

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,
Petitioner,

v.

SYNCHRONOSS TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-00850
Patent 6,671,757 B1

Before TREVOR M. JEFFERSON, DAVID C. McKONE, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Dropbox, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–15 of U.S. Patent No. 6,671,757 B1 (Ex. 1001, “the ’757 patent”) pursuant to 35 U.S.C. §§ 311–319. Patent Owner, Synchronoss Technologies, Inc., filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, in our Decision to Institute (Paper 10, “Dec.”), we instituted this proceeding as to claims 1–8, 10–13, and 15 of the ’757 patent.

After institution, Patent Owner filed a Patent Owner’s Response (Paper 18, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner’s Response (Paper 22, “Reply”). Oral argument was held on June 22, 2017, and a transcript of that hearing is part of this record. Paper 40 (“Tr.”). In their papers, Petitioner relies on the testimony of Dr. Azer Bestavros (Ex. 1003 and Ex. 1035) and Patent Owner relies on the testimony of Dr. Arthur M. Keller (Ex. 2008).

Patent Owner filed a Motion to Exclude Evidence (Paper 30 (“PO Mot. Excl.”)). Petitioner filed an Opposition to Patent Owner’s Motion to Exclude Evidence (Paper 34, “Pet. Opp. Excl.”) and Patent Owner filed a Reply to Petitioner’s Opposition to Motion to Exclude (Paper 39, “PO Reply Excl.”). In addition, Patent Owner filed a Motion for Observations (Paper 29) and Petitioner filed a Response to Patent Owner’s Motion for Observations (Paper 33).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of the

challenged claims. Upon review of the parties' papers, evidence, and argument and for the reasons discussed below, we find that Petitioner has not demonstrated by a preponderance of the evidence that any challenged claim of the '757 patent is unpatentable.

B. Related Proceedings

The parties state that the '757 patent has been asserted in *Synchronoss Technologies, Inc. v. Dropbox, Inc.*, 3:16-cv-00119-HSG (N.D. Cal.); *Synchronoss Technologies, Inc. v. EgnYTE, Inc.*, 3:16-cv-00120-HSG (N.D. Cal.); *Synchronoss Technologies, Inc. v. Funambol, Inc.*, 5:16-cv-02026 (N.D. Cal.); *Synchronoss Technologies, Inc. v. Hyperlinc Technologies, Inc.*, 3:15-cv-02845-MLC-TJB (D.N.J.); and *Synchronoss Technologies, Inc. v. Asurion Mobile Applications, Inc.*, 3:11-cv-05811-FLW-TJB (D.N.J.). Pet. 2; Paper 6, 2. We instituted trial on claims 16–20, 22–25, 27, and 29 of the '757 patent in *Dropbox, Inc. v. Synchronoss Technologies, Inc.*, Case IPR2016-00851 (PTAB Oct. 7, 2016) (Paper 10).

C. The '757 Patent

The '757 patent generally describes a system and method for synchronizing devices coupled to the Internet or a network. Ex. 1001, [57]. The '757 patent asserts that such synchronization is used in synchronizing personal contact information between systems but also has broader applicability. *Id.* at 5:40–45. The '757 patent discloses

a system for synchronizing data between a first system and a second system. The system includes a first sync engine on the first system interfacing with data on the first system to provide difference information. A data store is coupled to network and in communication with the first and second systems. A second

sync engine is provided on the second system coupled to receive the difference information from the data store via the network, and interfacing with data on the second system to update said data on the second system with said difference information.

Id. at 3:33–43. Figure 3, reproduced below, depicts one embodiment using the differencing routines to perform synchronization. *Id.* at 4:45–47.

