UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, LLC,

Petitioner,

v.

SYNKLOUD TECHNOLOGIES, LLC,

Patent Owner.

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IPR2019-01655
U.S. 9,098,526

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PATENT OWNER SUR-REPLY

Contents

I.   Introduction.

Under the proper claim construction as set forth by Patent Owner Synkloud Technologies, LLC ("PO" or "Synkloud"), none of the claims of U.S. Patent 9,098,526 ("the '526 patent") would have been obvious. Many of the claim limitations are wholly absent from the prior art.

Under these circumstances, documentary evidence is required to establish that the absent limitations would have been obvious. *K/S HIMPP v. Hear-Wear Technologies, LLC*, 751 F.3d 1362, 1366 (Fed. Cir. 2014)("an assessment of basic knowledge and common sense as a replacement for documentary evidence for factual findings lacks substantial evidence support."). But Petitioner Unified Patents ("Unified") makes no attempt in its Reply to provide the documentary evidence required to establish obviousness. Nor does it attempt to argue that *K/S HIMPP* is not the law.

Instead, Unified restates its sole reliance on its expert declaration to advance the theory that the limitations that are absent from the prior art would have been obvious. *See* Reply, 9-21. For this very reason, Unified's argument violates the mandate of *K/S HIMPP*. It is improper to rely on after-the-fact expert declarations, rather than contemporaneous documentary evidence, to support an obviousness theory that relies on modifications of the prior art to supply missing limitations. Indeed, Unified's Reply ignores the testimony of Synkloud's expert Mr. Jawadi, which explains why a person of ordinary skill in the art (POSITA) would not have been motivated to modify the prior art

to include the missing claim limitations.

Moreover, Unified's arguments are based on erroneous claim construction. Although Unified contends that the claims would have been obvious under Synkloud's constructions, it does not, in fact, apply Synkloud's constructions in its Petition or Reply,

Unified's Petition and Reply are based on erroneous claim constructions and the mistaken view that the claim limitations that are wholly absent from the prior art would have been obvious just because it says so (*e.g.*, without any supporting documentary evidence). Unified has not nearly met its burden to show by a preponderance of the evidence that any claim of the '526 patent would have been obvious.

II.   PO's Claim Constructions Are Consistent With the Plain and Ordinary Meaning Of The Claims As Understood By A POSA and With The Specification.

A.   Predefined Capacity

The proper construction of "a storage space of a predefined capacity assigned exclusively to the user of a wireless device by a storage server" requires that "the server assigns an amount of storage, storage to be assigned exclusively for one user, that amount having been set in advance of any interaction or negotiation between the server and the user." PO Response, 11.

In response, Unified builds and then knocks down a straw man argument that Synkloud never made. According to Unified, Synkloud's attention to the plain and ordinary meaning of this claim limitation as understood by a POSITA means that Synkloud's "argument is based on a tortured read of the specification that, even if correct

would amount to nothing more than a prohibited importation of limitations from the specification." Reply, 6. But this is plainly not so.

Synkloud agrees with and endorses the Federal Circuit's prohibition against importing limitations from the specification into the claims. But it is simply not relevant here. Synkloud does not make the argument prohibited by the Federal Circuit. Rather, Synkloud explains that its construction is consistent with the plain and ordinary meaning as understood by a POSITA. As explained by the expert, Mr. Jawadi, a POSITA would have understood that predefining capacity is different than allocating storage:

> a POSITA would have understood the predefining capacity to mean defining (i.e., deciding or setting in advance) the amount of storage <u>before</u> the storage is allocated or assigned to the user (EX2007, § 161);
> a POSTIA [sic] would not have conflated predefining capacity (predefining amount of storage before the storage is allocated or assigned) and allocating or assigning storage (which happens first) (*ibid.*).

Indeed, the prefix "pre" in "predefined" means "before." *Ibid.* Moreover, the claims explicitly recite that "a storage space of predefining capacity," is "assigned exclusively to the user … by a storage server," (EX1001, 5:65-66)—not by the user.

