

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOX, INC and DROPBOX, INC.,
Petitioner

v.

TOPIA TECHNOLOGY, INC.,
Patent Owner.

IPR2023-00427 (Patent 9,143,561 B2)
IPR2023-00433 (Patent 10,067,942 B2)

Record of Oral Hearing
Held: May 22, 2024

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

IPR2023-00427 (Patent 9,143,561 B2)

IPR2023-00433 (Patent 10,067,942 B2)

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The above-entitled matter came on for hearing on Wednesday,
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1 P R O C E E D I N G S

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3 JUDGE KENNY: This is the consolidated hearing for IPR2023-00427
4 and IPR2023-00433. I'm John Kenny. Appearing with me today are Judges
5 Giannetti, Powell, and Boudreau. Starting with the Petitioner, please enter
6 your appearance for the record.

7 MR. MEAD: Hello, Lowell Mead, on behalf of Petitioners Box and
8 Dropbox. And also with me is lead counsel, Ms. Heidi Keefe.

9 MS. KEEFE: Good morning or good afternoon. Sorry.

10 JUDGE KENNY: And who will be arguing today on behalf of
11 Petitioner?

12 MR. MEAD: I will be, Your Honors, but Ms. Keefe is here in the
13 room, present as lead counsel, but I'll be handling the argument.

14 JUDGE KENNY: Patent Owner?

15 MR. SALIBA: Hello, Your Honors. Raja Saliba, lead counsel for
16 Patent Owner Topia Technology, Inc. With me here today are backup
17 counsels Jay Lytle, Ebenesar Thomas, and Roman Rachuba arguing today.
18 Presenting on behalf of Patent Owner will be Ebenesar Thomas and Jay
19 Lytle with respect to grounds 1 and 2.

20 JUDGE KENNY: All right. Before we proceed, this is a public
21 hearing. Members of the public may be observing. During your argument,
22 be sure to identify any slide, exhibit, or paper you address. Please keep your
23 line on mute when you're not speaking. Please do not speak over one
24 another. If you have any technical difficulties, let the Panel or the IT
25 personnel to whom you've been in contact know. At the end of the hearing,
26 we're going to ask you to stay on the line so the court reporter can ask you

1 any questions the court reporter may have. No recording of this hearing by
2 anyone other than court reporter is permitted. Each side has been granted 90
3 minutes of argument time, a portion of which you can reserve for rebuttal.

4 Let's start with Petitioner. How much time do you want to reserve for
5 rebuttal?

6 MR. MEAD: We'll reserve 45 minutes.

7 JUDGE KENNY: All right, you may proceed.

8 MR. MEAD: Thank you. So, we'd like to start by going back to first
9 principles and considering the problems in the prior art that purportedly
10 existed and the proposed solutions both by the challenged patents and by the
11 prior art. And if Your Honors have reference to Petitioner's demonstratives,
12 I'll make reference to Exhibit 1049.

13 JUDGE KENNY: We do have access to them.

14 MR. MEAD: Okay, so, thank you. So, we could actually start with
15 slide 23. We have a summary and some excerpts from the background of
16 the invention, and I think all parties agree, and we're happy to, if Your
17 Honors are okay with it, the specifications of the patents are substantially the
18 same, and I think both sides will refer to the '561 Patent as representative.

19 And so, we have an excerpt here on slide 23. So, the specification
20 was filed 2006/2007 era. The issue at the time was a user may have multiple
21 different computers, right? So, the Internet had been around a few years,
22 people had network connectivity. As a user, I might have a computer at
23 home, I might have a separate computer at work, I might have a separate
24 laptop computer. And so, the issue that the patents are purporting to
25 address, so, as shown on our slide here, also in the '561 Patent, which is
26 Exhibit 1001, so, column 1 lines 31 through 37, although modern devices are

1 easily connected, they do not provide the customer a seamless environment.
2 The customer must manually handle many aspects of that connection. With
3 regards to file management, customers must manually move files between
4 their devices using some protocol like email, FTP, or by posting them on the
5 web. And the patent goes on to describe that leads to problems, right? So, it
6 can be undue complexity, it can be error prone. You know, it's a manual
7 human process, and it can be cumbersome. And the patent continues on.
8 You can see through slide 23 and slide 24, we have additional excerpts
9 describing that a customer has to manually move files as unnecessary and a
10 problem. We see on slide 24, continuing excerpts, manually using FTP,
11 manually emailing files. So, the proposed solution, and we have the excerpt
12 on slide 25. So, the proposed solution is, rather than the custom, the user
13 manually having to email themselves a file or manually post to an FTP site
14 and bring it down, we have a system set up so that there's automatic transfer.
15 So, we automatically transfer files between, say, my home computer and my
16 work computer and my mobile device, laptop. So, that's the core dichotomy,
17 the core proposed solution to the proposed problem.

18 And we see on slide 26, so in the detailed description of the proposed
19 invention in the patents, the only use of the word automatically outside of
20 the summary is that the invention, the embodiment of invention, allows a
21 user who's not shown, who owns or otherwise controls devices 210 and 280,
22 such as a home computer and a work computer, to automatically maintain
23 file synchronization between at least those devices and any other user
24 devices where you implement the invention. So, that's the core problem and
25 solution.

1 And then the problem for these challenged patents and claims is that
2 the prior art discloses exactly the same proposed problems in the prior art
3 and proposed solutions using the same wording. I mean, it's really strikingly
4 similar prior art. So, Sigurdsson, our first primary reference, if we look at
5 Exhibit 1016, if Your Honors would like to refer to it. So, the background
6 of the Sigurdsson reference describes, so in paragraph 2 of the background,
7 users want to have access to their digital information, whether they're on
8 their home computer, using a laptop at work, or on the road with a wireless
9 personal digital assistant. Paragraph 3 continues. It notes some current
10 systems permit a user to move files to a synchronization folder, which can
11 be used to transfer files between two or more clients. These systems,
12 however, may require explicit user action for this synchronization to take
13 place, i.e. it's manual. I mean, it's exactly the same issue. I've got my home
14 computer or work computer, but I need the user action. I need to manually
15 do that. And Sigurdsson describes exactly the same solution instead of the
16 manual process, automatically transfer. And we see throughout the
17 description in Sigurdsson. So, for example, paragraph 26, where it's the first
18 paragraph of the detailed description, describes a high-level system and
19 states, exchange of content between the computer devices can occur
20 automatically without a user specifying that the content should be sent to
21 another computer device. When, for example, a user may edit a Word file
22 on his home computer, when the user saves the document, the document's
23 content is automatically extracted and transmitted to the user's computer at
24 work. Right, so. Strikingly similar. Same words, I mean. So, for context,
25 this is why we have a, we believe, a compelling obvious in this case, in view
26 of Sigurdsson. And briefly, I'll briefly address Brown, the other primary

1 reference for Brown, 2. So, Brown is Exhibit 1025. If Your Honors would
2 like to refer --

3 JUDGE GIANNETTI: Counsel, this is Judge Giannetti. Would you
4 agree with me that although the word automatically is used in both places,
5 both in the patent being challenged here and in the prior art, that it could
6 have different meanings in different contexts?

7 MR. MEAD: Theoretically, that's possible, but here it's exactly the
8 same meaning. I mean, it's exactly.

9 JUDGE GIANNETTI: Well, but isn't that the issue? I mean, isn't the
10 issue what it really means --

11 MR. MEAD: It's --

12 JUDGE GIANNETTI: -- in the fact that the word is used in two
13 places doesn't really solve the problem as to whether the same meaning
14 applies in both contexts, does it?

15 MR. MEAD: No, absolutely. And to be clear, Petitioners are not
16 assuming, you know, in taking as granted that it's the same meaning. But if
17 you, when we go through the analysis and we'll walk through the claim
18 construction of the word automatically as used in the patents, it's exactly the
19 same meaning. It's the basic dichotomy between I do something manually,
20 user needs to do it. I'm the one. I'm a user. I have to physically email
21 myself, FTP manually. Versus automatically, which, according to its plain
22 and ordinary meaning in the patents and used in the same way in the prior
23 art, it's not manually. It's a simple dichotomy between manually doing
24 something or automatically, which left to its plain and ordinary meaning, but
25 essentially means not manually. So, happy to --

1 JUDGE GIANNETTI: Counsel, did Petitioner foresee that there
2 would be a difference of opinion and dispute over this term when the
3 petition was filed?

4 MR. MEAD: No, because during -- in the litigation there was
5 no -- this proposal never arose in litigation when the parties did go through
6 claim construction Patent Owner, and we have in the record at, sorry, we
7 have in the record the proposed constructions. Patent Owner took a plain
8 and ordinary meaning position in the litigation prior to the filing of the
9 petitions. And we agree with that. The broad claimed ordinary meaning of
10 automatically applies here. Only once we got into the IPR, Patent Owner for
11 the first time proposed this unduly narrow construction where not even the
12 word automatically, we'll walk through the claim, not just the word
13 automatically, but one specific usage of it in one piece of the claims. Patent
14 Owner is now saying, well, that, in that instance should be limited to a push-
15 based transfer without a request from a client. It never, in litigation, raised
16 that proposal. So, that's -- and our position is consistent throughout, Your
17 Honor, where in the petition through to today plain order meaning of
18 automatically applies. And that is what it is.

19 JUDGE GIANNETTI: I think Patent Owner has taken the position
20 that Petitioner should have taken a position on what the claim means other
21 than just plain and ordinary meaning and what the term automatically or
22 automatic means. You should have taken it earlier, for example, in the
23 petition. And what's your answer to that?

24 MR. MEAD: My answer is we, the position we took in the petition is
25 that the word automatically is used according to its plain and order meaning,
26 and that's the same position we've taken throughout. And then Patent Owner

1 is the one who has said there's a new, unduly narrow, explicit construction
2 that we would like to propose. And so, it was not raised in litigation. It was
3 never presented to Petitioners prior to the petition. So, that's not something
4 that we could have said. We addressed. We explicitly addressed in
5 litigation, Patent Owners taken plain and ordinary meaning throughout.
6 There are two other terms that are not material here where Petitioners
7 propose constructions that aren't material. They're like essentially the claims
8 don't cover, kind of, periodic synchronizing, but the prior art covers our
9 constructions or plain meaning. So, I'm not sure what else to tell you on
10 other than our petition presented our position consistent with what we do
11 today. Patent Owner, of course, has had ample briefing, including a sur-
12 reply, a sur-reply expert declaration to address any issues. I mean, if Patent
13 Owner thought that our petition should have addressed something, it's had
14 ample opportunity to fulsomely address that and address it at the hearing
15 today.

16 JUDGE GIANNETTI: Okay, thank you.

17 MR. MEAD: So, to continue. So, let's, I mean, if we could briefly
18 focus on the, on the construction of automatically what I think is important
19 to appreciate and we can look at the claim language. So, we have in the
20 slides, Exhibit 1049, demonstratives. So, summarizing where the word
21 automatically appears in the claims, claim 1 of the '561. So, this is on slide
22 18 of Petitioner's demonstrative slides, Exhibit 1049. And then from slide
23 18 through slide 22, we list out the instances. And the key point here is you
24 might, one might believe from Patent Owner's filings or positions that
25 there's some special usage of, well, automatically shows up in, you know,
26 with the first device.

1 First of all, there's no client or server cited in these claims, right, but it
2 happens, we have mappings on the prior art where, say, the first device maps
3 to a server in Sigurdsson or maps to a server in Brown. So, they focus on
4 the word automatically only in that one instance to say, in that one instance,
5 we want to limit it to a push-based without a request from a client. But if
6 you look throughout the claims, the same word automatically is used for all
7 file transfers. So, from one device to the other, first electronic file
8 automatically transferred. Second, automatic file automatically transferred.
9 So, continuing on to the next slide, automatically transferred the modified
10 file. Automatically transfer back. And if we go through claim 1 of the '942
11 Patent, it continues on the same way, automatically receive. So, it's not only
12 transferring; same word automatically. And so, if we see on slide 20, the file
13 copy is automatically received.

14 So, what it's telling us is we're not talking about some narrow push
15 versus pull, all throughout the claims and the specification. All we're talking
16 about is the high-level notion of I could do things manually, I can do things
17 automatically. That's the plain, I mean, that's just the plain and ordinary
18 meaning of the word automatically in this context. And I think what really
19 clinches it, if you see at the end of claim 1 of the '942 Patent on slide 22, so
20 it's not only file transfers, so the same word automatically is used in the
21 context -- right. So, the invention, the claimed invention overall, right, is,
22 so, file includes these features of files modified at one device, transferred to
23 another device, and then the modified file goes to yet another device. And
24 the end of claim 1 of the '942 says when you receive that modified file at a
25 third device, an older version of a first file that was stored there is
26 automatically caused to be replaced by the received copy. So, what does

1 that tell us? It tells the word automatically, that has nothing at all to do with
2 push-based file transfer without a request. This unduly narrow construction
3 makes no sense whatsoever when you see the claims as a whole, right.

4 What this confirms is it's just saying automatically that the user
5 doesn't have to do it. In this context, file is automatically received at a
6 receiving client. And what the word automatically adds is it doesn't just say
7 cause to be replaced, which could be a user doing it, right. I could manually
8 receive a file, you know, at my work computer that's updated, manually
9 replace the older one. And this is saying, no, no, it's automatic. System
10 handles it for you. It's not manual. So, if we look. So, that's the claim
11 language.

12 I think we looked already. So, we continue on in demonstrative slides
13 23 through 26. I think I already briefly addressed, you know, when you visit
14 the specification, it's 100 percent consistent with that broad, plain and
15 ordinary meaning. Prior art. I have to manually move files. It uses that
16 word manual many times. You know, I have to manually email myself, and
17 manually retrieve the email, or manually post to FTP, manually pull it down.
18 Invention is automatic. And so, and as Your Honors know, if there's no
19 disclaimer or lexicography, right, I mean, this is kind of black letter of
20 Federal Circuit law, you know, plain and ordinary meaning applies unless.
21 So, under, under the *Thorner* case, for example, unless there is clear
22 disclaimer or lexicography -- and there's nothing of the sort here. I don't
23 think Patent Owner even argues that there's any disclaimer or lexicography.
24 There's nothing remotely approaching that here.