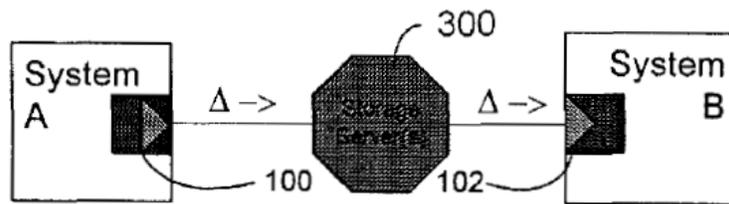


Figure 3

Figure 3 shows storage server 300 coupled between System A and System B. *Id.* at 6:48–51. System A provides difference information Δ to storage server 300 at one point in time. *Id.* at 6:53–58. Storage server 300 provides “the same difference information Δ to System B at a second point in time, but not the same as Δ the first point in time.” *Id.* In addition, multiple sets of difference information Δ may be provided at different points in time and stored for later retrieval by System B. *Id.* at 6:58–60. Server 300 is adapted to receive difference information Δ from differencing transmitter 100 and provide it to differencing receiver 102. *Id.* at 6:50, 6:64–7:1.

D. Illustrative Claim

Independent claim 1 is reproduced below with bracketed letters added
(Ex. 1001, 46:59–47:8):

1. [a] A system for synchronizing data between a first system and a second system, comprising:
 - [b] a first sync engine on the first system interfacing with data on the first system to provide difference information in a difference transaction;
 - [c] a data store coupled to the network and in communication with the first and second systems; and
 - [d] a second sync engine on the second system coupled to receive the difference information in the difference transaction from the data store via the network, and interfacing with data on the second system to update said data on the second system with said difference information;
 - [e] wherein each said sync engine comprises a data interface, a copy of a previous state of said data, and a difference transaction generator.

E. Instituted Grounds

We instituted a trial on the following grounds (Dec. 22):

Reference[s]	Basis	Claims
Nichols ¹	35 U.S.C. § 102	1, 3–8, 10, and 15
Kistler ² and Burns ³	35 U.S.C. § 103(a)	1–7 and 11–13

II. ANALYSIS

A. Applicable Law

1. Anticipation

To prevail in its challenges to the patentability of the claims, the Petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A claim is anticipated, and, thus, unpatentable, if a single prior art reference discloses each and every element of the claimed invention. *See Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003).

2. Obviousness

A 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

¹ David A. Nichols *et al.*, *High-Latency, Low-Bandwidth Windowing in the Jupiter Collaboration System*, USER INTERFACE SOFTWARE & TECH. (Nov. 14–17, 1995) (Ex. 1003, “Nichols”).

² James J. Kistler & M. Satyanarayanan, *Disconnected Operation in the Coda File System*, VOL. 10, No. 1, ACM TRANSACTIONS ON COMPUTER SYS. (1992) (Ex. 1006, “Kistler”).

³ Randal C. Burns & Darrell D.E. Long, *Efficient Distributed Backup with Delta Compression*, IOPADS '97 PROC. FIFTH WORKSHOP ON I/O IN PARALLEL & DISTRIBUTED SYS. (1997) (Ex. 1007, “Burns”).

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 skill in the art; and, (4) where in evidence, so-called secondary considerations, including commercial success, long-felt but unsolved needs, failure of others, and unexpected results.⁴ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966) (“the *Graham* factors”).

B. Level of Skill in the Art

Petitioner provides testimony from Dr. Bestavros that the person of ordinary skill in the art would have:

at least a bachelor’s degree in Computer Science or equivalent experience. Such a person would have experience working with and programming networked computer systems. Such a person would be familiar with the underlying principles of network synchronization, including data transfer, distributed systems, and content sharing and distribution across networks.

Ex. 1002 ¶ 24. Patent Owner contends that Petitioner’s identified level of ordinary skill in the art “is too vague to properly inform the claim construction or obviousness analysis.” PO Resp. 8. Patent Owner fails to identify how or why Petitioner’s proposed level of ordinary skill is vague or contrasts with the level of skill offered by Petitioner. Instead, Patent Owner

⁴ The parties do not address secondary considerations, which, accordingly, do not form part of our analysis.

offers testimony regarding the level of skill in the art (PO Resp. 8 (citing Ex. 2001 ¶ 31; Ex. 2008 ¶ 33)) that corresponds to the level of skill in the art identified by Petitioner's declarant, Dr. Bestavros. *Compare id.* at 8, with Declaration of Dr. Bestavros (Ex. 1002) ¶ 24. Indeed, Patent Owner's declarant, Dr. Keller, admits that Petitioner's and Patent Owner's argued levels of skill in the art are compatible. Reply 1 (citing Ex. 1034 (Deposition of Keller) 217:3–18). After reviewing the parties' argument and declarant testimony, we determine that a person with a bachelor's or master's degree in computer science with two or three years of experience with networked computer systems or equivalent experience is a person of ordinary skill in the art. PO Resp. 8; Reply 1; Ex. 1002 ¶ 24; Ex. 2001 ¶ 31, Ex. 2008 ¶ 33; Ex. 1034, 217:3–18.

