UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC. and MICROSOFT CORPORATION,
Petitioners

v.

DATANET, LLC.
Patent Owner

Case No. IPR2024-00080
U.S. Pat. No. 10,585,850

PATENT OWNER'S NOTICE OF APPEAL

via P-TACTS
Patent Trial and Appeal Board

via email
Director of the United States Patent and Trademark Office
c/o Office of the General Counsel, 10B20
United States Patent and Trademark Office
efileSO@uspto.gov

via CM/ECF
United States Court of Appeals for the Federal Circuit

Pursuant to 35 U.S.C. §§ 141-142, and 319, 37 C.F.R. §§ 90.2-90.3, Federal Rule of Appellate Procedure 15, and Federal Circuit Rule 15, Patent Owner DATANET, LLC ("Patent Owner") hereby provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision of the Patent Trial and Appeal Board (the "Board"), entered on April 25, 2025, Paper 27 (a copy of which is attached as Exhibit A), and from all underlying findings, determinations, rulings, opinions, orders, issues, and decisions regarding the *inter partes* review no. IPR2024-0080, of United States Patent No. 10,585,850 ("the '850 Patent"). This Notice of Appeal of the Final Written decision is timely under 37 C.F.R. §§ 90.3(a)(1), having been filed within 63 days of the April 25, 2025, Final Written Decision, Paper 27.

For the limited purpose of providing the Director with the information requested in 37 C.F.R. § 90.2(a)(3)(ii) and Federal Rule of Appellate Procedure 15(a)(2)(C), issues on appeal may include, but are not limited to the Board's factual findings and conclusions of law, the Board's determinations of the unpatentability of claims and any finding or determination supporting or relating to such determinations of unpatentability, including but not limited to claim-construction, the scope of the alleged prior art, Board findings that conflict with the evidence of record and are not supported by substantial evidence, as well as all other issues decided adversely to Patent Owner in any orders, decisions, rulings

and/or opinions, further including but not limited to: (i) the Board's interpretation of the alleged prior art; (ii) the Board's claim constructions; (iii) the Board's determination that claims 1-8, 10-16, and 18-21 of the '850 patent were shown to be obvious under 35 US.C. § 103, and are thus unpatentable, in view of U.S. Patent No. 7,062,532 ("Sweat"); (iv) the Board's determination that claims 9 and 17 of the '850 patent were shown to be obvious under 35 US.C. § 103, and are thus unpatentable, in view of U.S. Patent No. 7,062,532 ("Sweat") and International Publication No. WO 99/12101 A2 ("Schneider"); (v) the Board's legal errors in undertaking its obviousness analyses; (vi) the Board's motivation to combine analyses; (vii) the Board's findings that conflict with the evidence of record or are otherwise unsupported by substantial evidence; (viii) the Board's failure to consider evidence of record (including testimonial and documentary) fully and properly; and (ix) any other findings or determinations supporting or relating to these issues.

Patent Owner reserves the right to challenge any finding or determination supporting or relating to the issues above and reserves the right to address any issues that may arise on appeal or that Petitioner may raise on appeal.

Simultaneously with this submission, Patent Owner is filing a true and correct copy this Notice of Appeal with the Director of the United States Patent

and Trademark Office as well as a true and correct copy of the same, along with required filing fee, with the Clerk's Office for the United States Court of Appeals for the Federal Circuit as set forth in the accompanying Certificate of Filing.

Dated: June 26, 2025

Respectfully submitted,

By: /Rowan P. Smith/

Rowan P. Smith
Reg. No. 64,198
Messner Reeves LLP
7250 N 16th St Suite 410
Phoenix, AZ 85020
Telephone: 602.457.5225
rsmith@messner.com

CERTIFICATE OF FILING

The undersigned hereby certifies that, in addition to being electrically filed, a true and correct copy of the above-captioned "Patent Owner's Notice of Appeal" is being submitted via email to the Director on June 26, 2025, at the following email address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel 10B20
United States Patent and Trademark Office
efileSO@uspto.gov

The undersigned also hereby certifies that a true and correct copy of the above-captioned "Patent Owner's Notice of Appeal" and the filling fee is being filed with the Clerk's Office of the United States Court of Appeals for the Federal Circuit via CM/ECF, along with a copy of the Final Written Decision (Paper 27) on June 26, 2025.

Respectfully submitted,

By: /Rowan Smith/
Rowan Smith
Reg. No. 64,198
Messner Reeves LLP
7250 N 16th St Suite 410
Phoenix, AZ 85020
Telephone: 602.457.5225
rsmith@messner.com

CERTIFICATION OF SERVICE

The undersigned hereby further certifies that the above-captioned "Patent Owner's Notice of Appeal" was served in its entirety on June 26, 2025, upon the following counsel of record for the Petitioners via electronic mail:

Andrew Mason
Klarquist Sparkman, LLP
121 SW Salmon St, Suite 1600
Portland, Oregon 97204
andrew.mason@klarquist.com

Sarah Jelsema
Klarquist Sparkman, LLP
121 SW Salmon St, Suite 1600
Portland, Oregon 97204
sarah.jelsema@klarquist.com

