

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC. AND MICROSOFT CORPORATION,

Petitioners,

v.

DATANET, LLC

Patent Owner.

U.S. Pat. No. 8,473,478

Inter Partes Review Case No. 2024-00078

PATENT OWNER SUR-REPLY

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LIST OF PATENT OWNER'S EXHIBITS

Exhibit	Description
2001	[WITHDRAWN] Declaration of Zaydoon (“Jay”) Jawadi in Support of Patent Owner’s Preliminary Response
2002	[WITHDRAWN] Curriculum Vitae of Zaydoon (“Jay”) Jawadi
2003	Computer Busses, Bill Buchanan, CRC Press, 2000, pp. 139-143
2004	The Multi-boot Configuration Handbook, Roderick W. Smith, Que, 2000
2005	Encyclopedia of Microcomputers, Volume 2 - Authoring Systems for Interactive Video to Compiler Design; Allen Kent, James G. Williams, and Rosalind Kent; Taylor & Francis; 1988
2006	PhoenixBIOS 4.0 Revision 6 User's Manual; Phoenix Technologies Ltd.; June 22, 2000
2007	Forensic Computing: A Practitioner's Guide; A. J. Sammes, Brian Jenkinson; Springer Science & Business Media; 2000
2008	Introduction to Software Engineering; Ronald J. Leach; CRC-Press; 2000
2009	PC Interrupts: A Programmer's Reference to BIOS, DOS, and Thirdparty Calls; Ralf Brown, James Kyle; Addison-Wesley; 1991
2010	Hard Disk Controller: the Disk Drive’s Brain and Body; James Jeppesen, Walt Allen, Steve Anderson, Michael Pils!; Infineon Technologies; 2001
2011	SCSI-2 Standard; ANSI; 1994
2012	ATA Draft Standard; ANSI
2013	Newton's Telecom Dictionary: The Official Dictionary of Telecommunications Networking and Internet; 16th Edition; Harry Newton, Ray Horak; Cmp Books; 2000

2014	U.S. Patent Publication No. 2009/0254594 to Laurion D. Burchall
2015	<i>Reserved</i>
2016	U.S. Patent Publication No. 2007/0226436 to Cheng et al.
2017	U.S. Patent Publication No. 2004/0003103 to Witt et al.
2018	Foundations of Computer Technology; A. John Anderson; 1994; Taylor & Francis
2019	Redline comparing Pet., 19-25 with EX1003, ¶¶49-58
2020	Declaration of Zaydoon (“Jay”) Jawadi in Support of Patent Owner’s Response
2021	Curriculum Vitae of Zaydoon (“Jay”) Jawadi
2022	Deposition of David Maier, Ph.D., July 18, 2024
2023	Microsoft Press, Computer Dictionary, Third Edition (1997), p. 424
2024	The International Dictionary of Data Communications; Robert A. Saigh; 1998; Glenlake Publishing Company; pp. 159, 234, 278
2025	Deposition of David Maier, Ph.D., November 19, 2024

I. Introduction

As argued in the Patent Owner Response, and as further argued herein, the proposed combinations in both grounds fail for three reasons. Neither combination discloses or suggests “searching . . . for the archive file” under the proper construction and neither combination discloses or suggests the database limitations of the challenged claims. This is in addition to the further problem of the incompatibility of the art presented by the Petition for the proposed combinations. Patent Owner respectfully requests that the Board find the challenged claims patentable over the asserted art and arguments.

II. Claim Construction: “Searching . . . for *the* Archive File” Requires an *Actual* Search Operation for “the” *Actual* Archive File

As argued in the Patent Owner Response, “searching the first temporary storage location for the archive file,” as recited in Limitation 1.4, would require seeking the location *of the archive file, i.e.*, seeking the location of the archive file within the first temporary storage location by comparison of the data therein with a pattern for the archive file. Patent Owner Response (Paper 18) (hereinafter “POR”), 5-7.

Limitation 1.4 does not simply recite searching for *data*, but rather “searching . . . for *the archive file*.” The antecedent for “the archive file” is the archive file that is created in Limitation 1.3, *from* the operating file, on which an operation is

detected per Limitation 1.2, temporally proximate to the operation being performed and responsive to detecting the instruction per Limitation 1.1.

