

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BOX, INC., and DROPBOX, INC.,

Petitioners

v.

TOPIA TECHNOLOGY, INC.,

Patent Owner

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Case IPR2023-00433

Patent 10,067,942

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**PATENT OWNER'S PRELIMINARY RESPONSE**

**PURSUANT TO 37 C.F.R. § 42.107(a)**

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| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                                                                                                                                            |
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| 2001           | Hearing Transcript and Order Denying Defendant Egnyte’s Motion to Stay in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB                                                                                                                                                                                |
| 2002           | Screenshot of Egnyte Inc.’s Webpage, captured May 8, 2023:<br><a href="https://www.egnyte.com/dropbox-replacement">https://www.egnyte.com/dropbox-replacement</a>                                                                                                                                                             |
| 2003           | Defendant Egnyte’s invalidity contentions in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB                                                                                                                                                                                                             |
| 2004           | Defendants’ joint invalidity contentions in <i>Topia Technology, Inc. v. Box, Inc., SailPoint Technologies Holdings, Inc., and Vistra, Inc.</i> , 6:20-cv-01175-ADA and <i>Topia Technology, Inc. v. Dropbox, Inc., SailPoint Technologies Holdings, Inc., and Clear Channel Outdoor Holdings, Inc.</i> , 6:21-cv- 001373-ADA |
| 2005           | Scheduling Order in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB                                                                                                                                                                                                                                      |
| 2006           | Scheduling Order in <i>Topia Technology, Inc. v. Box, Inc., SailPoint Technologies Holdings, Inc., and Vistra, Inc.</i> , 6:20-cv-01175-ADA and <i>Topia Technology, Inc. v. Dropbox, Inc., SailPoint Technologies Holdings, Inc., and Clear Channel Outdoor Holdings, Inc.</i> , 6:21-cv-001373-ADA                          |
| 2007           | USPTO Memo regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (“Fintiv Memo”)                                                                                                                                                                        |
| 2008           | <i>Pro Hac Vice</i> Motion for Heidi Keefe filed by Defendant Egnyte in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB, D.I. 61 (and screenshot of Minute Order granting motion)                                                                                                                        |

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| 2010 | <i>Unified Patents LLC v. Justservice.net LLC</i> , IPR2020-01258, Exhibit 2017 (PTAB 2022)                                 |
| 2011 | <i>Unified Patents LLC. v. Topia Technology, Inc.</i> , IPR2022-00782, Paper 8 (PTAB 2022)                                  |
| 2012 | Proof of service for complaint filed against Egnyte in <i>Topia Technology, Inc. v. Egnyte, Inc.</i> , C.A. No. 21-1821-CJB |
| 2013 | Declaration of Dr. Prashant Shenoy                                                                                          |
| 2014 | Curriculum Vitae of Dr. Prashant Shenoy                                                                                     |
| 2015 | Selected Excerpts from Microsoft Computer Dictionary, Fifth Edition (2002)                                                  |
| 2016 | Declaration of L. Roman Rachuba                                                                                             |

Patent Owner Topia Technology, Inc. (“Topia” or “Patent Owner”) submits this Response to the Petition (Paper No. 3) seeking denial of institution of *inter partes* review of claims 1, 3-4, 10, and 12-13 (“the Challenged Claims”) of U.S. Patent No. 10,067,942 (“the ’942 Patent,” EX1002), filed by Box, Inc., and Dropbox, Inc., (“Petitioners”).

## **I. Introduction**

Petitioners ask this Board to institute an inter partes review of U.S. Patent No. 10,067,942 that has been asserted against the combined subscribers Box and Dropbox in parallel district court litigations.

The Board should decline to institute inter partes review of U.S. Patent No. 10,067,942 (“the ’942 Patent”) at least because Petitioners (1) fail to establish a reasonable likelihood that any challenged claim is obvious over the prior art, (2) fail to name all real parties in interest, and (3) risk wasting significant Board and judicial resources because trial on the ’561 Patent is scheduled before any final written decision will issue.

## **II. The Petition Must Be Dismissed For Not Including All Rpis And Should Be Dismissed For Fairness And Judicial Economy**

Petitioners’ failure to name all real parties-in-interest (“RPIs”), including time-barred Egnyte, Inc. (“Egnyte”), necessitates denial of institution under 35

U.S.C. §315(b). Additionally, the Board should exercise its discretion to deny under 35 U.S.C. §314(a) “because institution of a trial at the PTAB would be an inefficient use of Board resources in light of the ‘advanced state’ of the parallel district court litigation in which the petitioner had raised the same invalidity challenges” and would reward Petitioners’ gamesmanship in their invalidity defense strategy. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 2 (PTAB 2020) (precedential) (“Fintiv”) (citing *NHK Spring Co. v. Intrix-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB 2018) (precedential). Moreover, Petitioners’ late-filed follow-on Petition severely prejudices Patent Owner, who was forced to disclose its validity positions in its Preliminary Reply to Unified Patents LLC’s (“Unified”) Petition for *inter partes* review of the ‘942 Patent, wherein at least Petitioner Dropbox Inc. (“Dropbox”) was an unnamed RPI. *Unified Patents LLC v. Topia Technology, Inc.*, IPR2022-00782 (PTAB 2022).<sup>1</sup>

### **A. Facts**

Patent Owner Topia filed suit against Petitioners Box, Inc. (“Box”) and Dropbox in the Western District of Texas in December, 2021,<sup>2</sup> and the Complaints

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<sup>1</sup> Following a joint motion to terminate the proceedings, the Board did not have an opportunity to fully consider whether Dropbox was an unnamed RPI of Unified in IPR2022-00782.

<sup>2</sup> The cases against Box and Dropbox are *Topia Technology, Inc. v. Box, Inc.*, *SailPoint Technologies Holdings, Inc.*, and *Vistra, Inc.*, 6:20-cv-01175-ADA and *Topia Technology, Inc. v. Dropbox, Inc.*, *SailPoint Technologies Holdings, Inc.*, and *Clear Channel Outdoor Holdings, Inc.*, 6:21-cv- 001373-ADA.

were served January 5, 2022. In January, 2023, both of these cases were transferred to the Northern District of California. Topia also filed suit against Egnyte in December, 2021, in the District of Delaware, asserting the same patents as those asserted against Box and Dropbox.<sup>3</sup> Service on Egnyte was effected December 27, 2021. The instant Petition by Box and Dropbox was filed January 4, 2023, within the one-year time period (by one day) for filing IPR petitions that are based on a District Court Action. *See* § 315(b). But the instant Petition was filed *more* than one year after the Complaint was served on Egnyte in Delaware. As shown below, Egnyte is joined at the hip to Box and Dropbox both in the District Court litigations and in this IPR and is a real party-in-interest in this proceeding. Because the present Petition was filed more than one year after the Egnyte Complaint was served, the Petition is time-barred and should be dismissed. In support the following facts are undisputed:

- Egnyte has been time-barred from filing an IPR since before the instant Petition was filed;
- Trial with Egnyte will occur prior to any final written decision resulting from this Petition;

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<sup>3</sup> Topia Technology, Inc. v. Egnyte, Inc., C.A. No. 21-1821-CJB.

- Petitioners and Egnyte are parties to a joint defense agreement to further their goal of invalidating the '942 and related Patents;
- Petitioners' lead counsel for this Petition, Heidi Keefe of the law firm Cooley LLP, also represents Egnyte and Petitioner Box, Inc. ("Box") in district court proceedings involving the '942 patent and its related patents;
- Egnyte has a "long history" with Cooley LLP;
- Months before the filing of this Petition, Box (through Ms. Keefe as lead litigation counsel), Dropbox, and Egnyte prepared and served identical invalidity contentions in their respective district court cases;
- The lead grounds of these invalidity contentions are the same as in the instant Petition;
- Ms. Keefe argued Egnyte's only substantive motion in district court, an unsuccessful invalidity challenge on December 20, 2022, while simultaneously working (and merely two weeks later) executing the current IPR Petition filed January 4, 2023;
- Neither Petitioners nor Egnyte agree to be bound by a *Sotera* disclaimer regarding the grounds in this Petition; and

- Egnyte filed an unsuccessful motion to stay its District Court case based on the instant Petition by Box and Dropbox.

These facts are expanded upon in the discussions below.

## **B. Petitioners Failed to Identify Egnyte as an RPI**

*Inter partes* review petitions are required under 35 U.S.C. §312(a)(2) to identify all RPIs. Further, §315(b) precludes institution where, as here, “the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party-in-interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” *Id.* The facts demonstrate that Egnyte is both an RPI to this petition and a privy of Petitioners. Pet., 1.

For over 17 months, Petitioners and Egnyte have been intertwined with respect to not only this Petition, but also the co-pending litigations which involve the '942 Patent and its five related patents<sup>4</sup> (together, the “Asserted Patents”) because, *e.g.*, (a) they share litigation counsel in all forums where the Asserted Patents are at issue, including the instant proceeding in which Ms. Keefe is lead counsel ( *see e.g.*, EX2008 and EX2009); (b) they are pursuing a single and unified

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<sup>4</sup> Topia asserts the '942 Patent and five related patents (U.S. Patent Nos. 10,289,607; 11,003,622; 10,642,787; 10,754,823; and 9,143,561) (together “the Asserted Patents”) against Petitioners and Egnyte, respectively in *Topia Technology, Inc. v. Box, Inc.*, 3:32-cv-00063LB and *Topia Technology, Inc. v. Dropbox, Inc.* 3:23-cv-00062AGT (both cases transferred from W.D. Texas to N.D. Cal. in January 2023), and *Topia Technology, Inc. v. Egnyte, Inc.*, C.A. No. 21-1821-CJB (filed December 27, 2021 in D. Del.). All six patents have been petitioned for *inter partes* review by Petitioners.

invalidity defense strategy in all forums; and (c) they are parties to a joint defense agreement (“the Agreement”) (EX2001, 9:17-19, 10:9-10). Indeed, the collaborating Defendants have submitted *identical* invalidity contentions, of which the grounds in the Petition overlap. *C.f.* EX2003 (Egnyte contentions), and EX2004 (Petitioners’ contentions), both at 19 and 69. As Judge Burke stated in Egnyte’s Delaware case: “it’s about as close as you can get in terms of coordinating and understanding, et cetera, as you might.” EX2001, 11:10-12.

Likewise, both Petitioners and Egnyte (who clearly desires *inter partes* review of the ‘942 Patent) stand to benefit by previewing Patent Owner’s arguments, which may be addressed by at least Egnyte without the risk of estoppel in district court. Notably, the Petition’s grounds are identical to those Egnyte raises in the District Court via the same counsel. Put plainly, Petitioners and Egnyte have engaged in a strategy of gamesmanship to leverage a multi-forum invalidity attack on the Asserted Patents, all while attempting to avoid a statutory time-bar and any consequences of estoppel.