The Specification of the '526 patent confirms the plain and ordinary meaning "that storage **capacity is predefined** (i.e., defined, decided, or set out **in advance**) by the server (**not by the user**) for users **before allocating storage** to users" (*id.* at ¶164 (*emphasis in original*)):

Each server unit (e.g., the server 3 of the FIG. 2) partitions its storage

system into volume and each of the volumes will have multiple GB in size. Therefore, **each user of the wireless devices can be exclusively assigned for access to a specific storage volume on a server unit** (EX1001, 2:39-44.(*emphasis added*);

Based on the received storage information the administration staff on the console host (12), for example, can use a web-console (13) to partition each storage device and send the storage partition information to the console support software (5) of the server (3). **The storage partition information includes the number of the partitions (volumes) and the size of each partition (volume)**.

Id. at 4:12-16 (*emphasis added*).

Unified's expert did not respond to Mr. Jawadi's explanation of how a POSITA would have understood this claim limitation—even though he had the opportunity to do so by a declaration that could have been filed with its Reply.

Synkloud's construction should be adopted by the Board. Unified does not propose a different construction for this limitation.

B.   Coupling

The term "coupling" recited in claims 1, 11, 13, 14, and 15 should be defined as "linking of a system's components to form a relationship." EX2007, ¶198, *quoting* EX2005. For the wireless device "to carry out [a] requested operation for remote access to the assigned storage space" (EX1001, 6:1-4), it must be linked with the storage server.

This plain and ordinary meaning of the claim term "couple"—in addition to being supported by the claim language itself—is also consistent with the Specification, which

states that there is a "communication link between" the wireless device and the storage server. EX1001, 4:62.

In response, Unified alleges that "PO suggests that 'coupling' must be a high performance coupling." Reply, 7. But neither Synkloud nor its expert Mr. Jawadi made any such suggestion; neither mentioned "high performance coupling." Unified just made it up and then, addressed its own made-up arguments instead of addressing the arguments that Synkloud and Mr. Jawadi actually made.

Mr. Jawadi explained how a POSITA would have understood the claim term "coupling" in the context of the Specification. He explained that the claim limitation "coupling with the storage server to carry out" requires the wireless device to link with the storage server to carry out various operations:

> Dependent Claims 13, 14, 15, and 17 recite "coupling with the storage server to carry out an operation for" "remotely deleting, moving, copying, or renaming a folder in the assigned storage space" (Claim 13), "remotely creating a folder structure in the assigned storage space" (Claim 14), "remotely creating a folder in the assigned storage space" (Claim 15), and "remotely deleting, moving, copying, or renaming a file in the assigned storage space" (Claim 17).

EX2007, ¶202. He then concluded that an "email mechanism is not suitable for performing any of these operations" because emails do not have the efficiency, effectiveness, and interactivity to meet the inventor's purpose of performing operations for the wireless device in the storage server, as recited in the language surrounding the

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"coupling" term.[1] *Id.* at ¶¶ 202-205; *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 444 (Fed. Cir. 1986); *Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1300 (Fed. Cir. 2003) ("while certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms."); *see also Hockerson–Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374, (Fed.Cir.1999).

In addition, Synkloud's proposed construction is supported by the Specification, which explains that the claimed coupling must have some efficiency, effectiveness, and interactivity to enable the claimed operations to be performed:

> a system and method for the wireless device to efficiently and effectively use remotely located storage space (EX1001, '526 patent, Abstract);
> a user of a wireless device can access and browse any web-site on the Internet (id. at 3:3-6).

These types of claimed operations are simply not done by an email exchange. No one has ever browsed the web, for example, by sending an email to a server, receiving a web page

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[1] Unified's allegation that "PO's own expert could not explain with any precision to what degree something must be "efficient, effective, and interactive" before it qualifies as a "coupling" under PO's construction." (Reply, 8) is demonstrably false; Mr. Jawadi testified that coupling requires a "linking of a system's components to form a relationship" (EX2007, ¶198, citing EX2005); *see also* EX1022, 106:13-107:7.

via email in response, and displaying the web page on the wireless device. Unified did not introduce into evidence a single document suggesting in any way that an email exchange would have been considered to be a coupling or connection between a wireless device and a server. Indeed, Unified's expert did not respond to Mr. Jawadi.

Synkloud's proposed construction is consistent with the plain and ordinary meaning as understood by a POSITA and the Specification. It should be adopted by the Board. Unified did not propose a different claim construction.

C. Comprising storing a data objcct thcrcin or rctricving a data objcct therefrom

Unified argues that the claim limitation requires either storing or retrieving a data object, not both. Reply, 3-4. But Unified fails to explain how a data object could possibly be retrieved from a storage space before it is stored there. *Ibid*. The plain and ordinary meaning of this claim limitation, therefore, requires either storing a data object or both storing and later retrieving a data object.

