

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

DROPBOX, INC. and MICROSOFT CORPORATION,  
Petitioner,

v.

DATANET, LLC,  
Patent Owner.

---

IPR2024-00080  
Patent 10,585,850 B2

---

Before JOSIAH C. COCKS, GEORGE R. HOSKINS, and  
BACH V. HOANG, *Administrative Patent Judges*.

HOANG, *Administrative Patent Judge*.

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

## I. INTRODUCTION

### A. *Background*

Dropbox, Inc. and Microsoft Corporation (collectively, “Petitioner”) filed a petition for *inter partes* review (Paper 3 (“Pet.” or “Petition”)) challenging claims 1–21 of U.S. Patent No. 10,585,850 B2 (Ex. 1001 (“the ’850 patent”)). Datanet, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review. The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons explained below, we institute an *inter partes* review of all challenged claims on all grounds raised in the Petition.

### B. *Real Parties-in-Interest*

Petitioner identifies Dropbox, Inc. and Microsoft Corporation as the real parties-in-interest. Pet. viii. Patent Owner identifies Datanet, LLC as the real party-in-interest. Paper 4, 2.

### C. *Related Matters*

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters, including the following:

- *Datanet, LLC v. Dropbox, Inc.*, No. 6:22-cv-01142 (W.D. Tex.), filed October 31, 2022; and
- *Datanet, LLC v. Microsoft Corporation*, No. 2:22-cv-01545 (W.D. Wash.), filed October 31, 2022.

Pet. viii; Paper 4, 2.

Patent Owner further identifies the following related matters before the United States Patent and Trademark Office:

- IPR2024-00078 which challenges claims in related U.S. Patent No. 8,473,478 B2;
- IPR2024-00079 which challenges claims in related U.S. Patent No. 9,218,348 B2; and
- Reexamination No. 90/015,216 which requests *ex parte* reexamination of U.S. Patent No. 8,473,478 B2.

Paper 4, 2.

D. *Petitioner's Asserted Grounds*

Petitioner asserts that claims 1–21 would have been unpatentable on the following grounds:

|          | <b>Claim(s)<br/>Challenged</b> | <b>35 U.S.C.<sup>1</sup><br/>§</b> | <b>Reference(s)/Basis<sup>2</sup></b> |
|----------|--------------------------------|------------------------------------|---------------------------------------|
| Ground 1 | 1–21                           | 103                                | Schneider <sup>3</sup>                |
| Ground 2 | 1–21                           | 103                                | Schneider, Crawford <sup>4</sup>      |

---

<sup>1</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, (2011), revised 35 U.S.C. §§ 102 and 103 effective March 16, 2013. The ’850 patent claims priority to an application filed before that date, so we refer to the pre-AIA version of the statute, but our findings and analysis would be the same under the current version of the statute.

<sup>2</sup> Petitioner asserts these references are each prior art to the ’850 patent, which Patent Owner does not dispute at this stage of the proceeding. *See* Pet. 15 (Schneider), 45 (Crawford), 50 (Sweat).

<sup>3</sup> WO 99/12101 A2, filed September 4, 1998, published March 11, 1999. Ex. 1005.

<sup>4</sup> US 5,771,354, filed November 4, 1993, issued June 23, 1998. Ex. 1009.

|          | <b>Claim(s)<br/>Challenged</b> | <b>35 U.S.C.<sup>1</sup><br/>§</b> | <b>Reference(s)/Basis<sup>2</sup></b> |
|----------|--------------------------------|------------------------------------|---------------------------------------|
| Ground 3 | 1–8, 10–16,<br>18–21           | 103                                | Sweat <sup>5</sup>                    |
| Ground 4 | 9, 17                          | 103                                | Sweat, Schneider                      |

Pet. 2.

E. *Testimonial Evidence*

Petitioner relies on the proffered declarant witness testimony of David Maier, Ph.D. *See* Ex. 1004. Patent Owner relies on the proffered declarant witness testimony of Mr. Zaydoon Jawadi. *See* Ex. 2001.

F. *The '850 Patent and Its Provisional Application*

As relevant to this proceeding, the '850 patent describes a method of restoring a file to a previous version of the file. Ex. 1001, code (57). The '850 patent claims priority to U.S. provisional application 60/234,221 (“the '221 provisional”). *Id.* at code (60). The '221 provisional provides certain details regarding the file restoration method that the '850 patent does not. *Compare* Ex. 1001, *with* Ex. 1003. As the '221 provisional most thoroughly describes the file restoration method, and Patent Owner relies on details provided only in the '221 provisional (*see* Prelim. Resp. 2–6, 43), we focus our discussion on the disclosures of the '221 provisional.

The '221 provisional is a collection of documents describing a software application, AccuSafe, for backing up and recovering computer data. Ex. 1003, 135; *see generally id.* The '221 provisional describes a process for restoring a file in which

1. A selection of backed-up files in a directory hierarchy is presented to the user. Information displayed includes (at a minimum) File Name, Date/Time Stamp, and Original Location.

---

<sup>5</sup> US 7,062,532 B1, filed March 24, 2000, issued June 13, 2006. Ex. 1006.

2. The user will have the ability to view a file before restoration. This will be accomplished using the standard windows File Type associations so files will be viewed with their native viewer.
3. User selects directory or file to be restored. This can be a single file/directory or multiple files/directories. . . .
4. User selects a destination directory and destination file (original is default). . . .
5. Users selects to restore selected file.
6. File(s) residing on AccuSafe drive is/are verified . . . .
7. File(s)/Directory(s) is/are restored.

*Id.* at 205; *see id.* at 30–39. In a use-case scenario, a user incorrectly overwrites a particular file version and the user wishes to restore that current, incorrect file version to a previous version. *Id.* at 30–31. To do so, the user uses a restore function to retrieve the lost version. *Id.* at 31. The restore function displays a list of previous file versions which the user may preview and select for restoration. *Id.* at 32–34. When the user selects a previous file version to restore, the incorrect file version is restored by overwriting it with the selected previous file version. *Id.* at 35–39.

G. *Illustrative Claims*

Petitioner challenges all claims of the '850 patent. Of these, claims 1, 10, 18, and 19 are independent, and for purposes of this Decision, claim 1 is representative. Claim 1 is reproduced below with Petitioner's added limitation identifiers in brackets and line breaks. *See* Pet. 12–13.