25 And finally, in the specification, we see an excerpt on slide 27 in the
26 patent. So, Patent Owner wants to limit the claims to, you know, this one

1 instance of automatically being a push-based transfer without a request from
2 the client, right. The only place the patent actually talks about push or pull
3 and uses those words, it explicitly says both push or pull, either is
4 encompassed by our transfer of files. So, I mean, this is in, you can see the
5 excerpt on slide 27 of '561 Patent, column 10, lines 33 through 43. Instead
6 of pushing, the sync application may function to periodically pull or
7 otherwise actively retrieve from the transfer clients, right.

8 So, again, that reiterates and remember the claims, the same word
9 automatically is used for all of the file transfers, right, from one device to the
10 next, that one to the next, automatically, automatically, automatically back.
11 And this is telling us those can be pushed or pull. Right? So, I made -- so, I
12 think it's pretty clear from the intrinsic record, the claim language, the
13 overall context here, plain and ordinary meaning of automatically should
14 apply here, which is broad and simply distinguishes from manual.

15 So, unless there's any other questions on claim construction, I'll move
16 on briefly to some of the key disputes with respect to the grounds. And so,
17 and then to briefly go through, so, slide 12 summarizes the, what we see as
18 the key disputes. So, first one just addressed to the claim construction of
19 automatically. And then moving on to ground 1, the Sigurdsson and
20 Shappell grounds. So, I think the first dispute, or maybe kind of the primary
21 dispute the Patent Owner focuses on for both grounds, would assume the
22 unduly narrow construction that Patent Owner proposes, right, that this one
23 form of transferring is somehow limited to push based without a request.
24 Right? So, under -- if the plain and ordinary meaning of it automatically
25 were adopted, I don't think Patent Owner disputes. I mean, Sigurdsson, of
26 course, describes automatic. It uses that same word. So, does Brown.

1 Right? Like this all happens while this, I mean, that's the whole point of
2 both of those patents, just like the later filed challenge patents, right? As
3 you have automatic file transfer to replace the cumbersome manual file
4 transfer. Right?

5 So, but happy to address. So, even if, you know, if one were to adopt
6 or consider the Patent Owner's unduly narrow claim construction, the
7 Sigurdsson disclosure suggests that. And our position, absolutely, and Your
8 Honors' institution preliminarily found that Sigurdsson does disclose and
9 suggests. We believe that's absolutely correct. And we have this addressed
10 at slide 29 of our demonstratives. So, again, so this is assuming even if one
11 were to adopt, you know, the narrow, which we believe erroneously narrow
12 construction, that we need to transfer from the first device, which is mapped
13 to a server that needs to be a push without a request from the client, is it
14 going to receive that file. Sigurdsson explicitly describes that and renders it
15 obvious.

16 So, one example that was addressed in Your Honors' institution
17 decision in paragraph 68 that we see on slide 29 here, and what's critical
18 here is this is describing an alternative embodiment of step 606, right. So,
19 there's Figure 6 that describes one embodiment, which is describing where
20 user, like this client device has been offline, then comes online and basically
21 wakes up and says, okay, I'm online now. Hey, server, what do you have for
22 me? And checks with the server. Paragraph 68 says, now we're talking
23 about an alternative embodiment where instead of alternative to what is
24 being described in Figure 6, and it explicitly describes, as Your Honor noted
25 in the institution decision, the client can send the data directly to the server
26 as shown by this dashed line, and then the client X content can be sent

1 directly to the server bypassing client. The final sentence, the server 106 can
2 then transmit the content to the remaining client peers such as clients B and
3 C.

4 And as Your Honors correctly noted in the institution decision, there's
5 no description there. It does not say the server can then wait for a request
6 from clients and then if a request is received, respond to it and send it. It
7 says explicitly the server can then transmit the content to the peers. There's
8 no description that, well, those peers needed to make a request that sent
9 address and then the server acts.

10 And that's not the only place. I mean. what's critical too, so, Patent
11 Owner tries to characterize saying, well, that's just this anomaly and the rest
12 of Sigurdsson is 100 percent different. That's not true at all. I mean
13 Sigurdsson actually repeatedly describes the same thing. So, in paragraph
14 81 of Sigurdsson, as Your Honors also noted at institutions, we have exactly
15 the same description. I'm sorry, paragraph 80, we have exactly the same
16 type of description. The server sends the missing content to the third client.
17 For example, referring to Figure 4, the server 106 sends the client X content
18 to the client. So, again no description there of servers actually just waiting
19 until there's a request. Right?

20 And then there's another passage which was also presented in our
21 petition, Patent Owner hasn't focused on. So, Figure 5, I mean, if Your
22 Honors would like to turn to Exhibit 1016, which is Sigurdsson. So, Figure
23 5. And so, this is, what Figure 5 shows is an example of, you know, the file
24 transfer kind of process generally. And what we see here on the left side,
25 line A, an event occurs, update, index, post content. There's an arrow, one-
26 way arrow to the server, store content, and then a one-way arrow from the

1 server item 508 over to client B, store content. There's no description there
2 of, well, client B won't get it unless a client B does a request, right. And
3 that's described. And then if we look at the textual description to confirm
4 that paragraph 55 of Sigurdsson describes exactly the same thing. In step
5 508, the server stores the content received from the originating client and the
6 content is propagated to the second client. For example, in Figure 4, server
7 106 stores the client on a storage device, then transmits the content to client
8 B. Right.

9 So, again, it's, and client B is on the, you know, on the right side of
10 Figure 5. So, again, this is not an anomalous descriptive. Sigurdsson clearly
11 contemplates this, you know, server transmitting without a request from the
12 client. And then very briefly, Patent Owner raised an issue about, well, but
13 Sigurdsson doesn't describe like what are the low-level details, you know,
14 underlying how that happens? I mean, first of all, it's explicitly described
15 multiple times by Sigurdsson that discloses the claim requirements. The
16 claims are very high-level and result oriented. Right? They just say
17 automatically transfer. Right.

18 And so, again, this is even assuming push-based without a request.
19 Claims don't say, you know, wherein it's this protocol that's used. So, that's
20 the first point is the disclosure is there, the suggestion's there. But even if,
21 well, if one were wondering, well, how would that work in Sigurdsson, I
22 think we explained fulsomely. Sigurdsson explicitly described, so such, and
23 as shown as in Figure 3 of Sigurdsson, the client devices -- so, it's critical.
24 The client, we're talking about client devices like my home computer. Those
25 are programs with HTTP client and server capability. I mean, this is

1 explicitly shown in Figure 3. And then we address this as discussed in the
2 text.

3 The server, on the other hand, we know it has to have some like HTTP
4 server capability. The server is not -- Sigurdsson, just doesn't get into detail.
5 Well, you know, well, what does the server do? But a skilled artisan would
6 understand. Well, if the client, if my home computer and work computer
7 have server capability, it would make sense to have bidirectional that the
8 server naturally like mirroring that would also have both server and client
9 capability, right. So they're both -- and this is just simple programming.
10 This is like web programming 101 from decades ago, right. Server will have
11 client server capability. And if the server has client capability, can push
12 down to clients like so HTTP put or post from the server. And that would be
13 one way a POSITA would understand, like, well, naturally this would work.
14 So, I think that addresses the kind of the dispute, assuming the narrow claim
15 construction.

16 I wanted to address briefly a couple other points on ground 1. Plus, if
17 Your Honors have any questions regarding ground 1, I think the next
18 dispute, which I'll address briefly, was the motivation to combine Sigurdsson
19 and Shappell. I mean, for clarity, I think there's some lack of clarity, I think,
20 in Patent Owner's submissions about what are Petitioners relying on in each
21 reference. So, I think there's some kind of attacking references individually,
22 when it's, we're not relying on the combination reference for certain features.

23 So, here. So, Shappell is a highly analogous reference. Right. So,
24 Shappell is another file synchronization reference. Multiple computers that
25 files are shared among these computers. And the deficiency in Sigurdsson is
26 a very small one, which is just when a device receives an updated file, right,

1 so, let's say we go through the sync process. I update at my home computer,
2 transfers to the server, gets pushed out to my work computer. So,
3 Sigurdsson doesn't explicitly say, okay, so now I've got this new updated
4 version of the file at my, you know, the receiving computer. It's common
5 sense. There's only so many things you could do. You could replace that
6 file or just endlessly accumulate the old versions. And Shappell teaches,
7 well, you should replace it, right, so you have the current file, so you're not
8 just piling up old copies. So, that's classic kind of *KSR*. Like, Sigurdsson
9 leaves that open.

10 But a skilled artisan can look to what are the obvious common sense
11 things that are taught. Shappell fits that kind of hand in glove and it explains
12 that. And so, you know, there's, and there's no teaching away. I mean,
13 Patent Owner raises a teaching away argument. I think Your Honors
14 correctly recognize at institution. There's nothing remotely approaching a
15 teach away.

16 I mean, Shappell happens to be a description that includes an example
17 embodiment. So, and this is on demonstrative slide 34, there's an example
18 embodiment where there's a peer-to-peer network. But in introducing that,
19 Shappell is explicit that the type of network is not critical. So, this is at
20 paragraph 40 of Shappell, and it's only preferably a peer-to-peer. So, what
21 that tells us is in the grand hierarchies of types of networks, right, there's
22 peer-to-peer. And if you were to name the next one client server. Right?
23 So, if it's preferably peer-to-peer, but the type's not critical, you know, a
24 client server would obviously be another one that would be considered. And
25 that's, again, that fits with Sigurdsson.

1 And Shappell reiterates that even makes clear in paragraph 37 that the
2 remote computer, you know, it has an example of kind of peer-to-peer, but
3 says the remote computer may be a server or a peer device. So, it even
4 explicitly contemplates. So, there's nothing in Shappell that says, you know,
5 it'd be terrible to use my ideas with a client server system, nothing that even
6 remotely approaches them.

7 So, to finish ground 1, I think the only other dispute we address here,
8 I'm happy to address any others or on rebuttal if Patent Owner raises
9 additional ones. But an issue of like which reference we rely on for which
10 teaching. So, the claims we agree with Patent Owner require the same user.
11 So, the claims have devices and have users. So, the user is the human, right.
12 Claims require the same user being associated with multiple devices. And
13 Patent Owner knows, well, Shappell doesn't explicitly describe that. It
14 describes, well, you may have different users. We're not relying on
15 Shappell. I mean, Sigurdsson explicitly discloses that. That's the whole
16 point of Sigurdsson. So, I think there's no lack of disclosure there. So, just
17 in case there were any lack of clarity, Sigurdsson discloses the same user
18 associated with each device, including the server, through registration,
19 where each user is identified and registered.

20 So, unless there's any questions on ground 1, I'll briefly address
21 ground 2, the Brown ground.

22 JUDGE KENNY: Before you go to ground 2, maybe I can ask you a
23 question on claim construction. Assuming we go ahead and construe the
24 term automatically, how should we construe it?

25 MR. MEAD: So, a great question, Your Honor. So, I think we
26 maintain our position, you know, plain and ordinary meaning no explicit

1 construction constraint. But to answer your question, not manually. So, I
2 mean, that's the distinction. That's driven directly by the intrinsic record.
3 Right? So, that's the core dichotomy.

4 JUDGE KENNY: So, the construction would be, not manually?

5 MR. MEAD: Yes, Your Honor. I mean, that's, again, that if an
6 explicit construction were necessary, you know, I think the broad plain
7 meaning. But that would be it. So. Okay, so --

8 JUDGE POWELL: I have a question about that. How would the
9 server manually transfer something?

10 MR. MEAD: Hmm. Well, the server, that's a great question. So, the
11 claims here, I want to be really clear because there's been some, you know,
12 the way that the arguments can be a little bit, kind of, conflate issues a little
13 bit, I think. So, you know, Patent Owner kind of assumes, I think, that, you
14 know, these claims are client and server. If you actually look at the claims,
15 these claims don't require -- don't recite client and server per se. So, one
16 point is, you know, it happens -- you know, claims just say first device,
17 second device, third device. It happens that our, you know, our mapping on
18 the prior art is, you know, happens, it happens to map very well to, you
19 know, where one of those devices fits the server in Sigurdsson and the server
20 in Brown. So, I want to be clear that, you know, first of all, that, yeah, that's
21 not actually a claim requirement. And second of all, I mean, there isn't a
22 requirement to manually -- I mean, I agree that would be a, kind of, a
23 puzzling proposition to say, well, servers wouldn't usually be deemed to
24 manually transfer something, but they could. You could see a scenario
25 where the point is the user has to do it. Even the background of the patents
26 here describes the user has to post something up somewhere like FTP is

1 going to be a server. Right? So, if I manually posted an FTP, then go to my
2 home computer and manually log in and pull it, you know, you could call
3 that a manual process. Right? I mean, that's, you know. So, it's not that the
4 server is manually doing it itself, right, but the process of causing that to
5 happen would be the user.

6 And so, and then again, if you look at the claim language, it's the file
7 itself being automatically transferred. And so, and I think it fits all the
8 disclosure of, you know, throughout the patent as we're talking about, you
9 know, what is claimed is automatic transfer of this file. The system is just
10 doing it. You know, the server does it as opposed to the human saying, hey,
11 server, you know, I'm going to direct you to do it. So, I hope that answers
12 your question.

13 JUDGE POWELL: That's insightful.

14 JUDGE GIANNETTI: Counsel, Judge Giannetti. Before we leave
15 this subject. So, I have a question. It's not quite related to the art that we're
16 looking at, but I, like many people, have an iPhone. And my iPhone
17 sometimes goes to sleep or I will put it to sleep or turn it off. And when I
18 turn it on, it gives me a message saying, checking for emails. And then
19 suddenly emails will appear on my phone, updating my emails. Would you
20 call that automatic or manual?