Cameron Clawson
Klarquist Sparkman, LLP
121 SW Salmon St, Suite 1600
Portland, Oregon 97204
cameron.clawson@klarquist.com

Frank Morton-Park
Klarquist Sparkman, LLP
121 SW Salmon St, Suite 1600
Portland, Oregon 97204
frank.morton-park@klarquist.com

Dated: June 26, 2025

By: /Rowan Smith/
Rowan Smith
Reg. No. 64,198
Messner Reeves LLP
7250 N 16th St Suite 410
Phoenix, AZ 85020
Telephone: 602.457.5225
rsmith@messner.com

Exhibit A

Trials@uspto.gov
571-272-7822

Paper 27
Date: April 25, 2025

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
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

On May 8, 2024, we instituted an *inter partes* review of claims 1–21 of U.S. Patent No. 10,585,850 B2 (Ex. 1001 ("the '850 Patent")). Paper 8. ("Inst. Dec."). Having considered the full record at trial, and for the reasons explained below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–21 are unpatentable.

A. *History of this Proceeding*

On October 30, 2023, Dropbox, Inc. and Microsoft Corporation (collectively, "Petitioner") filed a petition requesting *inter partes* review of claims 1–21 of the '850 Patent. Paper 3 ("Pet."). During the preliminary proceeding, Datanet, LLC ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). Based on the preliminary record, we determined that Petitioner demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of at least one challenged claim, and we instituted an *inter partes* review of all challenged claims on all asserted grounds. Inst. Dec. 37.

During trial, Patent Owner filed a Response (Paper 16, "PO Resp."), Petitioner filed a Reply (Paper 19, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 21, "PO Sur-Reply").

An oral hearing in this proceeding was held on February 13, 2025, and a transcript of the hearing is included in the record. Paper 26 ("Tr.").

B. *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.

C. *Asserted Grounds*

We instituted trial on the following asserted grounds of unpatentability:

Claim(s) Challenged	35 U.S.C.[1] §	Reference(s)/Basis
1–21	103	Schneider[2]

[1] 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.

[2] WO 99/12101 A2, filed September 4, 1998, published March 11, 1999. Ex. 1005.

Claim(s) Challenged	35 U.S.C.[1] §	Reference(s)/Basis
1–21	103	Schneider, Crawford[3]
1–8, 10–16, 18–21	103	Sweat[4]
9, 17	103	Sweat, Schneider

See Pet. 2; Inst. Dec. 3–4.

D. *Testimonial Evidence*

Petitioner relies on the proffered declarant witness testimony of David Maier, Ph.D, submitted prior to institution. *See* Ex. 1004. Petitioner also relies on an additional declaration from Dr. Maier, submitted after institution. *See* Ex. 1024. In addition, Patent Owner twice deposed Dr. Maier and filed the corresponding transcripts. *See* Ex. 2006; Ex. 2007.

Patent Owner relies on the proffered declarant witness testimony of Mr. Zaydoon Jawadi, submitted after institution.[5] *See* Ex. 2004. In addition, Petitioner deposed Mr. Jawadi and filed the corresponding transcript. *See* Ex. 1027.

E. *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

[3] US 5,771,354, filed November 4, 1993, issued June 23, 1998. Ex. 1009.

[4] US 7,062,532 B1, filed March 24, 2000, issued June 13, 2006. Ex. 1006.

[5] Patent Owner has withdrawn Mr. Jawadi's earlier declaration and C.V., which were submitted prior to institution. PO Resp. 11; *see* Ex. 2001, Ex. 2002.

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 discusses details provided only in the '221 Provisional (*see* PO Resp. 3–9), 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. 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.
>
> 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.

F. *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 illustrative. Claim 1 is reproduced below with Petitioner's added limitation identifiers in brackets and line breaks for discussion purposes. *See* Pet. 12–13.[6]

> [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

[6] Petitioner adds limitation identifiers in claims 10, 18, and 19 and we also reference those identifiers for discussion purposes. *See* Ex. 1022.

> 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*

A patent claim is unpatentable under 35 U.S.C. § 103 "if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains." The legal 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) when in evidence, objective evidence of obviousness or nonobviousness.[7] *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966). One seeking to establish obviousness based on more than one reference also must articulate sufficient reasoning with rational

[7] The record does not include allegations or evidence of objective indicia of obviousness or nonobviousness.

underpinnings to combine teachings. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

In an *inter partes* review, the petitioner has the burden of proving unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e); *see also Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (stating that petitioner's burden of persuasion "never shifts to the patentee").

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* PO Resp. 10–11 ("Patent Owner agrees to this definition proposed in the Petition.").

Having considered the record, we adopt Petitioner's proposed level of skill, as articulated above. We are satisfied that Petitioner's proposal comports with the level of skill necessary to understand and implement the teachings of the '850 Patent. *Accord* Inst. Dec. 7–8.

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)).

Petitioner does not identify any terms or phrases for construction, contending all claims terms should be given their plain and ordinary meaning. Pet. 14.

