject matter). *Id.* ¶¶ 5, 16. She testified that "[m]y oral argument on the Section 101 motion was the full extent of my representation of Egnyte. Neither I nor any other counsel for Petitioners involved in these IPRs have represented Egnyte on any other issue." *Id.*

As to Egnyte's "identical" preliminary invalidity contentions, Ms. Keefe testified that "[n]either I nor anyone else at Cooley LLP advised Egnyte regarding what to include in its preliminary invalidity contentions."

Ex. 1029 ¶ 11. She stated that "Petitioner[] and Egnyte are competitors" and "did not collaborate in any way in developing Petitioner['s] IPRs." *Id.* ¶ 23. She testified that Petitioner "independently prepared, funded, and filed the IPRs for [its] own benefit, without considering Egnyte's interests and with no input from Egnyte." *Id.* ¶ 20.

At her deposition, under cross-examination by Patent Owner's counsel, Ms. Keefe confirmed the statements in her declaration. She testified that her representation of Egnyte was "narrow." Ex. 2018, 37:9–12 ("I entered a pro hac [in the Egnyte Litigation] in order to represent Egnyte in the 101 hearing in Delaware. That was my narrow engagement. That is all I did. That's all I've ever done."). [redacted] She testified that she is not Egnyte's counsel in the litigation, but that Egnyte is represented by another firm, FisherBroyles. *Id.* at 48:7–8. She testified that her representation of Egnyte ended with arguing the 101 motion. *Id.* at 48:20–23. She testified, emphatically, that "I am not, have not, and will not represent Egnyte in the district court litigation in Delaware for anything other than the 101 oral argument that I represented them in." *Id.* at 85:15–18.

In its Preliminary Sur-reply, Patent Owner responded that "[i]n the midst of preparing the Petitions, lead counsel Ms. Keefe orchestrated a back-room, off-the-books deal to represent long time Cooley client Egnyte in furtherance of a three-part master plan to circumvent the IPR statutory time bar and estoppel provisions." Prelim. Sur-reply 1. We did not agree with

Patent Owner's assertions of a "deal" involving Ms. Keefe or her firm, Cooley. Institution Dec. 11–13. We found that the evidentiary record before us, summarized *supra*, did not support the existence of any such "deal." *Id.* at 12. Nor did we find any evidence before us that Egnyte was a "long time Cooley client." *Id.*[5] Instead, the testimony of Ms. Keefe established that it was "agreed" she would argue the Section 101 motion for Egnyte because of her prior "extensive experience" arguing such motions in the District of Delaware. Keefe Decl. ¶ 4. She argued the motion on December 20, 2022, and at that point, her involvement and that of her firm in the Egnyte Litigation ended. *Id.* ¶¶ 4–5. We found, therefore, that there is no record support for Patent Owner's allegation of collusion between Ms. Keefe and Egnyte "to circumvent the IPR statutory time bar and estoppel provisions." Institution Dec. 12; *see* Prelim. Sur-reply 1.

Post-institution, Patent Owner renews its argument that "the Petition fails to identify all real parties in interest/privies of Petitioners, in particular, Egnyte Inc., which is time-barred under 35 U.S.C. § 315(b)." PO Resp. 1–7. Patent Owner for the most part repeats earlier arguments rejected in the Institution Decision while, at the same time, presents no new supporting evidence. For example, Patent Owner again points to the joint defense agreement ("JDA") in the Egnyte Litigation, which Patent Owner asserts "gives Petitioners a second bite at the apple, in the event the IPR allegations are unsuccessful, in contrast to the statute and its intent." *Id.* at 2.

[5] Ms. Keefe was unsure whether Egnyte was a former or current client of Cooley. Ex. 2018, 36:5–7.

As discussed, Ms. Keefe addressed the JDA in her testimony. Keefe Decl. ¶ 6. [redacted]

Patent Owner contends again that "[t]hrough the JDA, Petitioners and Egnyte have collaborated on the grounds raised in the Petition." PO Resp. 2. As alleged proof, Patent Owner again asserts that "Egnyte and Petitioners' district court invalidity contentions are identical." *Id.*; *see* Prelim. Resp. 3. On this subject, Ms. Keefe confirmed that neither she nor Cooley advised Egnyte in preparing those contentions. Ex. 2018, 158:3–9.[6] As discussed above, the text of the JDA supports this testimony. Ex. 1030, 6–7 §§ 2.5, 2.5.1.

[6] Petitioner points out that its invalidity contentions in district court were served before Egnyte's. Pet. Reply 2.

On July 22, 2024, approximately a week before the due date for this Decision, we received an email from Patent Owner's counsel, attaching two documents. Ex. 3005. Patent Owner contends that "consideration of this information is in the interest-of-justice because it is relevant to Egnyte's status as an unnamed RPI in these proceedings and was not available to the Board when it found Egnyte is not an RPI stating there was no evidence that Egnyte was a 'long time Cooley client.'" *Id.* (citing Institution Dec. 12).

The first of the two documents is a heavily-redacted, recent (July 15, 2024) email that appears to be from Egnyte's counsel to counsel for Patent Owner. Ex. 2050. The email indicates that the second document (Ex. 2051) was produced in the Egnyte Litigation and relates to Ms. Keefe's representation of Egnyte in the Egnyte Litigation, a fact that is not disputed. The second document appears to be a [redacted] engagement letter indicating that in [redacted], Egnyte engaged Cooley [redacted] Ex. 2051, 1. No further explanation of these documents is provided.

We have reviewed the documents and for the reasons that follow find they do not support Patent Owner's RPI claim. The [redacted] engagement letter makes no reference to Ms. Keefe or the Egnyte Litigation, and therefore does not provide contrary evidence to Ms. Keefe's testimony that the scope of her participation in that litigation was limited or that no documents exist that outline the scope of that representation. Nor does it contradict her testimony that she did not know if Cooley had an initial engagement letter with Egnyte. *Id.* at 32:1-3. Patent Owner cites no evidence that she knew of the letter when she testified. She explained in her testimony that she

checked Cooley's conflicts records and "Egnyte was listed either as a former client or a current client. And I cannot remember which it was." Ex. 2018, 36:5–6. In sum, we see nothing in these documents that supports Patent Owner's unnamed-RPI theory based on Ms. Keefe's limited participation in the Egnyte Litigation.

As Petitioner pointed out, the sharing of trial counsel in district court by a non-party to an IPR accused of infringing the same patent as the petitioner is a common occurrence, and by itself it is insufficient to make that non-party a real party-in-interest. Prelim. Reply 4 (citing *Adobe Inc. v. Rah Color Techs. LLC*, IPR2019-00629, Paper 35 at 12–13 (PTAB Sept. 4, 2019)). That is especially true here, where any overlapping representation was "narrow," and the accused products in the pending litigations are different. *Id.*; *see* Keefe Decl. ¶ 14 ("PO is accusing different products of infringement in the Egnyte litigation from those accused in the litigations involving Petitioner[]").

Patent Owner continues to rely heavily on *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018) ("*AIT I*"), on remand, *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128 at 5 (PTAB Oct. 2. 2020) (precedential) ("*AIT II*"). PO Resp. 2–7; PO Sur-reply 2–6. For the reasons stated in our Institution Decision (at pp. 13–16) and those discussed below, we determine that the *AIT* decisions do not support Patent Owner.

In *AIT I*, the Federal Circuit, in remanding the case to the Board, instructed that "[d]etermining whether a non-party is a 'real party in interest' demands a flexible approach that takes into account both equitable and

practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has *a preexisting, established relationship with the petitioner*." *AIT I*, 897 F.3d at 1351 (emphasis added).

Initially, Patent Owner contended that "the focus of the real-party-in-interest inquiry is on the patentability of the [challenged] claims . . . , *bearing in mind who will benefit* from having those claims canceled or invalidated." Prelim. Resp. 6–7 (quoting *AIT II*, Paper 128 at 5) (second and third alterations in original). We did not agree that either *AIT I* or *AIT II* supports this argument as presented by Patent Owner on the facts before us. Institution Dec. 13–16. We explained that the "Federal Circuit's analysis in *AIT I* went far beyond determining only whether a party benefits from the filing of the petition." *Id.* at 13. For example, the Federal Circuit's analysis required determining whether "the non-party . . . has a preexisting, established relationship with the petitioner." *AIT I*, 897 F.3d at 1351. We found that the record in this case provided no persuasive evidence of such a "preexisting, established relationship" between Petitioner and Egnyte. Institution Dec. 13.

Many other facts were considered by the Federal Circuit in *AIT I*, including evidence of close cooperation between RPX and Salesforce (the unnamed alleged RPI). Those facts included, for example, the following:

> 1. Testimony regarding "six communications between RPX and Salesforce employees in which the AIT-Salesforce Litigation and/or the AIT Patents were mentioned or discussed."
>
> 2. The first of these communications was initiated by RPX, during which RPX "mentioned that RPX had become aware that Salesforce had been sued by AIT"; "provided a small amount of information" that RPX knew about the litigation;

> indicated that, although RPX did not have knowledge of AIT's expectations for its litigation campaign, it had previous dialogue on other matters with the same counsel who was representing AIT in the litigation; and offered to reach out to that counsel.
>
> 3. The following month, after Salesforce "had just renewed its membership agreement with RPX," an in-person meeting was held during which Salesforce "indicated that it would be interested if RPX could reach out to AIT and find out any information regarding AIT's expectations for its litigation campaign."
>
> 4. During a phone call, Salesforce "again indicated that it would be interested in any information RPX could obtain concerning AIT's expectations for its litigation campaign." Shortly after this third communication, Salesforce filed its CBM petitions.
>
> 5. RPX initiated a call to Salesforce approximately two weeks later, during which Salesforce informed RPX that it had filed the CBM petitions, that a stay would therefore be granted in the district court litigation, and that Salesforce no longer was interested in having RPX reach out to AIT to obtain information about AIT's expectations for that litigation.