Limitation 1.4 requires an actual “search[]” under the plain and ordinary meaning of that word, for a specific archive file. Petitioners attempt to impermissibly broaden both (1) the word “search[],” and (2) the object of the search, which is “the archive file.” Both stretches of the claim language are incorrect.

A. The Statements in the Prosecution History are Not Definitional

Petitioners point to statements made by the applicant during the prosecution of the challenged patent linking the language of Limitation 1.4 in a prior version of the claims, to language in the specification as “exemplary support” therefor. Petitioners cite no caselaw to support their argument that this language, pointed to for exemplary support, can be taken as definitional.

The doctrine of prosecution disclaimer requires statements to be “clear and unmistakable disavowal,” which is not present here. *See Lazare Kaplan Int'l, Inc. v. Photoscribe Techs., Inc.*, 628 F.3d 1359, 1370 (Fed. Cir. 2010) (citing *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325-26 (Fed. Cir. 2003)).

The Federal Circuit has spoken directly on point, evaluating statements made by a patentee “direct[ing] the examiner to portions of the patent specification describing a structure . . . to show that the written description requirement was

satisfied” and that no new matter was being added. *SunRace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1307 (Fed. Cir. 2003). The Federal Circuit found statements of written description support, that were not pointed to “to define the term nor to distinguish the [components] in the claims from prior art” did “not provide the requisite disclaimer.” *Id.* The prosecution statements here were not used to define the term nor to distinguish anything from prior art. This “searching” language of the claim was not even directly at issue in the appeal brief cited by Petitioners. EX1002, 157-159 (argument on then-pending claim 34 related to detecting an instruction from an operating system and not the searching limitation).

“Exemplary support,” is merely that; it is exemplary rather than limiting or definitional. *See Syneron Med. Ltd. v. Invasix, Inc.*, No. 816CV00143DOCKES, 2018 WL 4696971, at *5 (C.D. Cal. Sept. 5, 2018), *report and recommendation adopted*, No. SACV160143DOCKESX, 2018 WL 11351325 (C.D. Cal. Sept. 28, 2018) (the “argument is unavailing, because in referencing the specification, the patentee . . . explicitly stated that it is an example and, thus, is not meant to be the only support.”); *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 821 F. Supp. 2d 1009, 1032 (N.D. Ill. 2011) (“[a]pplying the reasoning of *SunRace* to the circumstances of this case, the court finds that the statements identifying support in the specification for the [claim] term do not qualify as a clear and unmistakable disavowal of claim scope”); *see also Arbitron, Inc. v. International Demographics*

Inc., No. 2:06–CV–434 (TJW), 2009 WL 68875, *17 (E.D. Tex. Jan. 8, 2009)

(prosecution statement “that the carry detection transducer ‘reads alternately on the motion detector 54 and the temperature detector 55,’” *i.e.*, statements identifying relevant specification support, found not to be limiting).

There were other options to cite for support at the time of the appeal brief, including the language of the then-pending claim itself which, as part of the original claim set submitted with the application (EX1002 at 737 of 744 (original claim 34)), was part of the specification support. *See Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 998 n.4 (Fed. Cir. 2000), *cert. denied*, 531 U.S. 1183 (2001) (“One of this court’s predecessor courts clarified that disclosure in an originally filed claim satisfies the written description requirement.”) (*citing In re Gardner*, 480 F.2d 879, 880 (CCPA 1973)). Further, there are other disclosures of “searching” in the specification, neither of which imparts a special definition on searching (or on the object of this search, which is “*the* archive file”). *See* POR 6.

The words of the challenged claim are “searching . . . for the archive file.” This is a particular and different wording than Petitioners are attempting to import from the specification. The wording in the specification is “*examines* input buffer 20 to “*determine whether any* archive files are stored therein.” EX1001, 6:19-23 (emphasis added). This specification language is explicitly a “preferred operational

mode” (EX1001, 6:19), and the specification language is different from the claim language. Both the verb / action (the claimed “searching” versus the specification’s “examines... to determine”) and the object of that verb / action (the claimed “the archive file” versus the specification’s “any archive files”) distinctions matter, and the language of the specification is different than the language of the claim.

The language of the claim, of course, is what governs, and the language of the claim is narrower than the referenced language in the specification.