Patent Owner proposes a construction for the term "current version" of a file, as recited in limitation [1.4] of claim 1 and similarly recited in limitations [10.4] of claim 10 and [18.5] of claim 18. PO Resp. 12–14; PO Sur-reply 2–6. Related to that construction, Patent Owner proposes a similar construction of "restoring selected another revision of said file following said previewing step," as recited in limitation [19.5] of claim 19. PO Resp. 14–15; PO Sur-Reply 6–7. Petitioner disagrees with Patent Owner's construction. *See* Pet. Reply 1–6.

Below, we address the construction of the terms identified by Patent Owner. We determine that it is not necessary to construe any other claim terms or phrases for purposes of this Decision. *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)).

1. "storing the selected previous version . . . as the current version on the local storage location"

Patent Owner argues that, in claim 1, 10, and 18's recited methods of restoring a file to a previous version of the file, the term "current version" of a file should be interpreted to mean

> keeping parity between the file on both the local storage location and on the versioning system of the remote storage location, such that the version of a file now present on the user's computer also has a corresponding version on the remote storage location, each of them corresponding to the other and being the most recent version in time of such file.

PO Sur-Reply 3–6; PO Resp. 12–14.[8] Or, in a shortened version, "the current version" requires two separate current versions: a locally stored current version and "a corresponding most current version on the remote storage location." *See* PO Sur-Reply 5 (citing Ex. 2004 ¶¶ 51–55), 13.

We do not adopt Patent Owner's suggested construction. We address claim construction of this term in regard to claim 1, which is representative of similar limitations recited in claims 10 and 18.

Claim construction principles dictate that we may not ignore the explicit language of the claim. *Phillips*, 415 F.3d 1327 (*citing Generation II Orthotics Inc. v. Med. Tech. Inc.*, 263 F.3d 1356, 1365 (Fed. Cir. 2001) ("[C]laims can only be construed to preserve their validity where the

[8] Patent Owner's claim construction arguments at times refer to limitations reciting "storing the selected previous version by the computational machine as the current version on the local storage location," and at other times refers to "current version" or "as the current version." *See* PO Sur-Reply 3–4, 6; PO Resp. 13–14. In any case, Patent Owner asserts the same or a very similar construction for those terms and limitations, and we understand Patent Owner asserts the same claim construction applies to all those terms and limitations.

proposed claim construction is 'practicable,' is based on sound claim construction principles, and does not revise or ignore the explicit language of the claims."). In that vein, "[p]roper claim construction . . . demands interpretation of the entire claim in context, not a single element in isolation." *Hockerson–Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed.Cir.1999); *accord Phillips*, 415 F.3d at 1314 ("[T]he context in which a term is used in the asserted claim can be highly instructive.").

Patent Owner's interpretation that "the current version" requires *two* current versions — one locally stored current version and a corresponding remotely stored current version — asks us to improperly adopt a claim construction which ignores explicit claim language and context in order to read unrecited features into the claim. The limitation in question, more fully and in better context, recites "storing the selected previous version . . . as *the current version on the local storage location*." Ex. 1001, 9:24–26 (emphasis added). The express language shows that the claim is specifically directed to the current version on the local storage location and not any possible remote current version. As such, even if there were a "current version on the remote storage location" which corresponds to and is kept in parity with the current version on the local storage location, i.e., a backup copy of the locally stored current version, the claim does not recite that feature, establishing that it does not require that feature. Further, as to the context of the claim, the term in question is part of a recited method of restoring a file to a previous version of the file on a local computational machine, rather than a method for maintaining parity of remotely stored backup files during that restoration process. *See id.* at 8:63–9:28. As such, the explicitly recited claim language and the context of the claim do not support reading an unrecited remote backup feature into the claim.

Furthermore, the disclosures in the '850 Patent Specification and the '251 Provisional do not support interpreting "the current version" as a locally stored current version and a corresponding remotely stored current version. Patent Owner's only example where a file restoration operation creates a remotely stored backup copy does not support its interpretation. *See* PO Sur-Reply 4–5 (citing Ex. 1003, 147). The cited example does not back up the *restored* "current version" of the file; instead, the local version of the file that is *to-be overwritten* is backed up. Ex. 1003, 147 ("AccuSafe must *first* backup the user[']s file to the AccuSafe Media Device, *then* perform the restoration function. This will assure that no version of a file is lost as a result of the restoration process.") (emphasis added); *see id.* at 30–37 ("AccuSafe will save the existing file . . . before overwriting it with the copy the user is about to restore"). Patent Owner's other citation discusses file backup features outside the context of the claimed restore feature. *See* PO Sur-Reply 4–5 (citing Ex. 1003, 139). Furthermore, Patent Owner's declarant does not cite any portion of the Specification or the '211 Provisional which supports Patent Owner's asserted construction. *See* Ex. 2004 ¶¶ 59–62. Simply, there is no identified evidence in the '850 Patent Specification or the '211 Provisional where a selection to restore a file locally requires a corresponding current version of the file to be stored remotely. As such, the '850 Patent Specification and the '211 Provisional do not suggest adopting a limitation not recited in the plain language of the claim.

We also disagree with Patent Owner that rejecting its construction would render "storing . . . the current version on the local storage location" as "mere surplusage" on the basis that the claim also recites "restore the

selected previous version." PO Sur-Reply 3. The relevant portion of the claim recites:

> *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*.