*1. Egnyte is an RPI of Petition*

The determination of real parties-in-interest “should ‘sweep[]’ broadly.” *RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128, 5 (PTAB 2020) (precedential) (*AIT II*) (citing *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1349 (Fed. Cir. 2018) (*AIT I*)). “Whether a non-party is

a real party in interest is a ‘highly fact-dependent question.’” *AIT II*, 7 (quoting *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152, 6 (PTAB 2019) (precedential). “[T]he 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.” *AIT II*, 5 (emphasis added). “To decide whether a party other than the petitioner is the real party-in-interest, the Board seeks to determine whether some party other than the petitioner is the ‘party or parties at whose behest the petition has been filed.’” *Commscope Inc., v. TQ Delta, LLC*, IPR2022-00352, Paper 13, 9 (PTAB 2022) (citing *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1336 (Fed. Cir. 2018). In performing this analysis, the Board considers the following factors, however, the analytical approach must remain “flexible [and] take[] 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 II*, 2 (citing *AIT I*, 1351). The factors are:

- (a) Petitioners’ business model;
- (b) Petitioners’ “explanation of its own interest in the IPRs”;
- (c) “[W]hether, and under what circumstances, [Petitioners] take[] [the unnamed RPI entity’s] interests into account when determining whether to file IPR petitions”;

- (d) Petitioners' relationship with the unnamed RPI entity;
- (e) The unnamed RPI entity's "interest in" and "benefit from" the IPRs;
- (f) "[W]hether [Petitioners] can be said to be representing that interest";
- (g) "[W]hether [the unnamed RPI entity] actually 'desires review of the patent[s]';
- (h) The relevance of overlapping Board members; and
- (i) Communications between Petitioners and the unnamed RPI entity.

*AIT II*, 10 (citing *AIT I*, 1353-54).

Egnyte is unquestionably "a clear beneficiary that has a preexisting, established relationship with the petitioner[s]." *AIT II*, 2. On balance, the factors weigh heavily in favor of Egnyte being an RPI.

*1. Petitioners' Relationship With Egnyte (Factor (d))*

Egnyte and Petitioners share a close relationship for purposes of this proceeding and the related litigations, and have demonstrated a high degree of coordination in all forums. This petition is the latest effort of Petitioners' and Egnyte's single, unified invalidity strategy. Despite being competitors in the marketplace<sup>5</sup>, Petitioners and Egnyte are parties to the Agreement, at least with respect to the related litigations. Pursuant to the Agreement, Petitioners and Egnyte

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<sup>5</sup> See EX2002 (Webpage of Egnyte, touting Egnyte as a "Dropbox Replacement").

share “materials related to [the] common defenses, like non-infringement, [and] invalidity . . . .”) EX2001, 9:21-23. Trial Practice Guide (“TPG”), 17 (Explaining that membership in a joint defense agreement is relevant to the RPI inquiry.)

Petitioners’ selected prior art challenge grounds are the progeny of Egnyte’s invalidity contentions served September 2022 in the parallel district court proceeding, months before the instant Petition was filed. EX2003, 19, 69. Indeed, Egnyte’s invalidity contentions are themselves *identical* to Petitioners’ invalidity contentions served in their district court proceedings. EX2004, 19, 69. Presumably, Egnyte financed at least a share of the collaborative invalidity contentions that are a basis for this Petition. Put plainly, Petitioners and Egnyte are pursuing a single patent invalidity strategy across multiple forums. Their interests are not merely aligned, but are one.

Moreover, Box and Egnyte share litigation counsel, including Ms. Keefe, in their respective cases. Ms. Keefe also serves as lead counsel for this Petition (and every IPR brought by Petitioners against the Asserted Patents), representing both Petitioners. Egnyte also has “a long history” with Ms. Keefe’s law firm Cooley, LLP. EX2001, 10:5-7; EX2008 and EX2009. As the Board is aware, common counsel is relevant to the RPI inquiry and tends to weigh in favor of finding that an unnamed third party is an RPI. *Agilent Tech., Inc. v. Waters Tech. Corp.*, IPR2019-01131, Paper 12, 13-14, (PTAB 2019)

Petitioners selected their counsel for this Petition with full knowledge that she simultaneously represents Egnyte in the parallel District Court litigation, has intimate knowledge of Egnyte’s interests and attendant invalidity strategies, and is ethically constrained by these interests and strategies in any relevant forum. While preparing the present Petition, Ms. Keefe also represented Egnyte in the Delaware action where she argued Egnyte’s only substantive motion to date—a §101 invalidity motion on the Asserted Patents. Ms. Keefe, carries this ethical obligation while proceeding to work simultaneously on two projects with the same goal of invalidating the Asserted Patents. As counsel to all parties, Ms. Keefe cannot advocate on behalf of Box and Dropbox in the Petition without also ensuring that positions she takes are in the interest of Egnyte. As counsel to Egnyte she continues to have an ethical obligation to zealously advocate Egnyte’s interests in all proceedings. This proceeding is no exception. *Trimble Inc. v. Perdiemco LLC*, 802 Fed. Appx. 556, 558 (Fed. Cir. 2020) (“A lawyer shall not, without informed written consent from each client . . . , represent a client if the representation is directly adverse to another client in the same or a separate matter.” (quoting Cal. R. of Prof’l Conduct 1.7); *see also* USPTO R. Prof’l Conduct 11.107. It is unreasonable to think that Ms. Keefe can build a Chinese wall in her own mind and not let the left side of her brain influence the right side. Ms. Keefe’s obligation necessitates that Petitioners control and execute their instant IPR strategy at the

behest of Petitioners **and Egnyte**. To be clear, consistent with Ms. Keefe's ethical obligations, Petitioners cannot take positions adverse to Egnyte's interests in this proceeding. *See* EX2001, 11:10-12 ("The Court: [I]t's about as close as you can get in terms of coordinating and understanding, et cetera, as you might.").

Ms. Keefe's dual role as counsel both to Petitioners and to Egnyte is probative of the fact that Egnyte is an RPI here.. *Agilent Tech.*, 13-14 ("[I]n addition, Agilent and ProZyme share common counsel in the civil actions. Thus, we agree with Patent Owner that the totality of circumstances 'strongly suggests a centrality of decision making and a coordinated strategy for defending against Patent Owner's infringement claims.'") (citing *Paramount Home Entm't, Inc. v. Nissim Corp.*, IPR2014-00961, Paper No. 11, 9 (PTAB 2014) (finding that shared counsel may be relevant to the RPI inquiry); *Zoll Lifecore Corp. v. Philips Elec. N.A. Corp.*, IPR2013-00615, Paper 15, 15 (PTAB 2014) ("While common counsel alone is not dispositive of control, we are persuaded that Petitioner's actions[, including "receiv[ing] legal counsel from the same legal representative",] have blurred sufficiently the lines of corporate separation with its parent."); *Johnson Health Tech, Co. Ltd. v. Icon Health & Fitness, Inc.*, IPR2014-01242, Paper 16, 15 (PTAB 2015) ("JHT's control over JHTNA is further evidenced by the fact that the same attorneys representing JHTNA in the Utah Action also represented JHT in the reexam and currently represent both JHT and JHTNA in this inter partes

review.”); *Radware, Inc. v. F5 Networks, Inc.*, IPR2017-01249, Paper 10, 5 (PTAB 2019) (“The following additional considerations, together with the aforementioned indicators of corporate blurring, suggest that Radware, Ltd. has control, or the opportunity to control, the *inter partes* review before us: (1) Petitioner and Radware Ltd’s history of litigating together against Patent Owner; and (2) Petitioner and Radware, Ltd.’s shared litigation counsel Fabio Marino, who also serves as Petitioner’s lead counsel for the Petition before us.”).

The totality of circumstances, including shared counsel and materials, the Agreement, and the identical invalidity contentions, demonstrate Petitioners’ and Egnyte’s “preexisting, established relationship” (*AIT II*, 2) in executing a single, unified patent invalidity strategy. This factor weighs heavily in favor of Egnyte being considered an RPI, especially given the Federal Circuit’s directive to interpret “real-party-in-interest” “broadly” and “expansively.” *AIT I*, 897 F.3d, 1349.

## *2. Egnyte’s Interest and Benefit From the IPR (Factor (e))*

Egnyte is accused of infringing the ’942 Patent and therefore has a self-evident interest in this invalidity challenge. Furthermore, the Petition relies upon grounds that derive from Egnyte’s previously-served invalidity contentions, identical to Petitioners’ in their respective district court cases and recycled in the

Petition. EX2003 and EX2004, 19 and 69. This is not surprising, since Egnyte was time-barred from seeking its own *inter partes* review raising the communal invalidity grounds. Thus, Egnyte is a clear beneficiary with a direct interest in this Petition.

Despite the collaborative work product, Egnyte has refused to be bound by any estoppel stemming from this IPR. *See* EX2001, 22:12-18. Without the Board's intervention, Egnyte will be free to raise the identical invalidity grounds actually raised in this Petition and more, with the further benefit of previewing Patent Owner's responsive arguments and overall strategies. Indeed, all parties to the Agreement will be able to benefit from repeated and refined invalidity arguments that Egnyte can raise in district court. These benefits to Egnyte are in addition to the straight-forward potential benefit of a final written decision in Petitioners' favor. EX2001, 15:8-11 (The Court: "There could certainly be some benefit to [Egnyte] were those IPRs to work out in a certain way, because they involved the same patents."). Accordingly, this factor weighs heavily in favor of Egnyte being considered an RPI. *AIT II*, 24-25 ("[W]e agree with Patent Owner that, because of the pending litigation, the invalidation of the challenged patents would provide a benefit to Salesforce, supporting a conclusion that Salesforce is an RPI in these proceedings.").

3. *Petitioners' Explanation of Their Own Interest (Factor (b)) and Whether and Under What Circumstances Petitioners Take Egnyte's Interest Into Account (Factor (c))*

As Petitioners are accused of infringing the '942 Patent, they certainly have an interest in this invalidity challenge. This interest, however, does not negate Egnyte's interests and their role in this proceeding. *PayPal, Inc. v. PersonalWeb Technologies, LLC*, IPR2019-01111, Paper No. 27, 25 (PTAB 2019) ("The Federal Circuit has explained that, 'in drafting §315(b), Congress 'chose language that bars petitions where proxies or privies would benefit from an instituted IPR, even where the petitioning party might separately have its own interest in initiating an IPR.' [] Thus, representing their own interests in addition to those of Amazon's does not negate a finding [of] a privity [relationship].") (citing *Power Integrations, Inc. v. Semiconductor Components Indus., LLC*, 926 F.3d 1306, 1316 (Fed. Cir. 2019) and *AIT I*, 1347.

To begin with, Egnyte's interests have directly shaped the invalidity grounds raised in the Petition. This is because the Petition's grounds were first raised in the collaborative invalidity contentions of the joint defense parties—including Egnyte. As Egnyte's invalidity contentions necessarily take Egnyte's interests into account, and Petitioners' invalidity contentions are identical to Egnyte's, the Petition's

grounds sampled from this collaborative work product ultimately flow—at least in part—from Egnyte’s interests.

Egnyte’s interests are also represented by Petitioners’ choice of lead counsel in this *inter partes* review—Ms. Keefe—who also represents Egnyte in the Delaware case. Petitioners are necessarily constrained by Egnyte’s interests in this proceeding, as discussed above with reference to Factor (d).

*4. Whether Petitioners Can be Said to be Representing Egnyte’s Interest (Factor (f))*

Petitioners’ and Egnyte’s interests are 100% aligned in their unified invalidity defense strategy, and both Petitioners and Egnyte have an interest in previewing Patent Owner’s strategies and arguments in defending the Asserted Patents, which include the ’942 Patent. If the IPR is instituted, Egnyte will be able to argue the exact same grounds raised in the Petition, all with the further benefit of conferring and strategizing with Petitioners, pursuant to the Agreement, to analyze Patent Owner’s responsive arguments. Petitioners represent Egnyte’s interests in executing, via common counsel, a unified invalidity strategy that includes filing IPR petitions that Egnyte could not as a time-barred party. Thus, this factor weighs heavily in favor of Egnyte being considered an RPI of the Petition. *AIT II*, 25 (“[I]t stands to reason that RPX inevitably represented Salesforce’s interests, and provided benefit to Salesforce, by filing IPR petitions

challenging the same patents asserted against Salesforce in infringement litigation, in a manner that Salesforce itself could not do as a §315(b) barred party.”)