C. Claim Interpretation

We interpret claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim construction standard to be applied in an *inter partes* review proceeding). Under the broadest reasonable interpretation standard, claim terms are generally given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art, in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. Difference Information

In our Decision on Institution, we adopted the parties' agreed construction that "difference information" as recited in claim 1 is "information that comprises only the changes to one system's data which have occurred on that system, and instructions for implementing those changes." Dec. 6–7 (citing Pet. 8; Prelim. Resp. 8). Patent Owner does not dispute this construction (PO Resp. 9), and we see no reason to alter it here.

2. Difference Transaction

In our Decision on Institution, we adopted Petitioner's proposed construction of "difference transaction" as used in the phrase "provide difference information in a difference transaction." In particular, we concluded that the term refers to "one or more pieces of difference information communicated together." Dec. 7–8 (citing Pet. 10 (citing Ex. 1002 ¶¶ 48–52)). Patent Owner adopts this construction. PO Resp. 9. For the reasons discussed in our Decision on Institution, we maintain our construction.

3. Difference Transaction Generator

Patent Owner argues that Petitioner's failure to construe "difference transaction generator" as used in the challenged claims fails to provide adequate notice of a proposed construction. PO Resp. 9–10. Patent Owner contends that the proper construction of difference transaction generator is "software that compares a current state of the data to a previous state of the data to generate difference information, and then places the difference information into a difference transaction." PO Resp. 12, 15 (citing Ex. 2008

¶ 41). Patent Owner asserts this construction is consistent with the '757 patent specification that

consistently describes “generating” difference information by comparing the data to a previous state of the data. For example, the specification describes “*difference information*” as the product of “extraction” by, for example, a differencing transmitter or differencing synchronizer. Exhibit 1001, 6:3–8, 6:33–37. The “differencing synchronizer” is further described in the '757 patent as an “engine” (*Id.*, 11:48–53) or delta module or differencing engine (*Id.*, 12:18–19) that generates difference information through comparison[.]

PO Resp. 13. In support of its contentions, Patent Owner cites portions of the specification that discuss comparing records or comparison generation by calculating the difference in data between the output of an application and the copy of the data stored by the application. PO Resp. 13–14 (citing Ex. 1001, 12:14–53); *see also* Ex. 1001, 14:39–42 (discussing that the “last synchronized version of each application’s actual data . . . is then used for the next data comparison by the delta module”). Patent Owner argues that “generator” as used in the claims states “the manner by which the difference information present in the difference transaction is created. Because it is a ‘transaction generator,’ it also places the difference information into a difference transaction.” PO Resp. 14 (citing Ex. 2008 ¶¶ 40–44).

Patent Owner also argues that this construction is consistent with the plain language of the claims. Thus, Patent Owner argues that

claim 1 recites **both** “*data on a first system*” (or second) system interfacing with a sync engine **and** “*a copy of a previous state of said data.*” The purpose of maintaining two separate versions of the data is to perform a comparison. Thus, the recitation of two different versions of the data in claim 1 is consistent performing

a comparison. Exhibit 2008, ¶ 45. Furthermore, claim 1 specifies that the “*sync engine*,” which includes the “*difference transaction generator*” and the “*copy of a previous state of said data*,” is characterized as “*interfacing with data on the first system to provide difference information in a difference transaction*.” Again, the recited interaction between the different versions of the data and the “*difference transaction generator*” is consistent with the notion comparing the data in the process of generating “*difference information*” and “*difference transactions*.” Exhibit 2008, ¶ 46.

PO Resp. 15.