[1.1] 1. A method of restoring a file to a previous version of the file, a current version of the file being available at a local storage location, comprising the steps of:

[1.2] [1.2.i] (A) presenting information for a collection of one or more previous versions of the file, the information for the collection including information indicative of at least one or more of previous versions of the file,

[1.2.ii] wherein a restorable representation of each version, V, of the previous versions, is retrievable from a remote storage location,

[1.2.iii] the restorable representation having at least information required for recovering the version V by a computational machine with the current version being accessible, the remote storage location being accessible through a network;

[1.3] (B) responsive to a selection to preview a selected previous version of the file based on the presented information for the collection of (A), presenting a presentable representation of the selected previous version, the selected previous version being one of the previous versions of the file in the presented information for the collection, the presentable representation having at least information required for presenting at least a portion of the selected previous version by the computation machine with the current version being accessible; and

[1.4] (C) responsive to a selection to restore the selected previous version, retrieving the restorable representation of the selected previous version from the remote storage location and storing the selected previous version by the computational machine as the current version on the local storage location, the selected previous version available from the restorable representation of the selected previous version.

Ex. 1001, 8:63–9:28.

## II. ANALYSIS

### A. *Legal Standards*

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion

regarding unpatentability never shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) any secondary considerations, if in evidence. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966).

B. *Level of Ordinary Skill in the Art*

Petitioner asserts that a person of ordinary skill in the art “would have held a bachelor’s degree in computer science, electrical engineering, computer engineering, or a closely related field, and one or more years of experience in the design and development of file management, restoration, and archival systems.” Pet. 13–14 (citing Ex. 1004 ¶¶ 29–32). Petitioner further asserts “[m]ore education, e.g., a Master’s or PhD could compensate for a lack of work experience and vice versa.” *Id.*

Patent Owner does not dispute this assessment. *See* Prelim. Resp. 9 (“Patent Owner does not offer a competing definition at this time, because even under Petitioner’s proposed definition the Petition fails to present a reasonable likelihood of success.”).

For purposes of this Decision, we adopt Petitioner’s proposed level of skill, as articulated above. We are satisfied that Petitioner’s proposed definition generally comports with the level of skill necessary to understand and implement the teachings of the ’850 patent and the asserted prior art.

C. *Claim Construction*

We interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b). Under the principles set forth by our reviewing court, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would be understood by a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

Neither party proposes any claim terms for construction. Petitioner states it “appl[ies] the plain and ordinary meaning of all claim terms.” Pet. 14. Patent Owner states it “does not believe any claim constructions are necessary based on the arguments presented by Patent Owner at this time.” Prelim. Resp. 26.

We conclude, at this stage, that it is not necessary to address the construction of any claim terms or phrases. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. *Ground 1: Obviousness Based on Schneider*

Petitioner contends that the subject matter of claims 1–21 would have been obvious over Schneider. Pet. 14–45. Patent Owner opposes. Prelim. Resp. 27–37.

We have considered the parties’ arguments and the evidence presented at this stage, and we address them in the context of representative claim 1. For the reasons explained below, we determine that Petitioner has demonstrated a reasonable likelihood that it will prevail in showing that the subject matter of claims 1–21 would have been obvious over Schneider, notwithstanding Patent Owner’s arguments to the contrary.

1. *Overview of Schneider (Ex. 1005)*

Schneider describes techniques for “disk based information recovery in computer systems” which can recover “saved information [that] may be disk sectors, files, or portions of files.” Ex. 1005, 7:8–9, 7:21. In particular, Schneider discloses “Data Reversion Embodiments” allowing information to be reverted back to an earlier state and further that its “invention can be implemented to work either with managing data at the disk sector level or file level (or portions of a file).” *Id.* at 10:25–26, 129:27–130:23. Disk sector embodiments “revert a disk back to an earlier state” (*id.* at 10:30–11:1) while file level embodiments allow “earlier versions of a file” to “replace[] the current version” of the file (*id.* at 130:11–13).

Regarding the file level embodiments restoring earlier versions of files, Schneider explains it “present[s] the user with a list of prior states for a given file, and allow[s] any to be copied forward.” *Id.* at 24:10–12. Schneider also notes “it is useful to allow the user to select a file that can be retrieved from the past, and to automatically launch the appropriate application to view the file,” allowing the user “to view [the to-be-retrieved

file's] contents without actually formally retrieving the file.” *Id.* at 60:21–27. When an earlier file version is recovered, “the recovered file either replaces the current version or is copied to a new file.” *Id.* at 130:11–13.

Additionally, regarding where back-up information used for information recovery is stored, Schneider states that “five software methods for information recovery . . . in which the backup (historic) data is kept on the same hard disk as normally used by the user. In addition, a method is described for extending the backup services to utilize a second hard disk, and so provide a degree of hardware redundancy.” *Id.* at 33:29–34:5. Detailing storing back-up information on the redundant second hard disk, Schneider discusses an “approach to achieving an external backup” where an external disk drive “like the main disk, employs a method of saving original disk states,” i.e., “the external disk generally mirrors the main internal disk.” *Id.* at 109:6–11. Schneider also discloses that its “external disk . . . include[s] a disk interfaced to a target computer through a network.” *Id.* at 112:26–28.

## 2. *Independent Claim 1*

Petitioner provides arguments and evidence in support of its contention that claim 1 is unpatentable as having been obvious over Schneider. *See* Pet. 19–30; Ex. 1004 ¶¶ 56–71. Patent Owner opposes. *See* Prelim. Resp. 27–38; Ex. 2001 ¶¶ 65–127. We conclude Petitioner has demonstrated a reasonable likelihood of prevailing on its contentions, for the following reasons.

### a) *Preamble 1.1*

Petitioner contends that Schneider discloses the preamble, “[a] method of restoring a file to a previous version of the file, a current version of the file being available at a local storage location.” Pet. 19–20 (citing

Ex. 1005, 23:29–24:12, 31:19–24, 112:1–114:5, 113:9–10, 130:10–17, 135:6–8, Figs. 47A–I, 63; Ex. 1004 ¶ 58). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Schneider discloses the preamble.<sup>6</sup>

b) *Limitation 1.2.i*

Petitioner contends that Schneider discloses “presenting information for a collection of one or more previous versions of the file, the information for the collection including information indicative of at least one or more of previous versions of the file.” Pet. 20–21 (citing Ex. 1005, 31:19–24, 58:20–23, 59:27–60:5, 130:10–17; Ex. 1004 ¶¶ 59–60). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Schneider discloses this limitation.

c) *Limitation 1.2.ii*

Petitioner contends that Schneider discloses or renders obvious “wherein a restorable representation of each version, V, of the previous versions, is retrievable from a remote storage location.” Pet. 21–26 (citing Ex. 1005, 23:29–24:12, 24:21–24, 31:12–24, 105:15, 109:7–8, 109:19–29, 111:3–114:7, 130:10–13, Figs. 47A–I; Ex. 1004 ¶¶ 61–66; Ex. 1008, 6:9–36; Ex. 1009, 3:13–19, 3:37–39, 3:64–66; Ex. 1013, 544, 556). Patent Owner disputes both contentions that Schneider discloses or renders obvious this limitation. Prelim. Resp. 27–33. At this stage in the proceeding, Petitioner has shown a reasonable likelihood that Schneider discloses or renders obvious this limitation. We address both contentions in turn below.