*5. Egnyte Desired IPR Review (Factor (g))*

The fact that the '942 Patent is being asserted against Egnyte, who failed to timely file or join an IPR attacking the same patent, is “persuasive evidence that [Egnyte] would have been interested in Board review of the patentability of the claims in the patents asserted against it in litigation, supporting a conclusion that [Egnyte] is an RPI in these proceedings.” *AIT II*, 27.

*6. Communications Between Petitioners and Egnyte (Factor (i))*

Communications between Petitioners and Egnyte is evidenced by their collaborative efforts in the common invalidity contentions from which the Petition’s grounds are sampled. Moreover, Petitioners and Egnyte are parties to the Agreement and share common litigation counsel, who is also lead counsel to this Petition.

“Even if [Egnyte] did not directly discuss filing an IPR, the discussions of litigation are naturally tied to possible defenses, of which an IPR challenge is one. The discussion of pending litigation by [Patent Owner] against [Egnyte] by [Petitioners], who subsequently filed an IPR, weighs in favor of finding that

[Egnyte is] an interested party. Such communications need not expressly involve a request by [Egnyte] for [Petitioners] to file an IPR petition.” *AIT II*, 30.

This factor weighs in favor of Egnyte being considered an RPI.

*7. Petitioners’ Business Model (Factor (a))*

Neither Petitioner is a member-group organization structured to file IPR challenges, as was petitioner RPX in *AIT I*. However, Petitioners and Egnyte are closely intertwined and are parties to the Agreement, which evidences a privity relationship that the business model factor examines. *See AIT I*, 897 F.3d 1363 (“[I]f the extent of the legal obligations between the parties... is such that the parties share a high degree of commonality of proprietary or financial interest, privity is established and §315(b) bars the institution of the IPR petitions.”); *Volkswagen Group of America, Inc. v. Arigna Technology Ltd.*, IPR2021-01263, Paper 16, 12 (PTAB 2022) (“Moreover, unlike in *AIT Remand*, where petitioner was a defensive patent aggregation entity, the issues of control and funding, in this case, carry less weight in view of the evidence of Conti/Volkswagen's assertions to the two district courts, the nature of their relationship, and the degree to which Conti stands to benefit from Volkswagen's filing of the Petition.”).

In sum, the “sweep[ing]” breadth of the RPI inquiry, Petitioners’ close relationship with Egnyte, the parties 100% overlapping interests, Egnyte’s benefit

stemming from this Petition, and the parties’ gamesmanship and single, unified invalidity strategy, all point toward Egnyte being an RPI of this Petition and a privy of Petitioners. *AIT II*. 33 (“As the Federal Circuit instructs, [] the RPI inquiry sweeps more broadly than requiring explicit evidence of request, funding, or control, instead requiring consideration of the factors discussed above.” (citing *AIT I*, 1351 (“Depending on the nature of the parties’ relationship, an entity can serve as an agent to a principal and file an IPR on the principal’s behalf without the two formally agreeing that the agent will do so.”))).

2. *Failure to Name All RPIs is Fatal to the Petition*

Egnyte was served with a complaint alleging infringement of the ’942 Patent on December 27, 2021, over one year before the January 4, 2023 filing date of this Petition. As a result, and because Egnyte is an RPI, the Petition must be dismissed pursuant to §315(b).

**C. The Board Should Exercise Its Authority and Deny Institution In View of Fintiv and Judicial Economy**

Petitioners’ and Egnyte’s attempt to circumvent efficiency and fairness safeguards in disregard of the requirements for RPI disclosure will waste significant Board and court resources on this and the related IPR petitions for the

Asserted Patents.<sup>6</sup> None of the lawsuits against Petitioners or Egnyte are presently stayed—the Court for the District of Delaware (“Delaware Court”) expressly denied Egnyte’s motion to stay, finding that Egnyte made a deliberate choice to pursue a §101 challenge as opposed to filing an IPR petition. EX2001, 19-20 (The Court: “Egnyte made its choice. Didn't work out entirely the way they had hoped, but it worked out partially the way it hoped, so it's got to live with that choice. . . .

And now having not been entirely successful at [a] stay in this case through that path, [Egnyte is] going to option number two trying to rely on third parties in a way that it doesn't want to agree to estoppel.”). This same litigation will have proceeded to trial by the time the Board issues any hypothetical final written decision stemming from this petition. The Delaware Court will decide the same issues raised in this Petition and more, given that Egnyte refuses to be bound by any estoppel agreement. EX2005, 20; EX2001, 8:22-23(Egnyte’s Counsel: “we don't think it's right that Egnyte should have to agree or be bound by any estoppel provisions[.]”) Petitioners also did not submit a *Sotera* stipulation. Instead, Petitioners only claim to “not pursue invalidity in litigation based on any *instituted*

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<sup>6</sup> The IPRs on the other related Asserted Patents are: IPR2023-00427 (U.S. Patent 9,143,561) (Petition filed January 4, 2023); IPR2023-00429 (U.S. Patent 10,289,607) (Petition filed January 5, 2023); IPR2023-00430 (U.S. Patent 11,003,622) (Petition filed January 5, 2023); IPR2023-00431 (U.S. Patent 10,642,787) (Petition filed January 4, 2023); and IPR2023-00432 (U.S. Patent 10,754,823) (Petition filed January 4, 2023).

ground”, further demonstrating their gamesmanship and strategy to avoid estoppel provisions. Pet., 5.

Moreover, significant resources have been expended by Patent Owner, Petitioners, unnamed RPI Egnyte, and the judicial system. In Delaware, infringement contentions have been exchanged, briefing on claim construction is nearly complete (only Egnyte’s sur-reply remains outstanding), and substantial document production is complete. Fact discovery will close in September. EX2005, 19. With respect to Petitioners, prior to the respective cases being transferred to the Court for the District of Northern District of California (“NDCA Court”), in the Court for the Western District of Texas (“WDTX Court”), the parties fully briefed claim construction, and exchanged contentions (Petitioners’ invalidity contentions in the WDTX Court are identical to Egnyte’s in the Delaware Court). EX2006; EX2003, EX2004. Discovery is on-going in the NDCA Court.

In determining whether to deny institution, the Board is to consider the presence and status of parallel district court litigation. *NHK Spring Co., Ltd. v. Intri-plex Technologies*, IPR2018-00752, Paper 8, 11 (PTAB 2018) (precedential), and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB 2020) (precedential) (“Fintiv”). *Fintiv* sets forth a non-exhaustive list of factors that

balance system efficiency and fairness considerations when considering discretionary denial. *Fintiv*, 5–6. The factors are:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board’s exercise of discretion, including the merits.

*Id.*

Additionally, the *Fintiv* factors should be considered in view of the guidance provided in the June 21, 2022 Memo regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation. (“*Fintiv* Memo”). See EX2007.

Discretionary denial is warranted here because institution would be an inefficient duplication of multiple parallel district court litigations and would

unjustly reward Egnyte's and Petitioners' circumvention of the Rules to use this Petition as a consequence-free trial balloon for arguments and evidence that will be used in their district court litigations involving the Asserted Patents, including the '942 Patent. Each *Fintiv* factor favors exercising discretion to deny institution and none of the circumstances presented in the *Fintiv* Memo are applicable because Petitioners did not present compelling evidence of unpatentability (*see* Section III, *infra*), there is no parallel ITC proceeding, and neither Petitioners nor Egnyte submitted a *Soltera* stipulation.

1. *Whether a Stay Exists or Is Likely To Be Granted If A Proceeding Is Instituted*

No stay has been issued in any of the parallel litigations. Though motions to stay are pending in both of the respective NDCA Court litigations against Petitioners, the Delaware Court has explicitly denied Egnyte's motion to stay. EX2001, 53:22-54:2. This factor weighs against institution. *See Fintiv*, 12.

2. *Proximity of the District Court's Trial Date to the Board's Projected Statutory Deadline for a Final Written Decision*

Trial with Egnyte in the Delaware Court is scheduled for July 22, 2024, weeks before the August 9, 2024 earliest deadline for when any final written decision would be due should this petition be instituted. *See* 35 U.S.C. §§314(b) and 316(a)(11). There is no reason to believe that trial will be delayed, particularly as the Delaware Court has expressly denied Egnyte's stay motion.

The NDCA cases do not yet have a trial date.

Given that at least the trial in the Delaware Court will proceed before the expected final written decision date, this factor favors denial of institution. *Google, LLC. v. Personalized Media Comm., LLC.*, IPR2020-00723, Paper 22, 7 (PTAB 2020).

3. *Investment In the Parallel Proceeding By The Court And The Parties*

Under the third factor, the Board is to “consider[] the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, 9.

Patent Owner, Petitioners, unnamed RPI Egnyte, the NDCA Court and the Delaware Court have all spent significant resources on the Asserted Patents including the ’942 Patent.

Discovery is on-going in the NDCA Court, with both parties having already exchanged their first set of document requests and interrogatories. Prior to the respective cases being transferred to the NDCA Court, the parties fully briefed claim construction, exchanged contentions, and argued Petitioners’ motions to transfer from the WDTX. The Parties have been litigating for over seventeen months. EX2012; EX2006.

In Delaware, substantial document production is complete, claim construction is nearly fully briefed, contentions have been exchanged, and the parties have

completed arguments on Egnyte’s unsuccessful §101 invalidity motion. EX2001, 51(The Court: “[W]e are almost half way through this case, a case that was filed, after all, about 15 months ago. I say that not only because nearly all of document-related fact discovery has occurred and because we're on the cusp of the Markman process proceeding to a hearing, it's also because the Court, at defendant's invitation, invested a significant amount of time in the early section 101 motions process in this case and made a decision on that front.”)

The parties’ substantial investment in the three district court litigations favors denial of institution. *See Canadian Solar Inc. v. The Solaria Corporation*, IPR2021-00095, Paper 12, 11 (PTAB 2021).

4. *Overlap Between Issues Raised In the Petition And in The Parallel Proceeding*

Under the fourth factor, as the Board found in *Fintiv*, “if the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *See Fintiv*, 12.

Issues related to each of the Asserted Patents, including the ’942 Patent, are being litigated in three different tribunals. Petitioners already set forth the grounds raised in this Petition in their invalidity contentions. EX2004, 19, 69. Egnyte is

pursuing the exact same invalidity grounds, which evidences a single, unified invalidity strategy. EX2003, 19, 69 (contentions are identical to Petitioners’).

Additionally, Petitioners and Egnyte refuse to mitigate concerns of potentially conflicting decisions and duplicative efforts between the district courts and the Board by failing to submit a stipulation in the district court proceedings or elsewhere per *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential). Pet., 5 (Petitioners only agreed to “not pursue invalidity in litigation based on any instituted ground” in the Petition. Petitioners were silent with respect to any ground that reasonably could have been raised.) These circumstances evidence Petitioners’ scheme and favor denial of institution. *See Sand Rev’n II LLC v. Cont’l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24, 7 (PTAB 2020) (informative ); *Sotera*, 19; *Fintiv*, 18 (weighing Factor 4 in favor of denial of institution based on “concerns of inefficiency and the possibility of conflicting decisions”).

5. *Whether Petitioners and the Defendant(s) In the Parallel Proceeding(s) Are The Same Party*

Petitioners are the respective defendants in the NDCA Court. Unnamed RPI Egnyte is the defendant in the Delaware Court. As explained above, with respect to Egnyte, the Delaware Court will decide the same issues raised in this Petition and more, given that Egnyte refuses to be bound by any estoppel agreement.