B. The prosecution statements that Petitioners attempt to use here are not limiting or definitional. Petitioners Own Expert Agrees with Patent Owner’s Definition, Which Petitioners Ignore

As discussed in the POR, Dr. Maier – Petitioners’ expert – confirmed that, in the context of Limitation 1.4, “searching in the sense of when we have a collection of information” requires “identifying an element of that collection.” EX2022, 70:16-71:14. This is in line with Patent Owner’s proposed definition, which requires searching for the actual archive file, which is in a collection of information in both Grounds. Dr. Maier did not testify in deposition that searching in a collection of information requires searching for the collection as a whole or searching for the existence of any data within the collection or location. According to Petitioners’ expert, then, searching for a file requires searching for the actual file, which is “an element of that collection” stored in first temporary storage location. *Id.*

Petitioners *completely ignore* their own expert's agreement with Patent Owner on this point.

* * *

Limitation 1.4, “searching the first temporary storage location for the archive file” requires seeking the location of the archive file within the first temporary storage location by comparison of the data therein with a pattern for the archive file. Any Petitioner attempt to alter or broaden the claim itself is impermissible.

III. Ground 1

A. Kenley-Long Fails to Teach or Suggest Limitation 1.4 (“Searching . . . for the Archive File”) Under the Proper Claim Construction

Petitioners argue that Kenley-Long meets Limitation 1.4 under Patent Owner's construction because, allegedly, a POSITA would have implemented Kenley-Long so that a file copied into the memory buffer is done so “with such marking metadata in order to mark (i.e., identify) the copied file (i.e., the archive file) as the specific archive file (e.g., as opposed to another version of the file).” Reply 13 (citing EX1003 ¶¶67-68). This is an argument that is newly invented in reply by Petitioners. However, nothing in cited paragraphs 67-68 discusses any metadata that could identify Long's markers, only the marker header and trailer, with captured data appended to the header. EX1003 ¶67. The marker trailer purportedly contains information required to determine the location of the marker header. EX1003 ¶68. That is the only Long marker metadata specified in Dr. Maier's

opening expert report in the cited paragraphs. Petitioners are expanding this disclosure beyond what is in the reference. There is nothing in the Long markers, for example, to help determine one version of data from another version (let alone one file from another file or version of the file, as files are not at all addressed by Long).

Importantly, the cited disclosure itself, regarding the marker trailer of Long, contains an error, and so the actual disclosure does not even contain information required to determine the location of the marker header, and therefore does not allow for “accessing the audit buffer . . . in reverse order” as Long alleges and upon which functionality Petitioners rely. The fields in the marker trailer of Long are (1) Event (type of event), (2) MsgLen (length of the optional text string associated with the marker), and (3) Marker CRC (the Cyclic Redundancy Check). EX1004, 6:59-67 (Table 3). None of these fields in the marker trailer allows for accessing anything. When asked about this, Dr. Maier stated that “[i]t’s possible that the description given there for that field is not the best possible one.” EX2025, 51:18-20. This is being charitable. Dr. Maier then said that given the stated purpose, one of ordinary skill in the art would understand that the marker trailer “had to contain information reflective of the total length of the marker it was in.”

Id., 48:11-16. But the marker trailer data contains no such information, as actually disclosed in Long, and therefore fails to function even for its stated purpose.¹

But beyond the stated purpose of accessing the audit buffer in reverse order, nothing in Long, the Petition, or Dr. Maier’s original declaration, have anything to do with metadata or distinguishing versions of data (or files). Petitioners impermissibly add this now, in their reply and as such, it is improper.

Petitioners then proceed to point to a POSITA, who would have allegedly implemented Kenley-Long so that the “relevant marking metadata” and the “current location of the copied file (archive file)” would be stored in a database.

Reply 13. But again, there is no such “relevant marking metadata” in Long.

There is nothing in Long that discusses any metadata that is used to mark the markers as Petitioners now argue, and nothing in Dr. Maier’s original declaration states otherwise. Petitioners rely on paragraphs 77, 55, 58, 68, and 76-80 of Dr. Maier’s original declaration to argue that a “POSITA would naturally augment the catalog database of Kenley to store relevant information from the audit header taught by Long.” Reply 13. However, as discussed in the POR, the audit header of

¹ This is in addition to the mistake from Long pointed out in the Patent Owner Response where Long conflated its audit header and maker header. See POR 20-21; EX2022, 69:21-70:6 (discussing possible typo in Long).