---

<sup>6</sup> At this stage of the proceeding, the panel need not resolve whether the preamble is limiting because Petitioner shows sufficiently for purposes of institution that the prior art satisfies the recitation in the preamble.

(1) *Disclosure of files “retrievable from a remote storage location”*

Petitioner argues that Schneider discloses this limitation, asserting that Schneider’s file-level embodiment stores recoverable file versions on an external disk, i.e., “a remote storage location.” Pet. 21. Petitioner supports that assertion by explaining that Schneider’s “file versions are stored in [a] history buffer [that is] used to recover versions of desired files” and such “historic data (from which the files are restored) [are located] on an external device.” *Id.* (citing Ex. 1005, 31:12–24, 108:15, 109:7–8, 112:26; Ex. 1004 ¶ 61)). Petitioner also explains that Schneider’s “external (remote) disk maintains the same historic data as the internal (local) disk” and the external disk is used to recreate prior states including prior file versions. *Id.* at 22–23 (citing Ex. 1005, 24:21–24, 113:15–21, Figs. 47A–I; Ex. 1004 ¶¶ 62–63).

Patent Owner contends that Schneider does not disclose this limitation. Prelim. Resp. 27–30. Specifically, Patent Owner argues “in all of its file-recovery embodiments, Schneider retrieves individual files from **local** storage systems” and has “no need to access an external disk.” *Id.* at 29 (citing Ex. 2001 ¶ 76). That is, Patent Owner argues that Schneider stores and retrieves recoverable file versions locally, not remotely. Patent Owner acknowledges that Schneider describes using external disks for data recovery, but asserts that Schneider’s external disks are only used to store and recover “disk states” or “disk images”—rather than “restorable representations” of different versions of a file. *Id.* at 28–29 (citing Ex. 1005, 109:7–11, 109:28).

At this stage in the proceeding, Petitioner has sufficiently shown Schneider discloses storing recoverable file versions in “a remote storage location,” namely, an external disk. Schneider explains its “approach to

achieving an external backup is to have an external disk drive that, like the main disk, employs a method of saving original disk states.” Ex. 1005, 109:6–8. Schneider explains its “external disk generally mirrors the main internal disk.” *Id.* at 109:8–11. Figure 47I, reproduced below, shows such mirroring.

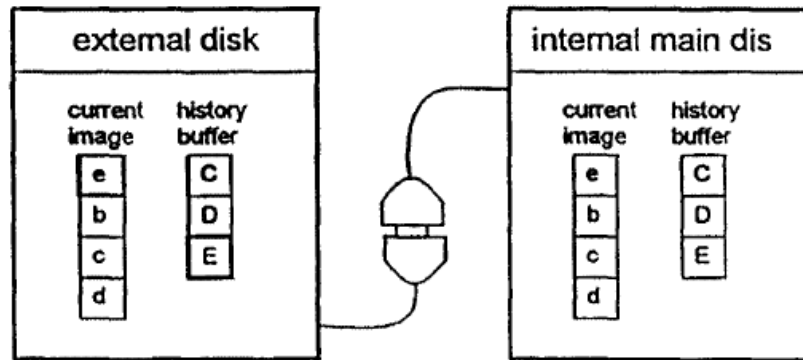


Figure 47I

Figure 47I shows a main internal disk on the right which stores current images b, c, d, and e and further stores history buffer C, D, and E; the main internal disk is connected to an external disk which is synchronized to the internal disk, storing copies of the same current images b, c, d, and e and history buffer C, D, and E. *Id.* at 112:22–24.

Notably, the external disk which mirrors the main internal disk includes a history buffer which Petitioner points out is used to recover files. *See id.* at Fig. 47I; Pet. 21. Patent Owner contests that, arguing that “historical buffer data does not include ‘a restorable representation of each version, V, of the previous versions’ of the file” because “the data stored on the external disk consists of saved ‘disk states.’” Prelim. Resp. 28 (citing Ex. 1005, 109:7–8). However, contrary to Patent Owner’s argument, Schneider’s disclosure aligns with Petitioner’s position, stating:

specialized access to the history buffer would be able to locate and recover versions only of desired files. . . . [F]rom the user's point of view, he or she could select a file and request the present invention's software to locate all available versions of that file, over time, that are still in the history buffer.

Ex. 1005, 31:19–24.

Although Schneider describes using history buffer data to restore file versions, Patent Owner particularly questions whether Schneider discloses file recovery using the history buffer and data stored on an *external disk*, as opposed to using that same information stored on an *internal disk*. Prelim Resp. 29. Patent Owner's question is at least reasonable because Petitioner has not identified any express disclosure in Schneider's discussion of its file recovery embodiments as to whether or not information for file recovery is accessed from an external disk. *See* Ex. 1005, 23:28–25:7. Similarly, Petitioner has not identified any express disclosure in Schneider's discussion of its external disk feature as to whether or not its external disk is used for its file recovery embodiments. *See id.* at 108:15–114:7. Schneider does, however, state its “invention can be implemented to work either with managing data at the disk sector level or file level (or portions of a file)” (*id.* at 10:25–26) and it “extend[s] the backup services to utilize a second hard disk, and so provide[s] a degree of hardware redundancy” (*id.* at 34:4–5). Those statements, in conjunction with Schneider's description that its external disk is a mirror of its main internal disk, at least suggest that Schneider discloses that its file recovery embodiments would recover files using data stored on an external disk. As such, Petitioner has shown a reasonable likelihood that this limitation is disclosed by Schneider.

(2) *Obviousness over Schneider*

Petitioner also contends that Schneider teaches or suggests limitation 1.2.ii, asserting that a person of ordinary skill in the art would have understood that the use of an external disk is “applicable to Schneider’s file level implementation.” Pet. 22 n.8 (citing Ex. 1005, 10:25–27; Ex. 1004 ¶ 62 n.4). Petitioner states that “Schneider teaches use of an external disk to ensure ‘a guaranteed usable backup image is available’ even if the local drive crashes or otherwise becomes unavailable.” *Id.* at 22 (citing Ex. 1005, 109:19–29). In that vein, Petitioner’s proffered declarant states that a person of ordinary skill in the art would implement “an external disk in the file level implementation in order to provide hardware redundancy so as to be able to recover historic file versions even in the case of a lost data on the internal drive, e.g., through a system crash.” Ex. 1004 ¶ 62 n.4 (citing Ex. 1005, 132:20–22).