Substantial work, including claim construction, §101 motion practice, substantial document production, and contention exchanges have been completed in the Delaware Court. Trial is scheduled weeks before any hypothetical final written decision will issue. *Fintiv*, 14 (“Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.”) Petitioners have not addressed the Egnyte litigation in the Petition. *Id.* (“An unrelated petitioner should, therefore, address any other district court or Federal Circuit proceedings involving the challenged patent to discuss why addressing the same or substantially the same issues would not be duplicative of the prior case even if the petition is brought by a different party.”) (citing *Stryker Corp. v. KFx Medical, LLC*, IPR2019-00817, Paper 10, 27–28 (PTAB 2019) (considering a jury verdict of no invalidity, based in part on evidence of secondary considerations, weighed in favor of denying institution where the unrelated petitioner failed to address this evidence in the petition)).

In addition to the specific circumstances and the overlap of issues with the Egnyte litigation, Petitioners’ close relationship also makes this factor weigh in favor of the Board exercising its discretion to deny institution. *Daiichi Sankyo, Inc. v. Seagen Inc.*, PGR2021-00030, Paper 11, 17 (PTAB 2021) (“Given that the real

parties in interest in this proceeding are parties to the Texas Litigation, we determine that this factor on balance weighs in favor of discretionary denial.”); *Cisco Systems, Inc. v. Estech Systems, Inc.*, IPR2021-00329, Paper 13, 14 (PTAB 2021) (finding that factor 5 weighs in favor of denial of institution where, though Petitioner was not a party to the infringement litigation, Patent Owner provided evidence, including evidence of common counsel, that Petitioner “direct[ed] and control[ed] defense of [the] proceedings, including the invalidity challenges presented therein.”). This factor favors denial of institution.

6. *Other Circumstances That Impact the Board’s Exercise of Discretion, Including the Merits*

The Board is to consider the merits of a petitioner’s challenge when determining whether to institute a post-grant proceeding in view of parallel district court litigation. EX2007, 4. As explained in more detail below in Section III, Petitioners have failed to meet their burden under 37 C.F.R. §42.108(c) of establishing a reasonable likelihood of success that any of the challenged claims are unpatentable, let alone a compelling case. *CommScope Techs. LLC v. Dali Wireless, Inc.* IPR2022-01242, Paper 23, 3 and 5 (PTAB 2023) (precedential) (“As the Guidance Memo and my precedential decision in *OpenSky* make clear, the compelling merits standard is a higher standard than the standard for institution set

by statute.”) (“[T]he Board must provide reasoning sufficient to allow the parties to challenge that finding and sufficient to allow for review of the Board’s decision.”).

Petitioner’s dubious arguments, its disregard for the RPI disclosure requirement, the significant risk of wasting judicial and Board resources, and Petitioners’ use of a previous IPR as a roadmap for this Petition (see Section II.D., below), all point to this additional factor as favoring denial of institution.

In sum, each of the *Fintiv* factors weigh in favor of denying institution, and the Board should exercise its discretion in accordance therewith.

**D. The Board Should Exercise Its Authority and Deny Institution Because The *General Plastic* Factors Weigh Heavily in Favor of Denying Institution**

This instant Petition is merely a follow-on Petition of that in IPR2022-00782 (the “’782 IPR”), filed by Unified Patents, LLC (“Unified”), which was also on the ’942 Patent.

The Board should exercise its authority under 35 U.S.C. §314(a) to deny institution to prevent inequities to the Patent Owner and to ensure the efficiency of the IPR process. *See General Plastic*. Each of the *General Plastic* factors weigh in favor of denying institution. *Id.*

1. *Whether the Same Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent*

The '782 IPR challenged the exact claims of the exact same patent as in the instant Petition.

Patent Owner maintains the position set forth in the '782 IPR that membership in a Unified technology group evidences an RPI relationship with Unified. *See e.g.*, EX2011, 20. At least Petitioner Dropbox is a member of Unified. EX2010, 7. Unified members pay dues to Unified in exchange for Unified filing IPR petitions on its member's behalf. Petitioners are also beneficiaries of the '782 IPR, and have already gained significant strategic advantage in this proceeding and the related litigations by previewing Topia's arguments.

Even if its Unified membership is not deemed sufficient to establish Petitioner Dropbox's RPI relationship with Unified, such a finding does not preclude *General Plastic's* applicability. *General Plastic*, 10; *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, -00063, -00084, Paper 11, 2 (Apr. 2, 2019) (precentral) (“[A]pplication of the *General Plastic* factors is not limited solely to instances where multiple petitions are filed by the same petitioner.”); *United Fire Protection Corp. v. Engineered Corrosion Sol'ns, LLC*, IPR2018-00991, Paper 10 (PTAB 2018) .

Given that the ‘782 IPR was filed on the exact same claims of the exact same patent, as well as Unified’s close relationship with at least Petitioner Dropbox, by way Dropbox’s membership in Unified, this factor weights in favor of denial of institution.

2. *Whether at the Time of Filing of the First Petition the Petitioner Knew of the Prior Art Asserted in the Second Petition or Should Have Known of it*

Unified filed its Petition in the ‘782 IPR on April 15, 2022. Petitioners first set forth the grounds for this Petition (and also repeated Unified’s grounds) in their preliminary infringement contentions in the WDTX cases three months later on July 14, 2022. EX2004, 19, 69. Thus, at the very latest, Petitioners were aware of the instant grounds a mere three months following Unified’s Petition.

Despite being aware of the grounds in their Petition since at least July 2022, and seeing Topia’s argument in response to Unified’s separate grounds since August 2022, Petitioners waited an additional five months to file the instant Petition, on the same claims of the same patent. Petitioners have offered no explanation for their delay. This factor weighs in favor of institution. *General Plastic*, 10.

3. *Whether at the Time of Filing of the Second Petition the Petitioner Already Received the Patent Owner's Preliminary Response to the First Petition or Received the Board's Decision on Whether to Institute Review in the First Petition*

The instant Petition was filed on January 4, 2023, almost five months after Patent Owner filed its Preliminary Response in the '782 IPR in August 2023, and almost two months after the Board issued its institution decision in November 2020. Petitioners have offered no explanation for their delay in filing. Thus, this factor strongly weighs in favor of denying institution. *United Fire Protection*, 15 (“Here, the circumstances show that the availability of Patent Owner's arguments and the Board's findings and conclusions of law in the 136 IPR provided substantial potential benefit to Petitioner to tailor its arguments. In view of the above, Factor 3 weighs strongly in favor of invoking our discretion to deny institution.”).

4. *The Length of Time That Elapsed Between the Time the Petitioner Learned of the Prior Art Asserted in the Second Petition and the Filing of the Second Petition*

Petitioners knew of the asserted prior art at least as of July 2022, nearly six full months before the instant Petition was filed, but potentially much earlier if the Board finds that at least Dropbox is an RPI of Unified. This factor strongly weighs in favor of denial of institution. *General Plastic*, 11 (“Petitioner provided no explanation in its Petition or in its Reply to Patent Owner's Preliminary Response

of any unexpected circumstances that prompted the new prior art searches, or for the delay.”)

5. Whether the Petitioner Provides Adequate Explanation for the Time Elapsed Between the Filings of Multiple Petitions Directed to the Same Claims of the Same Patent

Petitioners provide no explanation whatsoever for the time elapsed between filings. This factor strongly weighs in favor of denial of institution. *General Plastic*, 11.

6. The Finite Resources of the Board; and the Requirement Under 35 U.S.C. §316(a)(11) to Issue a Final Determination Not Later Than 1 Year After the Date on Which the Director Notices Institution of Review

The Petition at issue is the second petition on the exact set of claims first challenged by Unified in in the ‘782 IPR. Further, any potential final written decision would not issue until after trial is completed in Delaware. Institution would be a waste of judicial resources. *General Plastic*, 10-11; *Pfenex, Inc. v. Glaxosmithkline Biologicals SA*, IPR2019-01478, Paper 9, 15 (PTAB 2020) (“In general, having multiple petitions challenging the same patent, especially when not filed at or around the same time, as in this case, is inefficient and tends to waste resources.”); *NetApp, Inc. v. Realtime Data LLC*, Case IPR2017-01195, paper 9, 12–13 (PTAB 2017) (denying institution under 35 U.S.C. §314(a) of a follow-on petition filed by a different petitioner where, due to petitioner’s delay, the Board

likely would not have been able to rule on patentability until after the district court trial date); *TPG*, 58.

In summary, the factors weigh in favor of denying institution, and the Board should exercise its discretion in accordance therewith.

### **III. Petitioners Have Not Shown A Reasonable Likelihood Of Prevailing With Respect To Any Claim**

#### **A. Petitioners Have Failed to Establish a Reasonable Likelihood of Prevailing on Ground 1 Because the Prior Art Fails to Disclose Several Expressly Recited Features of the Claims**

Ground 1 of the Petition must fail because Sigurdsson in view of Shappell does not disclose several claimed features, including but not limited to, for example:

- 1) a first electronic device configured to automatically send, via the first application , the modified first electronic file copy to a third application at the third electronic device responsive to the determination that the first electronic device is in communication with the third electronic device and responsive to receiving the modified first electronic file copy from the second electronic device (e.g., [1d]<sup>7</sup>),
- 2) automatically send, via the first application, the modified second electronic file copy to the second application at the second electronic device

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<sup>7</sup> For the Board's convenience and ease of reference, the claim element numbers used in the Petition are referenced throughout this document.

responsive to the determination that the first electronic device is in communication with the second electronic device and responsive to receiving the modified second electronic file copy from the third electronic device (e.g., [1g]),

- 3) automatically sending, via the first application, the modified first electronic file copy to a third application at the third electronic device responsive to the determination that the first electronic device is in communication with the third electronic device and responsive to receiving the modified first electronic file copy from the second electronic device (e.g., [10c]), and
- 4) automatically sending, via the first application, the modified second electronic file copy to the second application at the second electronic device responsive to the determination that the first electronic device is in communication with the second electronic device and responsive to receiving the modified second electronic file copy from the third electronic device (e.g., [10f]).

Instead of considering the disclosure of the primary reference, Sigurdsson, as a whole, or even the full description of the relied-upon embodiment in Sigurdsson, the Petition relies on select sentences taken out of context while ignoring the principal structure and operations taught by Sigurdsson.

1. *Sigurdsson does not disclose “automatically send, via the first application, the modified first electronic file copy to a third application at the third electronic device ... responsive to receiving the modified first electronic file copy from the second electronic device”*

The plain language of the challenged claims specify that the first application at the first electronic device (i.e., a server) automatically sends the modified first electronic file copy to a third application at the third electronic device. For example, claim 1 recites:

[1d] ([1a] a first electronic device, associated with a user, configured to: ... ) **automatically send**, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device responsive to the determination that the first electronic device is in communication with the third electronic device and **responsive to receiving the modified first electronic file copy from the second electronic device.**

Independent claim 10 [10c] recite similar claim language.

According to the claims of the '942 Patent, it is the first electronic device that is configured to “automatically send” the modified first electronic file copy to a third application at the third electronic device. Sigurdsson discloses anything but a first electronic device automatically sending a modified first electronic file copy.

To the contrary, Sigurdsson discloses a system, in which, a receiving device (i.e., a Client C 406) performs several operations before requesting a copy of missing content. Much of Sigurdsson discusses client devices requesting such missing content from other client devices, in a peer-to-peer arrangement. See Abstract. Sigurdsson describes an embodiment in which Client C obtains missing content from a server 106. Only in response to the server receiving the request from Client C does it transmit that content to Client C. (FIG. 4, 6, ¶¶71-75, 80 (EX2013, ¶77). Therefore, in Sigurdsson, the server (*allegedly* corresponding to the claimed first electronic device) does not automatically send 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. (EX2013, ¶77).