21 MR. MEAD: That's an excellent question. I guess what I would, you
22 know, I'd have to think it through. I think what Your Honor is touching
23 upon conceptually is there might be instances where there's a fine line, right.
24 So, there might be cases where, you know, gosh, is that a manual process or
25 automatic? Because it's kind of both. Like, when you had to manually, kind

1 of, you know, open your, turn on, you know, swipe to unlock. Right. And
2 then your emails --

3 JUDGE GIANNETTI: Unlock the phone.

4 MR. MEAD: Right.

5 JUDGE GIANNETTI: I have to manually unlock the phone. But I'm
6 not asking for emails. That just happens.

7 MR. MEAD: Right.

8 JUDGE GIANNETTI: I get a message saying updating emails and
9 suddenly the emails appear.

10 MR. MEAD: Right. So, I think, I think the point here would be,
11 right, depending what you're talking about. So, if we're talking about are the
12 emails being transferred from the email server to your phone, I think in this
13 context, I think I'd say that's still automatic in the sense of you didn't
14 say -- you just unlocked your phone and then the rest of it happens
15 automatically. Right?

16 JUDGE GIANNETTI: Right.

17 MR. MEAD: So, your phone's programmed to do something. You
18 know, the email will ping the server. So, I think in that context, it depends
19 what you say is automatic. Like, was your phone automatically unlocked?
20 Well, no, you manually swiped it. But the automatic transfer of those files, I
21 think, would be. Like, you didn't enter a command saying, please send me
22 my emails that the server says, okay, I received your command. Right? But
23 I think the broader point to make too is the prior art, you know, the prior art
24 is not close to straddling that line. Right. I mean, the prior art is just clearly
25 and explicitly says, right, it's setting up the exact same dichotomy. Right.
26 Like Sigurdsson and Brown set up the exact same dichotomy of manual user

1 transfer versus explicitly describe using the same words, we're doing it
2 automatically. So, even if there are, you know, there may be places where,
3 you know, gosh, it's, you know, maybe you could characterize one or the
4 other. I think we're not close to that line. It's very clearly within bounds.
5 So.

6 JUDGE KENNY: Let me follow up on that. By manually, do you
7 mean with user involvement?

8 MR. MEAD: Yeah, with user involvement. I mean, I think I would
9 frame it as our control. Right. So, the --

10 JUDGE KENNY: Well, maybe I can take it back. What do you mean
11 by manually?

12 MR. MEAD: I think manually, well, it's one of those things where
13 there's, you know, we can go, you can, kind of, define a construction of a
14 construction. I think the principle I want to reiterate legally is, you know,
15 construing to the extent necessary to resolve disputes. So, I'll address your
16 question, but I want to make sure, conceptually, you know, does the prior art
17 fall within automatically or not? And construing to the extent necessary to
18 address that, it clearly what's described in Sigurdsson or Brown as not
19 manual. That's the whole point of both of those is it's not manual. It's the
20 automatic. The system does. I mean, to Your Honor's point as far as, well,
21 what does manually mean? I think it would, I mean, automatically means
22 not manually. And then manually would be something where it's, like,
23 involved is kind of a more indirect term, but, you know, control. So, not --

24 JUDGE KENNY: Right.

25 MR. MEAD: -- it's not controlled or directed by the user. Right.

1 JUDGE BOUDREAU: So, maybe what you're really getting at is,
2 without manual -- sorry, without manual intervention by a user, would that
3 be an accurate formulation?

4 MR. MEAD: I think so, yeah, I think. And that would be, you know,
5 consistent with, you know, neither side kind of put in dictionaries, you
6 know, kind of plain meaning. But that's, you know, that's kind of a classic
7 definition, I think, of automatically, too. So, I think that that should capture
8 it.

9 JUDGE GIANNETTI: I was a little surprised not to see, this is Judge
10 Giannetti, again, I was a little surprised not to see a dictionary definition
11 here.

12 MR. MEAD: Well --

13 JUDGE GIANNETTI: If somebody just submitted that. I was a little
14 surprised that with all of the discussion of what's manual and what's
15 automatic, that someone would have offered a Webster's dictionary or
16 something along those lines.

17 MR. MEAD: Well, I guess, apologies, I guess, on behalf of all parties
18 that we didn't put those in. But I mean, there, you know, I think Your
19 Honors, I think we would have no objection that, you know, Your Honors
20 are free to consult these publicly available dictionaries and references that,
21 yeah, I mean, I'm like -- well, I'm looking at one now, you know, by itself or
22 with little or no direct human control would be kind of a standard definition
23 of automatically. I think there's various ways to say basically the same
24 thing. Right. It's this dichotomy between automatic and manual. And
25 manual is, you know, human controlled or human intervention. Right. So.

26 JUDGE GIANNETTI: Yes, I guess I have your position on that.

1 MR. MEAD: Okay. So briefly, and then just very briefly, to address
2 Brown in the Brown grounds, I think. So, again, under the plain and
3 ordinary meaning of automatically, Brown explicitly describes, you know, it
4 uses the same words, automatic file transfer. The user's not doing it. The
5 system's set up to do it. And then if the narrow kind of push without a
6 request construction were adopted. And the key point there is it's the
7 combination with the Hesselink reference. Right? So, Brown, so what
8 Brown teaches is Brown's actual example, embodiment is well, we can do a
9 periodic sync, right? So, every X minutes will synchronize. But what
10 Brown says is, but other synchronization algorithms can be used, right? So,
11 it leaves open, tells a skilled artisan, go look at, think about other ones. And
12 what Hesselink motivates is, well, hey, what we should do is when a file is
13 changed at one computer, we should push that like I'm working on
14 something. Save it. Other connected computers should get that same file,
15 right? In paragraphs 183 and 189 of Hesselink, describe that, and then
16 explicitly motivate why you want to do that. So, you want to have the
17 updated files. And it explains the benefits from the user and system
18 perspective, so. I think the key point there is, even if there's this kind of, you
19 know, Patent Owner, will focus on, well, Brown itself doesn't explicitly
20 describe the server push. I will note, I mean, Brown does actually describe,
21 in column 5, it actually does describe the server pushes down changes. We
22 cited that in our papers. But even if there are any dispute about that
23 disclosure, it's the combination that just makes it very clear, and that's what
24 we're primarily relying upon.

25 I think the next dispute under ground 2 was the combination of,
26 whether it's a motivated, obvious combination to combine Brown with

1 Hesselink. And I think I've touched on this briefly already. Brown tees up
2 other synchronization algorithms can be used. Go look. You know, skilled
3 artisan, go look around and figure out what you want to do there. Hesselink
4 says, well, the algorithm we should use is when a file is changed at one
5 device, automatically push that out to all the other connected devices and
6 says in paragraph 189, this functionality saves the user a great deal of time.
7 There's no concern over having two different versions of a file or concern
8 that a user is not using the latest post up to date version. It reiterates that in
9 paragraph 192.

10 And then I think the only one other point that Patent Owner raised
11 about Hesselink was, well, Hesselink, you know, how does it actually
12 happen? And again, it's similar like we saw with Sigurdsson. It's explicitly
13 described. Right? And so, they kind of get into details of other parts of
14 Hesselink to say, well, is it clearly a push? From a skilled artisan
15 perspective, it's explicitly described, you transmit those out. It doesn't say,
16 let everybody know and then wait for their request. Right? Because that
17 wouldn't work for the -- that wouldn't satisfy the motivated reasons of, you
18 want to make sure they're updated. That's the whole point. And it explicitly
19 describes that. I mean, if there were any dispute about, okay, let's get down
20 into the weeds of file transfer of Hesselink. I mean, it does describe, and we
21 addressed this, including in the reply once Patent Owner raised this point,
22 that there's a full duplex connection between devices. So, Hesselink
23 paragraphs 87, 104 to 114, 141, where connected files are pushed through a
24 connection server. And so, even if there were some question of, you know,
25 okay, first we're assuming this network link construction, and then Hesselink
26 explicitly describes it. Well, how exactly is it doing it? That's also

1 addressed in Hesselink in terms of there is actual what we call a push file
2 transfer that's described in Hesselink. It's addressed in the papers, so.

3 So, unless Your Honors -- I'm right at my time. Unless Your Honors
4 have further questions, I'll reserve for rebuttal.

5 JUDGE KENNY: All right, I think we're ready to proceed to Patent
6 Owner now. How much time do you wish to reserve? Patent Owner, how
7 much time do you wish to reserve for rebuttal?

8 MR. THOMAS: Your Honor, we would like to reserve 20 minutes
9 for the rebuttal.

10 JUDGE KENNY: Okay, you may proceed.

11 MR. THOMAS: Good afternoon, Your Honors. I'm Ebenesar
12 Thomas. I am representing Topia today, and I will be presenting ground 1
13 objections. May it please the Board. During the allotted time today, first
14 question is, would it be okay if we actually share our demonstratives on the
15 screen?

16 JUDGE KENNY: I mean, we all, we do have copies of your
17 demonstratives. So it may be easier to call out from the demonstratives,
18 because then we'll have a full-size version of it versus what we'd see on the
19 screen.

20 MR. THOMAS: Okay, Your Honor. No problem. We will. We will
21 proceed in this manner. Yeah.

22 JUDGE KENNY: So, if you just call out the numbers, we can follow
23 it.

24 MR. THOMAS: Sure. Sounds good, Your Honor. Thank you. All
25 right, so, first thing, Your Honor, as the Petitioner noted, you know, the
26 problems in the background do have some similarities between the

1 Sigurdsson reference and the '561 Patent. But just want to point out, Your
2 Honor. So, the Petitioners have highlighted most of the manual approaches
3 that were undertaken at that time. But also, you know, in column 2 of the
4 '561 Patent, you know, there's a detailed description of other automated
5 approaches that were already present at the time.

6 So, the situation here is not merely are we trying to get this file from
7 one device to another, there's other considerations. For example, the
8 accessibility of the file. And the prior art background section described
9 solutions such as remote desktop and distributed systems. They happen to
10 have some other drawbacks, such as the accessibility issue or the latency
11 issue. So, they were already automated systems, but when user tries to
12 attempt it, maybe they will not have the connection to it or something like
13 that.

14 So, the inventors of the current '561 Patent came up with a solution
15 that addresses all these issues and not just merely automating a manual
16 system that was already out there. As we know, the history of patents
17 replete with people working on the same or similar problems at roughly the
18 same time. But it really comes down to what different ways can be taken,
19 approaches could be taken to address and solve the problem. And that's
20 really the case here.

21 You know, I'll move to slide 3 at this -- actually, slide 4 at this time.
22 Actually, let's, yeah, so slide 4, here. You know, so basically, the previous
23 systems use kind of like an approach where the focus was really on the
24 servers or the devices in the center, and they have users maybe be able to
25 access their files. But the inventor's main focus of the, as described very
26 clearly in the claim is that they wanted to make sure that the users had access

1 to their files, no matter what the situation would be. So, basically, from that
2 backdrop is where the inventors tries to address this problem. So, the
3 inventor's focus, really, we have users with multiple devices. Let's make
4 sure that those files, even if they modified at one end, are basically in all
5 these devices such that they don't have to worry about am I working with the
6 most recent versions.

7 And this can be illustrated in the next slide, Your Honor. I've just
8 pointed out, highlighted in Figure, this is Figure 3. This is slide 5. This is
9 Figure 3. I've just highlighted some things in green just to highlight that
10 what we're really talking about is the organization of the applications and
11 how they talk to each other. So, we will get to this a little bit more in detail
12 when we talk about the claim construction issues that the Petitioners have
13 raised now. You know, we're really talking about what the applications are
14 doing and how they're communicating with each other. And as you can see,
15 there's an application that's running on the user device 210 on the left side,
16 which will correspond to the second application in the claim. And we have
17 another application running on the right side on maybe the user's cell phone
18 or smartphone, and that would correspond to the third application in the
19 claim. And then we finally have another application running in the center on
20 the first electronic device or the server, and that will be the first application.
21 And for most of the discussion today, we're going to really focus on what is
22 this first application doing. Again, the whole thing is about how is this
23 application performing a certain function. And that's really going to become
24 the heart of the issue here. And if we also --

25 JUDGE GIANNETTI: Counsel? Counsel.

26 MR. THOMAS: Yes, Your Honor.

1 JUDGE GIANNETTI: Why is that? Why are we focusing just on
2 that? I mean, the claim is to a system, as I recall. And there are several
3 different aspects to that.

4 MR. THOMAS: Yes, Your Honor, the claim --

5 JUDGE GIANNETTI: The claim talks about three different, three
6 different devices, isn't that right?

7 MR. THOMAS: Yes, Your Honor. Three --

8 JUDGE GIANNETTI: So, why focus on number one, the first
9 device --

10 MR. THOMAS: So, the focus --

11 JUDGE GIANNETTI: -- when your claim is to a system?

12 MR. THOMAS: So, the claim is to the system, Your Honor, but the
13 key distinction is that the application, the element 1d we were going to talk
14 about is all what the application is doing, Your Honor. It's not -- so, the
15 claim is very specific as to what each one of these components are doing.
16 And that's the reason I wanted to highlight application one -- the application
17 that's in the center is that's the main application that we're discussing with
18 respect to element 1d and the configuration of this application and how it is
19 communicating with the other applications and the other devices -- on the
20 other devices.

21 JUDGE GIANNETTI: All right. I still see a system here of three
22 elements, and I'm still not convinced that the only element we should focus
23 on is number one, the first application.