Long does not store anything other than the locations of the first and last markers.

POR 12-15.

The argument from the Petition and Dr. Maier's original declaration is that the proposed Kenley-Long combination would function "such that information on current locations of different backup files, including the relevant audit-header information taught by Long, was stored in the relational database catalog taught by Kenley." EX1003, ¶78. But, as argued in the POR, Long does not store information on current locations of different backup files, rather only the first and the last markers. POR 12-15.

Petitioners' argument regarding semaphores again misses the point that a semaphore, at most, controls access or shows the presence of data within the memory buffer, and has nothing to do with searching for any individual markers in Long, and hence nothing about searching for any alleged archive files in the proposed Kenley-Long combination. POR 15-16.

Petitioners then argue that Patent Owner has failed to present evidence that Long's flushing of the memory buffer would likely be done as a block copy. Reply 14. This is incorrect. Patent Owner's expert testified that since Long stores the location of its first and last markers, and not the intermediate locations, and stores this data contiguously, Long would copy the buffer from the beginning to the end as a block copy when copying data out of the memory buffer. POR 12-15 (*citing*

EX2020 ¶¶ 163, 164). Long tracks the beginning and the end of its memory buffer so that it can move the whole memory buffer onto the end of the audit buffer and then update the end of the audit buffer's audit header.

Petitioners point to a disclosure of Kenley “selecting files to be migrated,” arguing that this shows the alleged combination of searching for archive files. Reply 15 (citing EX1014, 3:5-8). Petitioners then vaguely state that the combination of Ground 1 would search the memory buffer for files. Reply 15. This disclosure and argument is absent from the Petition. EX1025, 66:10-68:13. It is also unclear how this “selecting” in Kenley for moving files from secondary to backing storage (EX1014, 3:5-8) could have anything to do with “searching the first temporary storage location for the archive file” as recited in Limitation 1.4.

“In an inter partes review, the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ 35 U.S.C. § 316(e), and that burden never shifts to the patentee.” *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016) (*quoting Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015)). The Petitioners have not met this burden simply by arguing vaguely and repeatedly with errors, that a person of ordinary skill would have made necessary assumptions and unspecified changes.

B. Kenley-Long Fails to Teach or Suggest the Database Limitations (Limitations 1.6, 1.9, and 1.10)

Patent Owner presented arguments as to why the Petition's references to Kenley in relation to its database/catalog did not actually disclose any storage of location information. POR 18-19. As argued in the POR, nothing in these disclosures details any storage of location information. After deriding a focus on details (*see* Reply 16, discussing forests and trees), Petitioners characterize Kenley as *requiring* indications of the location of archive files, for Kenley to work. Reply 16.

Petitioners are reading this disclosure into Kenley.

Petitioners rely on a dictionary definition for “catalog,” as including “location of files” to argue that Kenley's catalog includes location information. Reply 16 (citing EX1027). But the disclosure of Kenley shows otherwise. All that the disclosures of Kenley from the Petition show is that lists of files in a save set are maintained. This is not location information. Set X has files A, B, and C. There is nothing about location information. Set X can be anywhere. This was argued in the POR and accompanying expert declaration of Jay Jawadi. POR 18-19; EX2020 ¶173. Importantly, the Kenley catalog is not in connection with the primary storage and contains information on data in the secondary and backing store. *See* EX1014, 3:17-28. It is unclear, even assuming that Petitioners are correct about Kenley's catalog disclosure (which they are not), how this discloses or suggests Limitation

1.6's recited "updating a database to indicate that the archive file is located in the temporary storage location."

And, of course, as outlined in the POR, Long does not store location information for its markers in its audit header, instead storing only information for the first and the last marker. POR 12-13. While admitting to this, Petitioners now present a new argument that the proposed combination would work by taking the last marker information from Long with each update and would include that in the Kenley database. Reply 13. This argument is not found in the Petition, which specifically argued to "store Long's audit-header information in Kenley's relational database." Petition 38. Petitioners are now re-working their proposed combination in an attempt to meet the claims given the deficiencies in Long. This is improper and impermissible. When asked how one would understand this from his original declaration, Dr. Maier pointed to vague language from his original declaration and stated that a POSITA would understand how to make the combination. EX2025, 52:18-57:3. But it is the Petitioners' burden to specify with particularity the grounds in the Petition itself, and not through a new revision at this late stage of the proceedings.