AIT I, 897 F.3d at 1342. These facts were considered in the Board's decision on remand, along with the nature of RPX's "business model" and Salesforce's "relationship with RPX." *AIT II*, Paper 128 at 10–15, 20–23.

Unlike in *RPX*, there is no evidence of record that Petitioner's "business model" involves filing patent challenges for the benefit of other entities. *See AIT II*, Paper 128 at 13 ("[A]s the Federal Circuit noted, RPX's SEC filing states that one of [RPX's] strategies for transforming the patent market is the facilitation of challenges to patent validity.") (citing *AIT I*, 897 F.3d at 1351) (alterations in original) (internal quotation marks omitted). And here, in contrast to *AIT I* and *AIT II*, there is no evidence of record of

any preexisting relationship or close cooperation between Petitioner and Egnyte regarding the contents of the Petition. *See* Keefe Decl. ¶ 23 (Petitioner and Egnyte "had no pre-filing communications regarding the potential content of Petitioner['s] IPR petitions."). Nor is there any evidence of the other factors considered by the Federal Circuit in *AIT I*, such as evidence of a "very significant payment shortly before" the petition was filed, *AIT I*, 897 F.3d at 1342, or evidence that Petitioner has held itself out as "an extension of a client's in-house legal team," *id.* at 1340.[7] And there is no evidence here of overlapping board of director members between the petitioner and the unnamed party, as there was in *AIT I*. 897 F.3d at 1354; *see* Keefe Decl. ¶ 23 ("Petitioners and Egnyte are competitors, share no board members, and had no pre-filing communications regarding the potential content of Petitioners' IPR petitions.").

During the course of this trial, Patent Owner has presented no new evidence on any of these factors, other than Exhibits 2050 and 2051, which we address *supra*. Patent Owner contends that Petitioner "[redacted] for shared counsel's representation of Egnyte to invalidate the '561 Patent, while drafting the Petition." PO Resp. 3. But Patent Owner cites no persuasive evidence to support this assertion other than Ms. Keefe's testimony that [redacted]. *Id.* (citing [redacted]). Ms. Keefe testified emphatically, "I am not, have not, and will not represent Egnyte in the district court litigation in Delaware for anything other than the 101 oral

[7] [redacted]

argument that I represented them in." *Id.* at 85:15–18. We find that Ms. Keefe's [redacted] work on a specific issue is *de minimis* and does not amount to [redacted].

Similarly, Patent Owner's reliance on a "mutual interest in invalidating the '561 Patent" is an insufficient basis for its argument that Egnyte is the real party in interest and is not supported by *AIT*. As we pointed out, the Federal Circuit's analysis in *AIT* required determining whether "the non-party . . . has a preexisting, established relationship with the petitioner." *AIT I*, 897 F.3d at 1351. We find that Patent Owner presents no persuasive evidence of such a "preexisting, established relationship" between Petitioner and Egnyte. *See* discussion *supra* and at page 15 of our Institution Decision (citing Ms. Keefe's testimony that Petitioner and Egnyte "had no pre-filing communications" regarding the potential content of the Petition). For the reasons discussed, the mere fact that they are parties to the JDA does not support the existence of such a "preexisting, established relationship" between Petitioner and Egnyte. As Ms. Keefe testifies, the JDA states [redacted]

Patent Owner points to no communications between Petitioner and Egnyte, and its argument that "the fact that the '561 Patent is being asserted against Egnyte" is evidence that Egnyte "would have been interested in

Board review" is speculation. PO Resp. 6.[8] The factors from *AIT I* are cited and relied on by the Board on remand in *AIT II*. *See, e.g.*, *AIT II*, Paper 128 at 11 (business model), 20 (pre-existing relationship). 27 (overlapping board members), 29 (communications with petitioner). Having considered the facts of record in this case, we determine that Patent Owner's reliance on *AIT I* and *AIT II* as support for its dismissal argument is misplaced. For the foregoing reasons, we find that the record does not demonstrate that Egnyte is an RPI, and we determine that Petitioner has met its burden of identifying all RPIs. We therefore deny Patent Owner's request to dismiss the Petition because of a failure to name Egnyte as a real party-in-interest.

We address briefly Patent Owner's passing argument that Egnyte is a privy of Petitioner. PO Resp. 5. Citing *Taylor v. Sturgell*, 553 U.S. 880 (2008), our Consolidated Trial Practice Guide[9] explains that "[t]here are multiple factors relevant to the question of whether a non-party may be recognized as a . . . privy." Consolidated Trial Practice Guide at 15 (internal quotation marks omitted). *Taylor* provides a well-known listing of factors that "provide a framework" for determining privity. *Taylor*, 553 U.S. at 893 & n.6.

Other than its passing reference to privity, Patent Owner does not address the *Taylor* framework or otherwise support its assertion of privity

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[8] Patent Owner has not moved for discovery of those communications in this proceeding. *See* PO Resp. 7 ("Petitioner and Egnyte have refused to produce communications between them.").

[9] Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019), available at https://www.uspto.gov/TrialPracticeGuideConsolidated.

between Petitioner and Egnyte. For the reasons discussed, we conclude that the sparse record before us does not demonstrate that Egnyte is a privy of Petitioner.

IV. ANALYSIS OF THE ASSERTED GROUNDS

A. Obviousness

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) so-called "secondary considerations," including commercial success, long-felt but unsolved needs, failure of others, and unexpected results. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). During the trial, neither party has presented any evidence on the fourth *Graham* factor.

B. Level of Ordinary Skill in the Art

According to Petitioner, a person of ordinary skill in the pertinent art "would have possessed a bachelor's degree in computer science (or similar degree), and two years of work experience developing software, including at least some experience with storage, synchronization, and human-computer interaction technologies." Pet. 7 (citing Balakrishnan Decl. ¶¶ 15–21). Petitioner adds that "[a] person could also have qualified with more formal

education and less technical experience, or vice versa." *Id.* (citing Balakrishnan Decl. ¶¶ 17, 21).

Patent Owner does not dispute this description of the person of ordinary skill. *See* Shenoy II Decl. ¶ 14.

We adopt the formulation of the level of ordinary skill in the art proposed by Petitioner as it is consistent with the prior art before us in this proceeding.

C. Claim Construction

1. Background

Prior to institution, neither party proposed any claim constructions for our consideration. Pet. 7 (Petitioner "do[es] not believe express claim construction is presently necessary.") (citing Balakrishnan Decl. ¶¶ 22–27); Shenoy I Decl. ¶ 21 ("In my analysis I have interpreted the claims in accordance with their plain and ordinary meaning."). As trial progressed, however, it became apparent that construction of the terms "automatic" and "automatically" in the context of transferring files, appearing in all claims, might well be dispositive of issues in the case. Patent Owner responded, not with an express construction, but with the following argument: "[T]he disclosures of Sigurdsson, Brown and Hesselink clearly require a client to send a request for synchronization of certain data before downloading the requested data, and therefore fail to disclose the 'automatic transfer' limitation." PO Resp. 8. Petitioner, in turn, criticized Patent Owner for its "erroneously narrow" construction. Pet. Reply 4. Petitioner countered Patent Owner's implicit construction with the following: "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." *Id.* at 5.

The dispute over the meaning of "automatically" continued at the oral argument. At the hearing, Patent Owner proposed making a distinction between automatic at the "system level" and automatic at the "component level." This distinction came in response to a hypothetical question involving the iPhone posed by the Board to Patent Owner's counsel:

> [THE BOARD]: Let's say that when I unlock my iPhone, it sends a signal to the server saying I'm available to receive the emails. And in response to that, the server downloads the emails to my phone. Let's assume that that's hypothetically how the system operates. How would that, how would you describe that, automatic or manual?

Hearing Tr. 41:3–7. After further colloquy, Patent Owner's counsel answered as follows:

> [COUNSEL]: It's automatic for the system level. That's exactly how I would view it, is that it is automatic from the system level. And if you want to go down the component level, then it would not be automatic. That's actually the end.

Id. at 43:11–14. This subject came up again later in the hearing, when Patent Owner's counsel responded to a question as follows:

> [COUNSEL]: [Y]ou know, [the Board] talked about the iPhone example and the iPhone, you wake up in the morning, you turn your iPhone on and all of a sudden the emails appear. Is that automatic or not? Well, we would say, yes, it's automatic at the system level. I mean, and *we don't disagree with the Petitioners that automatic would include without manual intervention*. But it's more than that. It's really

> between the two actors that are involved in whatever element of the claim that automatic transfer appears.

Id. at 57:12–18 (emphasis added).

2. Legal Principles

We construe claim terms as relevant to the parties' contentions and to the extent necessary to resolve the issues in dispute. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). We must, therefore, resolve the controversy over the meaning of "automatically" in the claims before undertaking our analysis of the prior art.

The Board applies the same claim construction standard as that applied in federal courts. 37 C.F.R. § 42.100(b) (2019). In this context, claim terms "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence."[10] *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips,* 415 F.3d at 1312–17). Extrinsic evidence is "less significant than the intrinsic record in

[10] Neither party has based its claim construction argument on the prosecution history of the '561 patent.

determining 'the legally operative meaning of claim language.'" *Phillips*, 415 F.3d at 1317.