Ex. 1001, 9:21–26 (emphasis added). Patent Owner's argument is that the limitation first recites "restore the selected previous version" and, as such, "the resultant overwritten file inherently becomes the 'current version' of such file." PO Sur-Reply 3. From that, Patent Owner reasons that the later-recited "current version" "must mean more than mere overwriting of a file" and, so, requires corresponding local and remote versions which are kept in parity. *Id.*

The linguistic structure of the claim is contrary to Patent Owner's argument. Patent Owner's argument treats "restore the selected previous version" and "storing the selected previous version by the computational machine as the current version on the local storage location" as though they were two separate steps. The claim language, however, shows that is not the case. First, the initial portion of the limitation at issue recites "responsive to *a selection to restore* the selected previous version" (emphasis added) — the action recited there is at most a selection, not a restoration as Patent Owner would have it. Moreover, the overall limitation recites that "responsive to a selection to restore the selected previous version," subsequent steps occur including "storing the selected previous version . . . as the current version on the local storage location." As such, "storing . . . the current version on the local storage location" is not surplusage; rather, it is a step that occurs "*responsive to* a selection to restore the selected previous version" (emphasis

added). In fact, Patent Owner's later arguments assert that "storing the selected previous version" is a step responding to "the selection to restore the selected previous version." Patent Owner's Sur-Rely states "[b]y its plain meaning, this 'storing' action must be in response to the 'selection' action." PO Sur-Reply 13.

Accordingly, we do not interpret the claim such that "the current version" of the file, recited within the limitation "storing the selected previous version by the computational machine as the current version on the local storage location" requires

> keeping parity between the file on both the local storage location and on the versioning system of the remote storage location, such that the version of a file now present on the user's computer also has a corresponding version on the remote storage location, each of them corresponding to the other and being the most recent version in time of such file

as suggested by Patent Owner. PO Sur-Reply 3–4, 6; PO Resp. 14. Instead, we give the limitation its plain and ordinary meaning, i.e., the selected previous version of the file is stored as the current version of the file on the local storage location.

2. "restoring selected another revision of said file"

Patent Owner argues that, in claim 19's recited method of restoring a file, the term "restoring selected another revision of said file following said previewing step" should be interpreted "to mean that the 'selected another revision of said file' becomes the most recent version in time on both the local machine and the 'Internet storage area network.'" PO Resp. 15 (citing Ex. 2004 ¶ 65); PO Sur-Reply 7. Patent Owner points out that claim 19's preamble recites "a current version of the file being available at a local storage location" which is "updated or replaced" by the "selected another

revision of said file." PO Resp. 14–15; PO Sur-Reply 7. From that, Patent Owner asserts the "'current version' of the file, as recited in the preamble, will be the 'selected another revision of said file.'" PO Resp. 15; PO Sur-Reply 7. And, following that, Patent Owner references the reasoning it provided in its asserted claim construction of the term "current version" for claims 1, 10 and 19 (*see supra* § II.C.1) to assert a similar construction for this term. *See* PO Resp. 14–15; PO Sur-Reply 7.

Like our claim construction analysis above, the express language and context recited in claim 19 do not support Patent Owner's argument that a "restor[ed] selected another revision of said file" should be construed to require two separate, corresponding current versions of a file, one stored locally and another stored remotely. Patent Owner states the "restor[ed] selected another revision of said file" corresponds to the preamble's recitation of "a current version of the file being available at a local storage location." PO Resp. 15; PO Sur-Reply 7. As discussed above, the claim specifically recites "a current version of the file being available *at a local storage location*" and, further, does not recite limitations requiring restoration includes a corresponding remote backup file. *See* Ex. 1001, 12:10–30. And, as also discussed above, the context of the claim shows that the claim is directed to a method of restoring a file. Still further, as discussed above, the Specification and associated provisional application do not describe a remotely stored current version corresponding to a locally stored current version in the context of a restoration process, and, so, do not support Patent Owner's interpretation.

Accordingly, we do not interpret the claim such that "restoring selected another revision of said file following said previewing step" requires "that the 'selected another revision of said file' becomes the most

recent version in time on both the local machine and the 'Internet storage area network'" as suggested by Patent Owner. PO Resp. 15 (citing Ex. 2004 ¶ 65); PO Sur-Reply 7. Instead, we give the limitation its plain and ordinary meaning, i.e., a selected another revision of said file is restored at a local storage location.

D. *Summary of Prior Art References*

Below we summarize the asserted references. We discuss any additional pertinent details of the references in our patentability analysis.

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. 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 describes "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.

E. *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 collectively disputes Petitioner's showing for limitation [1.4] of independent claim 1, limitation [10.4] of independent claim 10, and limitation [18.5] of independent claim 18. PO Resp. 36–38. Patent Owner also disputes Petitioner's showing for limitation [19.5] of independent claim 19. *Id.* at 38–39. Patent Owner further disputes Petitioner's showing for dependent claims 2 and 11. *Id.* at 39–40.

For the reasons explained below, we determine that Petitioner has shown, by a preponderance of the evidence, that the subject matter of these claims would have been obvious over Sweat to one of ordinary skill in the art before the effective filing date of the claimed invention.

