

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.

IPR2023-00429
Patent 10,289,607 B2

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

GIANNETTI, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Box, Inc. and Dropbox, Inc. (“Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting *inter partes* review of claims 1, 3–5, 7, 12, 14, 17, 19, and 20 (the “challenged claims”) of U.S. Patent No. 10,289,607 B2 (Ex. 1003, “the ’607 patent”). Topia Technology, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply to Patent Owner’s Preliminary Response (Paper 9, “Prelim. Reply”), and Patent Owner filed a Sur-reply to Petitioner’s Preliminary Reply (Paper 13, “Prelim. Sur-reply”).

The Board has authority to determine whether to institute *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons stated below, we determine that Petitioner has not established a reasonable likelihood that it would prevail with respect to any claim challenged in the Petition. We, therefore, deny institution of *inter partes* review.

II. BACKGROUND

A. Related Matters

The parties identify the following district court proceedings involving the ’607 patent:

Topia Technology, Inc. v. Box, Inc., 6:21-cv-01372-ADA (W.D. Tex.)

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. 1; Paper 4, 1.

The parties identify the following related patents: U.S. Patent Nos. 9,143,561; 10,067,942; 10,642,787; 10,754,823; and 11,003,622. Pet. 1–2; Paper 4, 1–2.

The parties identify the following related *inter partes* review proceedings involving the related patents: IPR2022-00782, IPR2023-00427, IPR2023-00430, IPR2023-00431, IPR2023-00432, and IPR2023-00433.

Pet. 2; Paper 4, 3.

B. Real Parties-in-Interest

Petitioner identifies Box, Inc. and Dropbox, Inc. as the real parties-in-interest. Pet. 1. 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. Prelim. Resp. 1. For reasons discussed *infra*, we do not need to reach this issue in this proceeding.

Patent Owner identifies Topia Technology, Inc. as the real party-in-interest. Paper 4, 1.

C. The '607 Patent (Ex. 1003)

The '607 patent is titled “Architecture for Management of Digital Files Across Distributed Network.” Ex. 1003, (54). The '607 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 1:20–34, 4:46–51. Figure 2 of the '607 patent shows an embodiment of the invention and is reproduced below.