3. Analysis

As instructed by *Phillips*, we first look to the words of the claim. *Phillips*, 415 F.2d at 1312. Patent Owner contends that the'561 patent claims 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 to another device *associated with the same user*." PO Resp. 7, 11–12. To illustrate this interpretation of "automatically," Patent Owner points to the language of limitation 1d: "Consistent with this focus, claim feature [1d] (and similarly claim [8c]) recites 'the first application is further configured to automatically transfer the modified first electronic file copy to the third electronic device [associated with a user] ... " *Id.* at 7 (alterations in original) (emphasis omitted).

Patent Owner relies on the Federal Circuit's decision in *Rovi Guides, Inc. v. Vidal*, No. 2020-1994, 2022 WL 1152311 at *1 (Fed. Cir. Apr. 19, 2022). PO Resp. 9. Patent Owner contends *Rovi Guides* stands for the proposition that "all terms included in the claim must be considered since each term must add something more." *Id.* Citing *Rovi Guides*, Patent Owner contends that "[t]he *automatically* transferring limitation requires the first application on the first electronic device (e.g., a server) to *automatically* transfer the modified first electronic file copy to the third electronic [sic] *associated with the user*." *Id.* at 10. Elsewhere in its response, Patent

Owner distinguishes a prior art data transfer process from the claimed automatic updating process because it is based on a "client pull" in contrast to a "data push." PO Resp. 51–52.; *see also* Shenoy II Decl. 32 (standard HTTP protocol "does not 'automatically' send or push content such as ads to a browser since HTTP did not have such functionality and was a pull-based request-response protocol.").

Petitioner responds that Patent Owner's construction of "automatically" in limitation 1d (and corresponding limitation 8c) is "erroneously narrow." Pet. Reply. 4. Referring to the '561 patent specification, Petitioner asserts that "[t]he 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." *Id.* at 5 (citing Balakrishnan Reply Decl. ¶¶ 23, 26–28, 32–34, 52, 67). In further support of this construction, Petitioner points to several instances where the specification contrasts manual operations (e.g., moving or transferring files) with automatic operations. *Id.* (citing Ex. 1001, 1:31–62, 2:66–3:20, 3:54–61). Embracing Patent Owner's description of the claims as "user-centric," Petitioner contends "[n]othing in the claims or specification requires file transfer that is automatic 'from the perspective of the server' in the extremely narrow sense PO assumes—unilaterally initiated by the server without receiving any communication from another device." *Id.* at 6. Neither of the independent claims expressly recites a server.[11] Petitioner

[11] Claims 1 and 8 are directed to a system and its method of operation, respectively.

argues that Patent Owner "does not attempt to argue any disclaimer, disavowal, or lexicography that would exclude 'automatic' transfers that occur in response to communications between devices." (citing *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1366 (Fed. Cir. 2012)). *Id.*

We agree with Petitioner that the language of the claims does not limit transfers to those that are automatic "from the perspective of the server," that is, unilaterally initiated without receiving communication from another device. *See* PO Resp. 13; Pet. Reply 5–6. As Petitioner explains, "[t]he ['561] patent's only use of the word 'automatically' in the detailed description of the preferred embodiment reflects this user-centric perspective." Pet. Reply 5 (citing Ex. 1001, 7:47–51).

Phillips instructs us that "the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." *Phillips*, 415 F.3d at 1315 (internal quotes and citation omitted). While we do not find the parties' arguments based on the claim language alone sufficient to resolve this issue, we are persuaded that the specification of the '561 patent makes it clear that the claims should not be limited to what Patent Owner terms "push" transfer operations by a server, but should at least encompass "pull" operations by a client device. Specifically, the '561 patent expressly states that pull transfer operations may be interchanged with push transfer operations in the disclosed system:

> [A]s 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, the synch application 380 may instead function to periodically "pull" or

> otherwise actively retrieve such files from the transfer clients 310, 320.

Ex. 1001, 10:36–43.

We have considered Patent Owner's other claim construction arguments and find them unavailing. PO Resp. 8–12; PO Sur-reply 6–13. For example, we do not find Patent Owner's argument that "[i]f '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" to be persuasive. PO Sur-reply 8. We disagree with Patent Owner that knowing that a file transfer is not manual provides no additional information over just knowing that there is a transfer. The former excludes manual transfers involving a human user while the latter does not. We further disagree that Patent Owner's "push" construction gives meaning to "automatically," while a construction that would also include a "pull" would not. Nor are we persuaded by Patent Owner's argument that the '561 patent's discussion of the interchangeability of push and pull transfers is "an unclaimed alternative embodiment." PO Sur-reply 12. The Federal Circuit has observed that "there is a strong presumption against a claim construction that excludes a disclosed embodiment." *Nobel Biocare Servs. AG v Instradent USA, Inc.*, 903 F.3d 1365, 1381 (Fed. Cir. 2018). Patent Owner has identified nothing in the intrinsic record that convinces us this presumption has been overcome here. Finally, we do not credit the argument by Patent Owner at the oral hearing that there is a distinction between automatic at the "system level" and automatic at the "component level." *See* discussion *supra*; Hearing Tr. 43:11–14; 57:12–18. The

argument is not timely and is, in any event, unsupported by the intrinsic evidence or testimony.

In summary, we reject Patent Owner's proposed construction of "automatically" as being limited to "push" transfer operations that are initiated by a server and not including "pull" operations that are initiated by a client as contrary to the '561 patent specification. Instead, we adopt as most consistent with the specification Petitioner's broader construction of "automatically" as the transfer of files that is not done manually by a human user. Pet. Reply 5.

D. Description of the Prior Art References

1. Sigurdsson (Ex. 1016)

Sigurdsson discloses a system for sharing and synchronizing content across a user's multiple computing devices. Ex. 1016 ¶¶ 2, 4, 16. Figure 4 of Sigurdsson is reproduced below.

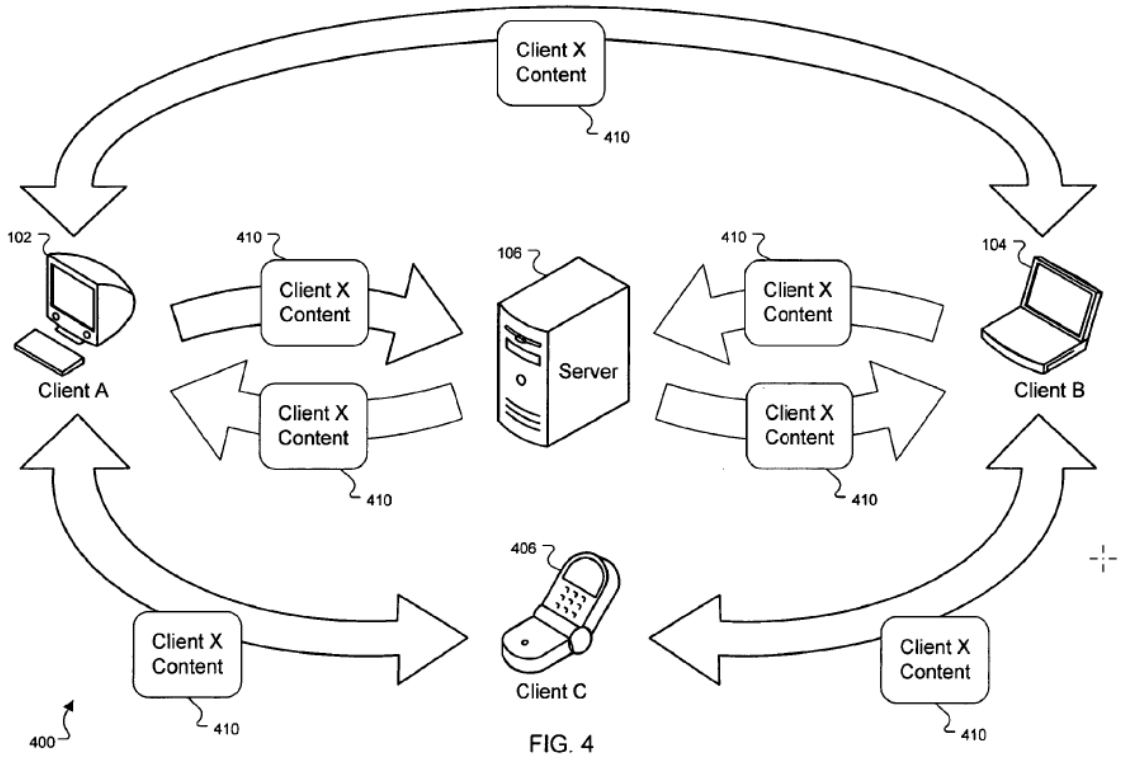

Figure 4 of Sigurdsson is a schematic showing system 400 for sharing and synchronizing content using a mixed peer-to-peer and client/server architecture. *Id.* ¶ 51. Server 106 is used to share content among Client A 102, Client B 104, and Client C 406, which may include, e.g., home computers, work computers, and mobile computers such as cell phones. *Id.* ¶¶ 27, 51.

For example, a user at Client A 102 may edit and save a document on their work computer. Ex. 1016 ¶ 52. Client X content 410 originating on Client A 102, which can include a copy of the document saved by the user as well as metadata, is posted to server 106. *Id.* ¶ 54. Server 106 stores Client X content 410 and, upon receiving a request for missing content from, e.g., client B 104, transmits Client X content 410 to Client B 104. *Id.* ¶¶ 46, 55. Also, each of Clients 102, 104, 408 can push new data to other

clients instead of waiting until the other clients send a request for missing content. *Id.* ¶ 84.