1. Independent Claim 1[9]

a) Preamble/Limitation [1.1]

Petitioner relies on Sweat to teach the preamble, which recites "[a] method of restoring a file to a previous version of the file, a current version

[9] For ease of presentation, we discuss some limitations of claim 1 combined with related limitations.

of the file being available at a local storage location." Pet. 55–56 (citing Ex. 1006, 10:51–61, 11:5–8; Ex. 1004 ¶¶ 116–117).

Patent Owner does not dispute this contention. *See* PO Resp.

We are persuaded that Sweat teaches the preamble.[10] Sweat describes a file management system which allows a user to download a selected version of a file stored on a server to a local computer. Ex. 1006, 3:58–61, 10:51–63.

b) Limitations [1.2.i] – [1.2.iii]

Petitioner relies on Sweat to teach limitations [1.2.i] – [1.2.iii], which collectively recite

> (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, wherein a restorable representation of each version, V, of the previous versions, is retrievable from a remote storage location, 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. 56–59 (citing Ex. 1006, 3:2–8, 3:12–14, 5:85–58, 9:19–24, 10:52–11:2, 17:16–17, Figs. 1, 4; Ex. 1004 ¶¶ 118–22).

Patent Owner does not dispute these contentions. *See* PO Resp.

We are persuaded that Sweat teaches these limitations. Sweat's file management system allows earlier versions of files to be selected and viewed. Ex. 1006, 10:51–58, 23:37–24:34. Those earlier file versions are

[10] We need not determine whether the preamble is limiting because Petitioner has shown that Sweat teaches this aspect of the claim. *See Realtime Data*, 912 F.3d at 1375.

stored on a server and can be recovered from the server. *Id.* at 5:52–59, 9:19–34.

c) Limitation [1.3]

Petitioner relies on Sweat to meet limitation [1.3], which recites

> (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. 59–61 (citing Ex. 1005, 4:26–29; Ex. 1006, 10:55–59, 24:6–19; Ex. 1004 ¶¶ 123–124).

Patent Owner does not dispute this contention. *See* PO Resp.

We are persuaded that Sweat meets this limitation. Sweat allows a user to view a selected previous version of a file, e.g., in a separate window or in a view tab. Ex. 1006, 10:52–57, 23:38–24:22. We agree that a user would have been motivated to use Sweat's viewing function to preview a selected earlier file version before restoring that earlier file version because doing so would allow a user to confirm the selected earlier file version is the correct version to restore, which would save time and computing resources. Pet. 60–61; Ex. 1004 ¶ 124.

d) Limitation [1.4]

The parties dispute whether Petitioner adequately shows that Sweat meets limitation [1.4], which recites

> (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, 9:21–28 (emphasis added); *see* Pet. 61–62; PO Resp. 36–38; Pet. Reply 21–23; PO Sur-Reply 13–15.

As relevant to the parties' dispute, Petitioner argues it would have been obvious to use the "Download" feature described by Sweat to replace a corrupted or otherwise compromised file, thus meeting "storing the selected previous version . . . as the current version on the local storage location." Pet. 60–62. 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). Sweat's download function "[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.

From those disclosures, 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).

Patent Owner does not dispute Petitioner's assertions regarding Sweat's disclosures or that a person of ordinary skill in the art would have used Sweat's download function to restore a corrupted or compromised local file version by replacing it with an earlier file version, and, by doing so, storing a current version of the file on the local storage location. *See* PO Resp. 36–38; PO Sur-Reply 13–15.

Instead, Patent Owner argues Sweat does not meet this limitation because Sweat's *server* does not have a corresponding "current version" of the locally restored file "such that each of these files (remote and local) correspond to the other and are the most recent versions in time of such files." PO Resp. 37 (citing Ex. 2004 ¶ 118).

Having considered the parties' arguments and evidence, we are persuaded that Petitioner has shown, by a preponderance of the evidence that Sweat meets limitation [1.4]. We agree with Petitioner that Sweat's download function allows a user to select previous versions of a file stored remotely on a server and use that selected file to overwrite a locally stored version of the file. Pet. 60–61; Ex. 1006, 5:49–55, 10:58–63. We also agree with Petitioner that one of ordinary skill in the art would have been motivated to use Sweat's "Download" feature "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" because doing so can repair a corrupted or otherwise compromised file. Pet. 61 (citing Ex. 1004 ¶ 124; Ex. 1005, 4:26–29).

Patent Owner's contrary arguments (*see* PO Resp. 36–38; PO Sur-Reply 13–15) are unavailing because they are premised on its erroneous claim construction. *Supra* § II.C.1 (addressing construction of this term). In particular, the claim does not require Sweat to store a current version of a file stored on its remote server which corresponds to and is kept in parity with a locally stored current version. Therefore, whether or not Sweat has such a corresponding remotely stored current version does not counter Petitioner's showing.

Accordingly, we are persuaded that Petitioner has shown, by a preponderance of the evidence, that Sweat meets limitation [1.4].

e) Conclusion as to Claim 1

For the reasons provided above, we are persuaded that an ordinarily skilled artisan would have found it obvious, in view of Sweat's teachings, to arrive at the subject matter recited in claim 1. Accordingly, we conclude that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claim 1 would have been obvious over Sweat.