Indeed, in deposition, Dr. Maier stated that a person of ordinary skill in the art would use extra data, beyond Long's, in the catalog of the Kenley-Long combination. EX2025, 47:23-48:14. But, when asked what additional data would

be used, Dr. Maier admitted: “I don't go into detail here about exactly what the additional elements would be that would be added to Kenley's system catalogue database.” EX2025, 50:7-10.

C. Kenley and Long are Incompatible and Therefore it Would Not Have Been Obvious to Combine Kenley with Long as Proposed by Petitioners

Long pertains to disk sectors and Kenley to files. The two technologies are distinct and the operations are incompatible between the systems. In attempting to argue for their combinability, Petitioners argue about allegedly broader disclosure in Long. They incorrectly argue that Long teaches a non-existent “general technique” (Reply 5), which it does not.

1. Long does not have general disclosure, untethered to sectors.

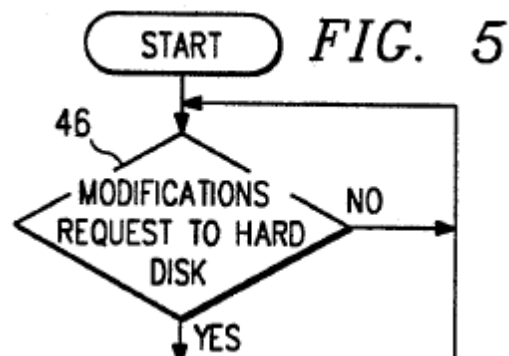
Petitioners argue that Long describes a “request from an application to modify the contents of the hard disk.” Reply 8. They argue that this shows a connection spanning the higher-level application to the lower-level hard disk. But the entire disclosure of Long is about the lower level / hard disk / sectors. That is how Long captures any changes, wherever they might originate, as argued in the POR. POR 28-30. Petitioners’ expert understood this: “*I believe Long would detect file-based operations, file-modification operations emanating from the operating system or a user program because those file modifications ultimately get down to the level where you are writing disk.*” EX2022, 48:8-13 (emphasis added). That is how Long

works, at the “level where you are writing [to the] disk.” *Id.* Any “detection” of file-based operations is merely the consequence of files being composed of sectors and Long working at the level of sectors; Long itself clearly does not detect file-based operations.

Petitioners are now arguing about some allegedly more general disclosure of Long. Reply 8-9. They point to Claim 31 of Long, which recites a method and does not recite the word “sector” or “sectors.” When asked about why he pointed to claim 31 as allegedly being more general than the rest of Long, Dr. Maier stated that it was “the claim I mentioned during my [prior] deposition,” and that he was “not really completely familiar with different flavors of claims” and that he was unable “to create a mental state of . . . a point in a deposition that took place previously.” EX2025, 21:18-23:1. It is true that Long’s claim 31 does not explicitly recite “sectors,” but it does recite “locations of the storage device.” EX1004, 12:26-27. All other Long claims recite the same phrase. EX1004 10:17-18 (Claim 1); 11:21-22 (Claim 16); 14:21-22 (Claim 46, reciting “locations on the storage device”). Long’s disclosure makes clear that locations of the storage device are sector data storage locations. *See* EX1004, 9:39-43 (discussing “the sector data and its associated location on the hard disk”).

In addition to Claim 31, Petitioners and Dr. Maier cite to Long's abstract as alleged disclosure that goes beyond sectors. Reply 9. Yet, the Abstract similarly recites "locations of the storage device," *i.e.*, sectors. EX1004, Abstract.

In his second deposition, Dr. Maier also pointed to Long's Fig. 5 as allegedly being broader than sectors. EX2025, 18:7-19:6. Long's Figure 5 is the figure whose specification text includes the "application request" that Petitioners rely so heavily upon. EX1004, 7:39-42. However, Figure 5 itself discloses this request not as having anything to do with an application, but as "modifications request to hard disk." EX1004, Fig. 5.