For an alleged teaching of claim [1d], the Petition relies on Sigurdsson, FIGS. 4, 6, ¶¶51-55, 68-80 and Balakrishnan, ¶¶429-446. Pet., 21-26. The Petitioners' analysis is lacking, as it fails to show each and every element of the claimed features including, the first electronic device being configured to “**automatically send**, via the first application, the modified first electronic file copy to a third application at the third electronic device responsive to the determination that the first electronic device is in communication with the third electronic device and **responsive to receiving the modified first electronic file copy from the second electronic device.**”

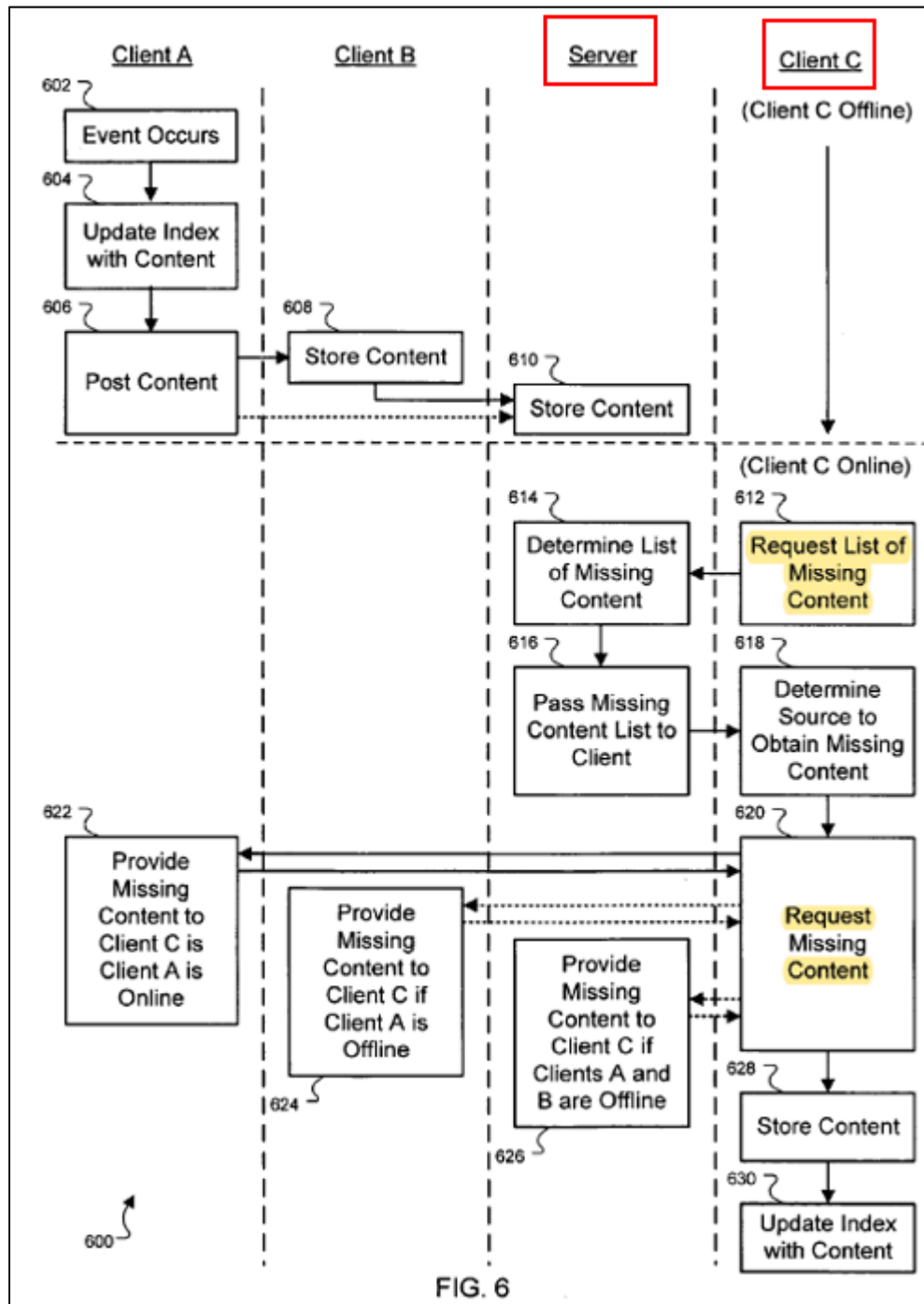
The “**automatically send**” feature in the claims of the ’942 Patent refers to the automatic aspect from a first electronic device’s perspective (that is, the first electronic device automatically sends the modified first electronic file copy). (EX2013, ¶78). Claim 1, for example, recites “a first electronic device, associated with a user, configured to: ... **automatically send**, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device ... **responsive to receiving the modified first electronic file copy from the second electronic device.**”

As such, the issue here is not *merely* whether Sigurdsson discloses an automatic synchronization from a user’s perspective. Instead, the issue is whether Sigurdsson discloses a first electronic device (i.e., a server) that **automatically sends** the modified first electronic file copy to the third electronic device. It does not.

Not only does Sigurdsson fail to teach or suggest that first electronic device “**automatically send[s]**, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device”, it also fails to disclose that such a transfer is “**responsive to receiving the modified first electronic file copy from the second electronic device.**”

Sigurdsson, in FIG. 6 (reproduced below with annotations), discloses a sequence diagram of a request/response based mixed peer-to-peer and client/server architecture, including a server, and clients A, B, and C. As shown in FIG. 6, the

server in Sigurdsson provides missing content only in response to a request from a client (e.g., “Client C” at steps 612 and 620). (EX2013, ¶80).



Sigurdsson (EX 1016), FIG. 6

That is, in FIG. 6, client/server structure and operation of Sigurdsson requires at least two separate requests from the client device (“Client C”) to the server, before the server provides the missing content to the client device, neither of which are **“receiving the modified first electronic file copy from the second electronic device”**. (EX2013, ¶80).

Specifically, Sigurdsson requires the following steps in order:

- “In step 612, the third client **requests** a list of missing content from the server. For example, the Client C 406 **requests** a list of missing content from the Server 106 when it connects to network that links the server and other clients, such as the Internet”. (¶69).
- In response, “In step 616, the server passes the list of missing content to the third client (e.g., Client C), which had been offline.” (¶73).
- Subsequently, “In step 618, the third client uses the list it received from the server to **determine where it can obtain the missing content...**” (¶74). In another alternate embodiment of step 620, both the first and second clients can be offline at the time of the third client's request for missing content. In this case, the third client can obtain the missing content from the server. (¶79).
- Finally, “[i]n step 626, the server sends the missing content to the third client. For example, referring to FIG. 4, the Server 106 sends Content 410 to the Client C 406.” (¶80).

It is only after going through this sequence of Client C expressly requests the server for any missing content, Client C determining where it can obtain that missing content, and then requesting the content from the server, the server responds by transferring the content to Client C. (EX2013, ¶81). As such, in Sigurdsson, the server 106 does not **automatically send** the content 410 to the Client C 406 responsive to receiving the content 410 from Client A 402. (EX2013, ¶81).

This aspect is further evident throughout the disclosure of Sigurdsson. For example, Sigurdsson at FIG. 2 and ¶¶ 37, 40 and 46 discloses a request for missing content from the second client. For instance, “**the second client polls** for updates” (¶37), “the client requests the updated content that it needs. For example, in FIG. 1, the Client B104 sends a request to the Server 106 for the missing Client A Content 108” (¶40), and the request is “**periodically issue[d]**”, “**the request 310 includes a Time Range 312 parameter** identifying the range of time stamps for the missing content” and “the Request 310 is issued **in order** for the Client B 104 to obtain the Client A Content 108 that the Server 106 has yet to send to the Client B104” (¶46) (EX2013, ¶82).

Moreover, the Petition’s reliance on FIG. 5 of Sigurdsson is misplaced because FIG. 5 and the related text provides only a general description without disclosing several of the claimed features including the “**automatically send**, via the first application (at the first electronic device), the modified first electronic file copy

to a third application at the third electronic device ... **responsive to receiving the modified first electronic file copy from the second electronic device**” as discussed above. In fact, the disclosure in FIG. 5 simply summarizes the request based file transfer approach from FIG. 6 discussed above in detail. (EX2013, ¶83).

In addition, the Petitioners admits that Sigurdsson requires “(3) receiving a request from Client C 406 for missing data”. Pet., 22. Dr. Balakrishnan attempts to make up for Sigurdsson’s deficiencies with respect to “automatically send” feature by plucking out the following statement from Sigurdsson “The Server 106 can then transmit the content to the remaining client peers, such as the Clients B and C.”. Balakrishnan, ¶436. However, when viewed under proper context, Sigurdsson discloses that only if the server 106 receives a request for the content from the Client C 406 (step 620), will the server provide the content to the client (step 626). ¶¶ 79-80. (EX2013, ¶84). In the example provided in the Petition for allegedly showing automatic transfer, Dr. Balakrishnan admits that the sever 106 only sends the missing data to client C in step (4), after receiving a request for Client C for missing data in step (3). Balakrishnan, ¶523.

Here, both the Petitioners and Dr. Balakrishnan acknowledge that Sigurdsson discloses a request-response based system, which contradicts a server “automatically” sending a file to a receiving device without a request for content from the receiving device. Accordingly, Sigurdsson does not teach or suggest that

the first electronic device “**automatically send**, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device ... **responsive to receiving the modified first electronic file copy from the second electronic device**”. (EX2013, ¶86). A POSA would not have found it obvious to replace the request-response architecture taught by Sigurdsson with the claimed feature of automatically sending the modified file without any client request for the modified file. (EX2013, ¶87). In fact, it would not be obvious to replace a fundamental feature of Sigurdsson’s request-response architecture, namely, providing a service in response to a request from a client with an “automatic” provision of a service (i.e., sending a file) without any client request for the missing content. For the reasons set for above, Sigurdsson does not teach or suggest “**automatically send**, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device ... **responsive to receiving the modified first electronic file copy from the second electronic device**.”

2. The terms “automatically send” and “responsive to receiving the modified first electronic file copy from the second electronic device” must be given proper and full weight

The requirements of “**automatically send[ing]**” “**responsive to receiving the modified first electronic file copy from the second electronic device**” cannot be ignored. See, e.g., *Rovi Guides, Inc. v. Vidal*, No. 2020-1994, 2022 U.S. App.

LEXIS 10465, at \*5-6 (Fed. Cir. Apr. 19, 2022) (“The available-to-a-user limitation requires the claimed system be configured to check whether an archived program is available to a specific user. A broader construction, which would only require the system be configured to check whether an archived program exists, would render the ‘to the user’ language meaningless ... So the ‘to a user’ phrase in claim 1, presumably, must add something more. Indeed, the system must not only check whether an archived copy exists; it must ensure the specific user has access to that copy”).