Patent Owner contends that it would not have been obvious to use Schneider’s external disk in its individual file recovery features. Prelim. Resp. 30–33. Patent Owner argues Schneider’s external disk is “a solution to a specific problem – loss of the user’s hard drive” and Schneider provides “no motivation to extend the use of that external disk” to individual file recovery.” *Id.* at 30. Patent Owner further argues “Schneider already provides a better solution[] (i.e., recovery from local storage) for file recovery.” *Id.* Patent Owner also argues “specific teachings of Schneider teach away and discourage a [person of ordinary skill in the art] from the use of Schneider’s external disk for individual file recovery operations,” specifically, “the external disk may contain a disk image that is out-of-date or stale,” “accessing the external disk drive is slower than the internal disk drive,” and “the external drive is optional and, at times, may be disconnected

or unavailable.” *Id.* at 30–33 (citing Ex. 1005, 110:3–10, 112:1–8, Fig. 47A–C; Ex. 2001 ¶¶ 83–87).

At this stage in the proceeding, Petitioner has sufficiently shown this limitation would have been obvious over Schneider. Although Patent Owner argues Schneider “provides no motivation to extend the use of [its] external disk to the specific file recovery case” (Prelim. Resp. 30), obviousness does not require that a reference itself provide modification for the modification. *See KSR*, 550 U.S. at 415. In any event, Petitioner and its proffered declarant have pointed out a reason described in Schneider which suggests using external disk storage for file level recovery: hardware redundancy which allows “recover[ing] historic file versions even in the case of a lost data on the internal drive, e.g., through a system crash.” Ex. 1004 ¶ 62 n.4 (citing Ex. 1005, 132:20–22); *see* Pet. 22 n.8.

Further, we do not agree with Patent Owner’s argument that local storage is necessarily “a better solution[]” than remote storage in the case of local storage failure. Prelim Resp. 30. If local storage fails, it follows that remotely stored information can be accessed more easily than locally stored information and, so, would be beneficial to provide. And, even if it were the case that that local storage is a “better solution[]” than remote storage in some scenarios, “[i]t’s not necessary to show that a combination is ‘the best option, only that it be a suitable option.’” *Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 800 (Fed. Cir. 2021) (citing *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1197–98 (Fed. Cir. 2014)) (emphasis omitted). Remote storage is a suitable option for information recovery because Schneider itself describes remote storage used for information recovery.

We also disagree with Patent Owner’s argument that Schneider teaches away from using Schneider’s external disk for file level recovery.

Prelim. Resp. 30–33. A “teaching away” requires a reference to actually criticize, discredit, or otherwise discourage the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Patent Owner has not identified where Schneider counsels against using external storage for file level recovery; at best, Patent Owner identifies external storage shortcomings to be considered and weighed against the benefits of internal storage. *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) (“The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.”). Although Patent Owner points out that external storage, as compared to internal storage, may contain a “stale” disk image, has slower access to data, and may at times be disconnected (Prelim Resp. 31–32; Ex. 2001 ¶¶ 83–87), we weigh those considerations against the benefits of external storage Petitioner identifies, e.g., hardware redundancy, a longer history of information to restore from, conserving local storage space and power, and allowing multiple computers access to shared backup data (Pet. 22–26; *see* Ex. 1004 ¶ 62 n.4). On this record, the external storage shortcomings do not nullify the benefits motivating external storage. *Medichem S.A. v. Rolabo S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine”) (citing *Winner*, 202 F.3d at 1349 n.8). As such, Petitioner has shown a reasonable likelihood that Schneider teaches or suggests this limitation.

d) *Limitation 1.2.iii*

Petitioner contends Schneider discloses or renders obvious “the restorable representation having at least information required for recovering the version V by a computational machine with the current version being accessible, the remote storage location being accessible through a network.” Pet. 26–27 (citing Ex. 1005, 24:12–14, 35:26–36:3, 130:10–13; Ex. 1004 ¶¶ 67–68). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Schneider discloses this limitation.

e) *Limitation 1.3*

Petitioner contends Schneider discloses

[1.3] (B) responsive to a selection to preview a selected previous version of the file based on the presented information for the collection of (A), presenting a presentable representation of the selected previous version, the selected previous version being one of the previous versions of the file in the presented information for the collection, the presentable representation having at least information required for presenting at least a portion of the selected previous version by the computation machine with the current version being accessible[.]

Pet. 27–28 (citing Ex. 1005, 11:10–13, 22:28–23:2, 60:3–5, 60:21–29, 130:10–13, 142:17–18, 160:27–28; Ex. 1004 ¶¶ 69–70). Petitioner asserts that Schneider provides a preview of a file version to be restored, “e.g., by copying the previous file to a temporary directory and allowing the user to view that temporary copy.” *Id.* at 28 (citing Ex. 1005, 60:3–5, 60:21–29; Ex. 1004 ¶ 69). Petitioner also asserts, in an alternative to copying the previous file to a temporary directory, a preview of a file version to be restored is provided by “simulat[ing]” an earlier version of a disk drive to preview version of a file to be restored. *Id.* (citing Ex. 1005, 11:10–13, 22:28–23:2, 130:10–13, 142:17–18, 160:27–28). Petitioner states that

“previewed file” discloses the claimed “presentable representation.” *Id.* at 29.

Patent Owner does not dispute that Schneider copies a past version of a file to a temporary directory such that the copied version can be viewed. *See* Prelim. Resp. 33–35. Rather, Patent Owner contends that feature fails to disclose “presenting a presentable representation of the selected previous version.” *Id.* at 33. In particular, Patent Owner argues that “open[ing] recovered files from temporary folders . . . is not equivalent to a previewing function, as commonly understood.” *Id.* at 34. Patent Owner emphasizes that Schneider’s copied file version is a “**formally recovered**” file and, as such, the copied file is not a “presentable representation” as recited by this limitation. *Id.*

At this stage in the proceeding, Petitioner has sufficiently shown this limitation is disclosed, taught, or suggested by Schneider. Patent Owner’s argument is not commensurate with the scope of the claim. Schneider states it allows users to view a past file version’s “contents without actually formally retrieving the file, as the viewed file is automatically discarded.” Ex. 1005, 60:25–28. Not only is that disclosure expressly contrary to Patent Owner’s assertion that Schneider’s copied file version is a “formally recovered” file (Prelim. Resp. 34 (emphasis omitted)), but that disclosure plainly describes previewing the file version to be ultimately recovered. Patent Owner has not shown where the ’850 patent or presented evidence supports its assertion that the “commonly understood” meaning of “previewing” precludes opening a file that has “already been recovered, whether to a temporary folder or elsewhere.” *See id.* Furthermore, the ’850 patent seems to suggest that the preview mechanism for its file restoration feature creates a temporary directory, similar to Schneider. The ’221

provisional describes a “temporary directory used by the restore operation,” e.g., “‘TempDirForRestore’=‘C:\\Program Files\\AccuSafe\\Temp\\Restore.’” Ex. 1003, 78. Accordingly, the viewing of temporary file versions in Schneider adequately discloses this limitation.