System 400 can enable peer-to-peer content sharing and synchronization for clients that are currently online to share Client X content 410 directly between the clients. Ex. 1016 ¶ 62. For system 400 to supply client X content 410 to an offline client, server 106 can be used as a drop box for Client X content 410 until the offline client comes online again. *Id.*

2. Shappell (Ex. 1020)

Shappell discloses a computer network system that enables users to share files in a server-less shared memory space. Ex. 1020, (57), ¶ 1. Files in the shared space can be copied to a user's local machine. *Id.* ¶ 62. When a modification of a file contained in the shared space occurs, machines that have previously obtained a copy of the shared file will remove the local copy of the out-of-date file and obtain an updated version of the file. *Id.* ¶ 81.

3. Brown (Ex. 1025)

Brown discloses client machines synchronizing with each other by synchronizing to a common server account. Ex. 1025, 2:65–67. Figure 1 of Brown is reproduced below.

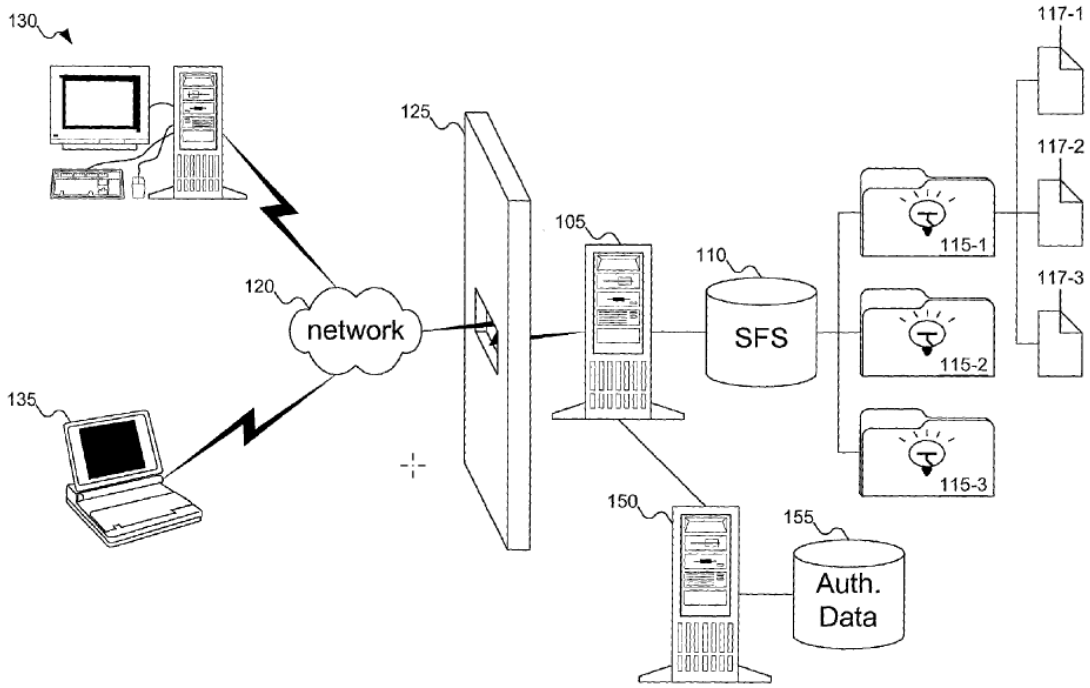

FIG. 1

Figure 1 of Brown shows server 105 with clients 130, 135 accessing files stored on server 105. *Id.* at 3:54–56. Server 105 includes server Synchronization File System (SFS) 110 with a functional interface and metadata organization that enables synchronization by clients 130, 135. *Id.* at 2:59–62. Clients 130, 135 include a client Synchronization Application (SA) that uses server SFS 110 to synchronize local client data with server 105. *Id.* at 2:63–65. The synchronization process is initiated by a client SA when it makes a sync poll call to server 105, passing to it a client sync index (CSI) identifying its current known state of the server account. *Id.* at 5:14–17.

If a server sync index (SSI) value representing the state of the server account matches the CSI value passed in by the polling client, the client is up to date with the current state of its server account. Ex. 1025, 5:3–13,

5:17–19. In that case, server SFS 110 returns the SSI (having the same value as the CSI) back to the client. *Id.* at 5:19–21. Otherwise, server SFS 110 returns the SSI along with server metadata information the client needs to transition its account from its current state to the current state of server 105. *Id.* at 5:21–24. The client SA also monitors local file system activity on the client and sends changes to server SFS 110 during synchronization. *Id.* at 3:46–50.

4. Hesselink (Ex. 1026)

Hesselink discloses synchronization of files among a user's multiple computers. Ex. 1026 ¶ 210. "[A] user may choose to always synchronize all copies of a file, wherein, whenever the user makes a change to that file locally, at any location, then all of the devices which subscribe to that file are automatically updated immediately." *Id.*

E. Obviousness of Claims 1, 3, 4, 8, 10, and 11 Based on Sigurdsson and Shappell

1. Claim 1

Petitioner asserts that claim 1 would have been obvious in light of Sigurdsson and Shappell. Pet. 14–33. Petitioner provides an element-by-element claim analysis,[12] supported by expert testimony. *See id.*; Balakrishnan Decl. ¶¶ 500–537.

For the reasons that follow, we find that Petitioner demonstrates that each element of claim 1 is met by Sigurdsson and Shappell.

[12] Our analyses in this and the following sections track Petitioner's paragraph references for the claim limitations. *See* Pet. App. A.

a) Preamble[13]

Petitioner contends the preamble of claim 1 ("A system comprising . . . .") is met by the system comprising Sigurdsson's Clients A–C and server 106 in Figure 4, reproduced in Section IV.D.1, *supra*. Pet. 14.

b) Limitation 1a

Petitioner identifies server 106 in Figure 4 of Sigurdsson as the "first electronic device" in claim limitation 1a. Pet. 15. Petitioner identifies Synchronization Manager 332, included within server 106, as the claimed "first application." *Id.* Petitioner identifies Sigurdsson's Client A and Client C as the second and third electronic devices, respectively. *Id.* at 17.

c) Limitation 1b

Petitioner contends this limitation is met by Sigurdsson. Pet. 19–21. Petitioner contends that Sigurdsson's server 106 is "configured to receive . . . a copy of a first electronic file in the form of, for example, a very large maintenance manual." *Id.* at 19 (internal quotation marks omitted) (alteration in original) (emphasis omitted). Petitioner contends that in Sigurdsson, "Client A may automatically transfer a copy of a first electronic file (maintenance manual) from the second application (HTTPS Client/server) when the user modifies a content of the first electronic file." *Id.* (internal quotation marks and emphasis omitted).

d) Limitation 1c

Petitioner contends this limitation is met by Sigurdsson. Pet. 21–22. Petitioner explains that "Sigurdsson describes Client C as operating similarly

[13] We do not express a view on whether the preambles of claims 1 or 8 are limiting.

to Client A, and it would have been obvious to include the same components in Clients A and C to implement the functionality recited in claim [1b] using Client C to automatically transfer a file to the server." *Id.*

e) Limitation 1d

Petitioner relies on Sigurdsson and Shappell as teaching or suggesting this limitation. Pet. 23–29. Petitioner explains that "[i]n connection with the embodiment in Figure 6 [reproduced below], Sigurdsson explains that Server 106 may send content, such as the modified maintenance manual received from Client A, to another client, such as Client C, in order to keep Client C up-to-date with the latest file changes from other clients." *Id.* at 23 (citing Ex. 1016 ¶ 80).

Figure 6 of Sigurdsson follows.