Petitioner argues that Patent Owner’s proposed construction merely restates the requirements in the claims that the sync engines contain a “previous state of the data.” Reply 3–4. Petitioner does not challenge Patent Owner’s construction, but instead argues that Patent Owner’s construction reads this claim limitation into the term “difference transaction generator,” at most “add[ing] a requirement that the recited ‘previous state’ of the data be *used* to generate difference transactions.” *Id.* at 3. Petitioner further argues that Patent Owner’s claim construction does not distinguish the prior art because the “previous state” of the data is used to generate difference transactions as recited in the claims.

We agree with Patent Owner’s proposed inclusion of “compar[ing] a current state of the data to a previous state of the data to generate difference information” determining that it is consonant with recitations of the claim that describe use of “the previous state of [the] data” in difference transactions. PO Resp. 13–15; Reply 3. We do not find that Patent Owner’s construction regarding “plac[ing] the difference information into a difference transaction” (PO Resp. 13–15) is supported by the specification or

required by the claims. Thus, based on the parties' arguments, the intrinsic evidence and the plain language of the claim, we agree, in part, with Patent Owner that the broadest reasonable interpretation of a "difference transaction generator" requires software that "compares a current state of the data to a previous state of the data to generate difference information used in a difference transaction."

D. Anticipation Based on Nichols (Ex. 1003)

Petitioner contends that claims 1, 3–8, 10, and 15 are anticipated by Nichols, providing claim charts and citations to the Bestavros declaration in support of the contentions. Pet. 11–25 (citing Ex. 1002 ¶¶ 55–66, 67, 70–75, 77–80, 81, 96, 102–103).

1. Nichols (Ex. 1003)

Nichols describes a remote "collaboration system" that allows users to share and collectively edit various data objects in a client server system. Ex. 1003, 111, 113. Nichols discloses that the graphical user interface consists of shared virtual objects called "widgets" that are coordinated via the server and clients as the widget values change. *Id.* at 112. Nichols further discloses that the system synchronizes shared "widget values" using "a central server shared by all of the users." *Id.* at 111, 114. The server communicates with local client work stations, where "each client synchronizes with the server," and the "the server serializes all changes and echoes changes made by one client to all others that are sharing the widget." *Id.* at 115. Nichols describes that "running independent two-party synchronization protocols" between each client and the server allows the system to perform "*n*-way synchronization." *Id.*

2. Analysis

With respect to independent claim 1 and dependent claims 2–15, Petitioner argues that Nichols discloses the “sync engine” components recited in claim 1, including “a data interface,” “a difference transaction generator,” and “a copy of a previous state of said data.” Pet. 14–15. Petitioner also asserts that Nichols discloses the “management server” as recited in dependent claims 8 and 10 (Pet. 23–25), as well as the Internet limitations of dependent claim 3, the time lag limitations of dependent claims 4 and 5, and the bidirectional system limitations of dependent claims 6 and 7 (Pet. 15–16).

Patent Owner contends that Petitioner fails to show that Nichols discloses the “difference transaction generator” recited in claim 1—and all other challenged claims—that derives difference information from the previous state of the data. PO Resp. 22–24. Patent Owner argues that the Petition describes only a widget in Nichols that communicates changes in data but does not expressly perform a comparison that involves the *previous state of the data* as required by claim 1. *Id.*

With respect to the difference transaction generator, Petitioner’s claim chart states:

Nichols discloses that the Jupiter client generates difference transactions in response to locally implemented changes to shared data. “Both client and server keep track of widget state, and communicate high-level state changes. . . .” Ex. 1003 at 112. “The client copy allows user changes to be reflected immediately in the window, before they are processed by the server.” *Id.* at 113; Ex. 1002 ¶¶ 75, 79.

Nichols discloses multiple examples of “difference transactions” generated by the client. For example, in the context of the TextEdits widget, a “general ‘replace this region of text with this value’ message suffices” to communicate the change in data. Ex. 1003 at 114. Likewise, Figure 3 shows the client sending a “del 4” [delete the fourth character] message to the server. *Id.* at 115; Ex. 1002 ¶ 75.