24 MR. THOMAS: Well --

25 JUDGE GIANNETTI: To the --

26 MR. THOMAS: -- Your Honor --

1 JUDGE GIANNETTI: -- exclusion of the others. I think that's where
2 your argument's going, though, isn't it?

3 MR. THOMAS: Well, to take a step back, Your Honor, you're
4 correct. All the applications are important and it's really how they interact
5 with each other. So, basically you are correct, Your Honor, that the first
6 application's interaction with the third application and the first application's
7 interaction with the second application is really in question. So, it is a
8 system that includes these devices and then these devices have these
9 applications. So, the reason I --

10 JUDGE GIANNETTI: Thank you.

11 MR. THOMAS: -- first application is most of the discussion was
12 coming into element 1d. So, that was the issue. And just to, in the claims
13 itself, all these operations that are listed, if you have the claims readily
14 available, it starts from where the first electronic device is configured to
15 receive and then the first electronic -- so, actually we can go to, I have this
16 here, actually, Your Honor, if you can go to the previous. Yes, slide 7.
17 Slide 7. You can see here in slide 7 after the first, after it describes the first
18 electronic device configured to selectively execute first application. That
19 part, it goes into wherein the first electronic device is configured to and all
20 these operations are describing what the first application is configured to do.
21 So, that's why I was focusing on that first application in Figure 3, Your
22 Honor. Does that answer your question, Your Honor?

23 JUDGE GIANNETTI: Not really. I read on in the claim and I see it's
24 talking here about received from a second application and then the first
25 electronic device is configured to receive. Configured to receive things from
26 a third electronic device. I mean, I see the way you drafted this claim with

1 this configure to language, but if you read on in the claim, you have
2 inferentially claimed a number of other elements as part of the system. So,
3 I'm not sure I agree with you that we should focus on the first electronic
4 device and when we're really looking at a system here. But go ahead with
5 your argument. I don't want to get hung up on this issue, but I'm not totally
6 satisfied with your answer.

7 MR. THOMAS: Thank you, Your Honor.

8 JUDGE KENNY: Actually, before you jump back, I wanted to follow
9 up on something you said earlier, and that was you said the background of
10 the invention in the challenged patents distinguishing systems as well.
11 Maybe you could highlight to me what particular passages of the
12 background you're talking about.

13 MR. THOMAS: Yes, Your Honor. So, this is with respect to the,
14 some of the automated systems that I was referring to?

15 JUDGE KENNY: Yeah, I think earlier you had said that in addition
16 to distinguishing manual systems, the background also distinguishes
17 automatic systems. And so, I was looking for --

18 MR. THOMAS: Yeah.

19 JUDGE KENNY: -- where, in particular, in the background that's
20 done.

21 MR. THOMAS: So, it's in column 2 starting at line 10. So, here we
22 have a remote desktop software. So, basically in this system the user on any
23 device is able to access their file. So, basically you can have three devices
24 but you still have access to the file. So, this is what I was talking about
25 earlier. The solution that's being addressed is not just having the file
26 transfer, but it's also making sure the accessibility of the file. So, these

1 systems are automated systems because as soon as you log in you're able to
2 have access to your files. And then you also have, starting at line 23, a
3 distributed file systems where the server will act as a repository. And this is
4 actually very similar to what Sigurdsson does. It's like to act as a repository
5 and when a user wanted to access the file they can come and access their
6 file. The problem with these approaches were that if there is some latency
7 issues or connectivity issues, they won't have access to their files. So, that
8 was the problem with these type of automated approaches.

9 JUDGE KENNY: And how do I know those are automated?

10 MR. THOMAS: Because except for just trying to access these files,
11 because there's nothing the user has to do except for just accessing their
12 files. Because for example, the remote desktop, you know, you log in and
13 you're basically accessing this screen of your home computer. So, there's
14 nothing, there's no transfer of anything that's happening. Again, the key was
15 that the accessing of the files. So, they had access to their files.

16 JUDGE KENNY: Okay, I do see the word automatically appearing,
17 line 50 of column 2, actually referring to automatically caching. Was that
18 what you were referring to, or also what you were referring to, or is that
19 somewhat irrelevant?

20 MR. THOMAS: So, I was talking more in general sense. That
21 specific automatic caching is actually, if you notice, it was what the local
22 device was doing, Your Honor. The main issue really was the overall
23 automated approach. So, if you notice that as one of the extensions to that
24 was they were doing some sort of automatic caching. So, basically if, on the
25 user's laptop, they had kept accessing some certain files, that file might have
26 been automatically cached on their local system. So, again, that automatic

1 caching in no way could be a user interaction because it's automatically
2 caching the file on their local system. So, yes, Your Honors, that is the
3 extension of why I was explaining this automated system.

4 JUDGE KENNY: Okay. And so, you're interpreting the paragraphs
5 that, I mean basically, the paragraph that runs from lines 10 through 22 and
6 the one that runs from 23 to 43 as describing some kind of automated
7 transfers, is that correct?

8 MR. THOMAS: Yes, yes at least those, yes and yes.

9 JUDGE KENNY: And how do we know those are automated?

10 MR. THOMAS: Because those systems are really set up where the
11 servers are like a storage that's in the center. So, for example if I wanted to
12 access a file that file is in the center. So, basically the user already can come
13 and just access the file. They don't have to do anything. So, if I want to open
14 up file A, all I have to do is you'll have the same thing showing on your
15 screen and you would just basically, like, for example on your local
16 computer now, you'll have documents and things under certain folders. So
17 basically, you'll have a distributed server folder or something where when
18 you just click on it you're going to pull up that file. So, basically the point
19 being, you know, there's no transferring of the files happening but the access
20 itself is provided by an automated system. All the user is doing is just, I
21 want to see this file, and you will have whatever file was the -- so, for
22 example if the user is on device A, and they save something into this storage
23 repository, and they come from device B, and then try to access the file, so
24 they're going to just pull up that file. So, basically they're not doing
25 anything to transfer anything. The file is basically automatically saved into

1 the repository, and from somewhere else they're going to pull up that file.

2 That's really why it would be automated.

3 JUDGE BOUDREAU: This is Judge Boudreau. Just to be clear: In
4 those embodiments in column 2, starting at line 10, and in column 2, starting
5 at line 23, are there multiple copies of files that are being updated, or is there
6 just a single copy that's accessible from various locations in those
7 embodiments?

8 MR. THOMAS: So, the distributed system would have that up-to-
9 date copy on. So, that's why, in the explanation I was giving you, Your
10 Honor, is that if I'm on my laptop and I save it into this distributed file
11 system, I can maybe come through my phone and access that file from that
12 distributed system and it would have the latest copy. So, it would have that
13 one copy in there. That's the latest if I had saved something in there. So, the
14 main point of such system is that you could access it instead of you having
15 to have it on your file, you access it from anywhere. So, that's the idea
16 behind such systems. So, again, the drawback would be that if for some
17 reason you're in a poor connectivity area, then you're not going to be able to
18 maybe get it as fast or not get it at all. That's one of the other things that
19 they were trying to address.

20 So, the point really is that it's not, as the Petitioners put it, we're just
21 carrying USB or email or something to transfer. There were other systems
22 out there that had the access for the files that did not involve such manual
23 approaches as they put it. So, Your Honor, if you don't have any other
24 questions with respect to that, I can, I can move to slide, let me see here.
25 Lost train of thought. Yeah, we'll move to slide 8 of the presentation.

1 So, what we see here in slide 8 is, this is why I was focusing
2 particularly on element 1D earlier, is because this is the term that, that uses
3 the word automatically transfer that the Petitioners have now raised the
4 claim construction issue for.

5 JUDGE GIANNETTI: It's not the only term though, is it? And I
6 think that Mr. Mead pointed out some others that used other --

7 MR. THOMAS: Yes, Your Honor.

8 JUDGE GIANNETTI: One of the problems I have in focusing just on
9 one --

10 MR. THOMAS: I understand.

11 JUDGE GIANNETTI: -- one element here is that it seems to me the
12 word automatically transfer is used throughout this claim.

13 MR. THOMAS: Yeah.

14 JUDGE GIANNETTI: Not just with respect to the first device.

15 MR. THOMAS: Yes, Your Honor, that's a great point. If you
16 actually go to slide, so I guess, if you go to slide 12, I have
17 shown -- actually, not slide 12, slide 13. I have identified exactly what your
18 questioning, questions, Your Honor. Basically, you know, there are other
19 terms -- I mean, other times the term automatically used, Your Honor, so
20 that it's used at least as you can see on this slide, five times. But the key
21 point is that each one of those times, it's not just generally described at a
22 system level, but it's talking about at the component level. Basically, it's
23 qualifying it and modifying it with which application is the application that's
24 doing that transfer. So, in this case, if you look at element 1b, it's transferred
25 by the first app for the second application, basically that application is the
26 one that's automatically transferring the file, versus in the next step it's the

1 third application that is automatically transferring the file. And then 1d and
2 1e, the emphasis comes back to the first application that is configured to
3 automatically transfer the file. So, that is why each instance of it is still
4 always tied to the particular application or the component within the system
5 that's doing it. And that's why the claim is very specific on what the
6 automatic is.

7 JUDGE GIANNETTI: We can take the automatic transfer, the term,
8 it's used consistently throughout the claim in the same meaning in all places?

9 MR. THOMAS: So, to answer that, Your Honor, so basically
10 automatically transfer, what we say is that within the context of the claim.
11 So, it's well settled that you have to look at the term that surrounds them as
12 well. So, basically, you know, this is a very specific software-related
13 application where the components themselves are what we're dealing with
14 right now. So, we're not talking about a very general sense, just a system.
15 We've gone down into, like I've shown in that Figure 3 with the highlights of
16 the application. We're really just talking about what these components are
17 doing. And at that stage, when you look at it, we have to look at within the
18 context of what the other terms are saying too. So --

19 JUDGE GIANNETTI: Counsel, let me just, yes, let me just cut to the
20 chase here.

21 MR. THOMAS: Yes, Your Honor.

22 JUDGE GIANNETTI: Are you taking the position that automatically
23 transfer in this claim can have different meanings depending on the context?

24 MR. THOMAS: So, automatically transfer would have the meaning
25 that is tied to that application. So, basically the application that --

26 JUDGE GIANNETTI: So, the answer to my question is yes?

1 MR. THOMAS: Within the -- the answer is, it would have the
2 meaning within the context of the surrounding words.

3 JUDGE GIANNETTI: So, it can have a different meaning in different
4 places in the claim. Is that what you're telling me?

5 MR. THOMAS: Yes, Your Honor. Yes.

6 JUDGE GIANNETTI: Okay, thank you.

7 MR. THOMAS: Yes, Your Honor. So, to really just to, in the same
8 slide, Your Honor, if we actually, you know, now take the Petitioner's
9 proposed limitation in here, Your Honor, and replace it, basically the term
10 automatically would basically have no meaning. For example, let's just take
11 a look at this claim, and let's look at just element 1d and say we remove the
12 term automatically. Right? In that instance, it would read that the first
13 application is configured to transfer the file. And so, again here, the first
14 application would be configured to transfer the file. Now if we insert the
15 Petitioner's proposed construction directly from their page and their
16 discussion earlier and replace it, it would read, the first application is further
17 configured to, not manually by a human user, transfer the modified file. So,
18 this will be a somewhat bizarre construction because the first application is
19 already not human. So, you know, it wouldn't, it doesn't make sense just on
20 the plain reading, plain meaning of the term automatically, it wouldn't make
21 sense to have such an interpretation. So, this would basically make the word
22 automatically meaningless and void. So, therefore, that's why we still, the
23 Patent Owner maintained that there's no claim constructions needed except
24 for the plain and ordinary meaning in the context of the claim.

1 JUDGE KENNY: Well, let me ask you about that. Basically, counsel
2 for the other side just said you'd use manually to be controlled or directed by
3 a user. Why couldn't a user control or direct one device to transfer a file?

4 MR. THOMAS: So, as I explained a little earlier, Your Honor, so we
5 have gone down to the component level how the components are talking to
6 themselves. So, basically we're talking about the first application. So, the
7 first application itself is not a human. And in fact, their construction is
8 suggesting that somehow the human is not transferring the file; but we're
9 talking about the application not transferring the file. So, that's the reason
10 that that scenario here is we're still talking about a relationship between
11 who's initiating this transfer, which is that first application. So, if it is, I
12 guess my answer is that the -- since we are at such a component level, we're
13 really just talking about the interaction between, you know, is this first
14 application waiting for a request from someone, i.e. the third application, or
15 is it automatically sending it without --

16 JUDGE KENNY: I guess the question is why is it superfluous? In
17 other words, if the first device requires a user to say send it, then that would
18 seem to further limit transfer limitation.

19 MR. THOMAS: So, Your Honor, so we've gotten into the middle
20 stage of this process. We're now at the server stage. And the person skilled
21 in the art would understand that at this stage we're really talking about what
22 applications are talking to each other. So, from the system point or the, you
23 know if you just take a look at this claim, there's a user modification that is
24 triggering the first step. So, that is not what we're talking about. We've
25 gotten into what is happening now within the application talking to each
26 other stage, and that's the difference. So, maybe the scenario is closer to

1 what you were referring to when the user modifies the file or something out
2 of the system area that might trigger the whole process. But then we still
3 have to go in to see what the components themselves are --

4 JUDGE KENNY: Okay, but the actual transfer, I mean, I think what
5 the other side is arguing is that manual would mean that somehow the user is
6 controlling or directing that transfer. For example, saying send it. And
7 automatic would not involve the user in that same way. So, why, given how
8 they're using the term automatic, would the term automatic be superfluous?

9 MR. THOMAS: So, I guess, Your Honor, the response is that if the
10 claim was just at a system level, say for example, an automated system to do
11 X, maybe in that system maybe the user triggers all the system. But now we
12 have gotten out to the component levels. And that's the reason I think such
13 modification, to have the user do something here makes it superfluous
14 because we already having the first application doing that step. So, that
15 application is what we're focused on and not a user from the outside trying to
16 say, you know, let's trigger this process.

17 JUDGE KENNY: I asked this question to the other side. I'll ask it to
18 you also. If we are to construe the term automatically, how should we
19 construe it?