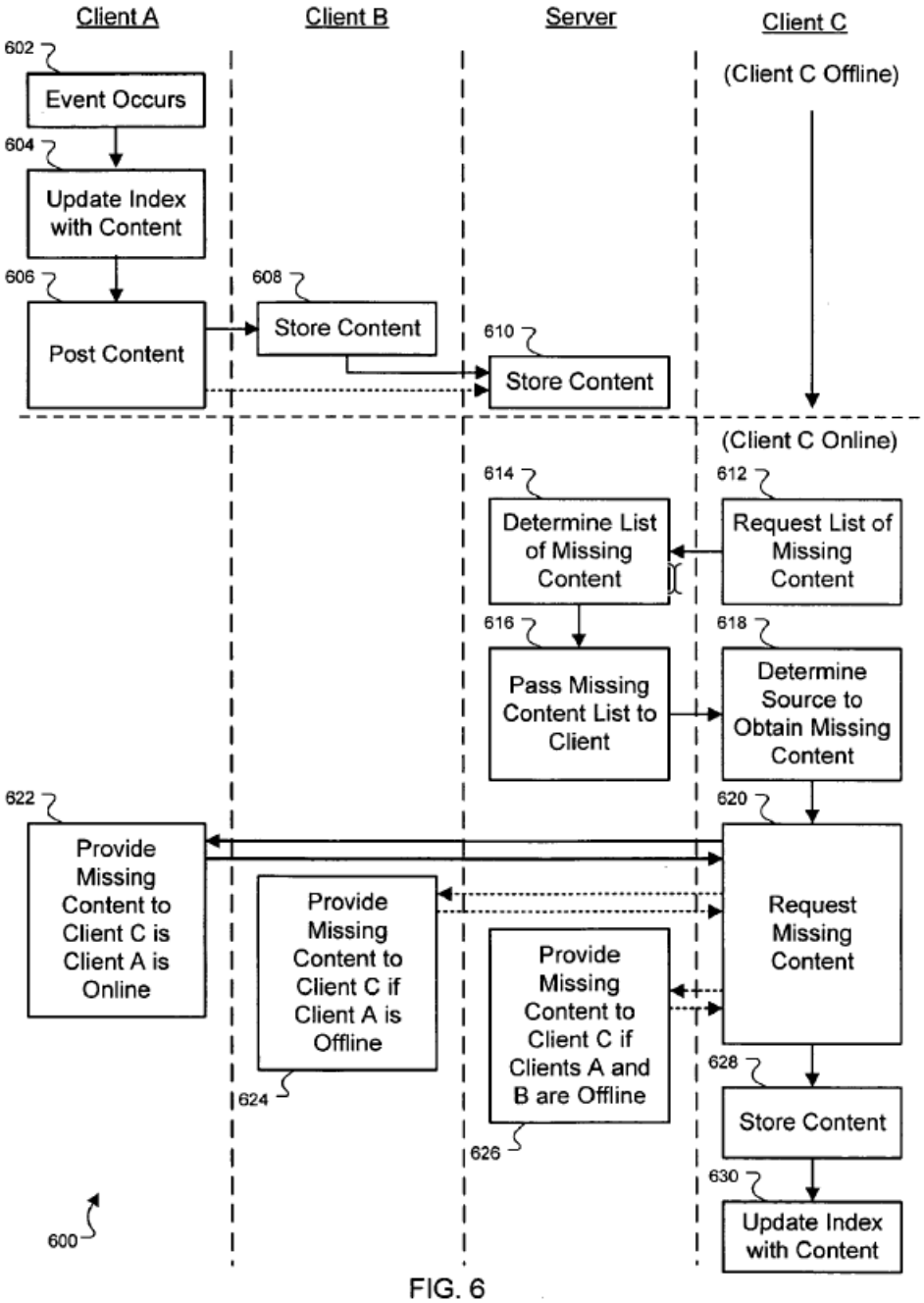

FIG. 6

Figure 6 is a sequence diagram showing a method for sharing and synchronizing content using a mixed peer-to-peer and server architecture when a client that is off-line comes online according to Sigurdsson. Ex. 1016 ¶ 21. Petitioner relies on Step 626 as showing a server sending

missing content to a third client. Pet. 23 (citing Ex. 1016 ¶ 80). Petitioner contends that "[i]t would have been obvious to practice this limitation in view of additional examples in Sigurdsson, which teach or suggest receiving Client A content at Server 106 and automatically transferring the content to Client B, C, or any other client." *Id.* (citing Ex. 1016 ¶ 68; Balakrishnan Decl. ¶¶ 521–523). Petitioner contends further that "[a person of ordinary skill] would have been motivated to use these teachings and Server 106 to automatically transfer the modified first electronic file copy (e.g., maintenance manual) to the third electronic device (Client C)." *Id.* at 24 (citing Balakrishnan Decl. ¶¶ 521–525) (internal quotation marks and emphases omitted).

Petitioner contends also that "[i]t would have been obvious in view of Sigurdsson that the first electronic file could be received and stored on the third electronic device." Pet. 25 (citing Ex. 1016 ¶ 81) (internal quotation marks and emphases omitted). Also, "[i]t would have been obvious in view of Sigurdsson in combination with Shappell 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." *Id.* at 26–27 (citing Balakrishnan Decl. ¶¶ 527–533) (internal quotation marks and emphases omitted).

Petitioner contends it would have been obvious to combine Sigurdsson and Shappell: "It would have been obvious to combine Sigurdsson with Shappell's teachings, predictably resulting in Sigurdsson's system where a modified file received from an originating client is automatically forwarded to a receiving client after receipt of the file at

Server 106, to replace an older version of the file stored at the receiving client." *Id.* at 30. Petitioner explains that "[t]he combination would have straightforwardly combined prior art elements according to known techniques." *Id.* Petitioner continues that the combination would "predictably improve Sigurdsson's system in the same way the relevant features enhance Shappell's disclosed systems." *Id.* (citing Balakrishnan Decl. ¶¶ 183, 533).

Patent Owner's response to this challenge to claim 1 focuses mainly on claim limitation 1d, and, to a lesser degree, claim limitation 1e. PO Resp. 12–19. These arguments by Patent Owner will be discussed *infra*.

f) Limitation 1e

Petitioner's analysis of this limitation refers back to claim limitations 1c and 1d. Pet. 31–32. Petitioner contends that "[f]or the reasons discussed above in connection with claims [1c] and [1d], it would have been obvious to automatically transfer the modified second electronic file copy (small office memo) from the server, via the server's first application, to Client A (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." *Id.* at 31 (citing Balakrishnan Decl. ¶¶ 534–535) (internal quotation marks and emphases omitted).

g) Limitation 1f

To meet this limitation, Petitioner relies on Sigurdsson. Pet. 32–33. Petitioner explains that "Sigurdsson discloses that the second application (e.g., the HTTPS Client/server on Client A) may automatically transfer[] 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." *Id.* at 32 (citing Balakrishnan ¶¶ 536–537) (internal quotation marks and emphases omitted) (alteration in original).

h) Discussion.

Patent Owner's response to Petitioner's claim 1 analysis for this challenge focuses on the "automatic transfer" recitation in limitation 1d: "wherein the first application is further configured to *automatically transfer* the modified first electronic file copy to the third electronic device." Ex. 1001, 10:62–64 (emphasis added); PO Resp. 12–19. Patent Owner contends that "[t]he Petition fails to give proper weight to 'automatically transfer,' and instead of considering the disclosure of Sigurdsson as a whole, or even the full description of the relied-upon embodiment in Sigurdsson, improperly relies on select sentences taken out of context while ignoring the principal structure and operations taught by Sigurdsson." PO Resp. 12. Patent Owner contends that "[t]here is no dispute that the transfer Sigurdsson describes in step 626 of FIG. 6 is not automatic from the perspective of the server." *Id.* at 13. Patent Owner further explains, "[t]his is because the transfer of missing content from Server 106 to Client C is initiated by a request from Client C for a list of missing content in step 612 and a request for the missing content in step 620." *Id.*

Petitioner responds that Patent Owner's arguments "rely heavily on an erroneously narrow claim construction of 'automatically' transferring files." Pet. Reply 4. More specifically, Petitioner asserts Patent Owner's claim construction "incorrectly assumes this automatic transfer requires 'push-

based functionality.'" *Id.* We agree with this argument by Petitioner. We find that Patent Owner's analysis relies on a construction of "automatic" that we have rejected. *See* Section IV.C, *supra*. Specifically, Patent Owner argues that "[w]hile it is true that Sigurdsson discloses that the Server 106 can transmit the content to the remaining client peers, such as the Clients B and C, Sigurdsson is clear that this transmission of the content by the server 106 is performed only after receiving a request for the missing content from the Clients B and C." PO Resp. 18 (citing Shenoy II Decl. ¶ 10). We determined *supra*, however, that neither the language of the claims nor the specification of the '561 patent supports this narrow construction of "automatically transfer" as permitting a "pull" but not a "push." *See supra*, Section IV.C. We have rejected this construction and, therefore, we find that under a proper construction of "automatically," for the reasons given by Petitioner and summarized above, Petitioner has demonstrated that claim limitation 1d is taught by Sigurdsson and determine that claim 1 would have been obvious over Sigurdsson and Shappell.

We have considered Dr. Shenoy's testimony on limitation 1d and do not find it convincing because it also is based on Patent Owner's rejected claim construction for "automatically." For example, Dr. Shenoy testifies that "Sigurdsson requires a server to receive a request from a client device before the server transmits missing content to the client device." Shenoy II Decl. ¶ 137. Dr. Shenoy further testifies that Sigurdsson does not disclose "automatically" sending the modified file to a third electronic device because "Sigurdsson describes that its system is implemented as an HTTP client/server operating based on request/response process." *Id.* Dr. Shenoy

further testifies that "[a]n HTTP protocol did not support push-based functionality at the time of the invention. Therefore [an ordinarily skilled artisan] would not read Sigurdsson as disclosing 'automatically sending the modified first electronic file copy to the third electronic device.'" *Id.* This analysis by Dr. Shenoy is contrary to our construction of "automatically," and therefore we do not credit it. *See* Section IV.C, *supra*.

Even under Patent Owner's construction of "automatically," however, we would disagree with Patent Owner's argument that Sigurdsson does not teach or suggest the automatic transfer of a modified file from the server to a third electronic device. Pet. Reply 10–12 (citing Balakrishnan Reply Decl. ¶¶ 62–63, 65–66, 70). We find that Sigurdsson expressly teaches the transfer of a modified file from its server 106 to its Client C (the third electronic device) in its description of step 626 and of the "alternative embodiment of step 606" in the sequence diagram of Figure 6. *See* Ex. 1016 ¶¶ 68, 80, Fig. 6. Referring to Figure 6, Sigurdsson discloses that "[i]n 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." Ex. 1016 ¶ 80. Similarly, with the alternative embodiment of step 606, "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*." *Id.* ¶ 68 (emphasis added). We find that this describes an automatic transfer from Server 106 to Client C even with Patent Owner's construction of automatically. *See* Pet. Reply 10–12; Balakrishnan Reply Decl. ¶¶ 46, 50, 62. The user devices in Sigurdsson include both an HTPPS client and an

HTTPS server. Balakrishnan Reply Decl. ¶¶ 35, 86 (citing Ex. 1016, Fig. 3, ¶ 47). This means that Sigurdsson's sever has an HTPPS client that can effectively push data to user devices. *Id.* ¶¶ 35–36, 62–63; Ex. 1016, Fig. 3, ¶¶ 31, 47, 68. We credit Dr Balakrishnan's testimony that thus a person of ordinary skill would understand that Sigurdsson teaches or suggests the use of an HTTPS client in server 106 to automatically push content from server 106 to an HTTPS server in Client B or Client C, i.e., without any request for such content. *See* Balakrishnan Reply Decl. ¶¶ 35–36, 62–63, 70.