Pet. 15. With respect to the Jupiter clients and servers of Nichols, Petitioner asserts that

Jupiter clients and servers “maintain a full copy of each widget’s value” and synchronize the widget value as it is changed at any client sharing the widget. Ex. 1003 at 114. For widgets that comprise significant amounts of data—such as text editors—the complete value of the widget is not sent when it is modified. *Id.* Instead, clients transmit an “incremental state update message” describing the modification—*i.e.*, difference information—which the server then serializes and sends “to all the other clients.” *Id.* at 114–15, 118; Ex. 1002 ¶ 58. Those clients receive the difference information and update their local copies of the shared data. *See* Ex. 1003 at 114–15; Ex. 1002 ¶ 77.

Pet. 12.

Petitioner argues that Patent Owner fails to understand the complex widgets disclosed in Nichols, such as TextEdits and Stroke Edits, which use incremental state update messages. Reply 11–12; Ex. 1003, 113–1ss14.

Specifically, Petitioner argues that

For Text Edit widgets, Nichols states that the client sends a message instructing the server to “replace this region of text with this value.” Ex. 1003 at 114. Such a message contains not merely the user’s inputs or the overall value of the widget, but instead communicates the text that has changed by reference to the previous “region.” Ex. 1035 ¶¶ 1–16. It is thus a “difference transaction.” And because this update message is generated using exactly the comparison that [Patent Owner] argues is

required, Nichols discloses a “difference transaction generator” even under [Patent Owner’s] construction. Ex. 1035 ¶¶ 15–16.

Reply 12.

Petitioner further argues that for the Text Edit widgets, the changes consist of the current state of the data and the previous state of the data. Reply 12 (Ex. 1035 ¶¶ 8–9, 12–16). Thus, the Text Edit widget of Nichols discloses the “copy of the previous state of the data” as required in claim 1. Petitioner asserts that it is not arguing that it is inherent that the replace message in the Text Edit widget discloses maintaining a copy of the previous state of the data and the current state of the data in the sync engine of claim 1. Tr. 41:9–22 (stating that Petitioner’s argument is not an “inherency argument” but is based on what the “replace command is depicting”).

As discussed above, we determined that the “difference transaction generator” is properly construed to require software “comparing a current state of the data to a previous state of the data to generate difference information used in a difference transaction.” Petitioner did not directly challenge this construction, but instead asserted that this comparison merely reflects what is required by the claims and that Nichols discloses it. Reply 3–4. In accordance with the plain language of the claims that require the first and second sync engine of claim 1 to comprise “a copy of a previous state of said data, and a *difference transaction generator*,” Petitioner must show by a preponderance of the evidence that Nichols discloses a sync engine that contains the current state of the data and previous state of the data to generate difference information.

Petitioner’s evidence for the difference transaction generator relies on the Text Edit widget in Nichols, which discloses a message to “replace this region of text with this value” (Ex. 1003, 114 (col. 2)). Reply 12 (citing Ex. 1035 ¶¶ 1–16). Petitioner argues that Nichols’ disclosure of a prior region of text that is identified and replaced demonstrates a difference transaction. Reply 12. The update performed in the “replace” command, Petitioner argues, is “generated using exactly the comparison that. . . is required” by a difference transaction generator. Reply 12 (citing Ex. 1035 ¶¶ 15–16).

Petitioner has not established that Nichols discloses a “difference transaction generator” persuasively or sufficiently to establish anticipation. The Nichols citations and testimony cited by Petitioner relate to suggestions to a person of ordinary skill in the art, which relate to obviousness, not anticipation. Ex. 1035 ¶¶ 15–16; Reply 12; Ex. 1003, 114. Specifically, Petitioner’s declarant, Dr. Bestavros, testifies that “the [person of ordinary skill in the art] would understand that what Nichols teaches is comparing the Text Edit widget’s new value to some previous state, so that the system can determine what region of text has changed and needs replacing.” Ex. 1035 ¶ 15. Further, Dr. Bestavros testifies that:

Nichols thus *teaches* that the Jupiter client maintains a previous state of the data so that, whenever the time comes to send aggregated changes to the server, the client is [] able to identify to the server which region of text is to be replaced. *See* Ex. 1003 at 114. The [person of ordinary skill in the art] *would understand* that Nichols discloses a comparison of the current state of the Text Edit’s data (what is reflected immediately at the client) to the previous state of the data (the widget’s previous value maintained by the client) so that the client can generate the

update message that identifies which previous data has been changed.