20 MR. THOMAS: So, Your Honor, if the Board were to -- actually,
21 give me one second, Your Honor. Give me one second, Your Honor. So,
22 basically the construction should be that the actor initiating the transfer
23 without the other actor requesting for the transfer of the file. And this is
24 consistent with what we have explained throughout our briefing. Sometimes
25 we provide it with examples, but this is really the core of what it is, is that an
26 actor initiating the transfer without having another actor requesting for the

1 transfer. So, that would be the interpretation if we do need one. But as I
2 mentioned, Your Honor, within the context, that would be what that
3 interpretation would be.

4 JUDGE KENNY: Okay, so specifically looking at 1d, if we were,
5 and this is in the '561 claim with the automatically transfer, if we were to
6 construe, automatically transfer, how should we construe it?

7 MR. THOMAS: So, basically the first, so that would be the first
8 application is configured to initiate that transfer without a request for that
9 transfer from the, I guess here, the third electronic device. So, basically the
10 first application configured to automatically initiate that transfer without the
11 other actor requesting for that transfer.

12 If there are no other questions, Your Honor, then I would like to go
13 into the first grounds --

14 JUDGE GIANNETTI: Counsel. Just one more question. I just like
15 to --

16 MR. THOMAS: Yes, Your Honor.

17 JUDGE GIANNETTI: I'd just like to ask you the same question I
18 asked the Petitioner, and that is my iPad. When I unlock my iPad and I
19 suddenly see emails there, is that an automatic transfer or is that a manual
20 transfer?

21 MR. THOMAS: So, this is actually a really good question and it
22 really gets to the core of what I'm trying to explain with our claims. It's
23 basically, we have to look to see exactly how the components are talking.
24 And in your scenario, just given, it's not clear how the system was provided
25 to see who, you know, how the, for example, your iPhone application's
26 talking to the server application, or not sure exactly --

1 JUDGE GIANNETTI: Well, let me hypothesize something.

2 MR. THOMAS: Yes, Your Honor.

3 JUDGE GIANNETTI: Let's say that when I unlock my iPhone, it
4 sends a signal to the server saying I'm available to receive the emails. And
5 in response to that, the server downloads the emails to my phone. Let's
6 assume that that's hypothetically how the system operates. How would that,
7 how would you describe that, automatic or manual?

8 MR. THOMAS: So, from the systems point of view, Your Honor, the
9 overall sense is, I guess, just so we're in line with the claims of the patent, so
10 just want to note that it's not actually asking for a file. With that said, for
11 example, in the scenario you mentioned, we're talking about specific file
12 transfer and not maybe just some data. So, but with that said, you know, if
13 we are talking about the overall system, you know, if you're just looking at
14 the whole thing, you know, the claim -- so, in the example you've given, you
15 know, the application that's on the iPhone is going to be requesting. So, now
16 if you look at the server's perspective then, you know, that, say, for example,
17 that's the first application. That application is no longer automatically
18 sending the file because that application is really sitting there and waiting to
19 see am I getting a request. So, this goes back to Judge Kenny's question or
20 the interpretation should be --

21 JUDGE GIANNETTI: Well, in my hypothesis, my hypothetical, it's
22 not getting a request for the emails. It's getting a signal saying that the
23 iPhone is online and it's available to receive emails. That's the signal. It's
24 not saying send me emails, it's saying I'm online again.

25 MR. THOMAS: So, it's still initiating it to that particular application
26 to do something in response to it. So, the server application itself is not the

1 one that initiated that. It is the iPhone application, which would be the third
2 application in our claim.

3 JUDGE GIANNETTI: So, you would say manual, not automatic?

4 MR. THOMAS: Well, not manual, Your Honor. What I would say is
5 that the first application is not automatically transferring that. Or --

6 JUDGE GIANNETTI: So it's manual. It's manual because it's being
7 requested. You view this signal that I'm available to receive emails, that's
8 being sent by the iPad coming online. You view that as a request for emails
9 and so therefore it's manual. Is that what you're saying?

10 MR. THOMAS: So, so the word automatic, you know, just, you
11 know, in a very general, normal sense, is manual versus maybe not manual,
12 but, you know, not user involved. But once we get into the actual technical
13 areas in this claim, you know, we really are no longer in a manual versus not
14 manual. It really comes down to what is automatic in terms of its action.
15 So, basically --

16 JUDGE GIANNETTI: Well, Counsel, isn't your theory plain
17 meaning? Why do we have to --

18 MR. THOMAS: So, the --

19 JUDGE GIANNETTI: -- dig down into the claim if it's plain
20 meaning?

21 MR. THOMAS: So --

22 JUDGE GIANNETTI: I'm just asking you how you would categorize
23 this scenario that I gave you when --

24 MR. THOMAS: Right.

25 JUDGE GIANNETTI: -- my phone is on?

1 MR. THOMAS: Yes, Your Honor. So, it's the plain meaning to a
2 person of ordinary skill in the art. And a programmer would understand that
3 once they've already built the system, you know, if we really just think about
4 it, am I going to wait for someone to send it or automatically send it? That
5 really just comes down to that. A programmer is not, it's no longer at the
6 stage of is it manual versus not, because he's already programming at the
7 server level. And now we're really just focusing on, so that's --

8 JUDGE GIANNETTI: I don't think you're answering my question,
9 Counsel. I think it's a pretty straightforward question, and I haven't heard an
10 answer yet that satisfies me. Is it manual or is it automatic?

11 MR. THOMAS: It's automatic for the system level. That's exactly
12 how I would view it, is that it is automatic from the system level. And if you
13 want to go down the component level, then it would not be automatic.
14 That's actually the end.

15 JUDGE GIANNETTI: But is it? Well, that to me is a non-answer,
16 but let's go forward. I now have your views on this. I don't want to belabor
17 it, but I don't think you've really answered my question.

18 MR. THOMAS: Sure, Your Honor. Thank you. We'll go to the
19 Sigurdsson reference on the ground 1. And we will, for that we would turn
20 to -- so, basically, if you look at -- so, before I get to that, Your Honor, so
21 only -- so, in ground 1, the claims are rejected using Sigurdsson, basically,
22 for all the claims, I mean, all the elements of the claims except for to replace
23 a file. And for that, the Petitioners rely on the Shappell reference. And so,
24 one second, Your Honor. Just grabbing the slides here. Okay, so basically,
25 you know, it really comes down to that 1d element.

1 So, right now I'm at slide 18. So, here we have the first application is
2 further configured to automatically transfer the modified first electronic file
3 to the third electronic device, basically the term that we talked about quite a
4 bit. So, you know, Sigurdsson is relied on for basically the first part of it,
5 except for the to replace file. So, what is Sigurdsson really all about? And
6 if we look at Figure 4 of Sigurdsson, we can see that the figures, you know,
7 the main focus of Sigurdsson. There are other discussions, and, you know, if
8 you have specific questions on that, I'll be glad to answer those questions.

9 But you – Figure 4 of Sigurdsson really is one of the main discussion
10 points for Sigurdsson. And what is it really doing in Figure 4 is that it
11 provides a mixed architecture. And what do they mean by mixed
12 architecture is that they provide a server-client architecture that acts as a
13 Dropbox. And they use that word Dropbox multiple times. And basically,
14 it's a system where maybe a device can post their files there. And then the
15 server would act as just a repository for other clients to retrieve the file. And
16 then there's also a peer-to-peer approach where it's shown on the outside
17 arrows that they can communicate with each other and transfer the files as
18 well.

19 So, this is the backdrop. So, the key thing is that the architecture
20 that's set up is to perform this two-step process. And in Figure 7 they have
21 the actual details of how this would work. And if you look at Figure 7, and
22 this would be actually, a copy of this is in slide 23 of our demonstratives,
23 sorry, not -- Figure 7, it's on slide 25. So, basically this is actually the
24 detailed block diagram of that architecture. And if you notice on the top that
25 I've highlighted in such a system, when the server is involved as a Dropbox,
26 the client is requesting for the missing content. And this is just not in this

1 location, but in every instance that are -- that the details is being to start
2 talking about. When we start talking about how does that client retrieve the
3 file, it always is requesting for a file. And it's shown in, for example, Figure
4 2 of the Sigurdsson reference where it shows it, and then in Figure 6.
5 Anytime you get into the detail, it's always requesting the file.

6 And so, against this backdrop is where we want to look at what
7 paragraph 68 is talking about. So, that, you know, I might be slightly
8 jumping around here, but in slide 8, you know, we kind of have -- slide 20.
9 Sorry. In slide 20, you know, we're showing what the main issue, really,
10 here is. As I mentioned, there are other discussions, but the main point that
11 we really dispute is, you know, these two portions merely describe what the
12 server is doing and not how it's doing it, because all the details
13 corresponding to that is explained throughout the Sigurdsson reference. For
14 example, as I shown in Figure 7 and the corresponding descriptions on how
15 to do it.

16 And, you know, I think one of the main issues that I know even in the
17 Institution that you had raised, Your Honors, is that here the server says it
18 can transmit the file, the content to the remaining peers. As I mentioned
19 before, the general idea of Sigurdsson in Figure 4 and here, if you look at
20 paragraph 68, they themselves refer back to Figure 4. The general idea of
21 Sigurdsson is to, of Figure 4 is to provide this peer-to-peer and client-server
22 system. If you actually look at paragraph 68 of Sigurdsson, they explain
23 what a peer-to-peer does is that when a server of our two clients are online,
24 they can transfer the file.

25 So, in a general sense, that's really what the focus of Sigurdsson's
26 Figure 4 is. So, here, if the client is client B, for example, is already online,

1 it would receive the file from client A. But even in a scenario where both,
2 for example, even in a scenario, it doesn't want to use that system, you
3 know, if you look at Figure -- if it doesn't want to use the peer-to-peer
4 system when it is online, if we turn to Figure 2 of the Sigurdsson reference,
5 it clearly shows that client B is already online. And even in that instance, it's
6 polling for updates.

7 So, basically, the point, Your Honor, is that in both instances when it's
8 online or when it's offline, you know, it's going to be requesting for the file
9 and therefore it's not automatically transferred by the server to the other side,
10 to the third client, Your Honor. And it's the -- and in fact, in, you know, if
11 you look at paragraph 46 of Sigurdsson, it clearly says that the client B
12 periodically issues a request for missing content to the server. So, the whole
13 system is set up such that if it's not there, even if it wants to use the server
14 system and it's online, it's still only going to periodically use, periodically try
15 to access this file from the server.

16 So, this really gets back to what I started off with, Your Honor. So,
17 you know, Sigurdsson and the '561.

18 JUDGE GIANNETTI: Counsel, let me just, let me just stop you
19 there. Paragraph 68 refers to this as an alternative embodiment. It's an
20 alternative to, I think, what you were just pointing out to us. Right?

21 MR. THOMAS: So, specifically it says it's an alternative to step 606.
22 And that's in reference to, in step 606, you know, it's a dashed line that's
23 saying that the client A could basically skip client B and send it to the
24 server.

25 JUDGE GIANNETTI: Yes.

1 MR. THOMAS: It's specific to that step and not overall embodiment,
2 but it's specific to that step 606. It's specific that you could either go to
3 client B at 608 to store the content, or it could skip that and go to 610. So, I
4 think your question is, Your Honor, so, you know it's already online, right.
5 And basically, the setup that when it's already online is what's actually
6 illustrated in Figure 2. And that's why I was saying that even in that
7 instance, it's requesting the file. So, you know, we're not disputing that the
8 server does end up sending the file. It's what is it, how is it doing it? And
9 that's where the key difference between two different approaches that were
10 undertaken is that the Sigurdsson system sets up the server as a Dropbox,
11 and maybe for a specific reason, they wanted to do that, and that was their
12 goal. So, anytime a client, even if it's online or not, it's going to request it.
13 Because if you look at that paragraph 40, 46, I was referring to, and it's also
14 again in paragraph 85, with more specific relationship to this discussion, is
15 that it's periodically issuing the request. That means it's online and it's just
16 periodically, maybe every, not sure, it doesn't explain, but it's periodically
17 requesting. That means that it is online and it's requesting for that file. And
18 if it's not online, then the explicit steps in Figure 6 will be undertaken where
19 it comes back online and takes over.

20 JUDGE BOUDREAU: This is Judge Boudreau. Don't we also need
21 to look at paragraph 84, though, which says that each of the clients can push
22 new data to the other clients instead of waiting until the other clients send a
23 request for missing information? And that's --

24 MR. THOMAS: Yes, Your Honor.

25 JUDGE BOUDREAU: -- in Figure 7, why doesn't that override that
26 step 710 that you pointed to on your, in Figure 7?

1 MR. THOMAS: Yes, Your Honor. So, again, just looking at
2 specifically what it's talking about here, I'm just turning to that specific
3 portion. It's talking about that each client pushes it instead of waiting until
4 the other client requests. So, basically here it's talking about what the clients
5 are doing, not the server. And it's basically, it's talking about at the outset
6 stage. And if you look at a couple of lines above that, it's talking about how
7 the connection is open for the server and the client to post the file. So,
8 basically we're saying that that step is automatic without request. But there's
9 nothing in that sentence that talks about the server itself pushing that new
10 data to without a request. Because it really gets back to the architecture that
11 the Sigurdsson is built on, which is to create as a Dropbox or a repository, so
12 that it's not actively trying to send these things. Because some other
13 discussions, if you notice the next line of it is really talking about how it's
14 actually stored locally and it's waiting for the retrieval. So, the discussion is
15 really about what that client is doing at that first stage when it's posting,
16 that's not in response to the request, but it doesn't go into the details of how,
17 in that specific line, as to what the server is doing.

18 JUDGE BOUDREAU: In Figure 7, is that request 710, request for
19 missing content, is that coming from the server, or is that coming from one
20 of the clients?