Additionally, even if we agreed with Patent Owner that “presenting a presentable representation of the selected previous version” excludes viewing a temporary file in a temporary folder, Petitioner also points out that Schneider’s simulated disk feature provides a preview which apparently *does not* copy file versions into a temporary directory for review (Pet. 28): “referencing either the file on a simulated disk *or* copying the file from a simulated disk to a temporary directory” (Ex. 1005, 60:21–24 (emphasis added)). Patent Owner does not address Schneider’s alternative embodiment where a past file version is viewed by referencing the file on a simulated disk. *See* Prelim. Resp. 33–35. We agree with Petitioner that viewing of past file versions by referencing the file on Schneider’s simulated disk also adequately discloses this limitation. As such, Petitioner has shown a reasonable likelihood that Schneider discloses, teaches, or suggests this limitation.

f) *Limitation 1.4*

Petitioner contends Schneider discloses

[1.4] (C) responsive to a selection to restore the selected previous version, retrieving the restorable representation of the selected previous version from the remote storage location and storing the selected previous version by the computational machine as the current version on the local storage location, the selected previous version available from the restorable representation of the selected previous version.

Pet. 29–30. Petitioner asserts Schneider allows a user to select a previous file version for restoration from a displayed list of available stored previous

versions. *Id.* (citing Ex. 1005, 130:10–13). Petitioner further asserts Schneider then restores the selected previous file version by replacing the current file with the recovered file. *Id.* (citing Ex. 1005, 130:10–13, 15:20–16:21, Fig. 2; Ex. 1004 ¶ 71).

Patent Owner, referring to its earlier arguments regarding limitation 1.2.ii, contends Schneider does not teach or suggest “retrieving the restorable representation of the selected previous version from the remote storage location” because Schneider recovers files from local storage rather than from its external disk. Prelim. Resp. 35–36. However, as discussed above in § II.D.2.c., Petitioner has adequately shown that Schneider discloses or renders obvious storing data for individual file recovery on an external disk.

Patent Owner further contends Schneider does not disclose “storing the selected previous version . . . as the current version on the local storage location.” *Id.* at 36–37. Specifically, Patent Owner argues Schneider does not disclose storing the recovered file “as the current version” because Schneider’s file recovery technique “merely involves copying the (previously recovered) file from a temporary location to a more permanent location in which an existing file may be overwritten.” *Id.* Schneider, however, expressly states that its “recovered file either *replaces the current version* or is copied to a new file.” Ex. 1005, 130:12–13 (emphasis added). The recovered version becomes the current version it replaces. As such, at this stage in the proceeding, Petitioner has shown a reasonable likelihood that Schneider discloses, teaches, or suggests this limitation.

g) *Sufficiency of Claim Mapping*

Patent Owner contends that Petitioner fails to specify where each element of the claim is found in the prior art as required by 37 C.F.R.

§ 42.104(b)(4) because Petitioner's claim mapping

(a) fails to identify how the references are applied and which reference is the primary reference, secondary reference and tertiary reference, (b) fails to address the majority of claim elements and (c) fails to explain where the claim limitations that Petitioner purports to address are found in each of the references.

Prelim. Resp. 27. We disagree that Petitioner has failed to make its showing.

Patent Owner's argument that Petitioner must identify "which reference is the primary reference, secondary reference and tertiary reference" (*id.*) is incorrect on the law and, furthermore, illogical for a single reference obviousness analysis. The Federal Circuit has "made clear that 'where the relevant factual inquiries underlying an obviousness determination are otherwise clear,' characterizing references 'as 'primary' and 'secondary' is merely a matter of presentation with no legal significance." *Schwendimann v. Neenah, Inc.*, 82 F.4th 1371, 1384 (Fed. Cir. 2023) (collecting cases). Moreover, there are no secondary and tertiary references; this obviousness ground relies on a single reference, Schneider.

Second, contrary to Patent Owner's assertion that the Petition fails to address the majority of the claim elements and fails to explain where the limitations are found in the references (Prelim. Resp. 27), Petitioner has specifically listed each limitation, under its own heading, and explained with citations to the record how the relied upon reference teaches or suggests the limitation at issue (*see generally* Pet.). We conclude Petitioner sufficiently maps the claims to the disclosure of Schneider, and articulates reasons the

claims would have been obvious over Schneider, to justify institution of review.

h) *Conclusion as to claim 1*

For the reasons discussed above and based on Petitioner’s contentions and evidence, summarized above, we are persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that claim 1 is unpatentable as obvious over Schneider.

3. *Remaining Claims 2–21*

Petitioner also contends that the subject matter of claims 2–21 would have been obvious over Schneider. Pet. 19–45. Petitioner substantiates its contentions with analysis addressing each claim limitation and identifying supporting evidence. *See id.*

We are persuaded that Petitioner has demonstrated a reasonable likelihood that it will prevail in establishing that the subject matter of claims 2–21 would have been obvious over Schneider. Other than the arguments addressed above in connection with claim 1 (*supra* § II.D.2), Patent Owner does not dispute Petitioner’s arguments, analysis, or evidence for the remaining claims (*see* Prelim. Resp.).

4. *Institution of Inter Partes Review*

Because we are persuaded that Petitioner has shown a reasonable likelihood of prevailing in showing that the subject matter of claim 1 would have been obvious over Schneider, we institute *inter partes* review of all claims and all challenges raised in the Petition. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2020) (35 U.S.C. § 314 “simply requires [the Director] to decide whether the petitioner is likely to succeed on ‘at least 1’ claim. Once that single claim threshold is satisfied, it doesn’t matter whether the petitioner is likely to prevail on any *additional* claims; the

Director need not even consider any other claim before instituting review.”); 37 C.F.R. § 42.108(a).

However, we address Petitioner’s remaining grounds and Patent Owner’s corresponding arguments below, to provide guidance to the parties for the upcoming trial. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”) 6, 64 (Nov. 2019) (*available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=Tri alPracticeGuideConsolidated>).

E. *Ground 2: Obviousness Based on Schneider and Crawford*

Petitioner contends that the subject matter of claims 1–21 would have been obvious over Schneider and Crawford. Pet. 45–49. Patent Owner opposes. Prelim. Resp. 38–42.

We have considered the parties’ arguments and the evidence presented at this stage, and we address them in the context of representative claim 1. For the reasons explained below, we determine that Petitioner has demonstrated a reasonable likelihood that it will prevail in showing that the subject matter of claims 1–21 would have been obvious over the combination of Schneider and Crawford, notwithstanding Patent Owner’s arguments to the contrary.