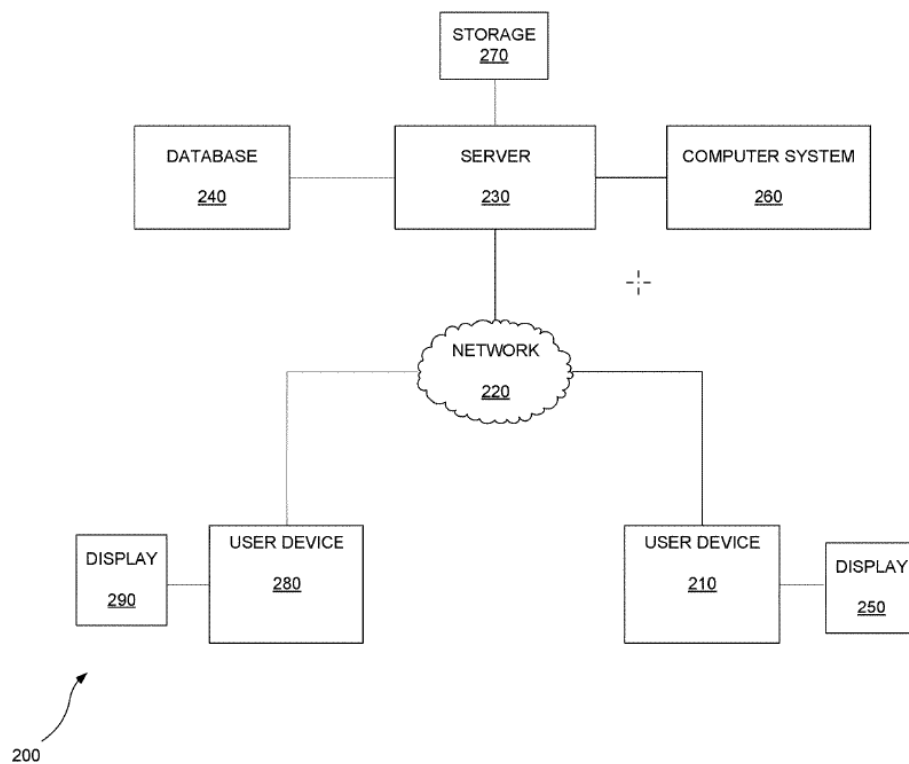


FIG. 2

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 7:23–29. 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 7:46–51. A file-transfer and/or synchronization application 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 7:62–8:12.

A file that the user desires to be synched or shared is uploaded by user device 210 and received by server 230. *Id.* at 8:13–15, 8:29–41. 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 8:23–26, 8:42–60. 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 8:26–28, 8:48–56. 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 8:60–64.

D. Illustrative Claim

The Petition challenges claims 1, 3–5, 7, 12, 14, 17, 19, and 20, of which claims 1, 12, 17, and 19 are independent. Claim 1 is illustrative of the claimed subject matter and is reproduced below:¹

1. [Preamble] A system comprising:

[1a] a server system comprising one or more processors
programmed with computer program instructions that, when
executed, cause the server to:

[1b] receive, over a network, a copy of a first file from a first
client device associated with a user, wherein the copy of

¹ References provided by Petitioner appear in square brackets. *See* Pet. App. A.

the first file is automatically received from the first client device responsive to the user modifying a content of the first file stored on the first client device, the copy of the first file being a version of the first file that is generated from the user modifying the content of the first file;

[1c] receive, from the first client device, first metadata associated with the version of the first file that is generated from the user modifying the content of the first file, the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file;

[1d] determine that the server system is not in communication with a second client device associated with the user;

[1e] store the copy of the first file on the server system;

[1f] automatically transfer the first metadata to the second client device based on the first priority being greater than the second priority such that the first metadata is transferred to the second client device prior to the copy of the first file being transferred to the second client device; and

[1g] automatically transfer, over a network, the copy of the first file to the second client device associated with the user to replace an older version of the first file stored on the second client device, responsive to (i) resuming communication with the second client device and (ii) receiving the copy of the first file from the first client device.

Ex. 1001, 10:58–11:25.

E. Prior Art References and Other Evidence

Petitioner relies on the following references (Pet. 4):

1. U.S. Patent Application Publication 2007/0174246 A1 (July 26, 2007) (Ex. 1016, “Sigurdsson”);

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

3. U.S. Patent Application Publication 2006/0190506 A1 (August 24, 2006) (Ex. 1019, “Rao”);

4. U.S. Patent 7,035,847 B2 (April 25, 2006) (Ex. 1025, “Brown”); and

5. U.S. Patent Application Publication 2005/0120082 A1 (June 2, 2005) (Ex. 1026, “Hesselink”).

In addition to these references, Petitioner relies on a Declaration of Dr. Ravin Balakrishnan. Ex. 1028 (“Balakrishnan Decl.”). Patent Owner has submitted a declaration of Prashant Shenoy, Ph.D. Exhibit 2013 (“Shenoy Decl.”).

F. The Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability. Pet. 4.

Claim(s) Challenged	35 U.S.C. §²	References
1, 3–5, 7, 12, 14, 17, 19, 20	103(a)	Sigurdsson, Shappell, Rao
1, 3–5, 7, 12, 14, 17, 19, 20	103(a)	Brown, Hesselink, Shappell, Rao

III. ANALYSIS OF THE CHALLENGED CLAIMS

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

² Because the earliest application from which the ’607 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).

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). At this stage, 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. 5–6 (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.* at 6 (citing Balakrishnan Decl. ¶¶ 17, 21).

Patent Owner does not provide a description of the person of ordinary skill.