21 MR. THOMAS: It's from the clients, Your Honor.

22 JUDGE BOUDREAU: So, are we to assume that the server itself
23 always pulls the data from the clients or --

24 MR. THOMAS: So --

25 JUDGE BOUDREAU: -- how should we understand the --

26 MR. THOMAS: So, basically --

1 JUDGE BOUDREAU: -- relationship between that step and the data
2 that's coming from the clients to the server?

3 MR. THOMAS: Yes, Your Honor. So, basically, actually, in the next
4 figure they do describe another way of doing it. Let's just look at Figure 7,
5 first. When the client A is sending the file to the server, as you can see,
6 there's a storage. So, this is where it's really considered as just a repository.
7 So, it's putting all these things that are coming in and it's waiting to see does
8 anybody want this file. In Figure 4, as we talked about it, the unique thing is
9 that client B actually doesn't even have to get it from that server. So, it can
10 actually get it from one of the other devices. So, the server is not actively
11 working to, oh, I got to get this to the other person. It's really like, all right,
12 does anybody want this file. Then it would go and fetch in its database and
13 see, okay, you gave me this. So, in Figure 7, if you notice that it's even
14 sending a time range. So, basically it's checking to see, hey, this time range,
15 like what are the files you have; is anything for me. So, basically the server
16 is going to check and if it doesn't have, and this is what I was saying, that
17 there's another explanation in Figure 8. It might even go to client A and be
18 like, hey, client B wants a file, do you have this? So, that's why the server is
19 not really dedicated to keep sending the, pushing the file automatically to the
20 other side. It's always waiting for the request. And it even does more
21 processing, more determination based on what the client B itself wants,
22 because it might not even ask for the file.

23 JUDGE BOUDREAU: Now to tie this back into the response that I
24 think you gave to Judge Giannetti a little while ago with respect to his
25 hypothetical about the iPhone pulling emails, or whether the emails are
26 being delivered via push mechanism, I think you had drawn a distinction

1 between automatic at the system level and automatic at the component level.

2 Would you agree that Sigurdsson is at least automatic at the system level?

3 MR. THOMAS: Yes, Your Honor. So, yes. In that sense, yes.

4 Because it is, at least it appears to have the client requesting when it's,

5 maybe, it's coming online. Yeah. In that, yes.

6 JUDGE BOUDREAU: So, your argument then is that it's just not

7 automatic at the component level?

8 MR. THOMAS: Component level. And specifically, from the first

9 application to the second application and vice versa as well. Vice versa,

10 meaning from the first application to the other client as well. So, basically,

11 the client is the one that's sending these files automatically.

12 JUDGE BOUDREAU: I see. So, your arguments are really based on

13 this distinction between automatic at the system level and automatic at the

14 component level, then?

15 MR. THOMAS: Yes, Your Honor. As claimed. And it is a

16 fundamental difference, Your Honor, because considering back what the

17 inventors are facing with the problems they're trying to address, there could

18 be other solutions. And Sigurdsson selected this for a particular reason and

19 put it, because they wanted this as a repository Dropbox system, they did not

20 go with the other approach. But the applicants, as I mentioned, the claims

21 themselves are specific and that's how it's set up.

22 JUDGE BOUDREAU: And what is your evidence that the

23 disputed -- that the challenged patents here require that this term, automatic,

24 or automatically, relates to the component level as opposed to the system

25 level?

1 MR. THOMAS: Your Honor, the first, I guess, is the claim itself.
2 Because the claims were originally filed, it wasn't added on later. In the
3 original patent itself, the applicants had drafted it in that manner. So, it's
4 specific there itself and it's consistent with the testimonies of Dr. Shenoy in
5 his declaration as well. So, basically, that would be the support for that
6 interpretation.

7 JUDGE BOUDREAU: But is there anything you can point to in the
8 intrinsic record other than the claim language itself?

9 MR. THOMAS: So, in column -- give me one second, Your Honor, I
10 do have it. So, in column 8, lines 35 to 45 do talk about that, Your Honor,
11 where the -- where what the server application 380 synchronization
12 application is configured to perform that system or perform that automatic.

13 JUDGE BOUDREAU: I'm sorry, you said column 8? Which lines
14 did you refer to?

15 MR. THOMAS: Starting at maybe 34 onwards. Because basically,
16 the controlling device is the synchronized, sync application 380 that's
17 monitoring the devices and then it's. It's the one that's transferring the
18 devices. Transferring to the devices. That would be the intrinsic evidence
19 for that.

20 JUDGE BOUDREAU: Thank you.

21 MR. THOMAS: Thank you. So, now we're going to just skip to
22 ground 2, and I turn it over to Mr. Lytle.

23 JUDGE KENNY: Before you leave, Counsel, let me go back to what
24 you were just talking about. The actual claim language requiring that the
25 automatic level versus the system level. Looking at the '561 Patent, the
26 claim itself is directed to a system. Is it not?

1 MR. THOMAS: The claim itself is a system, but then it goes into the
2 first leg where it says we're in the first electronic -- let me look at the claim
3 real quick, Your Honor. So, it starts off at a system comprising, but then it
4 goes to the specifics where the first electronic device is configured. And
5 then when we get to step 1d, it further goes into the next step, which is the
6 first application further configured. So, yes, the claim is directed to a
7 system, but then we've gotten into the specifics of the components and that's
8 really where the automatic keeps getting tied into a specific app component.

9 JUDGE GIANNETTI: Well, Counsel, why didn't you claim this
10 differently? Why did you claim it as a system? Why didn't you start out
11 saying a first electronic device configured? Your theory seems to be
12 contradicted by the preamble of your claim.

13 MR. THOMAS: I'm not sure, Your Honor. That's how the claims are
14 drafted, Your Honor. Yeah, sorry.

15 JUDGE KENNY: But specifically getting onto the phrase, I mean,
16 the part that you think requires it to be automatic at a component level is
17 what precise language?

18 MR. THOMAS: It's in element 1d, it's the first application is further
19 configured to automatically transfer. So, it's tied to that first application
20 being configured to automatically transfer.

21 JUDGE KENNY: And you think because of that phrasing it has to be
22 automatic at the component level rather than at the system level?

23 MR. THOMAS: Yes. Yes, Your Honor. Thank you, Your Honor. I
24 will turn my time to Mr. Lytle for ground 2, at this time.

25 MR. LYTLE: Hello, Your Honors, I'm Jay Lytle and I'll be speaking
26 about ground 2, although I think a lot of the issues that we've been talking

1 about probably overlap. And I'll try to answer your questions and your
2 hypotheticals, not only in context with ground 2, which I think helps inform
3 things a bit, but we'll talk about the things Mr. Thomas talked about.

4 So, ground 2 is looking at our exhibit demonstratives 2038 on
5 beginning on slide 35. Ground 2, obviousness is based on two references,
6 Brown and Hesselink. And these two references, you know, actually I think
7 Brown is somewhat instructive to some of the issues that we've been talking
8 about. Brown, as Mr. Thomas said, a lot of these references in the Topia
9 system we're talking about, they're grappling with the same problem. The
10 problem is user devices are proliferating. Back in the 2007/2000 timeframe,
11 people are working on a home computer, dashing off to an airport with their
12 laptop, and actually the iPhone had just come out that year. So, maybe the
13 iPhone wasn't even getting emails at that time, but it was back, it's a different
14 time than it is now. So, we have to look back at that time, what was going
15 on. And Brown kind of describes a bit of that.

16 So, I'd like to draw your attention to Brown itself, which is Exhibit
17 1025 at column 3. Brown is a client server architecture. And if you look at
18 the second full paragraph in column 3, Brown begins about its solution to
19 this problem of trying to synchronize a user's device. And it came up with a
20 different way of solving the problem than Topia's patents, and it points out
21 some of the problems they were facing. The second paragraph on column 3
22 says the client-server architecture, talking about Brown's architecture is
23 designed to minimize the load on the server processor in order to maximize
24 the processor, the server scalability. To that end, as many processor
25 intensive operations as possible are, such as message digest, communication,
26 compression, and synchronization, are performed at the client, client essay,

1 the client synchronization application. And so, what Brown is recognizing
2 there is that his architecture is designed to deal with this problem of
3 scalability of the server. A server serves many, many clients. And so, the
4 more work that the server has to do, that's the fewer clients that it can serve.
5 So, to maximize the scalability, it's pushing these functions, as many of the
6 processor loaded functions, down to the client as possible. And that drives a
7 different architecture, which drives a different solution to the same common
8 problem that everybody's trying to solve here.

9 And so, Brown came up with a very specific architecture to be able to
10 do this. First of all, it also recognizes in the third paragraph of column 3 that
11 there's another problem. The client-server architecture is designed to
12 minimize the amount of data that's transferred on the wire during the
13 synchronization process. And again, it's trying to reduce, deal with this
14 problem of communication, or communication bandwidth back in the 2000,
15 you know, back in the early-2000 timeframe, when networks weren't as fast
16 as they are now.

17 And so, Brown has a very specific architecture to do this, and it's
18 pushing as much down to the client as possible, and that's driving a different
19 architecture. And so, one of the ways that Brown accomplishes this,
20 reducing the data transmission, is instead of transferring the entire file every
21 time it's been changed, it just transfers the changes to the files. And so, it's
22 minimizing the data that's being transferred back and forth. But Brown talks
23 about, well, there's some cost to that, and the cost is figuring out where those
24 changes are. And Brown describes a very specific way of determining
25 what's the difference between the file up at the server and the file down at
26 the client. And this is what Brown calls these MDAs that are transferred,

1 message digests that are going back and forth. And it does this because it's
2 come up with a very unique way of determining where are the changes in the
3 files.

4 And if you look at Brown Figure 1, you'll see this is the overall
5 system. You've got clients, you've got server 105, and this synchronization
6 file system 110. Again, Brown's trying to solve the same problem
7 everybody is. They're trying to get the same copy, the same version of the
8 file on the user's devices. But again, it's doing it in a different way.

9 And if you turn to Figure 4a, 4a is now describing, not at the system
10 level, but at the device, you know, between the client 130 and the server
11 105. And it uses this indexing system. There's a client synchronization
12 index that the client has and a server synchronization index, the SSI that the
13 server has. And that's what that does, is Brown teaches that it performs
14 something called a hash function on its version of a file. And a hash
15 function is a computational way of uniquely identifying these, more or less,
16 the signature of the file.

17 And through this hash function, it creates, the client creates this index.
18 And the server also has, from the server's copy, it has its index. And this is
19 done to make it easy for the file server to determine if there's a change in the
20 file. When the client requests the file to come down to it, this is what's
21 shown in Figure 4a. The client starts this process by transferring its client
22 sync index, the CSI, to the server. And again, you can see in the upper right
23 hand corner, this procedure is figuring out are the client and server
24 synchronized or not. So, it starts by the client sending the CSI to the server.
25 Why is it important that it's a CSI? Because it's just a number. And the
26 server can compare its number, its SSI, with the CSI that the client sends up.

1 And if they match, then that means the files are the same and they're
2 synchronized, and the server will send down its SSI. And when the client
3 sees that, hey, it's SSI is the same as my CSI files are in sync, I don't need to
4 do anything.

5 But if they're different, then the client has to request the server to send
6 information to it. And this comparing of these indexes is a very simple
7 matching process, not very processor-intensive. So, again, this is getting the
8 Brown's recognition that the server has to serve a lot of clients. You might
9 have thousands of clients asking the server, hey, send me the latest file. The
10 Brown system has a very simple way for the server to figure out if there's a
11 change and does it need to do anything. And it's with this CSI and SSI.

12 Now, the hash function I talked about that's performed, that is a
13 processor-intensive function. But Brown has the client create those indexes.
14 It has the client create those hash functions. That's what's shown in Figure 6.
15 And the corresponding description of that is talking about the client
16 performing these functions to generate these indexes. And so, again,
17 imagine 1,000 clients out there that are doing this work rather than the server
18 doing it. So, Brown is teaching, pushing that processing down to the client.
19 The same with the network bandwidth. Brown is concerned about that and
20 it's transferring just the modified portions of the file to minimize the amount
21 of data that's being transferred back and forth. And Brown teaches that it's
22 the client that's figuring out through this CSI-SSI operation which parts of
23 the file have changed, and then it asks the server to send it down.

24 And so, this is, again, from the -- this is not at the system wide level.
25 We're talking about interactions between two components within the system,
26 a client and the server. And so, the interactions between those, Brown

1 teaches, it's very important in its architecture that the client makes the
2 request for this and the client initiates this whole process. And that allows
3 the server not to be loaded so much. And it supports this scalability feature
4 that Brown is concerned with.

5 So, that's a little bit of context of what's going on back at the time.
6 These were some of the challenges that were being faced by engineers and
7 computer scientists at the time. And so, the architecture is important.
8 Where you put the functions is important, and that's what Brown is teaching.
9 And Brown here is, if you can go back to, looking back to Figure 4a, you
10 know, it's the client that is initiating this whole synchronization process
11 between the server and the client. And so, again, it's important.

12 We, you know, Judge Giannetti talked about the iPhone example and
13 the iPhone, you wake up in the morning, you turn your iPhone on and all of
14 a sudden the emails appear. Is that automatic or not? Well, we would say,
15 yes, it's automatic at the system level. I mean, and we don't disagree with
16 the Petitioners that automatic would include without manual intervention.
17 But it's more than that. It's really between the two actors that are involved in
18 whatever element of the claim that automatic transfer appears. And so, if
19 you turn to element 1d.

20 JUDGE KENNY: Now, Counsel, before you get there, can you tell
21 me where in your papers you raised this client-server automatic distinction?

22 MR. LYTLE: Sure. I'll check my notes here. And first of all, Patent
23 Owner response, page 43. We talked about Brown teaching the client
24 initiating the synchronization.

25 JUDGE KENNY: No, but I mean in terms of the term. The potential
26 construction of the term automatic, where did you argue that it should be

1 construed to be, sorry, at the component level rather than at the system
2 level?