2. Independent Claim 10

Independent claim 10 recites substantially similar subject matter to that recited in independent claim 1. *Compare* Ex. 1001, 8:63–9:28 *with id.* at 10:4–34. Petitioner relies on the same analysis for both claims 1 and 10. *See* Pet. 55–62. Patent Owner argues the construction of terms in claims 1 and 10 together (*see* PO Resp. 12–14) and the merits of Petitioner's challenge to claims 1 and 10 together (*see id.* at 36–38).

For the reasons explained above in connection with claim 1, we are persuaded that Petitioner has shown, by a preponderance of the evidence that

the subject matter of claim 10 would have been obvious over Sweat. Patent Owner's contrary arguments are not persuasive for the reasons we explained above. *Supra* § II.E.1.

3. Independent Claim 18

Independent claim 18 recites substantially similar subject matter to that recited in independent claim 1 and adds a precursory step to the file restoration functions recited in claim 1. *Compare* Ex. 1001, 8:63–9:28 *with id.* at 11:8–12:8. In particular, limitation [18.2] of claim 18 adds a step of

> (A) iteratively transmitting a representation of at least a portion of a current version of a file to a remote storage location for archiving the current version responsive to a determination of an availability of the remote storage location for accepting a transmission of the representation, the current version being accessible at a computational machine, the remote storage location being accessible through a network.

Ex. 1001, 11:11–18; *see* Ex. 1022, 4 (Petitioner's limitation identifiers referenced for discussion purposes). Petitioner argues Sweat meets this limitation because "a POSITA would have understood that Sweat iteratively transmits such backed-up file versions to Sweat's remote storage location" when a user saves changes or adds new information to a file. Pet. 68 (citing Ex. 1006, 5:56–57, 17:16–19; Ex. 1004 ¶ 139). Petitioner further asserts it would have been obvious to determine "the availability of the remote storage location prior to transmitting file back-up versions." *Id.* at 68 (citing 1004 ¶ 139). Additionally, Petitioner relies on the analysis it provided in claim 1 for the remaining, similar claim limitations in claim 18. *See* Pet. 68–69. We agree with Petitioner that Sweat describes an iterative backup process which occurs when a user saves changes or adds new information to a file

and further agree it would have been obvious to check whether the backup location was available before backing up the file.

Patent Owner does not dispute Petitioner's contention that Sweat meets limitation [18.2]. *See* PO Resp. Nor does Patent Owner rely on limitation [18.2] to support its claim construction or merits arguments. Rather, Patent Owner argues claims 1 and 18 together on the basis of similarly recited limitations [1.4] and [18.5]. *See* PO Resp. 12–14, 36–38.

For the reasons explained above in connection with claim 1, we are persuaded that Petitioner has shown, by a preponderance of the evidence that the subject matter of independent claim 18 would have been obvious over Sweat. Patent Owner's contrary arguments are not persuasive for the reasons we explained above. *Supra* § II.E.1.

4. Independent Claim 19

Independent claim 19 recites substantially similar subject matter to that recited in independent claim 1 and adds steps for decrypting and previewing multiple file versions and selecting one of those file versions for restoring. *Compare* Ex. 1001, 8:63–9:28 *with id.* at 12:9–30. In particular, limitations [19.4] and [19.5] of claim 19 add steps for

> (e) receiving another selection from said list indicating another revision of said file to restore;
>
> (f) previewing selected another revision of said file, wherein said selected another revision of said file is received from a network attached storage location; and
>
> (g) restoring selected another revision of said file following said previewing step in (f), optionally, decrypting said selected revision of said file prior to step (d) and decrypting said selected another revision of said file prior to step (f).

Ex. 1001, 12:12:21–30; *see* Ex. 1022, 5 (Petitioner's limitation identifiers referenced for discussion purposes).

Regarding the step for previewing multiple file versions, Petitioner argues a POSITA would understand that Sweat allows a user to iteratively select and preview different previous file versions until a user identifies the particular file version the user is searching for. Pet. 70 (citing Ex. 1004 ¶ 145); *see id.* at 66 (citing Ex. 1004 ¶¶ 78–79, 134). Regarding the steps for decrypting file versions, Petitioner argues a POSITA would understand that Sweat describes file data is transferred using an encryption protocol and, so, would be decrypted for use. *Id.* at 70–71 (citing Ex. 1006, 8:10–16; Ex. 1014, 259–260; Ex. 1004 ¶ 147).

We agree with Petitioner that a POSITA would understand that Sweat allows a user to select and preview different previous file versions and, indeed Sweat at least suggests as much by describing "versions tab 508 is used to open and view any file version" and then to "download a selected file to a local computer 104." Ex. 1006, 10:52–54. We also agree that Sweat at least suggests decrypting remote files for preview because Sweat uses HTTPS for file transfer, which a POSITA would have understood is an encrypted communication protocol. Ex. 1006, 8:10–16; *see* Ex. 1014, 259–260. Patent Owner does not dispute Petitioner's contention that Sweat meets these features. *See* PO Resp.