Patent Owner argues that the transfer in step 626 is not automatic from the perspective of the server because Sigurdsson describes this transfer as being initiated by requests from Client C: a list of missing content in step 612 and a request for missing content in step 618. PO Resp. 13. We disagree. Sigurdsson does not describe the transfer of a modified file with the alternative embodiment of step 606 as resulting from any request from Client C. Ex. 1016 ¶ 68. Further, the step does not require a request from a client. Balakrishnan Reply Decl. ¶¶ 46–51, 62, 69–70. We credit Dr. Balakrishnan's testimony that HTTPS servers at the relevant time could have implemented push-based data/file transfers to clients. *Id.* ¶ 63 (citing Ex. 1041 (IETF HTTP/1.1) § 9.5 (dated June 1999)). We therefore disagree with Patent Owner's arguments distinguishing Sigurdsson as not disclosing automatic transfers under Patent Owner's construction.

Sigurdsson describes other automatic transfers of files from computers to clients, for example, client-to-client transfers. Ex. 1016 ¶ 31 ("When the Client A 102 (e.g., the user's home computer) connects to the Server 106, Client B Content 112 originating from the Client B 104 is automatically

copied to the Client A 102, as indicated by arrow 116. . . . Similarly, whenever the Client B 104 (e.g., the user's work computer) connects to the Server 106, any missing Client A Content 108 is copied automatically to the Client B 104, as indicated by arrow 118."). This description also suggests making the transfer of files from server 106 to Client C automatic. Balakrishnan Decl. ¶ 525 ("It would have been obvious in view of these disclosures to automatically transfer a modified file received from Client A *to Server 106*, and *then automatically transfer* the modified file, via an 'open connection,' *to Client C* as soon as the file is received at the server," emphases added); Balakrishnan Reply Decl. ¶¶ 61, 66.

Dr. Balakrishnan testifies that "[i]t would have been obvious to use Server 106 to automatically send the modified first electronic file copy responsive to receiving the file copy from the second electronic device." Balakrishnan Decl. ¶ 522 (emphasis omitted). He explains that "[a person of ordinary skill] would have understood and found it obvious that Sigurdsson's reference to 'synchroniz[ing]' content stored on and shared between clients would have encompassed using the Synchronization Manager to automatically send, via the first application, the modified first electronic file copy to a third electronic device responsive to receiving the modified first electronic file copy from the second electronic device." *Id.* (alteration in original). He further testifies that "Sigurdsson explains that Client A content received at the Server could be automatically transferred by the Server to Client B, C, or any other client." *Id.* ¶ 523 (citing Ex. 1016 ¶ 68).

Finally, we find that Shappell's disclosure of "automatic replication" in combination with Sigurdsson would teach or suggest a system where a modified file received from an originating client is automatically forwarded to a receiving client after receipt of the file at Server 106. Pet. 26–30; Pet. Reply 14–15; Balakrishnan Decl. ¶¶ 527–533; Balakrishnan Reply Decl. ¶¶ 73–79. We further find, for the reasons given by Petitioner, including those summarized *supra*, that a person of ordinary skill would have combined the teachings of Sigurdsson and Shappell with a reasonable expectation of success. *See* Pet. 30–31; Pet. Reply 15–16; Balakrishnan Decl. ¶¶ 527–529; Balakrishnan Reply Decl. ¶¶ 75–79.

We have considered Dr. Shenoy's testimony on the teachings of Sigurdsson and Shappell, but do not find the testimony convincing because it is based on Patent Owner's rejected claim construction for "automatically." For example, Dr. Shenoy testifies that "Sigurdsson describes an embodiment in which Client C obtains missing content from a server 106. But that embodiment requires Client C to expressly request the missing content." Shenoy I Decl. ¶ 31. He concludes that "[t]herefore, in Sigurdsson, the server does not automatically transfer a modified first electronic file copy to the receiving device, such as Client C, since it only transfers the missing content when the receiving device expressly requests it." *Id.*; *see also* Shenoy II Decl. ¶ 50. This analysis by Dr. Shenoy is contrary to our construction of "automatically" and therefore we do not find it persuasive. *See* Section IV.C, *supra*.

Further, we do not agree with Patent Owner's "teaching away" argument directed to Shappell, which is advanced to demonstrate lack of a motivation to combine Shappell with Sigurdsson. PO Resp. 36–38. Patent Owner contends that because Shappell discloses a peer-to-peer network, it teaches away from Sigurdsson's use of a server. *Id.* Patent Owner does not dispute that "a reference does not teach away if it merely expresses a general preference for an alternative invention but does not criticize, discredit or otherwise discourage investigation into the invention claimed." *UCB, Inc. v. Actavis Lab'ys UT, Inc.*, 65 F.4th 679, 692 (Fed. Cir. 2023) (internal quotation marks omitted). Instead, Patent Owner contends that Shappell, in contrast to Sigurdsson, discloses "a computer implemented method and system enable users to share files in a *server-less* shared space." PO Resp. 37.

Patent Owner's argument is not persuasive. As the Federal Circuit has made clear, "that 'better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes.'" *Bayer Pharma AG v. Watson Lab'ys, Inc.*, 874 F.3d 1316, 1327 (Fed. Cir. 2017) (quoting *In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012)); *see also In re Haase*, 542 F. App'x 962, 969 (Fed. Cir. 2013) (determining that a reference did not teach away from using an aluminum polymer with an ammonium polymer just because the reference "show[ed] better turbidity results when using an aluminum polymer by itself"). Shappell itself states that "the type of network . . . is not critical," and is only "*preferably* a peer-to-peer network." Ex. 1020 ¶ 40 (emphasis added). We find that the mere fact that Shappell discloses a peer-to-peer system would not necessarily discourage a

person of ordinary skill from modifying Sigurdsson's server in light of Shappell's automatic replication feature, especially in view of Shappell's statement that the type of network is "not critical." *See* Balakrishnan Reply Decl. ¶¶ 76–78. We further find, as stated by Dr. Balakrishnan, that a person of ordinary skill "would not have been dissuaded by anything in Shappell from synchronizing files of the same user across multiple user devices as taught in Sigurdsson, particularly in view of Sigurdsson's explanation of the obvious benefits of keeping a user's files synchronized across multiple user devices, such as a user's home and work computers." Balakrishnan Reply Decl. ¶ 80.

Similar to claim limitation 1d, claim limitation 1e requires automatic transfer of a modified electronic file by a first electronic device. Patent Owner's analysis does not distinguish this limitation from limitation 1d. For the reasons given for limitation 1d, Petitioner's arguments as to limitation 1e are persuasive. We find that limitation 1e is taught or suggested by Sigurdsson and Shappell. *See* Balakrishnan Decl. ¶¶ 534–535.

Patent Owner contends that claim 1 "expressly requires the second electronic device and the third electronic device to be associated with the same user." PO Resp. 40 (emphasis omitted). Patent Owner asserts that Petitioner relies on Shappell for this "same user" teaching, and that Shappell, "when considered as a whole, overwhelming teaches a peer-to-peer system for sharing files among group members." *Id.* at 40–41. Petitioner responds that "the Petition relies on Sigurdsson (not Shappell) for file transfer among multiple devices associated with the same user (e.g., 'home computer,' 'work computer,' 'mobile device,' and server that authenticates the user)."

Pet. Reply 17–18 (citing Pet. 17–18, 27–29). Referring to Figure 4 of Sigurdsson, the Petition states: "Clients A, B, and C are associated with *the same user*." *Id.* at 18 (emphasis added); *see also* Balakrishnan Decl. ¶ 505 (citing Ex. 2016 ¶ 2, 58). Patent Owner's argument focuses on Shappell and does not address these citations to Sigurdsson by Petitioner. For the reasons given by Petitioner, we find that Sigurdsson teaches or suggests the "same user" limitation.

Patent Owner does not challenge Petitioner's analysis of other limitations of claim 1 for this ground, and we are persuaded by Petitioner's showing that the combination of Sigurdsson and Shappell teaches or suggests each of those limitations

i) Conclusion – Claim 1

For the reasons given, we find that the Petition demonstrates by a preponderance of evidence that the combination of Sigurdsson and Shappell teaches or suggests each limitation of claim 1 and that a person of ordinary skill would have combined the references as described with a reasonable expectation of success. Accordingly, we determine that Petitioner has demonstrated by a preponderance of evidence that claim 1 would have been obvious in light of Sigurdsson and Shappell.

2. Claim 8

Petitioner states that "Claim 8, is substantially similar to claim 1 except for the preamble." Pet. 35. Petitioner's obviousness analysis of this claim relies on its analysis of claim 1. *Id.* Petitioner's analysis concludes that the claim would have been obvious in light of Sigurdsson and Shappell. *Id.* at 35–36; Balakrishnan Decl. ¶¶ 544–548.

Claim limitation 8c is similar to limitation 1d and includes the "automatically transferring" limitation. Ex. 1001, 12:14–18. Patent Owner does not provide a separate analysis for this limitation in claim 8, but instead refers to arguments directed to claim limitation 1d discussed *supra*. PO Resp. 11–12.

For the reasons given for claim 1, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 8 would have been obvious in light of Sigurdsson and Shappell. Pet. 35–38. The Petition demonstrates that this combination of references teaches or suggests each limitation of the claim and that a person of ordinary skill would have combined the references as described with a reasonable expectation of success. *Id.*; Balakrishnan Decl. ¶¶ 544–548.