III. None Of The Claims Would Have Been Obvious Over The Combination Of Prust and Major Under The Proper Claim Construction.

The section of Unified's brief commencing with the heading "The Board need not construe any claim terms proposed by Patent Owner since the Petition demonstrates how the art discloses the limitations under Patent Owner's proposed constructions" (Reply, 3), in fact, fails to explain how the Petition's obviousness analysis applies to Patent Owner Synkloud's claim constructions. The heading is a canard. It does not reflect the content

of Unified's argument in the body of the section. Indeed, Petitioner fails to apply

Synkloud's claim construction throughout its Reply. *See* Reply, 9-21.

A. The Combination of Prust/Major Would Not Have Taught "utilizing download information for the file stored in said cache storage."

Unified sets forth two theories of why the claim limitation quoted above would

have been obvious. First, Unified argues that "Prust includes a conventional web

browser and thus, a POSA understood that a conventional web browser includes cache."

Reply, 9. Second, Unified argues that "the Petition sets forth modifying the teachings of

Prust to indicate the web cache as taught by Major, and includes detailed motivations

therefor." *Ibid.* Unified attempts to support its theories on the basis that "PO's expert

gutted the PO's cache arguments and demonstrated that none had factual support"

because he "admitted that the use of cache with web browsers was 'well-known and

widespread in 2003.'" *Id.* at 10-11.

Both of Unified's theories miss the mark entirely and are not commensurate with

the scope of the claims of the '526 patent. All the claims require much more than a mere

cache; they require "utilizing download information for the file stored in said cache

storage in response to the user device performed the operation for downloading the file

from the remote server into the assigned storage space." EX1001, 6:7-15. The

Specification describes this claimed method using the system depicted in FIG. 3:

1) The user of the wireless device (1) via a web-browser (8) access to a remote

web server site (15) to obtain information of the data for the downloading via path (a) of

FIG. 3 …

2) The other software modules (9) of the wireless device (1) obtain the downloading information for the data, which becomes available in the cached web-pages on the wireless device (1) after the web-browser (8) access to the web site (15).

3) The other software modules (9) of the wireless device (1) send the obtained downloading information to other service modules (7) of the storage server (3) via path (b) of FIG. 3.

4) Upon receiving the downloading information from the wireless device (1), the other service module (7) of the storage server (3) sends a web download request to the web-site (15) via path (c) of FIG. 3 based on download information obtained. and receives the downloading data streams from the web server of the web-site (15).

5) Upon receiving downloaded data streams, the other service modules (7) of the storage server (3) write the data streams into the file system of the assigned storage volume (11) in the server (3) for the wireless device (1).
EX1001, 5:7-16.[2]

None of the portions of Prust and Major cited by Unified in its Petition and Reply would have taught the claim limitation of utilizing download information in the cache of a wireless device to download a file to an assigned storage space. The so-called "dragging and dropping" alleged to be disclosed in Prust by Unified relates to dragging a file stored on the user's device—not a "remote server," as claimed in the '526 patent.

Unified also alleges that "Prust taught seamless access to remote storage using the

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[2] This portion of the Specification clearly demonstrates that Unified's allegations that the '526 patent does not disclose a cache (Reply, xx) is false.

operating system, browser, and email applications of a wireless device" and "transmitting URLs in an instruction to a remote storage to initiate an out-of-band download of a file at the URL onto the remote storage." Reply, 12. But the portion of Prust that mentions transmitting URLs describes a process in which a user types the URL into an email and sends the email. There is not a whisper of a suggestion in Prust that the URLs would have been retrieved from a cache storage of a wireless device and utilized to download a file from a remote server to assigned storage on a storage server, as claimed by the '526 patent.

Prust, even if combined with Major's teachings of a web cache, would not have taught this important limitation. The mere mention of a web cache would not have taught that download information from the web cache is utilized to download a file from a remote server to a storage server. Moreover, Prust's email application also does not meet the "coupling" limitation that is recited throughout the claims. *Infra*, § III.C; PO Response, 28-30.