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

Neither party proposes claim constructions for our consideration. Petitioner “do[es] not believe express claim construction is presently necessary.” Pet. 6. Petitioner indicates that in the pending litigation, Patent Owner proposes that no terms need construction and Petitioner proposes a construction for transferring a file “responsive to” a user modifying the file. *Id.* (citing Ex. 1027). According to Petitioner, that construction is satisfied by the grounds asserted by Petitioner in this proceeding. *Id.*

We construe claim terms only as relevant to the parties’ contentions and only 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). At this stage, we do not see the need to construe claim terms to resolve the issues in dispute.

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. 1006 ¶¶ 2, 4, 16. Figure 4 of Sigurdsson is reproduced below.

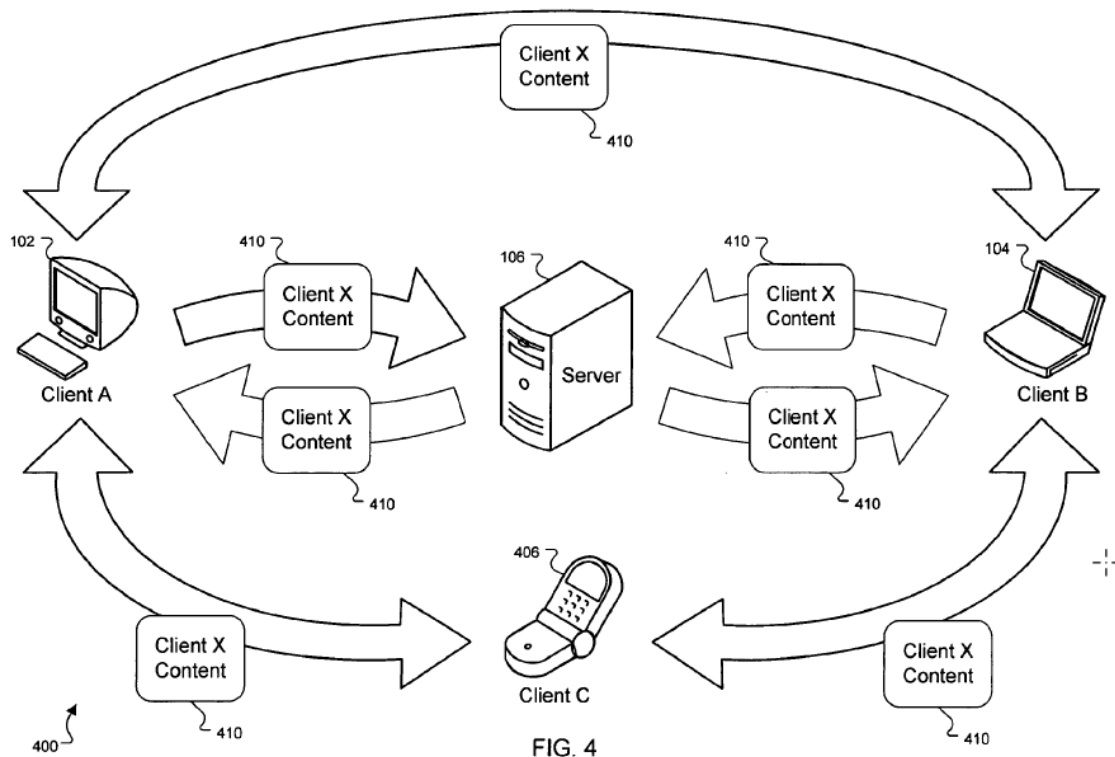


Figure 4 of Sigurdsson is a schematic showing system 400 for sharing and synchronizing content using a mixed peer-to-peer and client/server architecture. *Id.* ¶ 51. Server 106 is used to share content among Client A 102, Client B 104, and Client C 406, which may include, e.g., home computers, work computers, 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 his work computer. *Id.* ¶ 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. Each of Clients 102, 104 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. *Id.* ¶ 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. ¶ 62.