EX1004, Fig. 5 (excerpt). Dr. Maier admitted – although arguing that the disclosure of Figure 5 is somehow broader than sectors – that the one paragraph discussing Figure 5 in the specification discusses it in relation to sectors. EX2025, 19:1-21:7. Dr. Maier criticized Patent Owner's expert, Mr. Jawadi, as referring to "Long's embodiment of 'processing circuitry'" to the exclusion of other teachings. EX1024 ¶29. When asked what other embodiments there were, Dr. Maier was

unable to answer and agreed that the main (indeed, only) embodiment of Long included the processing circuitry. EX2025, 29:7-34:21.

Long teaches away from use at a higher level (POR 31) and there is no distinction between Long's error detection at the lowest level and Long's audit information, as all of this information is stored together. EX2025, 38:4-19 (Long stores its audit information and event information regarding errors together); *id.* at 40:20-41:8 (same). The very title of Long is "Fault Tolerant Computer with Archival Rollback Capabilities." EX1004, Title. Fault tolerance and error detection is core to Long and intermingled with its rollback capabilities.

As argued in the POR, Long concerns sectors, and has no "broader" disclosure that deals with files.

Petitioners introduce a new piece of evidence in their Reply on page 8, U.S. Patent No. 5,907,672 to Matze et al. ("Matze"), EX1025, which Petitioners argue shows mixing concepts from different approaches. Matze actually supports Patent Owner's arguments, comparing two backup strategies, "file-by-file, which has well-accepted usability characteristics but whose performance is proving extremely difficult to maintain as technology advances" and image backup. EX1025, 5:15-18. Matze generally concerns overcoming problems with image backup. EX1025, 5:24-30. In other words, Matze discourages backups using file-by-file systems, like the system of the challenged '478 patent.

2. Schneider-US does not make Ground 1's combination obvious

Petitioners rely heavily on Schneider-US as allegedly showing how obvious the combination of Long and Kenley would be. But Petitioners overstate Schneider-US as characterizing “the general teachings in Long” as a “fundamental method[.]”

Reply 6. Schneider-US characterizes the “move method” generally, and *not Long in particular*, as being a fundamental method. EX1016, 6:30-50. Long is discussed separately as describing the basics of the move method, but Long is not, itself, fundamental at all. EX1016, 8:8-9. The move method, far from being fundamentally helpful, is discussed in Schneider-US as having “the drawback of *fundamentally being slow*.” EX1016, 6:62-64 (emphasis added).

Schneider-US further discusses Long's process as having a “flaw” that the RAM cache is insufficient for file data, like word processing documents or graphic images, overflowing the cache which leads to delays. EX1016, 8:45-52. Schneider-US gives the example of a delay saving a file from 10 seconds to 30 seconds if the move method is used, which “most users would consider . . . a serious and potentially unacceptable performance impact to using the Move Method of saving original states.” EX1016, 8:49-52.

The fact that Schneider-US uses the move method in conjunction with disclosure about files does not make the combination of Long and Kenley obvious to a POSITA. Schneider and his co-inventors have not been presented as having

“ordinary skill in the art,” and their backgrounds are not in the record. EX2025, 13:20-15:11. They are not being proposed as POSITAs and have not been qualified as such.

IV. Ground 2

A. Cabrera-Schneider-Whiting Fails to Teach or Suggest Limitation 1.4 (“Searching . . . for the Archive File”) Under the Proper Construction – Which is Admitted by Petitioners

Petitioners admit that the Cabrera-Schneider-Whiting combination of Ground 2 fails to disclose or suggest Limitation 1.4 under Patent Owner’s proposed construction. Reply 24 (arguing only under the “proper construction,” which Petitioners claim is their own construction, and failing to argue under Patent Owner’s construction of Limitation 1.4). Petitioners’ expert, Dr. Maier, confirmed that the Petitioners were not arguing that the combination in Ground 2 met Limitation 1.4 under Patent Owner’s construction. EX2025, 78:22-81:2 (“do you argue under ground 2 under patent owner’s construction anywhere in this reply declaration on the ’478 patent? . . . A: I don't believe I argue under the patent owner’s construction of searching in -- in ground 2.”).

