Trials@uspto.gov
571-272-7822

Paper 21
Entered: June 29, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION and HP INC.,
Petitioner,

v.

SYNKLOUD TECHNOLOGIES, LLC,
Patent Owner.

IPR2020-00316
Patent 9,098,526 B1

Before SALLY C. MEDLEY, JESSICA C. KAISER, and SCOTT RAEVSKY, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Microsoft Corporation and HP Inc. (collectively "Petitioner") filed a Petition for *inter partes* review of claims 1–20 of U.S. Patent No. 9,098,526 B1 (Ex. 1001, "the '526 patent"). Paper 1 ("Pet."). Synkloud Technologies, LLC ("Patent Owner") filed a Preliminary Response. Paper 8[1] ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). Upon consideration of the Petition, the Preliminary Response, and the evidence of record, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least one claim of the '526 patent. Accordingly, for the reasons that follow, we institute an *inter partes* review of claims 1–20 of the '526 patent.

A. Related Matters

Petitioner indicates that the '526 patent is or has been the subject of, or relates to, the following court proceedings: *Synkloud Technologies, LLC v. HP Inc.*, Case No. 1-19-cv-01360 (D. Del. filed July 22, 2019) and *Synkloud Technologies, LLC v. BLU Products, Inc.*, Case No. 1-19-cv-00553 (D. Del. filed Mar. 22, 2019). Pet. 3 (Mandatory Notices). Petitioner also indicates that the '526 patent is the subject of IPR2019-01655, for which a decision to institute *inter partes* review has been granted. *Id.* (citing *Unified Patents LLC v. Synkloud Technologies, LLC*, IPR2019-01655 (PTAB Sept.

[1] Patent Owner filed two identical Preliminary Responses. Papers 7, 8. We refer to Paper 8. In this decision, we further expunge Paper 7 as duplicative.

30, 2019) ("IPR1655")); *see* IPR1655, Paper 13.[2] In IPR1655, Unified Patents LLC filed a petition challenging claims 1–20 of the '526 patent based on prior art not asserted in the instant Petition. IPR1655, Paper 1 at 1.

Petitioner argues that we should not exercise our discretion to deny institution under 35 U.S.C. § 314(a), citing and discussing the *General Plastic* factors. Pet. 3–5 (citing *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)). In particular, Petitioner asserts that

> none of the General Plastic factors weigh in favor of denial because, for example, (1) a different petitioner challenged the 526 in that earlier proceeding, (2) Petitioners' grounds in this proceeding all rely on different prior art than that earlier proceeding, and (3) Petitioners have not already received the Preliminary Patent Owner response for that earlier proceeding.

Id. at 5. Patent Owner does not contest Petitioner's showing as to this issue. *See generally* Prelim. Resp. Based on the record before us, having considered Petitioner's showing and the *General Plastic* factors, we determine not to exercise our discretion to deny institution under § 314(a).

B. The '526 Patent

The Specification of the '526 patent describes how a wireless device may use external storage provided by a storage server. Ex. 1001, 1:23–24. The '526 patent aims to address the lack of storage capacity faced by users

[2] Two additional court proceedings, which assert continuation patents sharing a common specification with the '526 Patent, were identified in IPR1655: *Synkloud Technologies, LLC v. Dropbox, Inc.,* Case No. 6:19-cv-00526 (W.D. Tex. filed Sept. 6, 2019) and *Synkloud Technologies, LLC v. Adobe Inc.*, Case No. 6:19-cv-00527 (W.D. Tex. filed Sept. 6, 2019). *See* IPR1655, Paper 13 at 3.

on their wireless devices by allowing a wireless device to use an external server for storing and retrieving data. *Id.* at 2:29–37, 5:1–41.

In one embodiment, the storage server's external storage may be partitioned by dividing it into multiple small volumes of storage space that may be exclusively assigned to users. *Id.* at 4:1–31. Partitioning may be done through a web-console on a console host by an administrator. *Id.* at 4:5–8. Based on storage information received from the storage server's support software, the administrator may use the web-console to partition each storage device and send storage partition information to the support software. *Id.* at 4:9–18. The support software may perform the actual partition by dividing the storage device into multiple small volumes, each of which may be exclusively assigned to and used by a user of a specific wireless device. *Id.* at 4:21–31.

The '526 patent also describes a "wireless out-band download" approach for downloading data from a remote location to an assigned storage volume. *Id.* at 2:8–10, 2:50–53, 5:1–30, Fig. 3.

Figure 3 is illustrative and is reproduced below.

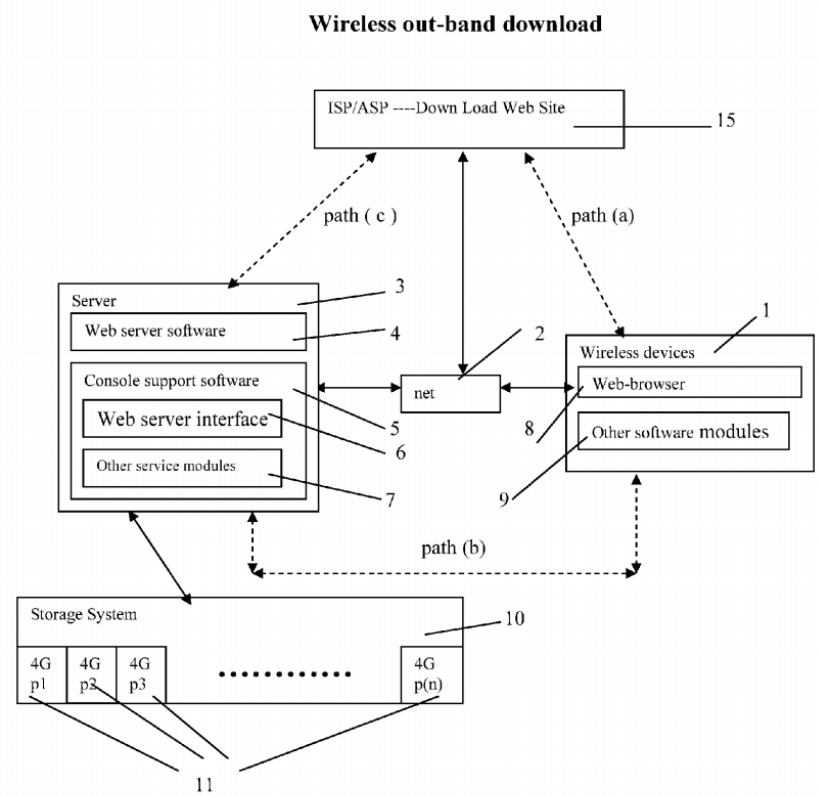

Fig. 3

Figure 3 shows a "wireless out-band download" approach, which includes a sequence of steps for downloading data from a remote web site server 15 into an assigned storage volume 11 of external storage system 10 on server 3. *See id.* at 2:8–10, 2:50–53, 5:1–30. First, the user of wireless device 1 may access remote web server site 15 via web-browser 8 to obtain information about the data for downloading (e.g., data name) via path (a). *Id.* at 5:8–12. Second, other software modules 9 of wireless device 1 may obtain the download information for the data, which becomes available in cached web-pages on wireless device 1. *Id.* at 5:13–17. Third, the other software modules 9 of wireless device 1 may send obtained download information to other service modules 7 of storage server 3 via path (b). *Id.* at 5:18–20. Fourth, other service modules 7 may send a web download request

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