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. *Rao (Ex. 1019)*

Rao discloses synchronizing a database containing raw data and metadata in two phases. Ex. 1019 ¶ 63. In the first phase, metadata is synchronized between a server and client while the raw data remains on the server system. *Id.* In the second phase, selected raw data is synchronized to the client system. *Id.*

4. *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.

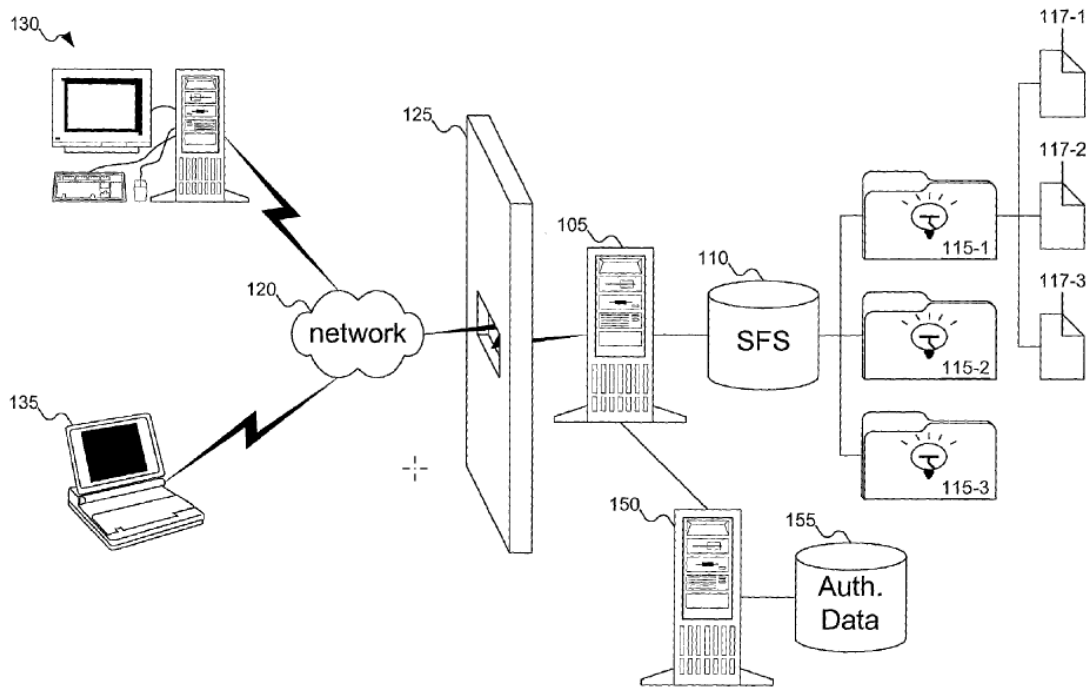


FIG. 1

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 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. *Id.* at 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.

5. *Hesslink (Ex. 1026)*

Hesslink 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, 3–5, 7, 12, 14, 17, 19, and 20 Based on Sigurdsson, Shappell, and Rao*

1. *Claim 1*

Petitioner asserts that claim 1 would have been obvious in light of Sigurdsson, Shappell, and Rao. Pet. 11–34. Petitioner provides an element-by-element claim analysis, supported by expert testimony. *See id.*; Balakrishnan Decl. ¶¶ 146–194, 224–225, 332–348. Petitioner contends that each limitation is met by Sigurdsson, Shappell, and Rao. *Id.*

Patent Owner responds that this challenge fails for two reasons:

(1) referring to claim limitation 1c, Patent Owner contends that Sigurdsson in view of Shappell and Rao does not disclose “the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file”; and (2) referring to claim limitation 1g, Patent Owner contends the same combination of references does not disclose “a server system configured to automatically transfer, over a network, the copy of the

first file to the second client device, responsive to receiving the copy of the first file from the first client device.” Prelim. Resp. 33–34.

a) Limitation 1c

Limitation 1c recites “receive, from the first client device, first metadata associated with the version of the first file that is generated from the user modifying the content of the first file, the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file.” Pet. App. A. Petitioner contends that this limitation is met by Sigurdsson with Shappell and Rao. *Id.* at 15–28.