In *Rovi Guides*, in overruling the PTAB which found the claims obvious, the Federal Circuit held that all terms included in the claim must be considered since each term must add something more. Applying the same rationale, the terms **“automatically”** and **“responsive to receiving the modified first electronic file copy from the second electronic device”** each must add something more in the claimed feature **“automatically send, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device ... responsive to receiving the modified first electronic file copy from the second electronic device.”**

The **“automatically send” “responsive to receiving the modified first electronic file copy from the second electronic device”** limitation requires the claimed system to not *merely* have the modified first electronic file copy end up at

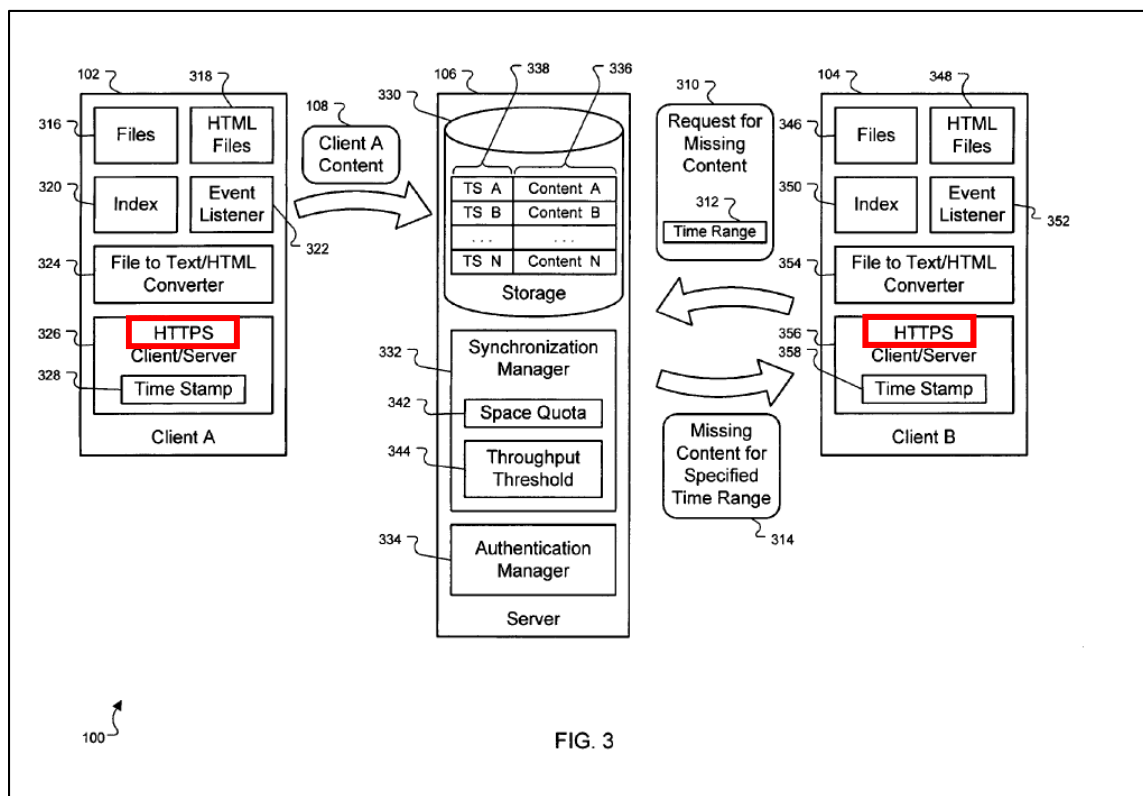
the third electronic device in any arbitrary manner, but the limitation requires the first electronic device to **automatically send** the modified first electronic file copy to the third electronic device **responsive to receiving the modified first electronic file copy from the second electronic device** without a request for the missing content from the third electronic device.

As such, since Sigurdsson discloses that the server 106 only transfers the missing content when requested by the client C 406 (i.e., after a request for missing content from the client C 406), the sending of the content to the client C 406 by the server 106 in Sigurdsson is responsive to a request from the client C 406 and not responsive to receiving the modified first electronic file copy from the second electronic device, and therefore, in Sigurdsson, the content is not automatically sent by the first electronic device (i.e., the server) responsive to receiving the modified first electronic file copy from the second electronic device. (EX2013, ¶88).

For the reasons set for above, when the terms “**automatically send**” “**responsive to receiving the modified first electronic file copy from the second electronic device**” are given full and proper weight as required, Sigurdsson does not teach or suggest “**automatically send**, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device ... **responsive to receiving the modified first electronic file copy from the second electronic device.**”

3. HTTP Client/Server architecture structurally requires a request then response based approach

In FIG. 3 (reproduced below with annotations), Sigurdsson discloses that the client devices 102 and 104 are implemented as a hypertext transfer protocol secure (HTTPS) client/server structure (i.e., HTTPS Client/Server 256 and HTTPS Client/Server 356). ((EX2013, ¶189).



Sigurdsson (EX 1016), FIG. 3

HTTP (Hypertext Transfer Protocol) is a protocol used to carry requests from a browser to a Web server and to transport pages from Web servers back to the requesting browser. (EX2015, Microsoft Computer Dictionary, p.259). Moreover, a HTTP server is server software that uses the HTTP protocol to serve up HTML

documents and any associated files and scripts when requested by a client, such as a Web browser (EX2015, Microsoft Computer Dictionary, p. 260). (EX2013, ¶90). An HTTP/HTTPS server (e.g., the web server) plays the role of a server in a client–server model by implementing the server part of the HTTP/HTTPS network protocol. (DEC. XX). An important feature of an HTTP/HTTPS server is that the HTTP/HTTPS server waits for incoming client requests and for each request the HTTP/HTTPS server responds by providing the requested information or performing a requested task. (EX2013, ¶90). The HTTP/HTTPS server does not perform actions on its own without a request from a client. (EX2013, ¶90). Since the HTTP protocol is a request-response protocol, where clients send HTTP requests to the server and the server sends HTTP responses after processing each request, the HTTP protocol does not support a functionality where the server can automatically send data to a client without the client making requests for data. (EX2013, ¶90).

FIG. 3 of Sigurdsson teaches a HTTPS server, which does not perform functions “automatically” without client requests for content. (EX2013, ¶91). Thus, Sigurdsson requires a HTTPS server system based on an HTTP request/response process for data transfer between the client and the server as illustrated in FIG. 3. (EX2013, ¶91). Therefore, Sigurdsson not only fails to disclose the features of “**automatically send**, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device

... responsive to receiving the modified first electronic file copy from the second electronic device”, it would not have been obvious to replace the principal structure (i.e., the server system based on an HTTP request/response process ) taught by Sigurdsson with the automatically transfer of a copy of the file to a client without any client request to satisfy the claim features. (EX2013, ¶91). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). Specifically, a POSA would not have found it obvious to replace the request-response based HTTP server taught by Sigurdsson with the claimed features of “automatically send” the modified electronic file copy to the third electronic device without any client request for the missing data. (EX2013, ¶91). In fact, it would not have been obvious to modify a fundamental feature of an HTTP architecture, namely, providing a service in response to a request from a client with an “automatic” provision of a service without any client request.

4. Shappell does not cure the deficiencies of Sigurdsson

Shappell is directed to “a **peer-to-peer network environment** to facilitate network communications among group members.” (¶7). Specifically, Shappell discloses,

a computer implemented method and system enable users to share files in a **server-less** shared space. By providing access to such **[server-less]** spaces via a visual presentation, the system renders content available for access by other group members. Access is sometimes provided through propagation of metadata or other uniquely identifying indicia associated with the shared space to all group members.

Abstract. (EX2013, ¶93).

Here, Shappell *expressly* teaches away from using a server. Consequently, Shappell cannot disclose a first electronic device (i.e., a server) **automatically sending** the modified first electronic file copy to a third application at the third electronic device. Accordingly, even if, assuming *arguendo*, Sigurdsson were to be modified based on Shappell, the modified structure still fails to teach or suggest the first electronic device (i.e., a server) “**automatically send**, via the first application (at the first electronic device), the modified first electronic file copy to a third application at the third electronic device ... **responsive to receiving the modified first electronic file copy from the second electronic device**.”

For at least these reasons, Shappell does not supply for the missing features in Sigurdsson.

5. Sigurdsson does not disclose “automatically send, via the first application, the modified second electronic file copy to the second application at the second electronic device ... responsive to receiving the modified second electronic file copy from the third electronic device”

Claim 1 [1g] further recites that the first electronic device is configured to **“automatically send, via the first application, the modified second electronic file copy to the second application at the second electronic device responsive to the determination that the first electronic device is in communication with the second electronic device and responsive to receiving the modified second electronic file copy from the third electronic device.”**

Independent claim 10 [10f] includes similar claim language.

For the reasons discussed above in connection with [1d], Sigurdsson in view of Shappell fails to disclose these features of claims [1g] and [10f].

**B. Petitioners Have Failed to Establish a Reasonable Likelihood of Prevailing on Ground 2 Because the Prior Art Fails to Disclose Several Expressly Recited Features of the Claims**

1. Brown does not disclose “automatically transferring the modified first electronic file copy to the third electronic device”

The plain language of the challenged claims specifies that a first electronic device, associated with a user is configured to automatically send, via the first application, the modified electronic file copy to the second or third electronic device responsive to the determination that the first electronic device is in communication with the second or third electronic device and responsive to receiving the modified

electronic file copy from the third or second electronic device, as recited in the claims, features [1d], [1g], [10c], [10f]. For example, as explicitly recited in claim [1d], the modified first electronic file copy, received from the second application at the second electronic device, is **automatically** transferred from the first electronic device to the third electronic device.

Petitioners argue that Brown discloses automatic file synchronization, citing Brown at 3:40-47. (“From the user's perspective, the synchronization process is automatic, runs in the background and requires minimal monitoring or intervention.”). Pet., 44. However, the automatic process described in Brown is from the user’s perspective, meaning that the process may need little or no involvement of human operation from the user. In contrast, the automatic transfer in the claims of the ’942 Patent refers to the automatic aspect from the server’s point of view (that is, the first electronic device executing the first application), in view of the recitation “**a first electronic device ... automatically send**, via the first application, **the modified first electronic file copy** to a third application **at the third electronic device ...**” of claim 1, and similarly claim 10, of the ’942 Patent. That is, the claims of the ’942 Patent indicate that the server is to send the modified file to the client without a need for the client to explicitly request it.

Brown’s disclosure is unambiguously directed to the opposite manner, that is, the file synchronization must be initiated by the client request to the server. Brown’s

approach therefore cannot satisfy the automatic transfer requirement of the claims of the '942 Patent – *i.e.*, the server transfers the file on its own without a request from a client. (EX2013, ¶ 95).

That is, the claims of the '942 Patent adopt a *push*-based file transfer from the server to the client, without the need for the client to explicitly request it. Brown's disclosure is directed to the opposite method, that is, client *pull*. In Brown, the client SA or the user must initiate synchronization. Absent such request, the server would not initiate the transfer of the version of the file generated from the user modifying the content of the file. (EX2013, ¶ 96).