When claim limitations are wholly absent from the prior art, contemporaneous documentary evidence is required to support an obviousness theory that relies on modification of the prior art to supply the missing limitations. *K/S HIMPP*, 751 F.3d at 1366. Unified and its expert, Dr. Long, did not provide the required documentary evidence. *See* Reply, 9-13.

Unified's statements that "PO does not meaningfully contest the expert opinions of

Dr. Long," "ignores the wireless device product literature Chaganti," and that PO's expert concedes the so-called "general knowledge" (Reply, 12) are demonstrably false. Mr. Jawadi explained in detail why utilizing download information stored in cache would not have been obvious:

> copy and paste operation (or typing) with web browser cache does not disclose utilizing download information stored in cache (EX2007, pp. 9-46); no reason to add cache to Prust (id. at 14-19); the copy-and-paste (which is heavily relied upon by Unified) is not even mentioned in Prust, Major, or the '526 patent (id. at 19-21); the steps of using copy-and-paste from web browser cache in wireless device are not convention and not obvious (id. at 22-25); the user (not the code) performs copy-and-paste (id. at 25-29); URLs of data objects are not displayed by the browser and cannot be copied directly using copy-and-paste (id. at 29-33); the web page containing the URL must be cacheable (id. at 33); not all web pages are cacheable or cached (id. at 33-36); a user cannot tell if a web page displayed by the web browser is from cache or stored in cache (id. at 36-38); Prust does not discloser where the URL for the purported out-of-band download is obtained from (id. at 38-39); Prust does not disclose out-of-band download through browser or through operating system (id. at 39-41); Typing is impractical (id. at 42-43); Petitioner's theory regarding utilizing download information stored in cache is far fetched (id. at 43-45); and

Purpose of Major's cache does not match the '526 patent (id. at 45-46). Unified's expert had the opportunity to respond to this extensive testimony from Mr. Jawadi but did not do so.

Unified does not nearly show by a preponderance of the evidence that this limitation would have been obvious.

B. The Combination of Prust/Major Would Not Have Taught "a storage space of a predefined capacity assigned exclusively to a user of the wireless device by a storage server."

As explained *supra* § II.A, the proper construction of the claim limitation quoted above requires that "the server assigns an amount of storage, storage to be assigned exclusively for one user, that amount having been set in advance of any interaction or negotiation between the server and user."

Neither of the two sentences relied upon by Unified (Reply, 14, *citing* EX1006, Prust, 4:39-41 and 4:46-49) relates to this claim limitation. The first states that "the storage network 220 defines a pool of virtual storage area 225 that can be individually assignable" (id. at 4:39-41). There is a significant difference between defining a pool of virtual space as taught by Prust and assigning a "predefined capacity" of storage "exclusively to a user," as required by the claims.

The second sentence of Prust (4:46-59) relied upon by Petitioner describes the allocation of storage to a user: "[u]pon prior approval, storage network 220 allocates a storge area 225 to the user such that, as described in detail below, the user can remotely access the corresponding virtual storage area via client computers 205." This is very

different than pre-defining capacity exclusively to a user, as required by the claims. As explained by Mr. Jawadi, "[a] POSITA would have known that predefined capacity means that the server defines, <u>in advance</u>, the amount of storage to allocate to the user before allocating any storage to the user … Petitioner conflates allocating (reserving, setting aside, or holding) and predefining (which happens in advance of allocating)." EX2007, ¶ 187. Unified did not even attempt to show that Prust would have taught the predefined requirement. Nor did it allege that Major compensates for Prust's deficiencies. *See* Reply, 13-14.

Accordingly, Prust would not have taught (i) capacity is predefined exclusively for each user (ii) by the storage server, (iii) before any interaction between the user and storage server. And Unified did not provide any documentary evidence showing that the limitations that are wholly absent from the prior art would have been obvious.

C. The Combination of Prust/Major Would Not Have Taught "coupling of the wireless device with the storage server."

As explained *supra* § I.B, the proper construction of "coupling" is "linking of a system's components to form a relationship." Unified states that "PO's construction is not correct and should be rejected" (Reply, 14) but does not state which construction should be used. *Id.* at 14-15.

Synkloud had explained that Prust's email did not satisfy the "couple" limitation because email does not link components of a system to form a relation. PO Response, 28-30. Unified's argument in response that it "relies on the email embodiment for the storage

operation," not the other claimed operations (Reply, 15), misses the point. Unified relied only upon the email of Prust for the claimed operation of "download[ing] a file from a remote server … into the assigned storage space through utilizing download information for the file stored in said cache storage." This storing operation, as well as the other operations are required to be "carr[ied] out" by "coupl[ing] [the wireless device] with the storage server." EX1001, 6:1-3.