Petitioner explains that Sigurdsson discloses “first metadata associated with the first file generated from the user modifying the content of the first file.” *Id.* at 15 (emphasis omitted). Petitioner asserts that in Sigurdsson, when a user modifies a file, metadata describing the content can be transmitted to Server 106 along with the file. *Id.*

Regarding the recitation in the claim of assigning priorities to the first metadata and the copy of the first file, Petitioner observes that in the ’607 patent, “[n]o affirmative assignment of priority values is described.” *Id.* at 17. Petitioner argues further that “Claim [1c] . . . does not recite that ‘the first metadata being assigned a first priority’ must be assigned its priority prior to the server system receiving that ‘first metadata.’” *Id.* Further, Petitioner asserts that “[u]nder any reasonable interpretation consistent with the specification, Sigurdsson in view of Shappell and Rao disclose and render obvious claims [1c], [1f], and 3.”³ *Id.* at 18 (emphases omitted).

³ Petitioner includes “priority-related limitation” 1f and dependent claim 3 under its discussion for limitation 1c. Pet. 17. Independent claims 12, 17,

Petitioner discusses two scenarios. In the first scenario, Petitioner relies on Sigurdsson alone, “if these limitations are interpreted to encompass a server system configured to receive metadata from a first device, and then automatically (not user-manually) transfer that metadata to a second client device.” *Id.* Petitioner explains under this scenario, Server 106 in Sigurdsson “receives from the first client device a file’s generated metadata *before* receiving the file, and then the server automatically transfers that metadata to a second client device *before* transmitting the file.” *Id.* (some emphases omitted).

According to Petitioner, Sigurdsson discloses a “priority algorithm” that “prioritizes the order in which files are transferred.” *Id.* at 18–19. Petitioner contends that “[a]s a result of the priority algorithm, Server 106 can first receive from the first client device the metadata associated with a low priority file that Server 106 has not received.” *Id.* (citing Ex. 1016 ¶ 72; Balakrishnan Decl. ¶ 170) (emphasis omitted).

Petitioner continues, “that metadata received by Server 106 is then transmitted by Server 106 to a second client device before Server 106 transfers the associated file.” *Id.* at 19 (emphasis omitted). According to Petitioner, when a client comes back online after a period of time requests a list of “missing content” from server 106, this request “configures Server 106 to prioritize transmitting the first metadata received from the first client device to the second client device before transmitting the file.” *Id.* at 20 (citing Balakrishnan ¶ 173) (emphasis omitted).

and 19 and dependent claim 3 include similar “priority-related limitations.” Prelim. Resp. 47. *See infra*.

Under the second scenario, where the claims “are interpreted to require affirmative, categorical assignment of greater/lesser priorities to metadata and files,” Petitioner relies on Sigurdsson with Shappell and Rao. Pet. 20–24. In this scenario Sigurdsson’s priority algorithm is “configured” to “categorically assign[] greater priority to metadata and lower priority to files, thereby causing metadata to transfer prior to the transfer of the associated files based on the greater priority.” *Id.* at 21 (citing Balakrishnan ¶ 176).

Petitioner contends that “Shappell teaches synchronizing files across multiple computers using metadata.” *Id.* at 22 (citing Ex. 1020 ¶ 9) (emphasis omitted). Petitioner contends that “Rao provides naturally complementary teachings to categorically prioritize synchronizing metadata before files between server and client, to advantageously enable functions at the client.” *Id.* at 24 (citing Balakrishnan ¶ 180) (emphasis omitted). Petitioner contends “[i]t would have been obvious to combine Sigurdsson with Shappell’s and Rao’s metadata-priority teachings, predictably resulting in Sigurdsson’s system where a priority algorithm at the first client and at Server 106 assigns a first, greater priority to metadata and lesser priority to files, resulting in the metadata transferring first (based on the first priority) before transferring associated files.” *Id.* at 24–25 (citing Balakrishnan Decl. ¶ 181).