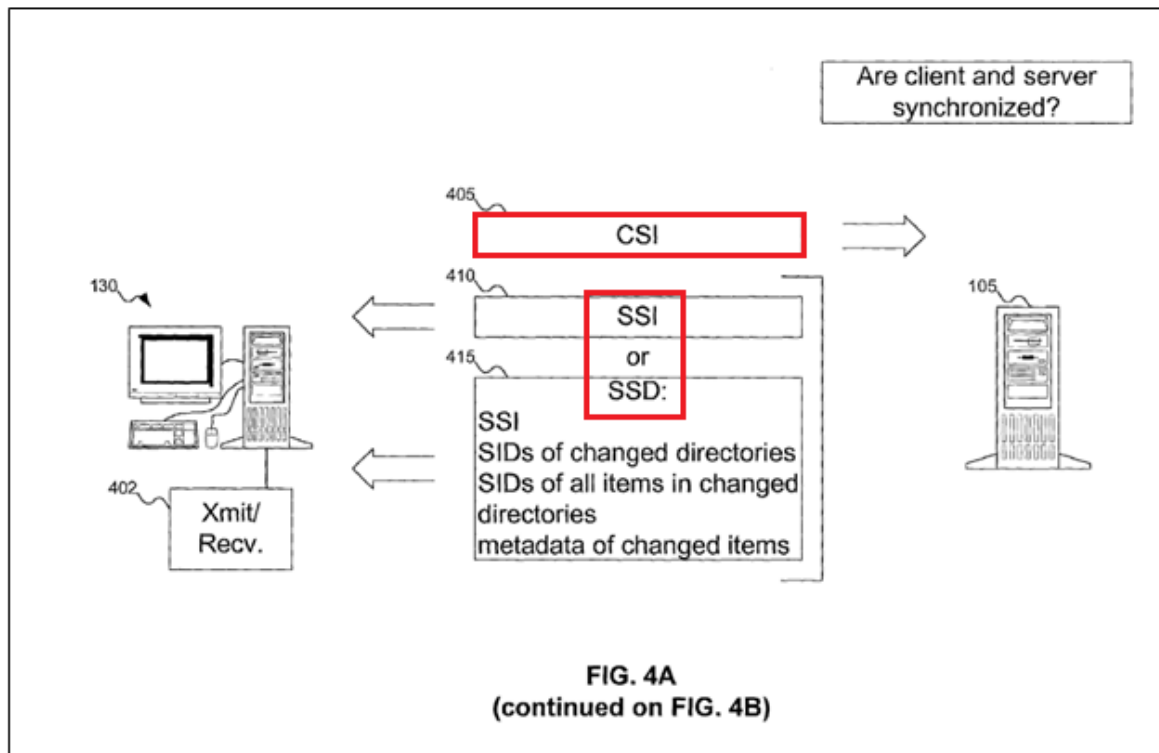
For an alleged teaching of claim [1d], Petitioner rely on Brown at 2:63-67, 3:1-8 and Balakrishnan, ¶¶896-898 and argue "After execution of the functionality discussed for claim [1b], above, **client 135 would initiate communication with the server** and receive a copy of the modified first electronic file sent to server 105 by client 130." Pet., 55. However, as Petitioners correctly acknowledge, in Brown, to synchronize with the server, the client must pull changes from the server, as opposed to the modified file being "automatically" transferred from the server to the client. Clearly, Brown uses a protocol that uses a "pull" mechanism and not the server automatically pushing the modified file to the client. In the "pull" mechanism, the client does not know when new data is available and the client must poll the server

to see if there is new data available to the client and request that data from the server (i.e., pull the data). (EX2013, ¶ 98).

In Brown, the client SA needs to poll the server to check if there are any changes to make to the client's directory and metadata to be synchronized to the server state. Brown, 5:14-27 (“The synchronization process is **initiated by a client SA when it makes a sync poll call to the server**, passing it the client sync index (CSI) identifying its current known state of the account.”) In detail, referring to FIG. 4A and 10:9-30 of Brown, the client 130 first sends the client sync index (CSI) to server 105, as shown in box 405, to see if server 105 and client 130 are synchronized. Server 105 compares the received CSI with the server's current server sync index (SSI). If server 105 returns the SSI having the same value as the CSI to the client, as shown in box 410, client 130 knows that client 130 is synchronized with server 105. If the SSI received from server 105 does not match with the CSI of the client, the client's directory is not up to date and the client then requests server synchronization data (SSD) to learn about the new changes that have been made at server 105. (“If the CSI matches the server account's SSI value, then the client is up to date with the server. Otherwise **the client SA requests server synchronization data (SSD)**.”; Brown, 8:51-53). (EX2013, ¶ 97).

If server 105 has changes that client 130 lacks, server 105 then “sends the SSD to client 130 (in response to a request for the SSD by the client), informing the client

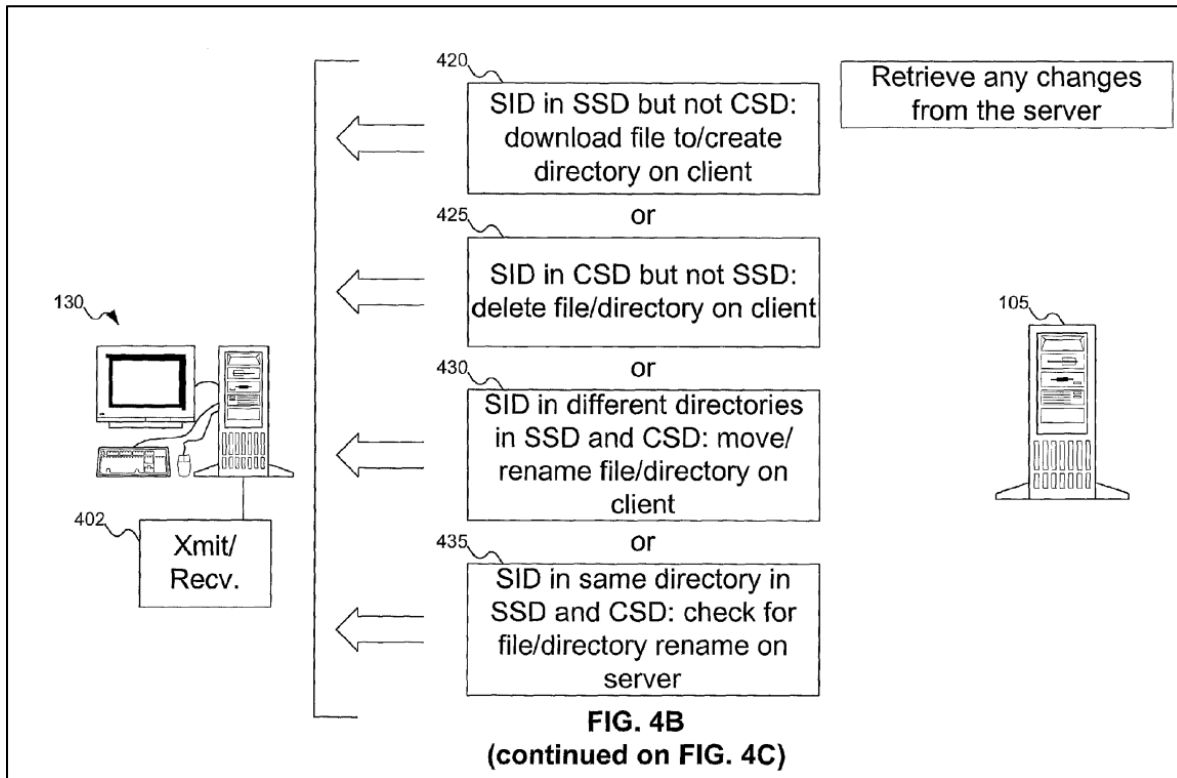
of the pertinent changes, as shown in box 415.” Brown, 10:19-21. Based on the SSD received from the server, “the client SA updates the client's directory and metadata to match the server state.” Brown, 8:62-63. (EX2013, ¶ 99).



Brown (EX 1025), FIG. 4A

Specifically, the client SA maintains client synchronization data (CSD) that it uses to track the state changes of the server, and by comparing the SSD with its CSD, client 130 can determine what changes have been made to the account on server 105. Brown, 8:63-65. Referring to FIG. 4B, Brown illustrates the update process **performed by the client** in which the client determines what updates need to be retrieved from the server based on any of four possible results of the comparison

between the SSD and the CSD and requests the changes related to the file or directory from the server. Brown, 10:45-48. That is, in Brown, the changes are retrieved from the server **upon the request received from the client**. (EX2013, ¶ 100).



Brown (EX 1025), FIG. 4B

Petitioners admit that Brown requires the client to access the server to find out if there are any changes to download (“[I]t would have been obvious that Brown’s synchronization process on laptop client 135 would **begin by checking** whether the server has any updates, including updates from other client devices, such as desktop client 130.”). Pet., 55. Thus, Brown does not disclose

“automatic” transmission of modified file from the server to the client. Further, Brown requires the client to download the changes upon determining that changes have been made to the server account. See e.g., Brown, 10:53-54 (“[C]lient 130 has **downloaded all the pertinent changes** from server 105.”), 11:19-21 (“[C]lient 130 ... returning to box 415 on FIG. 4A to **download the changes** made on the server by the other client.”), 14:2-3 (“At step 840, the client synchronizes with the server to **download any changes** on the server.”). As discussed above, the client downloading the requested changes is pull type, not the server pushing data to the client. (EX2013, ¶ 101).

2. HTTP Client/Server architecture structurally requires a request then response based approach

Brown at 4:2-5 discloses that communication between the clients and server 105 is tunneled within the hypertext transport protocol (HTTP).

As discussed above in II.B.3, the HTTP protocol is a request-response protocol, the HTTP servers use the client-pull architecture, where clients send HTTP requests to the server and the server sends HTTP responses after processing each request. The HTTP protocol does not support push-based functionality where the server can automatically send data to a client without the client making requests for data. (EX2013, ¶ 103).

Brown teaches a HTTPS server, which uses a client-pull architecture and does not perform functions “automatically” without client requests. Thus, Brown requires a HTTPS server system based on an HTTP request/response process for synchronization. Therefore, Brown fails to disclose the features related to “**a first electronic device ... automatically send, via the first application, the modified first electronic file copy to a third application at the third electronic device.**”

Furthermore, it would not have been obvious to replace the principal structure (i.e., “the pull-based HTTP server”) of Brown with a push-based server that automatically pushes data to a client without any client request. Specifically, a POSA would not have found it obvious to replace the pull-based HTTP server taught by Brown with a push-based server that automatically pushes data to a client without any client request. Neither Petitioners provide any rationale for making such replacement. In fact, a fundamental feature of an HTTP architecture, namely, providing a service in response to a request from a client teaches away from an “automatic” provision of a service without any request. (EX2013, ¶ 104).

3. *Brown cannot be modified to disclose push-based file transfer because it would change Brown’s principle of operation*

Brown specifically states at 3:17-28:

The client/server architecture is designed to **minimize the load on the server processor** in order to maximize server scalability. To that end, as many processor-intensive operations

as possible, such as message digest computation and comparison, data encryption and decryption, and **synchronization itself, are performed by the client SA**. Also, the **polling mechanism used by the client SA** to determine if the client is synchronized with the server is designed to **require minimal processing on the server** when the client and server are in sync. This is significant because as a rule only a small percentage of clients require synchronization activity at any point in time.

As noted above, Brown aims to minimize the load on the server processor, and to that end, as many synchronization operations as possible are performed by the client, including the operation to make a sync poll call to the server.