3. Dependent Claims 4 and 11

Claim 4 depends from claim 1 and adds the limitation "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*." Ex. 1001. 11:17–21 (emphasis added). Claim 11 depends from claim 8 and contains a similar limitation: "the second electronic device is not in communication with the electronic system." *Id.* at 12:29–32.

Petitioner contends that these similar limitations are met by Sigurdsson. Pet. 34–35 (claim 4), 37–38 (claim 11); Balakrishnan Decl. ¶¶ 541–543, 550. Dr. Balakrishnan refers to Sigurdsson's disclosure that in some embodiments, content is sent to the server for temporary storage when

a client is off-line and unable to receive it. Balakrishnan Decl. ¶ 543 (citing Ex. 1016 ¶ 66).

Referring to page 34 of our Institution Decision, where we discuss Figure 6 of Sigurdsson, and specifically the alternative embodiment of paragraph 68, Patent Owner responds that "[i]n giving a hypothetical example where a client (e.g., Client C) would not send a request to the sever to initiate the transfer, the Board considers the situation where the client (Client C) is not offline when the transfer is to occur." PO Resp. 20 (citing Institution Dec. 34). Petitioner in turn responds that Patent Owner "incorrectly asserts that claims 4 and 11 would not have been obvious over Sigurdsson and Shappell because Sigurdsson's ¶ 68 does not address the situation where Client C is offline." Pet. Reply. 17. Petitioner explains that "the Petition relies primarily on Sigurdsson ¶ 66." *Id.* (citing Pet. 34–35, 37–38). Citing testimony from Dr. Balakrishnan, Petitioner contends that "a [person of ordinary skill] would have found it obvious to send content from a source client to Server 106, store the content at Server 106, and then send the content from Server 106 to Client C after it comes back online using the steps in ¶¶ 69-81." *Id.* at 18 (citing Ex. 1016 ¶¶ 69–81, Balakrishnan Reply Decl. ¶¶ 56–60). We find Petitioner's argument is well-supported by expert testimony from Dr. Balakrishnan as well as Sigurdsson's extensive teachings of using Server 106 as a drop box when a destination client is off-line. *See id.* (citing Ex. 1016 ¶¶ 27, 51, 62; Balakrishnan Reply Decl. ¶¶ 71–73). We therefore determine for the reasons given that Petitioner has demonstrated by a preponderance of the evidence that claim 8 would have been obvious over Sigurdsson and Shappell. *See* Pet 35.

4. Dependent Claims 3 and 10

Claim 3 depends from claim 1, and claim 10 depends from claim 8. Claim 3 recites "The system of claim 1 wherein the first application is configured to store the modified first electronic file copy to a memory device associated with the first electronic device." Ex. 1001. 11:14–16. Claim 10 is similar. *Id.* at 12:26–28. Petitioner provides analyses for each of these dependent claims. Pet. 33–34, 37. Patent Owner does not separately respond to the dependent claims.

For the reasons given *supra* for claims 1 and 8, and for those presented in the Petition, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 3 and 10 would have been obvious in light of Sigurdsson and Shappell.

5. Conclusion – Sigurdsson and Shappell

In sum, after considering the arguments presented in the parties' submissions, including the Petition and Patent Owner's responses, we determine that, for the reasons given, Petitioner has demonstrated that claims 1, 3, 4, 8, 10, and 11 would have been obvious over Sigurdsson and Shappell.

F. Obviousness of Claims 1, 3, 4, 8, 10, and 11 Based on Brown and Hesselink

1. Claim 1

Petitioner asserts that claim 1 would have been obvious in light of Brown and Hesselink. Pet. 38–59. Petitioner provides an element-by-element claim analysis, supported by expert testimony. *See id.*; Balakrishnan Decl. ¶¶ 601–611, 867–907; Balakrishnan Supp. Decl. ¶¶ 134–

176. For the reasons that follow, we find that Petitioner demonstrates that each limitation of claim 1 is met by Brown and Hesselink.

a) Preamble

Petitioner shows that the preamble of claim 1 is disclosed in Figure 1 of Brown, reproduced in Section IV.D.3, *supra*. Pet. 38 (citing Balakrishnan Decl. ¶¶ 577–580).

b) Limitations 1a–1c

For limitation 1a, Petitioner identifies server 105 in Brown as the claimed "first electronic device," and the Synchronization File System ("SFS") as the claimed "first application." Pet. 39 (emphasis omitted). Petitioner identifies client 130 as an "exemplary" "second client device" and client 135 as an "exemplary" "third client device." *Id.* at 40 (emphasis omitted).

For claim limitation 1b, Petitioner relies on Brown and Hesselink. Pet. 41–45. Petitioner explains that "Brown describes in detail an exchange of metadata information between client 130 and server 105 to determine file changes on the client and server." Pet. 41–42 (citing Ex. 1025, Figs. 4A–4C, 5, 8A–11F, 10:7–9, 10:7–11:52, 11:64–66, 13:57–16:39; Balakrishnan Decl. ¶ 877). Petitioner explains further that "Brown also teaches that client 130's SA may monitor activity in its local file system to identify modified files to send to the server." *Id.* (citing Ex. 1025, 3:47–50).

Petitioner explains that "Brown discloses that such synchronization of modified files may be performed 'automatically' using the client's SA to transfer modified files to the server." Pet. 43 (citing Ex. 1025, 3:40–47) (emphasis omitted). Petitioner adds that "it would have been obvious in

view of Brown in combination with Hesselink to automatically receive a copy of a modified file from client 130 at server 105 when the user modifies the file." *Id.* (citing Balakrishnan Decl. ¶¶ 884–891). Petitioner contends further that "[i]t would have been obvious to combine the teachings of Brown and Hesselink, predictably resulting in the synchronization system of Brown in which the scheduling algorithm causes the upload of a modified file from a user device responsive to the user modifying the file as taught by Hesselink." *Id.* at 45–46 (citing Balakrishnan Decl. ¶¶ 601, 891).

For claim limitation 1c, Petitioner asserts "[i]t would have been obvious to implement the functionality performed by client 130 in claim [1b] but instead using client 135 (third electronic device) and client 135's SA (a third application executable on the third electronic device) to automatically transfer a copy of a second electronic file to the server when the file is modified." Pet. 52–53 (citing Balakrishnan Decl. ¶¶ 892–894) (internal quotation marks and emphases omitted).

c) Limitation 1d

For claim limitation 1d, Petitioner relies on Brown and Hesselink. Pet. 55–57. Petitioner asserts that "[a person of ordinary skill] would have found it obvious to 'automatically' send the modified first electronic file copy to laptop client 135, particularly in view of Hesselink's teachings discussed above for claim 1[b] regarding automatically and immediately forwarding file updates to all synchronizing clients." *Id.* at 55 (citing Balakrishnan Decl. ¶¶ 898–902) (emphasis omitted).

d) Limitations 1e–1f

For claim limitation 1e, Petitioner explains that "[f]or the reasons discussed above for claim [1c], Brown's clients operate similarly and interchangeably." Pet. 57. For claim limitation 1f, Petitioner relies on Brown and Hesselink and explains "it would have been obvious to use client 130's SA (second application) to practice this limitation by detecting file save operations using the SA and automatically transferring modified/saved files in response to detection of such operations." *Id.* at 57–58 (citing Balakrishnan Decl. ¶¶905–907) (internal quotation marks and emphases omitted).

e) Discussion

Patent Owner contends that the combination of Brown and Hesselink does not disclose the following from claim limitation 1d: "automatically transferring the modified first electronic file copy to the third electronic device." PO Resp. 42–52. Patent Owner does not discuss further the automatic transfer feature of other claim limitations such as 1e.

Patent Owner repeats its previous claim construction argument distinguishing "push" transfer processes that it contends are "automatic" from "pull" processes that it contends are not "automatic." PO Resp. 44–45. Patent Owner asserts that "the claims of the '561 Patent adopt a push-based file transfer from the server to the client, thus allowing the server to send the modified file to the client without a need for the client to explicitly request it." *Id.* at 45 (emphasis omitted). Patent Owner continues, "Brown discloses the completely opposite method, that is, <u>client pull</u>." *Id.* Dr. Shenoy's

analysis is similar. *See, e.g.*, Shenoy I Decl. ¶ 49 ("Brown discloses a 'pull' based file transfer from the server to the client.").

Particularly, in our consideration of claim construction, we expressly rejected a construction limiting the '561 patent claims to "push" transfer operations. *See* Section IV.C. We also rejected the argument that the claims must be viewed as "automatic from the perspective of the server." *See id.*; PO Resp. 7–8. In essence, this argument is a variation of Patent Owner's contention that the server must unilaterally initiate file transfers, without receiving communication from another device. Thus, the core of Patent Owner's analysis of this ground and of Dr. Shenoy's testimony is based on a rejected claim construction and for this reason must fail. *See* PO Resp. 42–52. Patent Owner's arguments are unavailing for additional reasons. Brown discloses that "[f]rom the user's perspective, the synchronization process is automatic, runs in the background and requires minimal monitoring or intervention." Ex. 1025, 3:40–42. Thus, Brown discloses that its server automatically transfers files even under Patent Owner's definition. *See also* Pet. 43–45; Balakrishnan Reply Decl. ¶¶ 155–156.