Patent Owner responds that “Petitioner mischaracterizes the ‘priority algorithm’ in Sigurdsson.” Prelim. Resp. 47. Patent Owner continues, “the ‘priority algorithm’ in Sigurdsson is for prioritizing between the content that is to be synchronized and not for prioritizing between metadata and the content.” *Id.* Patent Owner concludes that “Sigurdsson does not teach or

suggest that ‘the first metadata being assigned a first priority greater than a second priority assigned to the copy of the first file.’” *Id.* (quoting limitation 1c) (emphasis omitted).

We agree with Patent Owner that Sigurdsson’s priority algorithm applies to prioritizing content for synchronization, but not to prioritizing metadata over content. More specifically, the “data items” discussed in Sigurdsson refer to files containing content, that is, a maintenance manual, digital photos, and an office memo. Ex. 1016 ¶ 58. Although Sigurdsson discloses that metadata, such as file size or age, can be used to set the priorities for the transmittal of the respective content files, there is no disclosure or suggestion in Sigurdsson that the priority algorithm is used to assign priorities to metadata, or to compare the assigned priorities of metadata and files, or to use a “priority algorithm” for assigning the priorities of metadata versus files. *See* Shenoy Decl. ¶ 130.

In Petitioner’s analysis, a client’s request for missing content “configures Server 106 to prioritize transmitting the first metadata received from the first client device to the second client device before transmitting the file.” Pet. 20 (emphasis omitted). At most, this disclosure suggests that under certain circumstances, Sigurdsson’s server software may send metadata before files. But there is no disclosure or suggestion in Sigurdsson that under this disclosure, there is an assignment of priorities to metadata, a comparison of the assigned priorities of metadata and files, or a “priority assignment configuration” used for assigning the priorities of metadata versus files.

Petitioner admits that without modification, Sigurdsson does not disclose “a predictable variation where the priority algorithm (priority

assignment configuration) in the system, configured on the first client and/or Server 106, categorically assigns greater priority to metadata and lower priority to files, thereby causing metadata to transfer prior to the transfer of the associated files based on the greater priority.” Pet. 21 (emphasis omitted). To support its argument for making this modification to Sigurdsson, Petitioner relies on Shappell and Rao. *Id.* at 20–28. Petitioner contends that Shappell “teaches prioritizing transfer of metadata for a modified file before transferring the file itself.” *Id.* at 20. Petitioner contends Rao teaches “categorical assignment of first and second ‘phases’ to transfer metadata before files between clients and server.” *Id.* We do not find these arguments persuasive.

As an initial matter, none of these references teaches or suggests an assignment of priority to metadata or a comparison of the priorities of metadata and files. Prelim. Resp. 47–49; Shenoy Decl. ¶¶ 130, 133. At most, Sigurdsson teaches that metadata may be transmitted before files, and Shappell and Rao teach that metadata is always sent before files. But even if the metadata is sent, or are even “categorically” sent, as in Rao, before sending the files (*see* Pet. 20–21), that does not teach or suggest assignment of priorities or comparison of metadata and file priorities, as required by the priority-related claim limitations.