3 MR. LYTLE: Yeah, let me find that.

4 JUDGE KENNY: And, since we have two proceedings, which are
5 you looking at? The papers in the 427?

6 MR. LYTLE: I'm looking in the papers for the '561 IPR. Is that the
7 427? Yes. Just a moment, Your Honor. So, your question was where in the
8 papers did we raise the construction issue?

9 JUDGE KENNY: Well, I've heard today the comment about, well,
10 the distinction, you're arguing that the term should be construed at the
11 component level rather than at the system level. I don't remember seeing
12 that in any of the briefing. And so, that's what I'm trying to find out is did I
13 miss it? Is it argued somewhere?

14 MR. LYTLE: Yeah, I don't think we really use those terms at the
15 component level and at the system level. What we were focused on was the
16 claim language itself. And between the first application and the third client
17 device. In our papers, that's how it's couched. And so, those would be
18 components within the overall system.

19 JUDGE KENNY: Okay. And maybe, just so I'm clear, did you
20 propose a construction for the term automatic or automatically in your
21 papers?

22 MR. LYTLE: We did. For in the context of element 1d.

23 JUDGE KENNY: Can you point me to it?

24 MR. LYTLE: Yeah, let me find it here. Certainly, in the Patent
25 Owner sur-reply, page 9. Let me just get that.

1 JUDGE KENNY: Sur-reply page, sorry, this is the sur-reply in the
2 427 Patent -- for the 427 IPR?

3 MR. LYTLE: Yes.

4 JUDGE KENNY: And page 9?

5 MR. LYTLE: Page 9. So, in the first, if you've got -- let me know if
6 you're on page 9, I can show you where it is or explain where it is. In the
7 first full paragraph in the sur-reply on page nine we say a person of skill in
8 the art would understand it. We're talking about automatically transferred in
9 the context of element 1d to mean that the first application transfers a
10 modified file to the third electronic device without the third electronic device
11 requesting it. So, the --

12 JUDGE KENNY: I'm sorry, I'm actually missing. Where is it on
13 page 9?

14 MR. LYTLE: First full paragraph at the, one, two, third line down of
15 the first full paragraph.

16 JUDGE KENNY: On page 9.

17 MR. LYTLE: Yeah, this is paper number 49.

18 JUDGE KENNY: Okay, I'm sorry. Paper there. Okay, I'm sorry. I'm
19 on the right page now. Can you tell me again where it is?

20 MR. LYTLE: Yes, on page 9, first full paragraph beginning at line 3.
21 In that paragraph, it begins, a POSA would understand it to mean.

22 JUDGE KENNY: And then particularly it's the phrase understand it
23 to mean that the first application transfers a modified file to the third
24 electronic device without the third electronic device requesting the modified
25 file?

1 MR. LYTLE: Yes. Right. And by that we mean it's really the first
2 application that's initiating the transfer. The third application is not. It's not
3 initiating it.

4 JUDGE KENNY: But there's no discussion here about the term
5 having a different meaning for a system level versus a component level,
6 correct?

7 MR. LYTLE: Well, I think it's just inherently in, what we're arguing
8 is that we're focused down at the element level. And I think I heard the
9 question earlier, are we construing automatically transfer differently in the
10 claims? And I would say the answer is no. We're construing it to mean that
11 whoever the actors are in the particular claim element that's, you know, it's
12 between those actors, you know, who's going to transfer the file without it
13 being requested, without it being initiated by the other actor who's going to
14 receive it. So, I think that's consistent throughout the claims. But again, it
15 depends on the specific claim element you're talking about. About which
16 two entities are we talking about.

17 And again, this, why is it important that we're focused down what
18 we've been calling it at the component level? It's important for two reasons.
19 One is that's the way we should be interpreting the claims. We should be
20 interpreting the claims according to the claim language, including the
21 surrounding claim language. And so, when we're focused on elements 1d
22 and 1e, we're really focused on one particular leg of the file's journey from
23 the beginning to the, you know, from one device to the ultimate device it's
24 trying to get to. And so, again, it's, I think we need to look at each claim
25 element to talk about who are we talking about, where the file's being

1 transferred from and to. To see what, how does automatically transfer,
2 modify, or limit the claim in that way.

3 JUDGE KENNY: To get back to page 9, there's no discussion here of
4 system versus component level analysis, correct?

5 MR. LYTLE: Maybe not on that page, but I think we probably did
6 earlier on.

7 JUDGE KENNY: That's a question here. I mean, I think I'm hearing
8 this for the first time, and I'm saying, so I'm asking you where it is in your
9 briefs. So, besides that page can -- it's not on that page. Is it anywhere else
10 in your briefing?

11 MR. LYTLE: Let me defer to my colleagues here to find it. I believe
12 it is, and I think I'm running out of time, so I'd like to.

13 MR. THOMAS: Yeah.

14 MR. LYTLE: Do you mind if I come back to your question once we
15 get you --

16 JUDGE KENNY: Yeah, actually, you probably are out of time. I'll
17 probably give you a few more minutes. But the other question I had was,
18 why didn't Patent Owners submit any dictionary definitions for
19 automatically?

20 MR. LYTLE: Well, we thought it was clear from the claim language
21 itself. It's between two actors. When you read the patent itself, the patent,
22 the whole purpose of the patent is to, again, from a user-centric, to make a
23 user-centric system, from the system level, the eye level. We wanted the
24 user not to have to be involved in all these actions. I think in light of the
25 spec, when you read the claims, we thought it was not an issue until Patent
26 Owners, I mean, Petitioners, raised it.

1 JUDGE KENNY: Do you think the dictionary definitions, do you
2 think there are dictionary definitions that would support your case?

3 MR. LYTLE: Uh, probably, yeah. Um, I mean, we'd be happy to
4 submit some supplemental briefs. Yeah, we're just looking at one now,
5 having a self-regulating action or self-acting, but there's probably others as
6 well. And again, I think, I think, again, it needs to be looked at in the
7 context of the specification and claim languages themselves.

8 JUDGE KENNY: Okay. Do you have any more cites for the briefs in
9 terms of where the system versus component distinction was raised?

10 MR. LYTLE: Right now? Not. But maybe in our rebuttal time we
11 might be able to come back and let you know. And any other questions
12 about ground 2?

13 JUDGE KENNY: Just one moment.

14 MR. LYTLE: Okay.

15 JUDGE KENNY: I don't think we have any more questions. So, I
16 think it went a little bit over, but it was also, we did ask some questions, so
17 I'll still give you 20 minutes in the rebuttal period. So, at this point, I
18 assume you don't have anything further at this point, Counsel?

19 MR. LYTLE: I had. I've run out of time, but, you know, it's in our
20 briefs, so.

21 JUDGE KENNY: Well, I mean, if you want to take from your 20
22 minutes rebuttal, you can also do that. Or do you want to preserve the 20
23 minutes for your rebuttal?

24 MR. LYTLE: I'll take just a few minutes. One other distinction. You
25 know, the claims talk about transferring the file. The file. We're not
26 transferring -- it's different than the system of transferring just modifications

1 to the file. You know, just pieces of the file. We are -- the claims are
2 talking about transferring the file. In the petition, the only thing that
3 Petitioners argue is one sentence, one alternative embodiment, where Brown
4 talks about transferring the entire file. They're mainly focused on
5 transferring these MDAs, these portions of the files that changed. But they
6 say, you know, if so much of the file changed, then you could transfer the
7 entire file. But that's not paying attention to the claim language itself,
8 because again, in Brown, the client figures out what changed in the file. So,
9 the client's doing all this, and the client, that's not part of the first
10 application, automatically transferring it to the client. The transfer is
11 conditioned on the client figuring out, hey, in telling the server, should the
12 server send the entire file or should it send just the changes. And in Brown,
13 that's the client's job. Just to give you some citations for that, that would be
14 Brown column 10, 44 through 48, Brown column 12, 26 through 30.

15 Anyway, that was the other thing I wanted to point out. So, it's not
16 just the automatic transfer. That's the distinction.

17 JUDGE KENNY: I'll ask you one quick question on the Brown
18 grounds.

19 MR. LYTLE: Mm-hmm.

20 JUDGE KENNY: Why would setting up a push mechanism by the
21 server increase its load?

22 MR. LYTLE: Well, because, again, what Brown's teaching is a
23 couple of things. One is Brown's mainly talking about transferring the
24 changes to the file. And so, to figure out the changes to the file, you have to
25 go through this computationally intensive hashing function and create these
26 indices that Brown has set up. If you move that to the server, now the server

1 is doing that for all the clients in the system. You know, it could be
2 thousands of clients. So, it's a lot of load on them server. And that's what
3 Brown is teaching, pushing it back down to the client to do.

4 JUDGE KENNY: Okay, at this point, I think we'll take a break, a 10-
5 minute break, and then we'll resume in 10 minutes with the rebuttal cases.

6 MR. LYTLE: Thank you, Your Honor.

7 (Recess.)

8 MR. MEAD: Answer. If Your Honors have questions, more than
9 happy, of course, to answer those. So, subject to that, there's really only one
10 point wanted to address. I mean, I think the vast majority of Patent Owner's
11 presentation are issues we, you know, were addressed in Petitioner's opening
12 presentation. So, subject to questions from Your Honors.

13 The one point I wanted to address was with respect to the Brown
14 reference and just wanted to clarify. So, Patent Owner's Counsel had
15 referenced in Brown this notion. So, Brown has a technique where in some
16 instances, a portion of the file will be transmitted during synchronization.
17 But to be very clear, so Brown describes in column 12. So, Brown is
18 Exhibit 1025. So, column 12, lines 37 through 65. And for the record, and
19 this is also addressed extensively in Petitioner's petitions. So, both petitions
20 at pages 48 through 51 of each petition address this at length. And the point
21 is, in Brown, oftentimes it just depends on how extensive the changes are,
22 the entire file will be synchronized. And so, Brown expressly describes, as
23 Patent Owner's Counsel explained, Brown describes kind of a clever
24 technique where for each file you take hashes of segments of the file.

25 But what Brown then describes is, you perform a matching and you
26 have some threshold, some arbitrary threshold that's not detailed in this part

1 of Brown. If more than a certain threshold of the file has changed, you
2 transmit the entire file. And so, our claims here talk about a file. So, if
3 there's any issue or confusion about, you know, is Brown dealing with
4 synchronizing a file? So, for example, Brown, this is Exhibit 1025 at
5 column 12, lines 49 through 51 says, it starts off by discussing this hash
6 comparison and then says, on the other hand, if less than a threshold number
7 of message that is in the MDA's match, the entire file is transmitted. And
8 then the next paragraph further describes in detail.

9 So, I just wanted to make clear, just so there's no ambiguity. I mean,
10 it's, we addressed this point. I mean, there's no deficiency in Brown. It
11 explicitly describes right there the entire file. So, I mean, the other way to,
12 you know, logically, what Brown is saying is you synchronize and transmit
13 the entire file unless, you know, only some sufficiently small amount of it
14 has changed. And it's kind of a clever thing in Brown where it's, if you have
15 some huge file and you only made one little change to it, okay, we can just
16 map that change. So, I wanted to make sure that was addressed.

17 And then relatedly, on the point about, you know, purported load on
18 the server, and I believe, I believe it was Judge Kenny, I believe, raised a
19 question about, well, you know, how does that matter? And I think it was a
20 great question. We agree that, you know, Brown is not saying, well, you
21 know, there's like, at all costs, like whatever you do, you know, minimum,
22 you know, don't put load on the server. And this is again addressed in our
23 petition at, so, again, it's within the same section at paragraphs or section,
24 pages 48 through 51 of both petitions. So, both Brown and Hesselink
25 explicitly describe, so in the kind of the motivated combination of them,
26 right, where, you know, you're doing this. The synchronization algorithm is

1 motivated and taught by Hesselink both references describe the user can
2 specify here's a particular file or set of files or directory that I want to focus
3 my synchronization on, which makes good sense, right.

4 So, especially if I'm in the context like the Brown system, where I
5 have my home computer, my work computer. I don't need my entire
6 computer to be synchronizing all the time, right. If there's some random
7 changes that happen to be made by the system. I have a particular file that I
8 was working on at home I'm going to take to work with me on Monday. I
9 could just specify, you know, that's my synchronization focus. And so, we
10 explained this. It's explained in the petition, fully supported by Petitioner's
11 expert testimony as well. I just wanted to draw Your Honors' attention to
12 that.

13 So, that's the subject of that one clarification. And Petitioners didn't
14 have more we believe needed to be addressed. I think, you know, Your
15 Honors' questions on both sides presentations address a lot, address key
16 issues. Happy to answer any other questions, but otherwise, we would rest
17 and submit on the papers.

18 JUDGE KENNY: Let me ask you a couple of questions here. I
19 talked with opposing counsel about whether a push system in Brown would
20 unduly increase the load on the server. What's your answer to that?

21 MR. MEAD: I think, well, that was in part what I was trying to
22 address is that I don't think it necessarily will. I don't think we've seen some
23 clear showing that it necessarily would in the sense, because, you know, if
24 the, if the changes are going to be synchronized anyway, right, I mean, if all
25 we're talking about is, you know, what is our synchronization algorithm,
26 right? Changes are going to be pushed through. And I think Patent Owners,

1 you know, addressed at length, you know, the same, you know, hash
2 comparisons can be done in any event. It's done on the client in any event.
3 I don't -- I haven't heard a clear, you know, demonstration by Patent
4 Owner that, well, simply the transfer of the file using a Hesslink like
5 synchronization algorithm, there's not going to be additional processing at
6 the server to do that. And I think I addressed that in the papers, this concern
7 about server load. There's various competing concerns in every system
8 design, but Hesslink explicitly motivates, okay, that may be a factor. We
9 explain in the papers, it depends on the system, right? So, this is, we're
10 talking about real world systems here. You know, 15/17 years ago, if you've
11 got an Ethernet hardwired connection and very fast bandwidth, you may
12 have a corporate server that you just don't have a concern. Like, I'm
13 bringing my one Word document home to work with me. You know, you
14 don't have some concern, like, gosh, I'm over, you know, we're low
15 overloading the server that I'll synchronize that one file. I mean, this is all
16 laid out in multiple pages in our petition. So, I don't, I don't think that's
17 something that would motivate or cut against the combination, given that it's
18 explicitly motivated.