1. *Overview of Crawford (Ex. 1009)*

Crawford is titled in part, and describes, an “Internet Online Backup System [that] Provides Remote Storage for Customers.” Ex. 1009, code (54). Crawford discloses a system in which a “customer computer 50 connects to an on-line service system 100” offering “Offsite Archival Services.” *Id.* at 14:17–20, 14:45. Offsite Archival Services provide “virtual disk drives” where files are automatically copied for offsite archiving. *Id.* at 14:45–48; *see id.* at Fig. 2. Further, the “file[s] could be

stored on virtual disk[s] with directory structures maintained.” *Id.* at 14:55–56. Crawford also explains that, using the virtual disks, files can be copied to their original disk for restoration. *Id.* at 14:50–51.

2. *Independent Claim 1*

As discussed above in § II.D.2, Petitioner contends all limitations recited in claim 1 would have been obvious over Schneider alone. In this ground based on Schneider and Crawford, Petitioner contends that, to the extent that Schneider does not disclose or render obvious a “remote storage location accessible through a network . . . , such storage was obvious over Crawford.” Pet. 45–49 (citing Ex. 1009, codes (54), (57), 8:13–22, 12:40–45, 13:28–31, 14:18–25, 14:45–53, 16:3–7, 57:44–48, 61:20–24, Fig. 1; Ex. 1004 ¶ 98–102). In particular, Petitioner asserts that Crawford “allows a local customer computer to connect to a remote server over the internet ‘and obtain additional processing and storage resources for the customer’s computer.’” *Id.* at 46 (citing Ex. 1009, code (57); Ex. 1004 ¶ 99). Further, Petitioner asserts that “Crawford provides offsite archival services whereby files on the local customer computer ‘are automatically copied to on-line service virtual disks for offsite archiving’” and are “used to restore files on the local customer computer.” *Id.* at 47 (citing Ex. 1009, 14:45–53).

Patent Owner does not contest that Crawford discloses remotely storing back-up files for restoration over a network. *See* Prelim. Resp. 38–42. Instead, Patent Owner contends a person of ordinary skill in the art would not have combined Schneider and Crawford. *Id.*

For the reasons detailed below, Petitioner has shown a reasonable likelihood that a person of ordinary skill in the art would have been motivated to combine Schneider and Crawford to render claim 1 obvious.

a) *Motivation to Combine*

Petitioner contends that it would have been obvious to modify Schneider’s file back-up and restore system to store back-up file data using a “remote storage location accessible through a network,” as recited in limitation 1.2, in view of Crawford’s remote storage system. Pet. 45, 48. Petitioner asserts a person of ordinary skill in the art would have been motivated to do so for a number of beneficial reasons, in part by referencing the reasons discussed in its first ground. *Id.* at 48 (citing *id.* at 21–26). In particular, Petitioner points out the combination “reduce[s] the chances of the backup information being destroyed” (*id.* at 25–26 (citing Ex. 1013, 556)), “conserve[s] local storage space and power and allow[s] computers in different remote locations to access a single external storage disk” (*id.* at 26 (citing Ex. 1004 ¶ 66)), and provides a user “additional disk space, or access to a more powerful processor” (*id.* at 48 (citing Ex. 1009, code (57), 13:28–31)).

Patent Owner contends a person of ordinary skill in the art would not have combined Schneider and Crawford because Schneider teaches away from the proposed combination and Petitioner’s proffered motivations to combine the references are “deficient.” Prelim. Resp. 38. Similar to its earlier arguments discussed above (*see* § II.D.2.c), Patent Owner argues Schneider teaches away from the combination because “Schneider discourages attempts to use remotely stored back-up data, whether stored on an external disk or remote network drive for the purposes of file-level recoveries” as “the use of an external disk is not optimal for file recovery because the contents of the external disk can differ (lag behind) the contents of the use[r]’s local hard drive.” *Id.* at 39. Patent Owner further asserts that, “to mitigate these issues,” Schneider “describes only a local approach for

file recovery which is most efficient given the ease and speed of accessing locally stored records. For file-recovery, Schneider has no reason to rely on accessing remote drives.” *Id.* at 40–41.

For the reasons discussed above in § II.D.2.c, we disagree with Patent Owner that Schneider teaches away from the use of external storage. Although Patent Owner asserts that “Schneider discourages attempts to use remotely stored back-up data” (Prelim. Resp. 39), Patent Owner has not shown where Schneider makes such a statement and we do not read Schneider’s discussion of external storage lag considerations as discouragement. As discussed above, the external storage lag considerations do not outweigh the external storage benefits Petitioner identifies—redundant data storage, conservation of local resources, and multi-computer access. Pet. 25–26, 48.

As such, Petitioner has shown a reasonable likelihood that one of ordinary skill in the art would have been motivated to combine Schneider and Crawford.

b) *Conclusion*

For the reasons discussed above and based on Petitioner’s contentions and evidence, summarized above, we are persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that claim 1 is unpatentable as obvious over the combination of Schneider and Crawford.

3. *Remaining Claims 2–21*

Petitioner also contends that the subject matter of claims 2–21 would have been obvious over Schneider and Crawford. Pet. 45. Aside from independent claims 1, 10, 18, and 19, Petitioner appears to rely on its earlier

contentions, analysis, and evidence based on Schneider to account for the remaining claims. *See id.* at 45–49.

We are persuaded that Petitioner has demonstrated a reasonable likelihood that it will prevail in establishing that the subject matter of claims 2–21 would have been obvious over Schneider. Other than the arguments addressed above in connection with claim 1 (*supra* § II.E.2), Patent Owner does not dispute Petitioner’s arguments, analysis, or evidence for the remaining claims (*see* Prelim. Resp.).

F. *Ground 3: Obviousness Based on Sweat*

Petitioner contends that the subject matter of claims 1–8, 10–16, and 18–21 would have been obvious over Sweat. Pet. 50–71. Patent Owner opposes. Prelim. Resp. 42–47.

We have considered the parties’ arguments and the evidence presented at this stage, and we address them in the context of representative claim 1. For the reasons explained below, we determine that Petitioner has demonstrated a reasonable likelihood that it will prevail in showing that the subject matter of claims 1–8, 10–16, and 18–21 would have been obvious over Sweat, notwithstanding Patent Owner’s arguments to the contrary.

1. *Overview of Sweat (Ex. 1006)*

Sweat describes a project hosting system for “storing, managing, and sharing files” amongst members of a project team. Ex. 1006, 1:42–53, 3:58–61. Sweat’s file management system stores multiple versions of a file on a remote server, e.g., file versions 11, 10, 9, 8, and 7. *Id.* at 5:55–58, 9:19–23. In Sweat’s system, users can “open and view any file version [and] download a selected file to a local computer 104” from the remote server. *Id.* at 10:54–61. In particular, “[t]o open a version, the user selects the version from a list displayed . . . and selects a ‘View in Window’ button.