Prust's email is not coupling. Any operation performed by email in Prust does not satisfy the "couple" claim requirement. *Supra,* § II.B. In addition, both the Patent Owner Response (pp. 28-30) and Mr. Jawadi's declaration (EX2007, ¶¶ 126-133) explain why the other two mechanisms for a user device to access the storage server (*i.e.*, browser and operating system) would not have taught the claimed operations.

Once again, Unified fails to set forth any documentary evidence indicating that the "couple" limitation, which is wholly absent from the prior art, would have been obvious. *See* Reply, 14-15.

D. The Combination of Prust/Major Would Not Have Taught "a plurality of storage devices, one of the storage devices being configured with the storage space assigned exclusively to the user."

The claim language itself requires "the storage space assigned exclusively to the user" to be on "*one* of the storage devices." EX1001, 5:65-67 (*emphasis added*). Prust would not have taught this requirement, even under Unified's theory. As Unified admits (Reply, 15), Prust discloses that "[t]he storage device*s* provide a plurality of virtual

storage areas where each virtual storage area is assigned to a user." EX1006, Abstract. That is, Prust discloses that the "virtual storage area assigned to a user" is on a plurality (*i.e.*, two or more) of "storage devices" because the "s" at the end of the term "devices" means that the term is plural. Thus, Prust would not have taught the very different structure of dependent claims 3 and 20, in which "the storage space assigned exclusively to a user" is on "one" storage device. EX2007, ¶¶ 223-231.

Unified's reliance on the disclosure of RAID as one possible embodiment in the '526 patent (Reply, 15) is misplaced because claims need not be construed to encompass all disclosed embodiments where the claim language is clearly limited to one or more embodiment. *TIP Systems, LLC v. Phillips & Brooks/Gladwin, Inc.* (Fed. Cir. June 18, 2008).

E. A POSITA Would Not and Could Not Have Combined Prust and Major and Reasonably Expect Success.

Synkloud and its expert Mr. Jawadi described five groups of reasons why a POSITA would not have been motivated to combine Prust and Major in the manner suggested by Unified: (i) there was no reason to add Major's cache to Prust (ii) Major's teachings discourage wireless device access to external storage (iii) Major stores data objects in cache, negating the need for external storage (iv) Prust discourages using only one mode to access remote storage and (v) Prust does not disclose out-of-band download through a browser. EX2007, pp. 70-77. Unified ignored them. *See* Reply, 16.

Instead, Unified limits its response to an incomplete portion of only one of

Synkloud's arguments relating to Major's desire to reduce wireless access. Reply, 16. In the complete argument, Synkoud and Mr. Jawadi explained that Major discourages wireless access to external storage and teaches storing data objects in a "raw data cache" to thereby negate the need for external storage. PO Response, 34; EX2007, ¶¶ 243-248. Unified ignores this argument. Reply, 16. Indeed, Unified's expert did not even respond to Mr. Jawadi at all. Unified's obviousness analysis is flawed because it fails to address the reasons that would have discouraged a POSITA from combining the prior elements in the manner claimed by the '526 patent. *In re Dow Chem. Co*. 837 F.2d. 469 (Fed. Cir. 1988) (all information, "including that which might lead away from the claimed invention" must be considered).

IV. **None Of The Claims Would Have Been Obvious Over The Combination Of Chaganti and Major Under The Proper Claim Construction.**

A. **The Combination of Chaganti/Major Would Not Have Taught "download[ing] a file utilizing download information for the file stored in said cache storage."**

Chaganti and Major would not have taught the claim limitation quoted above. Neither reference makes any mention of utilizing download information for the file stored in the cache storage of the wireless device to download a filed from a remote server to an assigned storage space, as required by independent claims 1 and 11.

Unified's arguments in response are internally inconsistent. It first "states that Patent Owner criticized Chaganti for not 'teach[ing] a URL'" but later quotes that Patent

Owner as acknowledging that "'a line to a URL pointing to a digital item appears in Chaganti.'" Reply 18, *quoting* PO Response 38. More importantly, Unified's arguments are not commensurate with the scope of the claims. The mere mention of a link containing a URL is not nearly sufficient to show that the URL is retrieved from a cache and utilized to download a file from a remote server to an assigned storage space. EX2007, ¶¶ 310-333.

