

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

MOTION OFFENSE, LLC,
Patent Owner.

IPR2022-01312
Patent 10,613,737 B1

Before JEFFREY S. SMITH, JENNIFER S. BISK, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

Google LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–5, 13, and 14 of U.S. Patent No. 10,613,737 B1 (Ex. 1001, “the ’737 patent”) pursuant to 35 U.S.C. § 311(a). Motion Offense, LLC (“Patent Owner” or “PO”) responded by filing: a Disclaimer in Patent, under 37 C.F.R. § 1.321(a), disclaiming claims 1–5 and 13 (Ex. 2001); and a Preliminary Response (Paper 7, “Prelim. Resp.”), pursuant to 35 U.S.C. § 313, defending only claim 14. Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 10, “Pet. Reply”) as “authorized . . . to address Patent Owner’s arguments regarding discretionary denial under 35 U.S.C. § 314(a) in the Patent Owner’s Preliminary Responses” (Ex. 1020 (Board’s email, December 29, 2022, to the parties)). Patent Owner filed a Sur-Reply to that Reply (Paper 12 (“Sur-Reply”)) as “authorized to . . . address[] the same issue” (Ex. 1020).

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary 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.” For the reasons that follow, we institute an *inter partes* review as to claim 14 of the ’737 patent on the sole ground of unpatentability asserted in the Petition (*see infra* § VI (asserted ground)).

II. REAL PARTIES-IN-INTEREST

Petitioner identifies itself (Google LLC) as its sole real party-in-interest and notes it “is a subsidiary of [entities that] are not real

parties-in-interest to this proceeding.” Pet. 1. Patent Owner identifies itself (Motion Offense, LLC) as its sole real party-in-interest. Paper 4, 2.

III. RELATED MATTERS

Petitioner states that the ’737 patent is the subject of the following proceedings: *Dropbox, Inc. v. Motion Offense, LLC*, Case No. 6:20-cv-00251-ADA (W.D. Tex.); and *Motion Offense, LLC v. Google LLC*, Case No. 6:21-cv-00514-ADA (W.D. Tex.). Pet. 1. Petitioner further states they have concurrently filed: an IPR petition challenging U.S. Patent No. 10,303,353 (“the ’353 patent”) that is also at issue in the above actions; and an IPR petition challenging U.S. Patent No. 11,044,215 (“the ’215 patent”) that is also at issue in the second of the above actions (Case No. 6:21-cv-00514-ADA) and in *Motion Offense, LLC v. Dropbox, Inc.*, Case No. 6:21-cv-00758-ADA (W.D. Tex.). *Id.* PTAB records identify the above two petitions as respectively IPR2022-01311 and IPR2022-01313. The above three patents identify their respective applications as being continuation applications of an in-common U.S. patent application (No. 14/274,623).

Patent Owner also identifies each of the above actions and two IPR proceedings as “judicial and/or administrative matters that may affect, or may be affected by, a decision in the *Inter Partes* Review.” Paper 3, 2. Patent Owner describes the relatedness as “[t]wo parallel district court cases [that] involve the same patent, same claim[14,] and same art” (Prelim. Resp. 1) and designates the two cases as the above (1) Dropbox litigation of Case Nos. 6:20-cv-00251-ADA and 6:21-cv-00758-ADA (“Dropbox Litigations”) and (2) Google litigation of Case No. 6:21-cv-00514-ADA (“Google Litigation”). Prelim. Resp. 1, 22–26.

IV. THE '737 PATENT (Ex. 1001)

The '737 patent relates to sharing the contents of a folder using an email message and a file explorer interface without an attachment included with the email message. Ex. 1001, Abstract. An example process is summarized by the steps of Figures 2A and 2B. *Id.* at 7:6–13. A first part of the process creates and transmits a message including a “mount descriptor.” *Id.* at 27:35–40; 28:44–48; 30:37–40; 31:8–15; Figs. 2B, 8A. A “second” communications agent represents a second user and, in a first step 212, receives data object information identifying a data object in a “second” data store of a “second” execution environment that includes the second communications agent. *Id.* at 27:35–40; Fig. 2B. In the next step 214, the mount descriptor is created and configured for accessing the data object by a “first” data store in a “first” execution environment that includes a “first” communications agent that represents a “first” user. *Id.* at 28:44–48. In the next step 216, the second communications agent places the mount descriptor in a “first” message addressed to the first user. *Id.*, 30:37–40. In the next step 218, the second communications agent sends the first message to the first communications agent. *Id.* at 31:8–11.

A second part of the process uses the mount descriptor to create a representation of the data object in the first data storage and provide access to the data object (from the second data store). *Id.* at 20:58–66; 22:15; 22:61–62; 25:6–9; Fig. 2A. In the first step 202, the first communications agent receives the first message (which includes the mount descriptor) from the second communications agent. *Id.* at 20:58–66. In the next step 204, the first communications agent detects the mount descriptor. *Id.* at 22:15. In the next step 206, the first communications agent determines a “first” location of

the data object in the first data store. *Id.* at 22:61–62. In the next step 208, the first communications agent creates, based on the mount descriptor, the representation of the data object in the first data storage. *Id.* at 25:6–9.