Ex. 1035 ¶ 16 (emphases added).

On the complete record, Petitioner’s evidence and argument do not show that Nichols expressly or inherently⁵ discloses the current state and prior state of the data for the difference transaction generator on both the first and second sync engines as required by limitation 1[e]. Instead, Petitioner’s arguments and evidence are based on what Nichols *teaches* and what a person of skill *understands* the comparison performed in Nichols to include. Ex. 1035 ¶¶ 15–16; Reply 12; *see* Ex. 2009 (Deposition of Bestavros) 73:11–74:2 (testifying what “a person of ordinary skill in the arts reading [replace message] and understanding. . . what the system teaches and does would appreciate” the Text Edit widget in Nichols teaches a difference transaction). Such evidence does not establish by a preponderance of the evidence that Nichols *discloses* the recited “difference transaction generator.”

Petitioner’s evidence at most shows what a skilled artisan might have inferred from the disclosure of Nichols and, accordingly, that Nichols would have rendered obvious the claimed comparison, a challenge Petitioner never raised and on which we did not institute. As noted above, Petitioner does not contend that Nichols’ disclosure necessarily (or inherently) discloses the claimed comparison. Nor has Petitioner presented evidence to support the

⁵ Petitioner stated at the oral hearing that this argument does not rest on inherency, but that Nichols informs a person of ordinary skill in the art by using the same comparison required in the claims. Tr. 41:9–22; *see* Reply 11–12 (relying on declarant testimony).

rigorous requirements of an inherency finding. Rather, Petitioner attempts to avoid those requirements by asking us to accept its expert's inferences as to how a skilled artisan would have viewed Nichols' teachings. This is an obviousness inquiry not presented in the Petition. Petitioner's arguments and evidence also fail to address persuasively how Nichols discloses that the sync engines contain both the current state and prior state of the data as required by the construction of "difference transaction generator."

Based on the full record, Petitioner has not shown by a preponderance of the evidence that Nichols discloses a "difference transaction generator" as construed in Section II.C.3 above. Because this limitation appears in each of the challenged claims, Petitioner has not demonstrated by a preponderance of the evidence that claims 1, 3–8, 10, and 15 of the '757 patent are anticipated by Nichols.

E. Obviousness Based on Kistler (Ex. 1006) and Burns (Ex. 1007)

Petitioner contends that claims 1–7 and 11–13 would have been obvious over the combined teachings of Kistler and Burns. Pet. 42–60. Petitioner provides claim charts containing citations to the evidence and the Bestavros declaration in support of its contentions. Pet. 48–59 (citing Ex. 1002 ¶¶ 264, 273, 274, 276, 277–279, 282–299, 301–313, 332–334, 367–375).

In the Petition, Petitioner asserts that Kistler and Burns are prior art printed publications. Pet. 4. Our Decision on Institution granting trial on the ground based on Kistler and Burns treated certain arguments challenging the prior art status of those references in Patent Owner's Preliminary Response as objections pursuant to 37 C.F.R. § 42.64(b)(1) and granted

Petitioner ten business days from the institution to serve supplemental evidence in accordance with 37 C.F.R. § 42.64(b)(2). Dec. 19, 23. In response, Petitioner served Exhibit 1027 to corroborate that Exhibit 1006 is a prior art printed publication. Reply 8. Petitioner argues that “Exhibit 1027 is a copy of the Kistler reference from the ACM’s TOCS journal which was published in February 1992.” *Id.*

Patent Owner asserts that Exhibit 1027 is not the same document as Exhibit 1006. PO Resp. 42–43. Exhibit 1027 is, on its face, a copy of a published document taken from a journal available in a university library. Indeed, Petitioner repeatedly asserts that Exhibit 1006 is the version of Kistler published in ACM TRANSACTIONS ON COMPUTER SYSTEMS. Pet. 4 (citing the ACM journal as the source); Paper 3, 1 (citing same in the exhibit list). When providing supplemental evidence, Petitioner served a supplemental declaration from Dr. Bestavros (Ex. 1024) that describes Exhibit 1027 as being a copy of the actual ACM-published version of Kistler, as received by the University of Minnesota Library, but Petitioner does not address Exhibit 1006 or describe its contents in relation to Exhibit 1027. Ex. 1024 ¶¶ 4–9.