Patent Owner does not address the combination of Brown and Hesselink relied on by Petitioner. Instead, Patent Owner addresses the references separately. For example, Patent Owner argues that Hesselink "neither teaches or suggests that a server is configured to automatically update other computers on the network, only that 'the system' is configured to do so." PO Resp. 46 (citing Ex. 1026 ¶ 183) (emphases omitted). Petitioner responds that Patent Owner's argument does not "directly rebut" the combination of Brown and Hesselink because Petitioner relies on "[t]he

modified Brown server, configured to receive a modified file from one user device and immediately push it to another user device." Pet. Reply 19. We agree with Petitioner and find for the reasons given that this combination "satisfies" Patent Owner's claim interpretation for "automatic." *Id.*

Similarly, Patent Owner contends that "Hesselink only discusses the pull-based synchronization throughout its disclosure." PO Resp. 47. But, as Petitioner points out, Petitioner relies on "Brown's server synchronizing files between multiple user devices, obviously modified based on Hesselink's teachings and motivation to receive a modified file from one user device and immediately transfer it to another user device." Pet. Reply 20. In addition to relying on a rejected claim construction, Patent Owner's argument that this ground fails to show "automatic" file synchronization does not take into account Brown's explicit disclosure that its server pushes changes down to syncing clients. *Id.* (citing Ex. 1025, 5:36–38). We, therefore, agree with Petitioner that "[t]he modified Brown server, configured to receive a modified file from one user device and immediately push it to another user device, indisputably satisfies [Patent Owner's] claim interpretation." *Id.* (citing Balakrishnan Reply Decl. ¶¶ 134–157).

Referring to the preamble of claim 1, Patent Owner argues that "each of the [claimed] first electronic device, the second electronic device, and the third electronic device are all associated with a user, *i.e.*, the same user." PO Resp. 52. Patent Owner asserts that Hesselink fails to disclose this limitation. *Id.* at 52–56. We do not agree with Patent Owner's "same user" argument. As Petitioner points out, the Petition relies on Brown, not Hesselink, for the "same user" teaching. Pet. Reply 21; Pet. 40 ("Brown

teaches that clients 130 and 135 are 'each associated with a user.'") (emphasis omitted). We find, for the reasons given by Petitioner, that Brown discloses file synchronization among multiple devices associated with the same user and therefore meets this limitation. *See* Pet. Reply 21; Pet. 40–41 (citing Ex. 1025, 4:62–64; 11:55–56; Balakrishnan Decl. ¶ 871).

Petitioner contends it would have been obvious to modify Brown in light of Hesselink to "automatically transfer the modified first electronic file copy to the third electronic device," as is recited in limitation 1d. Pet. 55 (citing Balakrishnan Decl. ¶¶ 896–898) (emphasis omitted). Patent Owner challenges this contention, arguing that because "Brown aims to minimize the load on the server processor," this change would "fundamentally and impermissibly change the principle of operation of Brown from a pull type synchronization system to a push type synchronization system." PO Resp. 57–58. This, like Patent Owner's other arguments, relies on a rejected claim construction. Beyond that, however, it is wrong as a matter of law. As the Federal Circuit has made clear, "The fact that the motivating benefit [from combining references] comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another." *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000). Here, the additional burden on the server would be minimal because numerous functions performed by Brown's clients would still be performed by Brown's clients in the combination. Balakrishnan Reply Decl. ¶ 171; Ex. 1025, 3:22–26. In addition, there would be clear advantages to modifying Brown's system,

such as quick and efficient synchronization. Balakrishnan Reply Decl. ¶170–171.

We are not persuaded by Patent Owner's argument based on the discussion of HTTP requests in Hesselink. PO Resp. 51–52 ("[T]he HTTP protocol is a request-response protocol and the HTTP servers use the client-pull architecture.") (emphasis omitted). Not only is this argument contrary to our claim construction, but it is also contrary to the disclosures of Brown and Hesselink that other protocols besides HTTP can be used to transfer files. *See* Pet. Reply 20–21 (citing Ex. 1025, 3:1–5; Ex. 1026 ¶ 75). Further, we credit Dr. Balakrishnan's testimony that two of Hesselink's embodiments expressly contemplate using HTTP to effectively push data from a source client to a server and then from the server to a destination client. Balakrishnan Reply Decl. ¶ 141.

Finally, we address Patent Owner's "teaching away" argument based on Hesselink's peer-to-peer architecture. PO Resp. 58–60. Patent Owner argues that Hesselink teaches away from using server/client configurations taught by Brown because "Hesselink raises security concerns in using server/client architecture for file synchronization." *Id.* at 58–59. We do not find this argument persuasive. Patent Owner's arguments do not meet the test for a teaching away. As discussed *supra*, in Section IV.E.1, "that 'better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes.'" *Bayer Pharma AG*, 874 F.3d at 1327 (Fed. Cir. 2017). For the reasons given by Petitioner, we find that Hesselink does not teach away from client-server architectures, but at best describes a peer-to-peer alternative. *See* Pet. Reply 24–25.

For similar reasons, we find that Patent Owner's related argument that "a [person of ordinary skill] would not have looked to Hesselink's peer-to-peer system to modify Brown's server" is unavailing. *See* PO Sur-reply 24; PO Resp. 58–62. We are persuaded by Petitioner's argument that a person of ordinary skill would recognize that Hesselink's teachings of automatically updating a peer-to-peer connection between two computers would also apply to a client/server architecture. Pet. Reply 24–25. The Federal Circuit instructs that "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Intel Corp. v. PACT XPP Schweiz, AG*, 61 F.4th 1373, 1380 (Fed. Cir. 2023) (quoting *KSR*, 550 U.S. at 417).

We are not persuaded by Patent Owner's argument that *Intel* is inapplicable here because Brown and Hesselink address different problems. PO Resp. 61. As Patent Owner recognizes, both Brown and Hesselink have as a goal synchronizing data on a user's multiple computing systems (e.g., office and home). *Compare* Ex. 1025, 1:25–29, 1:47–55, *with* Ex. 1026 ¶ 8. We find that they are directed to solving the same problem.

As noted *supra*, claim limitation 1e requires automatic transfer of a modified electronic file by the first electronic device. For this limitation, Patent Owner does not present a separate argument.

In sum, for the reasons given, we find that the Petition demonstrates by a preponderance of evidence that the combination of Brown and Hesselink teaches or suggests each limitation of claim 1 and that a person of

ordinary skill would have combined the references as described with a reasonable expectation of success. We have considered Patent Owner's arguments and find them lacking for the reasons given. We further determine that Petitioner has demonstrated by a preponderance of evidence that claim 1 would have been obvious in light of Brown and Hesselink.

2. Claim 8

Petitioner's obviousness analysis of this claim relies on its analysis of claim 1. Pet. 63. Petitioner's analysis concludes that the claim would have been obvious in light of Brown and Hesselink. *Id.*; Balakrishnan Decl. ¶¶ 913–915.

Patent Owner does not address claim 8 in its response to this ground.

For the reasons given by Petitioner, we determine that Petitioner has demonstrated by a preponderance of the evidence that claim 8 would have been obvious in light of Brown and Hesselink.

3. Dependent Claims 3, 4, 10, and 11

Petitioner provides analyses for each of these dependent claims. Pet. 59–64; Balakrishnan Decl. ¶¶ 908–912, 916–917. Patent Owner does not address these claims in its Response.

For the reasons given, we determine that Petitioner has demonstrated by preponderance of the evidence that claims 3, 4, 10, and 11 would have been obvious in light of Brown and Hesselink.

4. Conclusion – Brown and Hesselink

In sum, after considering the arguments presented in the parties' submissions, including the Petition and Patent Owner's responses, we

determine that, for the reasons given, Petitioner has demonstrated that claims 1, 3, 4, 8, 10, and 11 would have been obvious over Brown and Hesselink.

V. CONCLUSION

For the foregoing reasons, we have determined that Petitioner has demonstrated by a preponderance of the evidence that the challenged claims of the '561 patent are not patentable. In summary,

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not shown Unpatentable
1, 3, 4, 8, 10, 11	103(a)	Sigurdsson, Shappell	1, 3, 4, 8, 10, 11	
1, 3, 4, 8, 10, 11	103(a)	Brown, Hesselink	1, 3, 4, 8, 10, 11	
Overall Outcome			**1, 3, 4, 8, 10, 11**	

VI. MOTION TO SEAL

The parties have filed a Joint Motion to Seal. Paper 58. The Motion requests sealing a portion of page 4 of our Decision Denying Patent Owner's Motion to Amend the Protective Order. Paper 54 ("Decision"). The parties have submitted a redacted public version of that Decision. Paper 57.

Petitioner contends that the "redacted content on page 4 of the Decision are portions of confidential materials that have been previously filed and maintained under seal in this proceeding relating to confidential joint-defense and attorney-client relationships," and "[h]ence the Petitioners respectfully request sealing of this content." Paper 58 at 3. The Motion to Seal is not opposed.

We have reviewed the Motion and the document at issue and have considered Petitioner's explanation of the confidential nature of the materials for which sealing is sought. We find there is good cause and therefore we grant the motion to seal.

VII. ORDER

Upon consideration of the record before us, for the foregoing reasons, it is:

ORDERED that claims 1, 3, 4, 8, 10, and 11 of the '561 patent are not patentable;

FURTHER ORDERED that the Joint Motion to Seal (Paper 58) is granted;

FURTHER ORDERED that, no later than ten business days after the issuance of this Final Written Decision, the parties may file a joint motion to seal portions of this Decision, explaining why those portions should remain under seal, and including as an attachment a redacted version of this Decision that can be made publicly available;

FURTHER ORDERED that this Final Written Decision shall remain under seal until any joint motion to seal is resolved;

FURTHER ORDERED that this Final Written Decision shall be made public if, after the expiration of the time for the parties to file a joint motion to seal, no such motion has been filed; and

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.[14]

[14] Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this Final Decision, we draw Patent Owner's attention to the April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

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