B. The Combination of Chaganti/Major Would Not Have Taught "a storage space of a predefined capacity assigned exclusively to a user of the wireless device by a storage server."

None of the portions of Chaganti and Major cited in the Institution Decision and the Petition would have taught the claim limitation quoted above. EX2007, ¶¶ 338-351. Those portions disclose allocating storage by the user (not the server as required by the claims) and allocating additional storage as the need arises (not a predefined capacity as required by the claims). *Ibid*.

In response, Unified refers to the same arguments in its Petition that were shown to be deficient by Mr. Jawadi; it does not provide any response from its expert or present any documentary evidence showing that this limitation, which is wholly absent from the prior art, would have been obvious.

C. The Combination of Chaganti/Major Would Not Have Taught "one of the storage devices being configured with the storage space assigned exclusively to the user," As Required By Dependent Claims 3 and 20.

Neither Unified's Petition nor Reply identifies any teaching in Chaganti or Major

of a single storage device having storage space that is assigned exclusively to one user (*i.e.*, that no other user may be assigned the same storage space). In addition, Unified did not set forth any contemporaneous documentary evidence showing that this limitation that is wholly absent from the prior art would have been obvious. *See* Reply, 20.

D. The Combination of Chaganti/Major Would Not Have Taught "obtaining and transmitting download information from the cache of a wireless device," As Recited In Dependent Claims 4 and 12.

As explained above, neither Chaganti nor Major mention where any download information is obtained from, let alone that it is obtained from a cache of a wireless device. *Supra*, § III.A; EX2007, ¶¶ 359-360. Unified did not set forth any contemporaneous documentary evidence showing that this limitation that is wholly absent from the prior art would have been obvious and Unified's expert did not respond to Mr. Jawadi. *See* Reply, 20-21.

E. The Combination of Chaganti/Major Would Not Have Taught That The Wireless Device Remotely Creates, Deletes, Moves, Copies Or Renames A Folder, As Required By Dependent claims 6, 7, 10, 13, 14, and 15.

Chaganti describes a library on the storage server that "may be partitioned to have a number of directories and sub-directories" (EX1008, 3:41-45; *see also id.* at 17:51-63), but as explained by Mr. Jawadi, does not teach or suggest that "**the wireless device** (remotely) **creates, deletes, moves, copies, or renames** a directory or directory structure." EX2007, ¶364 (*emphasis in original*).

Unified responds with conclusory attorney argument that "in Chaganti … the user

operates on the user's library using their wireless device, user computer 104." Reply, 21. But Unified's argument is not commensurate with the scope of the claims because they require much more than operating on a library. They recite creating a "folder structure," "folder," "remotely deleting or moving or copying or renaming a folder," etc. EX2007, ¶¶ 364-366. These claim limitations are wholly absent from the Chaganti/Major combination. *Ibid.* Unified did not set forth any contemporaneous documentary evidence showing that this limitation that is wholly absent from the prior art would have been obvious. *See* Reply, 21.

F. A POSITA Would Not Have and Could Not Have Combined Chaganti and Major and Reasonably Expect Success.

Synkloud and its expert Mr. Jawadi explained why a POSITA would not have been motivated to combine the teachings of Chaganti and Major and reasonably expect success. EX2007, ¶¶ 368-384. Mr. Jawadi explained that "Chaganti's cache is not used for out-of-band download, and Major does not describe any external storage and does not deal with out-of-band download." Id. at ¶ 376. He further explained that neither Chaganti nor Major mention copy-and-paste and that the "Dragging and Dropping" mentioned by Chaganti "does not deal with out-of-band download." Id. at ¶ 378. He also explained why "Major's Teachings Discourage Wireless Device Access to External Storage" and why "Combining Two Different Cache Implementation Is Difficult." *Id.* at ¶¶ 380-384.

Neither Unified nor its expert, however, responded to Mr. Jawadi's explanation. *See* Reply, 21. Although Unified states "that the requester and user may be the same

person," *ibid.,* it fails to address the disclosure in Chaganti describing a "'user,' who is a person or computer program that creates or effectively 'owns' the online personal library" (EX1008, 2:28-34) as *a separate entity* than "[t]he requester computer 106." *Id.* at 8:49-63.