Petitioner also contends that in light of Shappell’s and Rao’s teachings, and because Sigurdsson teaches that higher priority data items are sent before lower priority data items, a person of ordinary skill in the art would have found it obvious to configure Sigurdsson’s priority algorithm to assign greater priority to metadata, and lower priority to the associated files. Pet. 21–24. Petitioner additionally asserts that “[a person of ordinary skill]

would . . . appreciate the natural harmony between the priority algorithm and Server 106 prioritizing the ‘list of missing content’ (containing metadata) to inform clients about new content at Server 106, and prioritizing high-priority data items.” *Id.* at 22

We do not find Petitioner’s “natural harmony” rationale sufficient reasoning to support why a person of ordinary skill in the art would have modified Sigurdsson’s priority algorithm in view of Shappell’s and Rao’s teachings. Shappell and Rao teach that metadata is sent first and content or raw data is sent second. They do not teach assigning priorities to the files and their associated metadata and then comparing the priorities to determine which is greater. Petitioner contends that because the metadata is known to usually contain less data than a file and the updated version is newer, Sigurdsson’s priority algorithm would have been reconfigured to assign greater priority to the metadata and lower priority to the files. Pet. 23–24. Petitioner asserts that Sigurdsson motivates the modification because of the “natural harmony” of Sigurdsson’s algorithm to prioritizing metadata. *Id.* at 23. The Petition does not explain why (beyond hindsight) a person of ordinary skill in the art would have modified Sigurdsson to assign and compare priorities by reconfiguring Sigurdsson’s priority algorithm when it would have been simpler always to send the metadata first and content second, as taught in Shappell and Rao.

The additional arguments for combining the references presented by Petitioner (Pet. 24–28) do not overcome the failure of the references to disclose this feature of the claims.

b) Conclusion

For the reasons given, we are not persuaded that Petitioner has demonstrated sufficiently that the “priority-related” limitations including limitations 1c and 1f are taught or suggested by Sigurdsson, Shappell, and Rao. We, therefore, determine that the Petition does not demonstrate a reasonable likelihood of prevailing on this obviousness challenge as to claim 1.

In view of the foregoing, we do not address Petitioner’s analysis or Patent Owner’s response to the other limitations of this claim.

2. Claims 12, 17, and 19

These independent claims include limitations similar to limitations 1c and 1f. *See* Pet. Appendix A (limitations 12b, 12e, 17c, 17f, 19b, 119e).

Petitioner’s relies on its arguments and evidence presented for claim 1. Pet. 46–47. We do not find the arguments and evidence sufficient for the reasons discussed above.

Accordingly, for the reasons given, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on this obviousness challenge as to claims 12, 17, or 19.

3. Dependent Claims 3–5, 7, 14, and 20

Claims 3–5, 7, 14, and 20 depend from independent claims 1, 12, or 19. Petitioner’s challenges to dependent claims 3–5, 7, 14, and 20 presented in the Petition are insufficient for the reasons explained above for those independent claims.

Accordingly, for the reasons given, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on this obviousness challenge as to claims 3–5, 7, 14, or 20.

4. *Conclusion*

In sum, after considering the arguments presented in the Petition and Patent Owner's responses, we determine that, for the reasons given, the Petition does not demonstrate a reasonable likelihood of prevailing on this challenge.

F. *Obviousness of Claims 1, 3–5, 7, 12, 14, 17, 19, and 20 Based on Brown, Hesselink, Shappell, and Rao*

1. *Claim 1*

Petitioner asserts that claim 1 would have been obvious in light of Brown, Hesselink, Shappell, and Rao. Pet. 45–61. Petitioner's analysis of this ground is similar to its challenge based on Sigurdsson. *See supra*, Section III.E. Petitioner contends that “Brown alone discloses and renders obvious (and renders obvious with Shappell and Rao) the priority-related limitations . . . at least to the same extent the '607 specification discloses them.” Pet. 51 (emphasis omitted). According to Petitioner, to the extent that the priority-related limitations 1c and 1f “require further categorical assignment of priorities to metadata and files, Brown in view of Shappell and Rao disclose and render them obvious” for “similar reasons” to the previous challenge. *Id.* at 53 (emphasis omitted).