The parties dispute whether Petitioner has adequately shown Sweat meets "restoring selected another revision of said file following said previewing step." PO Resp. 38–39; PO Sur-Reply 15; *see* Pet. Reply 21–23. Both parties argue this limitation by referencing their contentions and arguments regarding limitation [1.4], which recites "storing the selected previous version by the computational machine as the current version on the

local storage location." *See* Pet. 70–71; PO Resp. 38–39; Pet. Reply 21–23; PO Sur-Reply 15. Indeed, as discussed above, Patent Owner's suggested construction of limitation [19.5] mirrors its suggested construction of limitation [1.4]. *See* PO Resp. 12–15, 38–39.

Therefore, for the reasons explained above in connection with claim 1, we are persuaded that Petitioner has shown, by a preponderance of the evidence that the subject matter of independent claim 19 would have been obvious over Sweat. As discussed above, Patent Owner's contrary arguments are not persuasive because they are based on a claim construction we do not adopt. *Supra* § II.C, II.E.1.

5. Dependent Claims 2 and 11

Petitioner contends claims 2 and 11 would have been obvious over Sweat. Pet. 62–63. Patent Owner disagrees. PO Resp. 39–40; PO Sur-Reply 16–18.

Claim 2 recites the "method of claim 1, wherein, for the presenting of (B), the presentable representation is presented using an application that created the file or the selected previous version." Ex. 1001, 9:29–32. This claim requires, and the parties seem to agree, that the computer application used to create the file is the same application used to preview previous versions of the file. *See* PO Resp. 40; Pet. 62–63.

Petitioner states that Sweat's "View in Window" feature allows a user to preview previous versions of Computer Aided Design ("CAD") drawing files. Pet. 59–60 (citing Ex. 1006, 10:55–58, 24:6–19; Ex. 1004 ¶ 123); *see id.* at 62 (citing Ex. 1006, 1:24–26, code (57)). Petitioner points out that Sweat describes previewing CAD drawing files by "install[ing] the appropriate viewer to open and view drawing files" on a user's computer.

Id. at 62 (citing Ex. 1006, 23:38–41). Additionally, Petitioner points out that CAD applications, such as AutoCAD, are used to create, edit, and view CAD files. *Id.* (citing Ex. 1006, 1:24–26, code (57)); Pet. Reply 24–25 (citing Ex. 1006, 23:29–33). From those teachings, Petitioner argues "it would be obvious to a POSITA that the same CAD application would be used to view previewed files of the same file type generated by that CAD application." Pet. 62–63; Pet. Reply 64 (citing Ex. 1024 ¶ 39).

We agree with Petitioner. Sweat's description of its "Viewing Files" feature explains that "a user must install the appropriate viewer to open and view drawing files." Ex. 1006, 23:38–41. Sweat lists examples of such viewers including software applications such as Volo™ View Express. *Id.* at 23:45–46, 23:63–67. While Sweat does not list a CAD file creating application in its exemplary list of viewers in that "Viewing Files" section (*see id.* at 23:38–24:35), elsewhere, Sweat states that a CAD application, e.g., "AutoCAD®," is "drawing/viewing software utilized by the viewer" (*id.* at 23:29–33). Furthermore, Petitioner's declarant offers undisputed testimony that AutoCAD is software for creating CAD drawing files and can also be used to view those created CAD drawing files. Ex. 1024 ¶ 39 (citing Ex. 1029, 19–23, 541–542). On that evidence, we agree a POSITA would understand that Sweat describes using a viewer to preview previous versions of CAD drawing files and that Sweat also describes AutoCAD (which creates CAD drawing files) can be used as a viewer. In light of that understanding, we agree it would have been obvious to use AutoCAD, i.e., "an application that created the file," to preview previous versions of that file. Pet. 62–63. We also agree that it would have been rational to do so because the same already locally available software application which created the file could then be used to view the file. *Id.*; *see* Ex. 1004 ¶ 128.

Patent Owner's arguments do not persuade us otherwise. Patent Owner dismisses Petitioner's obviousness argument as "irrelevant," and, instead, argues that Sweat does not disclose the claimed features. PO Sur-Reply 16–17; *see* PO Resp. 39–40. In particular, Patent Owner argues Sweat "discloses the use of specialized viewing software to view the related file" and emphasizes that "CAD software is clearly *not* being used in Sweat's 'View in Window' functionality" PO Resp. 39–40 (citing Ex. 1006, 23:39–51); PO Sur-Reply 17. While it may be the case that Sweat does not outright disclose the features recited in the claim, those arguments do not show fault in Petitioner's case that the claimed features would have been *obvious*. *See CRFD Rsch., Inc. v. Matal*, 876 F.3d 1330, 1345 (Fed. Cir. 2017) ("Even if a reference's teachings are insufficient to find anticipation, that same reference's teachings may be used to find obviousness."); *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016) ("A claimed invention may be obvious even when the prior art does not teach each claim limitation."), *overruled on other grounds by Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc).

Accordingly, we are persuaded that Petitioner has shown, by a preponderance of the evidence, that claim 2 is obvious over Sweat.