At the outset, Petitioner has failed to show that Exhibit 1006 is the version of Kistler that was published in ACM TRANSACTIONS ON COMPUTER SYSTEMS. Petitioner argues that Patent Owner “makes no attempt to claim that any difference between Exhibit 1006 and 1027 is relevant to any argument or disclosure at issue in this proceeding” and that “the content[s] of the two documents . . . are identical save for an irrelevant endnote, the formatting, and the quoted length of time of testing the system.” Reply 8.

Petitioner is mistaken because it is not Patent Owner's burden to show differences between the prior art Petitioner relies on in Exhibit 1006 and the actual document that Petitioner asserts is the published journal article in Exhibit 1027. Instead, it is Petitioner's burden to establish sufficient evidence that Exhibit 1006 is what its Petition and supporting declarations purport it to be. 35 U.S.C. § 312(a)(3)(A).

We also are not persuaded by Petitioner's argument that Patent Owner elevates form over substance in urging us not to rely on Exhibit 1027 to show that Exhibit 1006 is a printed publication. *See* Reply 8–9. In this instance, the issue is the statutory requirement under 35 U.S.C. § 312(a)(3)(A) that a petitioner provide copies of the printed publications relied upon that accompany the petition. In both form and substance, Petitioner did not comply with this requirement. *See* Pet. 4; Ex. 1002 ¶ 254; Ex. 1024 ¶¶ 4–9; *compare* Ex. 1006, *with* Ex. 1027. Indeed, Petitioner does not seek to replace the original submission of Exhibit 1006 with the supplemental evidence Exhibit 1027 or explain how Exhibit 1006 is a true copy from the source Petitioner identifies, the ACM publication. Reply 8–9. Petitioner has not shown that Kistler as provided in Exhibit 1006 is the printed publication from the ACM in support of its petition.

Having failed to show that Exhibit 1006 is from the ACM publication, Petitioner's Reply attempts to submit additional evidence (beyond the timely filed supplemental evidence) to support an argument that the Kistler document in Exhibit 1006 was itself published by its authors. Reply 7 (citing Ex. 1036; Ex. 1037; Ex. 1038). Petitioner provides testimony that the version provided as Exhibit 1006 was allegedly presented at a symposium,

bound in a volume distributed to symposium attendees, and emailed to colleagues. *Id.* (citing Ex. 1036 ¶¶ 11–16).

Patent Owner objects to this additional evidence as untimely, lacking foundation, and lacking relevance. PO Mot. Excl. 8–13 (moving to exclude Exhibits. 1036, 1037, and 1038). We agree with Patent Owner that Petitioner’s evidence (namely Exhibits 1036, 1037, and 1038) filed with its Reply is untimely.

Patent Owner objected to Petitioner’s evidence with respect to Exhibit 1006, and Petitioner filed timely supplemental evidence. PO Resp. 8–9. Patent Owner’s further objections and challenges to the sufficiency and admissibility of Petitioner’s evidence (both the Petition and the served supplemental evidence) are proper and do not open a second window after the Patent Owner Response for Petitioner to provide further evidence and an alternate theory under which Exhibit 1006 is a printed publication. PO Mot. Excl. 9–13, PO Reply Excl. 2; *see Standard Innovation Corp. v. Lelo, Inc.*, IPR2014-00148, slip op. 8–9 (PTAB Apr. 23, 2015) (Paper 42) (discussing the Board’s rules applicable to evidence introduced in a Petitioner’s Reply in support of whether a reference is a printed publication). We are not persuaded that Petitioner’s arguments that the new evidence is a timely response based on Patent Owner’s objections and argument. Pet. Opp. Excl. 9–13; Reply 7–8 (citing Ex. 1036 ¶¶ 1–16; Ex. 1037 ¶¶ 1–13). Accordingly,

we do not consider Exhibits 1036, 1037, and 1038 in reaching our determination regarding Exhibit 1006.⁶