Petitioner contends that Brown teaches that it is “desirable to minimize the amount of data a server sends to or receives from a client, so that other clients' requests can be handled in a timely manner.” *Id.* (citing Ex. 1025, 11:60–63) (emphasis omitted). Petitioner asserts “[t]his teaching would have motivated [a person of ordinary skill] to consider other references focused on sending metadata prior to file data to further improve Brown's approach for synchronizing files.” *Id.* Thus, Petitioner asserts that

Shappell and Rao “render obvious a predictable variation where Brown’s clients and/or server categorically assign greater priority to metadata and lower priority to files (priority assignment configuration) and transmit metadata prior to associated files based on such prioritization, to advantageously inform clients about updated files.” *Id.* (emphasis omitted). Petitioner argues “[f]or substantially the same reason” as in the previous ground, Shappell and Rao “disclose and motivate this obvious modification to Brown.” *Id.* at 53. In this combination, Petitioner relies upon Shappell as teaching transferring metadata “first” before files, and Rao as disclosing “categorically” prioritizing metadata synchronization before files. *Id.* at 53–54.

As discussed *supra*, in Section III.E, the priority-related claim limitations 1c and 1f require assignment of priority to the metadata and file and a comparison of the assigned priorities. Petitioner does not show a teaching in Brown of an assignment of priority to the metadata and file, or of a comparison of the assigned priorities, or use of a “priority assignment configuration” for assigning the priorities. Pet. 53. At most, Brown, as modified by Hesselink,⁴ discloses that metadata may be sent before sending files or portions of files. *See id.*

None of the other references teaches that there is an assignment of priority to metadata or a comparison of the priorities of the metadata and files. As discussed, Brown as modified by Hesselink, at most, teaches that metadata may be transmitted before files or portions, and Shappell and Rao

⁴ Petitioner relies on Hesselink for disclosing the first client automatically transferring a copy of a file specifically “responsive to the user modifying a content” of the file, as recited in limitation 1b. Pet. 47 (emphasis omitted).

teach that metadata is always sent before files. *See* discussion *supra* in Section III.E.1. As is discussed *supra*, even if the metadata is sent, or even “categorically” sent, before files are sent, that does not teach assignment of priorities or a comparison of metadata and file priorities as required by the claim limitations. *Id.* Nor has Petitioner sufficiently demonstrated that Shappell or Rao suggest assigning different priorities to metadata and files and comparing those priorities. As previously observed with respect to Sigurdsson, the Petition does not persuasively explain why a person of ordinary skill in the art would have modified Brown to assign and compare priorities when it would have been simpler always to send the metadata first and content second, as taught in Shappell and Rao.

Accordingly, for the reasons given, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its obviousness challenge to claim 1.

2. *Claims 12, 17, and 19*

Petitioner relies mainly on its arguments and evidence presented for claim 1. Pet. 67–68. We do not find those arguments and that evidence sufficient for the reasons discussed above.

Accordingly, for the reasons given, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on this obviousness challenge as to claims 12, 17, or 19, which include limitations similar to limitations 1c and 1f.

3. *Dependent Claims 3–5, 7, 14, and 20*

Claims 3–5, 7, 14, and 20 depend from independent claims 1, 12, or 19. Petitioner’s challenges to dependent claims 3–5, 7, 14, and 20 presented

in the Petition are insufficient for the reasons explained above for those independent claims.

Accordingly, for the reasons given, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on this obviousness challenge as to claims 3–5, 7, 14, or 20.

4. *Conclusion*

In sum, after considering the arguments presented in the Petition and Patent Owner’s responses, we determine, for the reasons given, that the Petition does not demonstrate a reasonable likelihood of prevailing on this challenge.

IV. DISCRETIONARY DENIAL

Patent Owner argues that we should exercise our discretion to deny institution for several reasons. Prelim. Resp. 1–33. We need not reach those issues in light of our assessment of the merits of the Petition, as discussed above.

V. CONCLUSION

For the foregoing reasons, we have determined that Petitioner has not shown a reasonable likelihood of prevailing with respect to any claims. Thus, we do not institute an *inter partes* review.

VI. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is *denied*, and no trial is instituted.

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