

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAP America Inc.,

Petitioner,

v.

Clouding IP, LLC

Patent Owner.

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IPR2013- \_\_\_\_\_

Patent 6,738,799

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**PETITION FOR *INTER PARTES* REVIEW**

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Mail Stop PATENT BOARD, PTAB

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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## EXHIBIT LIST

- 1001 U.S. Patent No. 6,738,799 to Dickinson
- 1002 Excerpts from Prosecution history of Application No. 09/303,958, the parent application of the '799 patent
- 1003 U.S. Patent No. 6,233,589 to Balcha et al.
- 1004 U.S. Patent No. 5,832,520 to Miller
- 1005 U.S. Patent No. 5,898,836 to Freivald et al.
- 1006 U.S. Patent No. 5,990,810 to Williams
- 1007 Petition in IPR2013-00073
- 1008 Board's Decision Instituting *Inter Partes* Review in IPR2013-00073
- 1009 Declaration of Dr. Andrew Grimshaw

## I. INTRODUCTION

Petitioner SAP America Inc., (“SAP” or “Petitioner”) respectfully requests *inter partes* review (IPR) of claims 1, 5-10, 12, 16-21, 23, 24, 30, 31, 37, and 42 of U.S. Patent No. 6,738,799 (the “‘799 patent,” attached as Ex. 1001) in accordance with 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq.*

The ‘799 patent has been the subject of two terminated IPRs: IPR2013-00073 (“IPR-073”) and IPR2013-00261 (“IPR-261”), and is currently the subject of IPR2013-00586 (“IPR-586”). In IPR-073, the PTAB instituted trial, and the case settled shortly after the patent owner attempted to amend its claims, thus conceding to the unpatentability of the challenged claims over the prior art of record. (*See e.g., Exs. 1007, 1008*). The instant petition challenges the *same* claims under the *same* grounds on which the PTAB instituted trial in the IPR-073 petition. The instant petition also includes an additional ground from the IPR-261 petition that directly refutes the arguments that the Patent Owner made to distinguish its claims in the IPR-073 petition. The instant petition is identical in substance to the IPR-586 petition, which was filed on September 16, 2013, and therefore Petitioner respectfully requests that this petition be joined with the IPR-586 petition. In view of the pending petitions, the PTAB should institute trial.

The ‘799 patent is generally directed to methods for synchronizing files between a first computer and a second computer. More particularly, the ‘799

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