Based on the foregoing, Petitioner has not shown by a preponderance of the evidence that Kistler as provided in Exhibit 1006 is admissible as a printed publication from ACM TRANSACTIONS ON COMPUTER SYSTEMS under 35 U.S.C. § 103. Accordingly, Petitioner has not demonstrated by a preponderance of the evidence that claims 1–7 and 11–13 of the '757 would have been obvious over Kistler and Burns.

III. PATENT OWNER'S MOTION TO EXCLUDE

Patent Owner moves to exclude Exhibits 1006 (Kistler), 1024 (Supplemental Declaration of Dr. Bestavros), 1027 (ACM TOCS copy of Kistler); 1028 (Minnesota Library Letter); 1029 (US. Patent 5,919,247), 1036 (Declaration of Satyanarayan); 1037 (Declaration of Arpachi-Dusseau), and 1038 (file directory listing). PO Mot. Excl. 1. In light of the foregoing, Patent Owner's motion to exclude Exhibits 1006, 1024, 1027, 1028, and 1029 is dismissed as moot. We address Patent Owner's motion to exclude Exhibits 1036, 1037, and 1038 submitted in support of Petitioner's Reply below.

⁶ Even if we did consider Exhibits 1036, 1037, and 1038, Petitioner's exhibits and argument rely on a new source of publication for Exhibit 1006 to establish it as an admissible printed publication. Reply 7–8. Contrary to Petitioner's argument, such evidence only adds support for our finding that that Exhibit 1006 was *not* published in the ACM as represented in the Petition and supporting evidence that Petitioner cites. *See* Pet. 4 (stating source of Exhibit 1006 as ACM publication).

As discussed in Section II.E., we agree with Patent Owner that Petitioner's evidence submitted with its Reply to support Exhibit 1006 is not timely. Petitioner has not provided sufficient or persuasive argument or evidence that Exhibits 1036, 1037, and 1038 are timely as supplemental evidence. Pet. Opp. Excl. 12–15. Categorizing supplemental evidence as a proper or timely reply to Patent Owner's arguments (*id.*) does not shield Petitioner's evidence from the requirements that it comply with the rules regarding supplemental evidence. *See Standard Innovation Corp.*, IPR2014-00148, slip op. 8–9 (PTAB Apr. 23, 2015) (Paper 42) (discussing improper and untimely supplemental evidence submitted in Petitioner's Reply); 37 C.F.R. §§ 42.23(b), 42.64(b)(1). Petitioner's reply evidence (Ex. 1036, Ex. 1037, and Ex. 1038) submitted in support of Exhibit 1006 (Reply 7 (citing Ex. 1036; Ex. 1037)) was submitted well after Patent Owner's timely objections (Paper 15) and after Patent Owner addressed Petitioner's timely supplemental evidence in the Patent Owner's Response. *See* PO Resp. 43–44; *see* Reply 8–9 (arguing supplemental evidence in support of Ex. 1006). Based on the foregoing, Patent Owner's motion to exclude Exhibits 1036, 1037, and 1038 is granted.

IV. CONCLUSION

For the foregoing reasons, we determine that the Petition has not demonstrated by a preponderance of the evidence that (1) claims 1, 3–8, 10, and 15 are anticipated by Nichols, and (2) claims 1–7 and 11–13 would have been obvious over Kistler and Burns.

V. ORDER

Accordingly, it is

ORDERED that claims 1–8, 10–13, and 15 of U.S. Patent No. 6,671,757 B1 have not been shown by a preponderance of the evidence to be unpatentable;

FURTHER ORDERED that Patent Owner’s Motion to Exclude is granted with respect to Exhibits 1036, 1037, and 1038, and dismissed with respect to Exhibits 1006, 1024, 1027, 1028, and 1029; 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.

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