Accordingly, a POSA would not have been motivated to modify Brown to reach push-based file transfer (EX2013, ¶¶ 105-107). It is well settled that if the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references cannot be relied upon to render the claims prima facie obvious. *See In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

4. Hesselink teaches a pull-based HTTP server system and thus fails teach automatic file transfer by the server

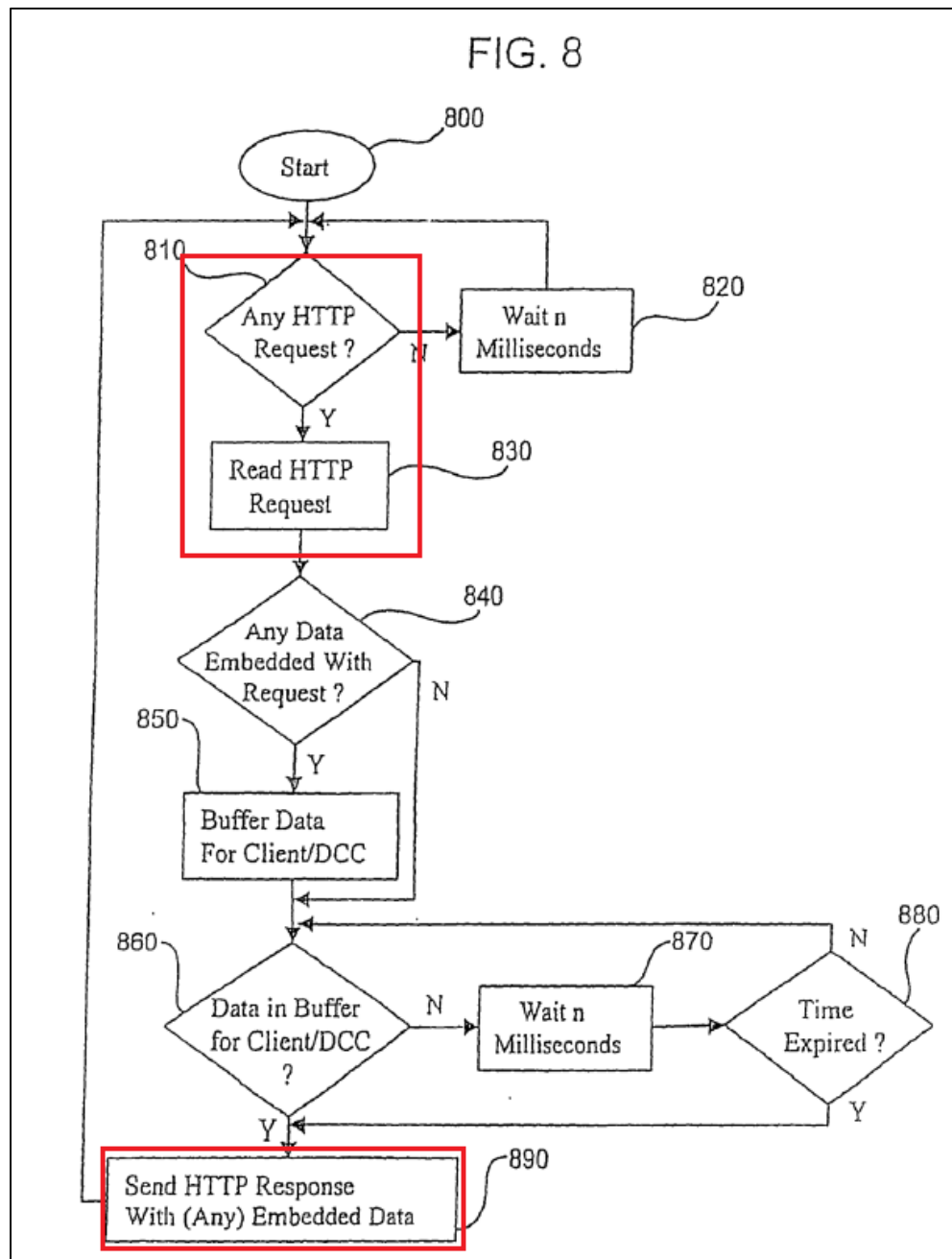
Just like in Brown, Hesselink uses a pull mechanism in its file synchronization process. That is, in Hesselink, the client must initiate a request for any update to the connection server. (EX2013, ¶ 108).

A data transfer process based on this client pull mechanism is described in detail at Hesselink, ¶109:

... Data from the device(s) 18 a-18 n that are destined for client computer(s) 12 a-12 n are posted to the connection server 14 a-14 n **using an HTTP request** as previously described. Receiving the HTTP request, the connection server 14 a-14 n then temporarily stores or buffers any data from the request in its memory (i.e., the sending buffer). The **next time an HTTP request comes from client computer 12 a-12 n** (in this example, but as noted above, a request could also be from another device control computer 36 a-36 n), the connection server 14 a-14 n retrieves the data from the sending buffer and sends the data to client computer 12 a-12 n (or other device control computer 36 a-36 n), **along with the response for the HTTP request**. Like the request sending procedure described above, the response sending procedure is also efficiently adaptive for sending data substantially as quickly as it has been received, **with persistent polling also being provided by the HTTP requests** which occur at least within a maximum defined

interval, regardless of whether any data is being sent along with the HTTP request.

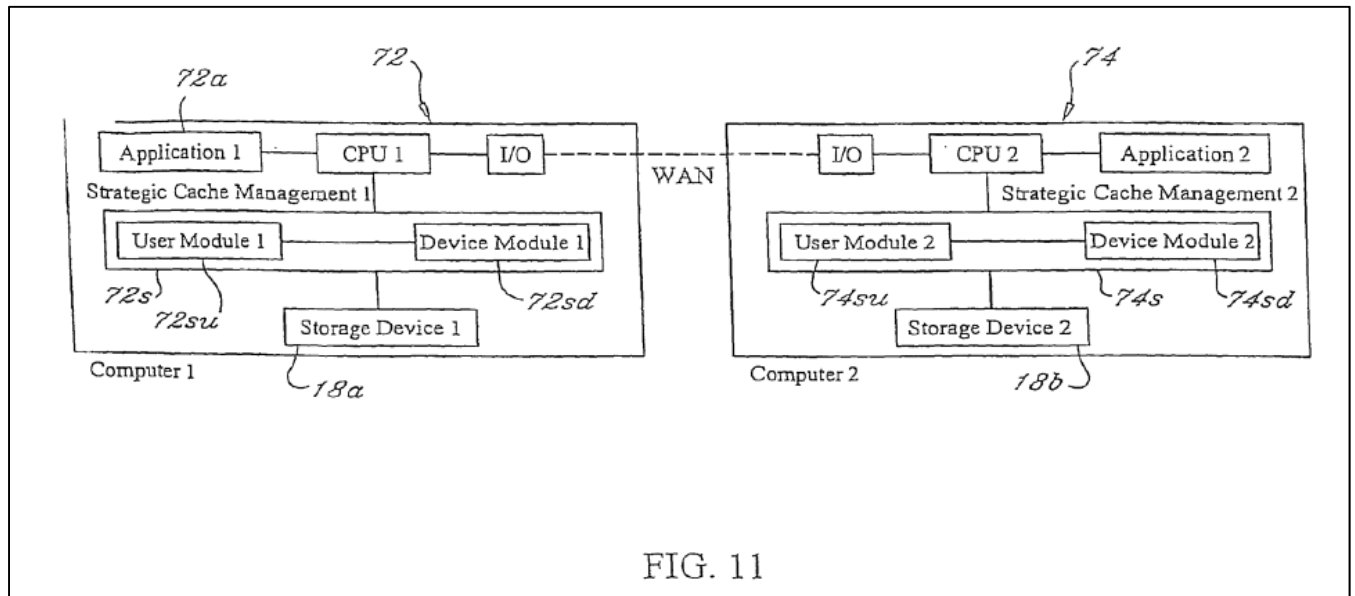
This HTTP request/response process for data transfer between the client and the connection server is illustrated in FIG. 8 of Hesselink. The process includes event 810 in which it is determined “whether or not **any HTTP request has been received** from client computer 12 a-12 n (or device control computer 36 a-36 n)”; if an HTTP request has been received and there is no data is embedded within the HTTP request, event 860 in which it is determined “if there is any data present for client computer 12 a-12 n from network-enabled device 18 a-18 n”; and event 890 in which “**an HTTP response** is sent to client computer 12 a-12 n by connection server 14 a-14 n,” and “[i]f any data was present in the connection server sending buffer for client computer 12 a-12 n, this data is **embedded within the HTTP response.**” Thus, Hesselink is precisely focused on a data transfer process based on client pull, which is implemented by clients sending HTTP requests to the server to request the data. This is the opposite to the server initiating data push to a client. (EX2013, ¶ 109).



Hesslink (EX 1026), FIG. 8

5. The Petition relies upon Hesselink's peer-to-peer embodiment, which cannot be modified to teach "automatic transfer" of the modified file from the server to a client device

Petitioners argue that: "[I]t would have been obvious in view of Hesselink to automatically forward updated files from server 105 to synchronizing clients as soon as file updates are received at server 105," citing Hesselink, ¶183. Pet., 56. However, updating designated subset of computers when data is updated as described in Hesselink, ¶183 is from the context of a file subscription discussed in Hesselink, FIGS. 11-13, which is based on a peer-to-peer connection between two computers, as opposed to a client-network architecture. Specifically, referring to FIG. 11 of Hesselink, two computers 72, 74 are connectable across a wide area network and a user module 72su of the computer 72 accesses data from remote storage device 18 b and user module 74su of the computer 74 accesses data from remote storage device 18 a. (EX2013, ¶ 110).



Hesselink (EX 1026), FIG. 11

Referring now to FIGS. 11 and 12 of Hesselink, where the user module 72su of the computer 72 receives a request from the user to browse through files and directory of the remote file systems of storage device 18 b, “it may first check its local cache to find whether such file overhead information is available and valid at event 1202.” Hesselink, ¶137. If the user module 72su is actively subscribed to the device module 74d of the second computer 74 and an active subscription period is running, it is determined that there is file overhead information that is available and valid at event 1204, and the device module 74sd sends any updates to user module 74su regarding the file overhead information of the associated directory over the prescribed active subscription period, at event 1214. Hesselink, ¶¶137, 139. Clearly, Hesselink merely discloses updating, by a first computer, a second

computer with the file overhead information such as file name, file size, folder status, last modified date, created date, etc. regarding its directory (Hesselink, ¶71), upon receiving a request to access to its local storage from the second computer. (EX2013, ¶ 111).

While acknowledging the deficiency in Hesselink’s embodiment due to the peer-to-peer environment, Petitioners still argue that a POSA would not have been dissuaded from combining Hesselink with Brown in view of Hesselink’s use of a peer-to-peer model as opposed to Brown’s client/server model. This is opposite to what Hesselink actually teaches. Hesselink addresses the security concerns in using server/client architecture for file synchronization. (“[M]any users may be uncomfortable storing photos of their families on some photo service server in some unknown location where it is also often unknown what level of security (if any) such server is provided with.”; Hesselink, ¶6). To solve this problem, Hesselink proposes a peer-to-peer method that allows users to access their files on any network accessible communication device, from any location accessible over that network. Hesselink, ¶10. Thus, contrary to Petitioners’ assertion, Hesselink clearly disparages or teaches away from implementing its method in a client/server model. (EX2013, ¶ 112).

Petitioners argue that “Hesselink does not teach that the devices in its synchronization network must not include any servers” and cites Hesselink, ¶122

as allegedly teaching any of computers 72, 74 and 76 as being a computer device including “file server.” Pet., 52. However, while Hesselink mentions including a server within its peer-to-peer system, such server only serves as a pipeline or conduit between two peers. Also, the “file server” mentioned in Hesselink, ¶122 is only an example of a type of computing device of computers 72, 74 and 76, each of which are peers in the peer-to-peer architecture (i.e., nodes between which a direct link is provided). The mere mention of a “file server” that may implement any of computers 72, 74 and 76 in FIG. 11 of Hesselink, ¶122 by no means implicates, let alone render obvious, Hesselink’s applicability to a client/server model. (EX2013, ¶ 113).

Furthermore, it would have been apparent to a POSA that Hesselink’s file synchronization based on the peer-to-peer system cannot be modified with the technique based on the client-server system as these systems employ two fundamentally different architectures. A peer-to-peer network allows computer hardware and software to communicate between peers. Unlike a client-server architecture, there is no central server for processing requests in a peer-to-peer architecture. A peer-to-peer based file synchronization is entirely different from the client-server system because each node is the one that processes the query from another node to decide whether to grant or deny it and thus each node should have the capability to access and manage information of other nodes. A POSA would

have been prevented from deriving the claimed invention from Brown and Hesselink because these two references teach fundamentally different architectures and are incompatible. (EX2013, ¶ 114).

#### **IV. Conclusion**

For at least the foregoing reasons, the Petition should be denied in its entirety, and no *inter partes review* should be instituted.

Date: May 9, 2023

Respectfully submitted,

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