19 JUDGE KENNY: Turning to the '561 Patent, Patent Owner argued
20 that the passage in column 2, lines 10 through 44, in the background of the
21 invention, described automated systems that the patent was trying to
22 distinguish. How do you address that argument?

23 MR. MEAD: Sure. So, I think the key point of focus. So, multiple
24 points here. So, the manual versus automatically is what the patent
25 describes at length from column 1 and then continuing throughout column 2
26 and 3. It's the problem that is being addressed is a given user has multiple

1 different computers, right? They're saying, look, we're now in an era where
2 like, you know, you have a computer at work, I have a different computer at
3 home, a different portable one. And how do I get, if I want to get files from
4 my own, one of my computers to one of my other computers? So, the
5 distinction that's set up is manually. It says over and over, I could manually
6 email myself manually posted to FTP, manually pull it down on the other
7 side. So, there's that distinction. And I think that's the core distinction. In
8 column 2, I mean, I think Your Honor looked at, there's only one use of the
9 word automatic or automatically. It's just talking about like on a local,
10 Patent Owner that agreed, you know, we're just talking about like a local file
11 system of like automatically caching. This is like on my, you know, I have
12 my one computer, my work computer has Word on it and I automatically
13 cache.

14 The word automatically does not automated or automatically or the
15 like is not used in any of that description. On the contrary, what these are
16 talking about is a remote desktop application where the user needs -- so, like,
17 you know, you're on your one computer, you log into a remote desktop and
18 it explicitly describes the user needs to do something. So, for example, on
19 column 2, lines 19 through 22 describing this remote desktop configuration
20 for full accessibility, the customer would have to keep all files and
21 applications on the host machine as any files on the client are not guaranteed
22 to be accessible. Right? So, the point is these are not the automated. The
23 problem that's being addressed is automated from my own machine to my
24 other machine. A given user, how do I keep my work computer and home
25 computer and laptop computer all synced? These systems are not addressing
26 that. Right? They're saying you could have a remote login, you can have

1 distributed file systems, kind of FTP, like, where we can all post stuff and
2 download it later. But none of those are automated in the sense of what
3 these patents are getting about. And it's, and absolutely, as Your Honors
4 correctly noted, we have two system level claims. Right? You have a
5 system. Multiple devices automatically transferring from one to the next,
6 from one to the next, because in the, you know, as opposed to manual.
7 Right? So, I think. I hope that addresses Your Honor's question. I don't
8 think there's anything inconsistent about in the background here.

9 JUDGE KENNY: And maybe I can ask you also, given Patent
10 Owners arguments about automatic from a system level and automatic from
11 a component level, do you have anything to say about those arguments?

12 MR. MEAD: I mean, so, I mean, I agree with Your Honors. I didn't,
13 you know, I didn't see that in their papers. But, but more to the point, I
14 mean, I don't, I just don't think that's a supportable claim construction under
15 *Phillips* and the law, and as Your Honors have rightly noted, the intrinsic
16 record. You know, the specification doesn't say anything like that. I mean,
17 there's no -- it'd be one thing at least if there were, let's say, explicit
18 teachings in the specification. Like, it's really important for, you know, to
19 have automatic this or that, and these other ones don't need to be automatic.
20 And there's nothing like that. Right?

21 I mean, the only mention, the only place that word automatic is used
22 in the patent is, so, this is the '561 Patent column 7, lines 47 through 50,
23 where they're basically introducing this Figure 3 system. An embodiment of
24 the invention, allowing a user, not shown, who owns or otherwise controls
25 devices 210 or 280, like so my home computer, my work computer, to
26 automatically maintain file synchronization between at least those devices or

1 any other user devices. So, that's system level. I mean, like, the one place
2 that word shows up, we're talking about system level, right? We're talking
3 about, rather than the old cumbersome, error prone prior art where I got to
4 email it or, you know, put it up on an FTP, take it down, I have a system
5 where, hey, it's all handled. The devices handle it.

6 So, there's no -- so, for multiple reasons, I mean, it's -- I don't -- I
7 agree, it wasn't raised. It's not consistent with the claim language. It directly
8 contradicts the teachings, I think. And as Patent Owner did not address, you
9 know, column 10 says both push and pull are within the scope of transfer.
10 So, I mean, it would read out the pull embodiment, right, if we were to limit
11 the push.

12 So, thank you. Unless there are any other questions. Your Honors,
13 thank you very much for your time and attention.

14 MR. LYTLE: Whenever you're ready, Your Honors, like to start my
15 rebuttal.

16 JUDGE KENNY: Yeah. There were no further questions, so, yes,
17 you may go ahead and start your rebuttal.

18 MR. LYTLE: Okay, so just to be clear, how much time do we have
19 for the rebuttal?

20 JUDGE KENNY: You had probably 18 minutes because we went
21 about two into your rebuttal.

22 MR. LYTLE: Okay.

23 JUDGE KENNY: So, I'd say --

24 MR. LYTLE: All right.

25 JUDGE KENNY: -- maybe 18 minutes is a good statement.

1 MR. LYTLE: All right, thank you. So, just a few things. One is, let
2 me get to the point that you asked about, where in our briefing were we
3 talking about system level versus component level. And unfortunately, I
4 didn't have enough time to talk about ground 2 and Brown. But it was
5 described extensively in the discussion of ground 2. Distinguishing the
6 reliance on Hesselink, the Petitioners essentially rely on one sentence in
7 Hesselink. It's in paragraph 83. In that paragraph, it simply says that -- we
8 got it here. It simply says that, as noted, the data is updated, such as when a
9 file is edited, for example, the system may be configured to automatically
10 update all or some designated subsets of computers on the network as soon
11 as the update has been performed at one location. That's really about all that
12 they rely on in modifying Brown. And they say, well, this teaches that it
13 would have been obvious to have the server automatically and immediately
14 send the file out without the client requesting us.

15 But a couple things. One is this. And in our briefing, particularly at
16 Patent Owner response on pages 45 through 47, you know, we talk about
17 this thing that it's automatic in the '561, the claim elements are talking about
18 automatic from the server's perspective, that is the first electronic device
19 executing the first application. And then we point out that the claims of the
20 '561 Patent adopt a push-based file transfer from the server to the client,
21 allowing the server to send the modified without the need to client express it.

22 Then we turn to Hesselink. Hesselink, paragraph 83. And we point
23 out that Hesselink, this paragraph 83 of Hesselink, is merely an
24 aspirational -- I'm sorry, Hesselink, paragraph 183. Not sure if I said that
25 right, but paragraph 183, Hesselink is really just describing kind of an
26 aspirational goal of the system, which is to automatically get the file from

1 one computer to the other. It doesn't talk about how to do that. It just says
2 the system automatic -- is configured to automatically update some
3 computers on the network as soon as the update's been performed at one
4 location. And we argued, again, Patent Owner's response, page 45 through
5 47, that that is really at the system level. And our claims, we're talking
6 about individual elements of a claim, you know, element 1d, element 1e,
7 which are talking about interactions between specific devices that are called
8 out in the claim, the first application and the third electronic device. So, at
9 least at that point, you know, I believe you'll find our distinction of the
10 system level versus component level. But we were really focused on
11 looking at the claim language and dealing with the claims, each element of
12 the claim.

13 JUDGE KENNY: So, just to confirm, you're saying you were -- let
14 me take that back. Today, I heard an argument that automatic should be
15 construed at the component level rather than the system level. And we had
16 asked where that appeared in the briefing. You're saying it appears, that
17 request that we construe it as such, appears in page 45 to 47 of the Patent
18 Owner response?

19 MR. LYTLE: Yes, that's one spot. Yes.

20 JUDGE KENNY: Well, okay. Where, on those pages, is that request
21 made?

22 MR. LYTLE: So, let me just say our construction isn't that
23 automatically transferred, just should be focused on the component level.
24 It's our construction is between whatever two actors, when automatically
25 transferred is discussed, it's that the actor who's going to take the action. In
26 the case of element 1d, it's the first application, you know, takes that action,

1 initiates that action without being requested by the recipient of the file. And
2 that's also, that's not a distinction between just the component and the
3 system. The same thing happens at the system level. You know, I don't
4 think we are construing automatic transfer to be different between, you
5 know, just for an element versus, you know, what the patent's talking about
6 overall. I think it's consistent. You know, even at the system level, you
7 know, with the, with the iPhone example, you know, you're thinking that's,
8 that's a black box. There's some event that happens. Maybe somebody
9 sends an email. It goes to the server. The server is going to send that to the
10 iPhone without the iPhone requesting it or asking for it. Now, the iPhone
11 might get turned on and it might tell the server, hey, I'm here, but it's not
12 asking for the files, it's not requesting an initiation of the transfer. So, I
13 think our construction is not different between the component level and the
14 system level. We argued the elements of the claim.

15 JUDGE GIANNETTI: Counsel, I thought that where we came out on
16 the example was that it was automatic on, it might be automatic on the
17 system level, but not necessarily on the component level. Now, are you
18 telling me that there's not a difference? I'm confused by where you're going
19 with this component system distinction.

20 MR. LYTLE: Sure. So, automatically means, automatically transfers
21 means transferring it. You know, you've got to have two actors there.
22 Right? Whether it's a person and, you know, the ultimate end device, or
23 maybe it's a user's two end devices, or maybe it's somewhere in between,
24 between a server and the client. You know, whoever's going to start the
25 transfer and do the transfers, does it, initiates it without being asked to start
26 the transfer.

1 JUDGE GIANNETTI: So, that's the component level?

2 MR. LYTLE: Well, I think it's at the system level, too, because,
3 again, at the system level, that's what paragraph 183 of Hesselink is saying,
4 is that the system may be configured to automatically update some or all
5 designated subsets of the computers. You know, at that system level, you
6 know, maybe, Hesselink's talking about, you know, the user is not going to
7 have to request it. But when you get down, when you're talking about the
8 internals of the system, you know, now you're not talking about a user. As
9 counsel even said, it would be a bizarre construction if you took, there's a
10 manual, a person would manually transfer the file between the first
11 application and the client. I agree, it is a bizarre construction. So, I think
12 the best way to understand it is that whoever is doing the acting, and it
13 depends on when you're reading the element of the claim, whoever's taking
14 that action is taking the action without -- it's initiating the action without
15 somebody else requesting it.

16 JUDGE GIANNETTI: So, we can ignore the distinction between
17 components and systems in determining what's automatic. Is that what
18 you're telling us?

19 MR. LYTLE: I think you have to look at the claim language and see
20 what the claim elements are --

21 JUDGE GIANNETTI: Well, let's talk about the claim. Claim 1.

22 MR. LYTLE: Okay.

23 JUDGE GIANNETTI: Looking at, in that claim, we can ignore the
24 distinction between claim, between component and components and systems
25 in determining what is automatically transferred?

26 MR. LYTLE: Well, I think when you look at element --

1 JUDGE GIANNETTI: Just answer my question, Counsel. Can we
2 ignore the distinction or not?

3 MR. LYTLE: Can you? I think you have to look at the claim
4 language and --

5 JUDGE GIANNETTI: Well, we've got the claim language and just
6 tell me, can we ignore the distinction?

7 MR. LYTLE: So, the claim language says -- I don't think there is a
8 distinction because the claim language is referring, for example, in 1d, it's
9 talking about the first application's configured to automatically transfer.
10 And so --

11 JUDGE GIANNETTI: Okay. Thank you. That's all I need. Thank
12 you.

13 MR. LYTLE: Okay. Opposing Counsel mentioned the full file
14 transfer disclosure that's in Brown and column 12, and that talks about, you
15 know, the client, again, the client may decide whether the full file should be
16 transferred or the parts of the file, the modified parts should be filed. And
17 so, again, Brown, column 12, line 48 through 51. I think that's what
18 Petitioner's Counsel was pointing out. Says, on the other hand, if less than a
19 threshold number of message digests in the MDA's batch, the entire file is
20 transmitted. We don't disagree that there's a situation in Brown when the
21 files transmitted, but it's not automatically transferred from the first
22 application to the client. The client has to figure out where the changes are.
23 The client has to figure out, are there enough changes in the file that it
24 makes more sense to transfer the whole file or just parts of it. And the client
25 tells the server what to send it. It tells it either send me the whole file or
26 send me these parts of the file that have changed.

1 So, just because Brown mentions there's a situation where the full file
2 can be transferred, it doesn't satisfy the claim limitation 1d where the first
3 application it's configured to automatically transfer. I mean, it wouldn't
4 make sense that the first application would automatically transfer this file if
5 the client has to tell it what to send. And so, that's where we see a
6 distinction with, even though Brown does mention a situation where a full
7 file is transferred, when you look at the claims, we don't believe it satisfies
8 that limitation because there wouldn't be no automatic transfer from the first
9 application. In that case, it would be conditioned on the client telling the
10 server what to send.

11 MR. LYTLE: Anything else, Your Honors? Any further questions
12 for us, the Patent Owner.

13 JUDGE KENNY: Just a moment. We have no further questions.

14 MR. LYTLE: Thank you, Your Honors.

15 JUDGE KENNY: All right, I want to thank both of you for your time
16 and presentations. They were helpful. Please stay on the line for the court
17 reporter in case the court reporter has any questions from today's proceeding.
18 And with that, this case is submitted. Thank you.

19 MR. MEAD: Thank you, Your Honors.

20 (Whereupon, the proceedings at 2:38 p.m. were concluded.)

IPR2023-00427 (Patent 9,143,561 B2)

IPR2023-00433 (Patent 10,067,942 B2)

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