Claim 11 recites substantially similar subject matter to that recited in claim 2. *Compare* Ex. 1001, 9:29–32 *with id.* at 10:35–38. Petitioner relies on the same analysis for both claims 2 and 11. *See* Pet. 62–63. Patent Owner argues claims 2 and 11 together. *See* PO Resp. 39–40. For the reasons explained above in connection with claim 2, we are persuaded that Petitioner has shown, by a preponderance of the evidence that the subject matter of claim 11 would have been obvious over Sweat.

6. Remaining Dependent Claims 3–8, 12–16, 20, and 21

Petitioner provides arguments and evidence in support of its contention that dependent claims 3–8, 12–16, 20, and 21 are unpatentable as having been obvious over Sweat. *See* Pet. 63–71; Ex. 1004 ¶¶ 129–93.

Patent Owner does not address dependent claims 3–8, 12–16, 20, and 21 beyond linking those claims to arguments in connection with the claims from which they depend, which we have considered above. *See* PO Resp. 36–38, 40; PO Sur-Reply 15–16. For reasons provided above in §§ II.E.1, II.E.2, II.E.4, and II.E.5, we have concluded Patent Owner's arguments are unavailing.

As to Petitioner's remaining (and unopposed) analysis addressing the subject matter of claims 3–8, 12–16, 20, and 21 that differs from claims 1, 2, 10, 11, and 19, we adopt Petitioner's analysis as our own in this Decision. *See* Pet. 63–71.

Accordingly, we conclude Petitioner has shown by a preponderance of the evidence that claims 3–8, 12–16, 20, and 21 are unpatentable as having been obvious over Sweat.

F. *Obviousness Based on Sweat and Schneider*

Claims 9 and 17 depend from independent claims 1 or 10, similarly adding that "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."

Petitioner contends that the subject matter of these dependent claims would have been obvious over Sweat and Schneider. Pet. 72–73. Petitioner supports its combination, arguing a skilled artisan would have been

motivated to combine Sweat and Schneider "in order to provide the file backup system of Sweat with the benefit explicitly described by Schneider of making its file transmissions impact-free to the user such that the user does not notice any performance degradation." *Id.* at 72 (citing Ex. 1004 ¶ 153); *see id.* at 38–39 (citing Ex. 1005, 32:9–12, 37:22–29). We agree that the benefit identified by Petitioner in Schneider would have motivated the combination.

Patent Owner mainly argues that these claims are not obvious for the reasons argued above in connection with Sweat alone. PO Resp. 40–41. Although Patent Owner offers a short assertion that the "Petition seeks to combine Sweat with Schneider with little more than the gift of hindsight" (*see id.*), Petitioner offers a motivation for its combination rather than relying on hindsight to combine the references (Pet. 72–73). Patent Owner's assertion does not address Petitioner's reasoning.

Accordingly, we conclude that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claims 9 and 17 would have been obvious over Sweat and Schneider.

G. *Other Grounds*

Petitioner contends that the subject matter of claims 1–21 would have also been obvious over Schneider and over the combination of Schneider and Crawford. Pet. 2, 14–49. Patent Owner opposes. PO Resp. 17–35.

We have concluded that each of claims 1–8, 10–16, and 18–21 is unpatentable as obvious over Sweat and that each of claims 9 and 17 are unpatentable as obvious over the combination of Sweat and Schneider. *See supra* §§ II.E–F.

On the record presented, Sweat and the combination of Sweat and Schneider collectively account for each of claims 1–21 and we discern no need to separately address Petitioner's remaining grounds over Schneider or the combination of Schneider and Crawford, so we decline to do so in this Decision. *See SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 371 (2018) (holding a petitioner "is entitled to a final written decision addressing all of the claims it has challenged"); *Bos. Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App'x 984, 990 (Fed. Cir. 2020) (recognizing the "Board need not address issues that are not necessary to the resolution of the proceeding," and agreeing the Board has "discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims").

III. CONCLUSION[11]

Based on the evidence presented with the Petition, the evidence introduced during the trial, and the parties' respective arguments, Petitioner has shown by a preponderance of the evidence that claims 1–21 are unpatentable.

[11] Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–8, 10–16, 18–21	103	Sweat	1–8, 10–16, 18–21	
9, 17	103	Sweat, Schneider	9, 17	
1–21	103	Schneider[12]		
1–21	103	Schneider, Crawford		
Overall Outcome			**1–21**	

IV. ORDER

It is:

ORDERED that claims 1–21 of the '850 Patent have been proven by a preponderance of the evidence to be unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

[12] We do not address the contentions that the challenged claims would have been obvious over Schneider alone or in combination with Crawford because we have concluded claims 1–21 each are unpatentable based on Sweat alone or in combination with Schneider. *See supra* §§ II.E, II.F.

FOR PETITIONER:

Andrew Mason
Cameron Clawson
Sarah 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:

Ari Jaffess
Ronald Abramson
Mord Lewis
Gina Kim
LISTON ABRAMSON LLP
ari.jaffess@listonabramson.com
ron.abramson@listonabramson.com
michael.lewis@listonabramson.com
gina.kim@listonabramson.com

Rowan Smith
MESSNER REEVES LLP
rsmith@messner.com