Alternatively, the user can click the view tab 504.” *Id.* at 10:55–58. “To download a version of the file from the server 106 to the local computer 104, the user selects the desired version and clicks a ‘Download’ button.” *Id.* at 10:58–61. As Sweat details, downloading a file “[c]opies the file or folder to the user’s local computer. The user can include subfolders and overwrite files that exist on the user’s local computer, as desired.” *Id.* at 5:51–55, 10:61–63.

## 2. *Analogous Art*

Petitioner contends “Sweat is analogous art to the ’850 patent because it is from the same field of endeavor,” namely “computer file storage, management, and recovery.” Pet. 50. Petitioner points out Sweat allows “users to view and download prior versions of files” and “allows a user to recover prior file versions from a server to the user’s local computer.” *Id.* (citing Ex. 1006, code (57), 10:51–55).

Patent Owner argues Sweat is not analogous art because “Sweat is directed to architectural drawing and project file sharing and collaboration, whereas the ’850 Patent is directed to file preservation, file capture, file management, and file restoration.” Prelim. Resp. 42–45. Patent Owner further argues that Petitioner’s “proposed modification of Sweat’s system to provide the automated file archiving and recovery solution of the ’850 Patent would render Sweat’s collaboration-based system unsatisfactory for its intended purpose and calls for significantly changing the principle of operation of Sweat.” *Id.* at 45.

We agree with Petitioner that Sweat is analogous art to the ’850 patent. Patent Owner’s arguments focus on Sweat’s collaborative file editing features and the ’850 patent’s specific manner of backing up files. *See* Prelim. Resp. 42. However, the “field of endeavor of a patent is not

limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field.” *Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1001 (Fed. Cir. 2016). The ’850 patent states, as its field of invention, that its “invention relates to file preservation, file capture, file management and file integrity techniques for computing devices.” Ex. 1001, 1:14–16. Sweat states, as its field of invention, that its “invention relates generally to organizing and providing access to information on a computer, and . . . for organizing and providing access to architectural drawings, files, and information over a network.” Ex. 1006, 1:17–22. Both Sweat and the ’850 patent are in the field of computer file management and storage; as such, we determine that Sweat and the ’850 patent are analogous art.

Furthermore, Patent Owner’s argument that “the proposed modification” renders Sweat “unsatisfactory for its intended purpose and calls for significantly changing the principle of operation” (Prelim. Resp. 45) does not address the test for analogous art. *See Unwired Planet*, 841 F.3d at 1000 (“Prior art is analogous and can be applied in an obviousness combination if it either (1) ‘is from the same field of endeavor, regardless of the problem addressed’ or (2) ‘is reasonably pertinent to the particular problem with which the inventor is involved.’”). That argument is, rather, more appropriately characterized as an argument that the modification asserted would not have been made. *See Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 F. App’x 755, 759 (Fed. Cir. 2015) (explaining that a change in a reference’s principle of operation concerns challenges to the motivation to combine references) (citing cases); *see also In re Urbanski*, 809 F.3d 1237, 1243 (Fed. Cir. 2016) (explaining that a combination which produces an inoperable device teaches away from a combination and, so,

does not show obviousness for that reason) (citing cases). In any case, that argument is based on a modification that Petitioner does not assert. Patent Owner discusses collaborative edits to the same file (Prelim. Resp. 43), but, as discussed below in § II.F.3.f, Petitioner's asserted application of Sweat restores a corrupted or otherwise compromised local file by downloading a previous version of the file (Pet. 60–62). As such, on the record before us, Petitioner has shown a reasonable likelihood that Sweat is analogous art to the '850 patent.

### 3. *Independent Claim 1*

Petitioner provides arguments and evidence in support of its contention that claim 1 is unpatentable as being obvious over Sweat. *See* Pet. 50–71; Ex. 1004 ¶¶ 114–126. Patent Owner opposes. *See* Prelim. Resp. 45–47; Ex. 2001 ¶¶ 161–198. We conclude Petitioner has demonstrated a reasonable likelihood of prevailing on its contentions, for the following reasons.

#### a) *Preamble 1.1*

Petitioner contends that Sweat teaches the preamble of claim 1. Pet. 55–56 (citing Ex. 1006, 10:51–61, 11:5–8; Ex. 1007, 7, 9, 31, 63; Ex. 1004 ¶¶ 116–117). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Sweat discloses the preamble.

#### b) *Limitation 1.2.i*

Petitioner contends that Sweat teaches limitation 1.2.i. Pet. 56–57 (citing Ex. 1006, 5:56–58, 9:19–24, 10:52–11:2, 17:16–17, Fig. 4; Ex. 1007, 21, 25, 30, 63, 104; Ex. 1004 ¶¶ 118–119). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Sweat discloses this limitation.

c) *Limitation 1.2.ii*

Petitioner contends that Sweat teaches limitation 1.2.ii. Pet. 57–59 (citing Ex. 1006, 3:2–6, 3:12–14, 5:52–55, 10:58–63, Fig. 1; Ex. 1007, 3, 9, 31, 33, 53, 79; Ex. 1004 ¶¶ 120–121). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Sweat discloses this limitation.

d) *Limitation 1.2.iii*

Petitioner contends that Sweat teaches limitation 1.2.iii. Pet. 59 (citing Ex. 1006, 3:2–8; Ex. 1007, 3, 53; Ex. 1004 ¶ 122). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Sweat discloses this limitation.

e) *Limitation 1.3*

Petitioner contends that Sweat teaches or suggests limitation 1.3. Pet. 59–61 (citing Ex. 1005, 4:26–29; Ex. 1006, 10:55–59, 24:6–19; Ex. 1007, 9, 31; Ex. 1004 ¶¶ 123–124). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Sweat discloses this limitation.

f) *Limitation 1.4*

Petitioner contends that Sweat teaches or suggests limitation 1.4, [1.4] (C) responsive to a selection to restore the selected previous version, retrieving the restorable representation of the selected previous version from the remote storage location and storing the selected previous version as the current version on the local storage location, the selected previous version available from the restorable representation of the selected previous version.

Pet. 61–62. In particular, Petitioner argues that “storing the selected previous version by the computational machine as the current version on the local storage location” is obvious over the use of Sweat’s download function

to replace a corrupted or lost local file. *Id.* First, regarding the technical operation of Sweat’s download function, Petitioner explains that a user “download[s] a version of [a] file from the server 106 to the local computer 104” and selects a local “target location to save the selected file.” *Id.* at 61 (citing Ex. 1006, 10:58–63; Ex. 1007, 9, 31). That downloading “[c]opies the file or folder to the user’s local computer” and can “overwrite files that exist on the user’s local computer, as desired.” Ex. 1006, 5:49–55.