Unified's obviousness analysis is flawed because if ignores nearly all the reasons set forth by Mr. Jawadi that would have discouraged a POSITA from combining the prior elements in the manner claimed by the '526 patent. *In re Dow Chem. Co.* 837 F.2d. at 469.

V.   Objective Indicia of Non-obviousness Support The Patentability Of The Claims Of The '526 Patent.

Unified's obviousness arguments are very weak. Several claim limitations are wholly absent from the prior art and Unified failed to provide contemporaneous, documentary evidence showing the missing limitations would have been obvious. *Supra*, § III. In contrast, the objective indicia of non-obviousness are very strong. ███ took a license to the '526 patent and related patents for ███████ (EX2011, 3) substantially more than the cost of prosecuting an *inter partes review*.

Unified's response is essentially twofold. First, it argues with reliance on *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898 (Fed. Cir. 1985) that the license to the '526 patent was taken "'because of business judgments that it is cheaper to take licenses than to defend infringement suits." Reply, 23, *quoting EWP Corp.*, 755 F.2d at 908. But *EWP Corp.* in inapposite. There, the evidence of obviousness outweighed the secondary

considerations of non-obviousness because the prior art taught "the very technique essential to the claimed invention--crimping of wire which is to be stretched later." *Id.* at 907. Here the techniques essential to the claim invention—utilizing the download information in the cache of a wireless device to store data from a remote site to assigned storage space of a capacity predefined by the server—are wholly absent from the teachings of the prior art. Moreover, the *EWP Corp.* decision issued in 1985, long before the America Invents Act (AIA) introduced *inter partes review* (IPR) "to provide 'quick and cost effective alternatives to litigation." H.R. REP. NO. 112–98, pt. 1, at 48 (2011). In *EWP Corp.*, the defendant would have needed to litigate the patentability of the asserted patent in district court. Here, the licensee to the '526 patent could have chosen the cheaper option of prosecuting an IPR against the '526 patent. Nonetheless, it chose to take a license for an amount that is far an excess of the cost of an IPR. Unified's reliance on *Iron Grip Barbell Co. v. USA sports, Inc.*, 392 F.3d 1317 (Fed. Cir. 2004) is misplaced for the same reasons. There, the claimed technique of putting handles on plates to that they could be more easily placed on barbells was taught by the prior art. Also, *Iron Grip Barbell*, like *EWP Corp.* was decided well before the cheaper IPRs became available with the passage of the AIA.

Second, Unified also argues with reliance on *Fox Factory, Inc. v. SRAM, LLC,* 944 F.3d 1339 (Fed. Cir. 1999), that there is no nexus between the license and the '526 patent. Reply, 22-23, *citing Fox Factory, Inc.*, 944 F.3d at 1373. But *Fox Factory Inc.* is

inapposite. There, the Court held that there was no nexus because the commercial success was due to an unclaimed feature. *Ibid.* 1375. Here, there is a nexus between the license and the '526 patent. Indeed, the '526 patent is explicitly listed in the license. Moreover, it is well-known that ████ sells its wireless ████ with a cloud storage service (████). The claims of the '526 patent are directed to the very same combination of a wireless device and cloud storage. In particular, the '526 patent claims a wireless device (*e.g.*, the ████) that utilizes download information to store a file from a remote storage (e.g., a web site) to storage space on an external server (*e.g.*, ████). Unified's reliance on *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339 (Fed Cor. 1999) is also misplaced because there, the Court found that there was the requisite nexus between the commercial success and the claimed invention. *Id.* at 1359.

The strong evidence of objective indicia of non-obviousness, when viewed in light of Unified's very weak argument for obviousness, indicates that the challenged claims of the '526 patent are patentable.

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CERTIFICATE OF COMPLIANCE

This Paper contains 5,584 words, excluding the portions exempted by 37 C.F.R.

¶42.24(a)(1). Accordingly, this Paper complies with the requirements of 37 C.F.R. §

42.24(b)(1).

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CERTIFICATE OF SERVICE

Under 37 C.F.R. §§ 42.6(e), this is to certify that I caused an electronic copy of the foregoing PATENT OWNER'S SUR-REPLY and its exhibits to be served on the Petitioner's lead and backup counsel listed below by filing in the Patent Review Processing System and by email to the following email addresses:

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