B. Cabrera-Schneider-Whiting Fails to Teach or Suggest the Database Limitations (Limitations 1.6, 1.9, and 1.10)

The Reply submits the new argument that the master file table of Cabrera stores location information and that Cabrera alone renders obvious the database limitations of the challenged claims. Reply 23. This argument is new to the Reply,

completely incorrect, and unsupported by Petitioners' expert, as admitted during his deposition. EX2025, 76:1-20 ("when I say in my reply declaration that Cabrera discloses a master file table storing location information for files . . . I did not demonstrate or support that point in my original declaration. . . . I did not offer evidence of that in this reply declaration.").

Cabrera does not store location information for files in its master file table, as admitted by Petitioners' expert. This was Petitioners' basis of combining Whiting, arguing that Whiting would enhance Cabrera's alleged ability to track data. Petition 65. As argued in the POR, it would not have been obvious to combine Whiting with Schneider and Cabrera as proposed, and the combination is not properly supported or detailed by the Petition, at least as far as the database limitations, Limitations 1.6, 1.9, and 1.10. POR 55-58.

C. Cabrera-Schneider-Whiting Fails to Teach or Suggest the Limitations 1.5

As argued in the POR, nothing in the Petition, Petitioners' expert declaration, or Cabrera discloses or suggests what mechanism Cabrera uses for moving data from its intermediate location to the remote storage or, most importantly for Limitation 1.5, what would trigger such a move. POR 43-46. The Petition ignored the intermediate location of Limitation 1.8 when mapping Limitation 1.5. In reply, Petitioners argue for a broad read of Limitation 1.5 and argue that Cabrera delivers data "in turn" from the intermediate system to the remote system. Reply 25-26.

Limitation 1.5 requires “moving the archive file to a second [/ permanent] storage location responsive to a second event,” but the Petition’s mapping shows, at most, moving data to the intermediate system responsive to the mapped events. There is no event shown, disclosed, or suggested that results in the archive file moving to the alleged second / permanent storage location.

Patent Owner had also argued in the POR that Ground 2 failed to disclose or suggest Limitations 8.5, 9.5, 10.5, and 11.5 for the same reasons as its failure to disclose Limitation 1.5. This POR argument was in error, because claims 8, 9, 10, and 11 of the ’478 patent do not recite moving the archive file to an “intermediate storage location,” (EX1001, 9:12-10:37), Patent Owner’s argument with regard to limitation 1.5 is limited to claim 1 and dependent claims 2-6.

D. The Cabrera-Schneider-Whiting Combination is not Obvious

Cabrera is periodic in nature. Petitioners argue that this periodic nature of Cabrera is discussed as being an “embodiment ‘[i]n the alternative.’” Reply 36 (quoting EX1005, 3:45-50). The quoted section of Cabrera makes clear that the alternative to waiting a period of time is to wait for an amount of data to be stored in the staging area. EX1005, 3:45-50. In other words, *the alternative is periodic as well*, as outlined in the POR and accompanying expert declaration. POR 47-49; EX2020 ¶¶ 221-224. Cabrera waits for a period of time or an amount of data to be

accumulated before initiating a backup. That is its nature and the proposed combination with Schneider is not obvious.

Finally, the combination is not obvious because doing so would fundamentally alter the principle of operation of Cabrera. POR 49-53. Cabrera backs up data after data is already written, not before a write operation occurs. This further shows the ingrained, periodic nature of Cabrera and incompatibility of Cabrera to the proposed combination of Ground 2.

Dated: December 6, 2024

Respectfully submitted,

/Ari J. Jaffess/

Ari J. Jaffess

(Attorney for Patent Owner)

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CERTIFICATION UNDER 37 CFR § 42.24(d)

Pursuant to 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner Sur-Reply totals 4,682 words, which is less than the 5,600 allowed under 37 CFR §42.24(c)(4).

Dated: December 6, 2024

Respectfully submitted,

/Ari J. Jaffess/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.205(b), the undersigned certifies that on December 6, 2024, a complete and entire copy of this Patent Owner Sur-Reply was served on Petitioners by filing through the Patent Trial and Appeal Case Tracking System (P-TACTS) and via email to andrew.mason@klarquist.com, cameron.clawson@klarquist.com, sarah.jelsema@klarquist.com, and frank.morton-park@klarquist.com, as authorized in Petitioners' mandatory notices.

Dated: December 6, 2024

Respectfully submitted,

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