Next, Petitioner asserts it would have been obvious to use Sweat’s download function “to restore a previous version of a file by copying the file to the user’s local computer and overwriting the current version of the file on the user’s local computer, so as to save the restored file as the new current version of that file.” Pet. 62 (citing Ex. 1004 ¶¶ 125–126). Petitioner explains that the download function would be used in such a manner where a user “desire[s] to restore a previous version of the file to replace the current version for example, in the case where the newest version of the file has become corrupted or where desired data has been deleted from the newest version.” *Id.* at 60–61 (citing Ex. 1004 ¶ 124; Ex. 1005, 4:26–29). That is, Petitioner argues that it would have been obvious to use Sweat’s download function to restore a corrupted local file version by replacing it with an uncorrupted remote version.

Patent Owner contends Sweat does not disclose “storing the selected previous version by the computational machine as the current version on the local storage location.” Prelim. Resp. 45–47. Specifically, Patent Owner argues Sweat does not teach or suggest “the downloading of an *old* version of a file via the versions tab of Sweat causes that file, once downloaded to be the *current* version of the file on the local storage location.” *Id.* at 46. Patent Owner also argues that Sweat “designate[s] a particular file as the

‘current version’ of a file” using its “Update Function,” rather than its download function. *Id.* at 46–47. Patent Owner further argues “downloading a file in Sweat [to cause] that file to be designated as the current version of the file” creates “significant confusion . . . in the context of a collaboration tool.” *Id.* at 46.

On the record before us, we agree with Petitioner that “storing the selected previous version by the computational machine as the current version on the local storage location,” as recited by the claim, would have been obvious over the use of Sweat’s download feature to replace and restore a corrupted local file. Pet. 60–62. Rather than addressing the Petitioner’s obviousness case, Patent Owner argues against different scenarios where older file versions are downloaded but do not replace corrupted files (Prelim. Resp. 46) or uploading competing current file versions for collaborative use (*id.* at 46–47). As such, Petitioner has shown a reasonable likelihood that Sweat teaches or suggests this limitation.

g) *Conclusion as to claim 1*

For the reasons discussed above and based on Petitioner’s contentions and evidence, summarized above, we are persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that claim 1 is unpatentable as obvious over Sweat.

4. *Remaining Claims 2–8, 10–16, and 18–21*

Petitioner also contends that the subject matter of claims 2–8, 10–16, and 18–21 would have been obvious over Sweat. Pet. 62–71. Petitioner substantiates its contentions with analysis addressing each claim limitation and identifying supporting evidence. *See id.*

We are persuaded that Petitioner has demonstrated a reasonable likelihood that it will prevail in establishing that the subject matter of

claims 2–8, 10–16, and 18–21 would have been obvious over Sweat. Other than the arguments addressed above in connection with claim 1 (*supra* § II.F.3) and the analogous art arguments addressed above (*supra* § II.F.2), Patent Owner does not dispute Petitioner’s arguments, analysis, or evidence for the remaining claims (*see* Prelim. Resp.).

G. *Ground 4: Obviousness Based on Sweat and Schneider*

Petitioner also contends that the subject matter of dependent claims 9 and 17 would have been obvious over Sweat and Schneider. Pet. 72–73. As discussed above, Petitioner contends Sweat renders claims 1 and 10, from which claims 9 and 17 respectively depend, obvious. Regarding claims 9 and 17, Petitioner references its earlier analysis of Schneider, asserting Schneider discloses “wherein the method has a substantially imperceptible impact on system performance from a user’s point of view by delaying one or more operations to prevent a perceptible impact on system performance from a user’s point of view” as recited in claim 9 and similarly recited in claim 17. *Id.* (citing *id.* at 38–39). Petitioner also substantiates its contentions with analysis addressing each claim limitation, sets forth adequate motivation and explanation for combining Sweat and Schneider, and identifies supporting evidence. *See id.*

We are persuaded that Petitioner has demonstrated a reasonable likelihood that it will prevail in establishing that the subject matter of claims 9 and 17 would have been obvious over the combined teachings of Sweat and Schneider. Patent Owner asserts that Petitioner fails to address the limitations recited in these claims. Prelim. Resp. 47. However, Petitioner stated that it references and relies on its previous analysis explaining that Schneider teaches the limitations recited in these claims (Pet. 72 (citing *id.* at 38–39)) which, as previously discussed in § II.D.2.g,

sufficiently maps the claims to the relevant disclosures and articulates reasons the claims are obvious to justify institution of review. Petitioner has also explained its reasoning in combining Sweat and Schneider.

As such, we are persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that claims 9 and 17 are unpatentable as obvious over Sweat and Schneider.

### III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314

Petitioner contends we should not exercise our discretion under 35 U.S.C. § 314(a) to deny institution in deference to the two co-pending district court infringement litigations. *See* Pet. 4. In support, each Petitioner entity (Dropbox, Inc. and Microsoft Corporation) “stipulates that, if the Board institutes IPR, it will not pursue in its parallel district court proceeding the grounds raised, or which reasonably could have been raised, in” the Petition. *Id.* Petitioner asserts this stipulation means “the PTAB will not discretionarily deny institution in view of parallel district court litigation.” *Id.* (quoting USPTO Memorandum, *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022)<sup>7</sup> at 3, 7).

Patent Owner does not address discretionary denial in its Preliminary Response. We do not exercise the authority to discretionarily deny institution.

---

<sup>7</sup> Available at [https://www.uspto.gov/sites/default/files/documents/interim\\_proc\\_discretionary\\_denials\\_aia\\_parallel\\_district\\_court\\_litigation\\_memo\\_20220621\\_.pdf](https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf).

#### IV. CONCLUSION

As explained above, we determine that Petitioner has established a reasonable likelihood of prevailing in its challenge to at least one claim of the '850 patent. Thus, we institute an *inter partes* review of all challenged claims on all asserted grounds.

The factual findings and conclusions of law in this Decision are preliminary and based on the current record. They are made for the sole purpose of determining whether Petitioner meets the threshold for initiating review. Any final decision as to the patentability of the challenged claims will be based on the full record developed during trial, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in such a response may be deemed forfeited.

#### V. ORDER

It is:

ORDERED that an *inter partes* review is instituted on all challenged claims, i.e., claims 1–21 of the '850 patent, and on all grounds of unpatentability specified in the Petition, as identified in Section I.D of this Decision; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '850 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.

IPR2024-00080  
Patent 10,585,850 B2

FOR PETITIONER:

Andrew M. Mason  
Cameron D. Clawson  
Sarah E. Jelsema  
Frank Morton-Park  
KLARQUIST SPARKMAN LLP  
andrew.mason@klarquist.com  
cameron.clawson@klarquist.com  
sarah.jelsema@klarquist.com  
frank.morton-park@klarquist.com

FOR PATENT OWNER:

Rowan P. Smith  
MESSNER REEVES LLP  
rsmith@messner.com

Christopher L. Limbacher  
HEIM, PAYNE & CHORUSH, LLP  
climbacher@hpcllp.com