V. ILLUSTRATIVE CLAIMS

Challenged claim 14 of the ‘737 patent depends from, and thus incorporates, disclaimed independent claim 3 and intervening claim 13. We reproduce, below, disclaimed claims 3 and 13 and challenged claim 14¹ (with the Petitioner’s identifiers of limitations in brackets).

3. [a] An apparatus, comprising:
 - [b] at least one non-transitory memory storing instructions; and
 - [c] one or more processors in communication with the at least one non-transitory memory, wherein the one or more processors execute the instructions to:
 - [d] send first hypertext markup language-equipped code via at least one network to a first node, [e] for causing, at the first node, display of at least one first interface with a first user interface element, utilizing the first hypertext markup language-equipped code that is sent via the at least one network, and [f] for allowing receipt, from the first node via the at least one network, an indication of at least one folder that is received via the first user interface element of the at least one first interface;
 - [g] send second hypertext markup language-equipped code via the at least one network to the first node, [h] for causing, at the first node, display of at least one second interface with a second user interface element, utilizing the second hypertext markup language-equipped code that is sent via the at least one network, [i] for allowing receipt, from the first node via the at least one network, indicia associated with at least one email address that is

¹ Because only claim 16 was not disclaimed, only claim 16 is presently challenged and will be identified as such.

received via the second user interface element of the at least one second interface and [j] for allowing receipt, from the first node via the at least one network, an indication to share the at least one folder;

[k] based on the receipt of the indication of the at least one folder, the indicia associated with the at least one email address, and the indication to share the at least one folder via the at least one network; cause generation of at least one email message identifying the at least one folder and including a reference to the at least one folder, without including at least one file in the at least one folder as an attachment of the at least one email message;

[l] cause to be sent, to a second node via the at least one network, the at least one email message, without including the at least one file in the at least one folder as an attachment of the at least one email message;

[m] send particular code via the at least one network to the second node for storage at the second node and cooperation with a file explorer interface, [n] for causing, based on the receipt of the indication of the at least one folder, the indicia associated with the at least one email address, and the indication to share the at least one folder via the at least one network: creation of a representation of the at least one folder in a location among one or more folders on the file explorer interface, where the second node is not caused to store the at least one file when the creation of the representation of the at least one folder is caused, and for: [o] causing, at the second node, display of the representation of the at least one folder in the location among the one or more folders on the file explorer interface; [p] allowing detection, at the second node, of an indication to open the at least one file in the at least one folder; and [q] in response to detection of the indication to open the at least one file in the at least one folder, causing retrieval of the at least one file via the at least one network for permitting display of the at least one file at the second node.

13. The apparatus of claim 3, wherein the apparatus is configured such that, when the creation of the representation of the at least one folder is caused, an additional representation on the file explorer interface is caused to be created that represents the at least one file, where the file explorer interface is displayed by a file explorer client application without a web page.

14. The apparatus of claim 13, [a] wherein the apparatus is configured such that the at least one folder and the at least one file are stored and synchronized utilizing at least one server, and [b] wherein the apparatus is further configured such that the at least one email message is caused to be sent without including the at least one file as an attachment of the at least one email message, and [c] the second node is not caused to store the at least one file when the creation of the representation of the at least one folder is caused, both for avoiding the at least one file from having to be communicated to and stored at the second node until the at least one file is requested by a user at the second node using the additional representation.

Ex. 1001, 44:26–45:22, 46:1–7, 48:55–49:34 (formatting modified and Petitioner’s identification of limitations added in brackets).

Because Petitioner’s arguments for claims 3, 13, and 14 frequently refer to arguments for disclaimed independent claim 1 and disclaimed depending claim 2, we also reproduce, below, claims 1 and 2 (with the Petitioner’s identifiers of limitations in brackets) for comparison to claims 3, 13, and 14. *See, e.g., id.* at 62 (“Claim element 3.b recites features substantially the same as those recited in claim element 1.a. Thus, the combination of Houston and Garcia discloses this feature for at least the same reasons.”).

1. [a] A non-transitory computer readable storage medium storing one or more programs, the one or more programs comprising instructions which, when executed by an apparatus, cause the apparatus to:

- [b] cause display, at a first node, of a first user interface element, a second user interface element, and a third user interface element;
- [c] allow receipt, at the first node, of information associated with at least one folder via the first user interface element;
- [d] cause to be sent, from the first node via at least one network, the information associated with the at least one folder;
- [e] allow receipt, at the first node, of an object associated with at least one email address via the second user interface element;
- [f] cause to be sent, from the first node via the at least one network, the object associated with the at least one email address;
- [g] allow receipt, at the first node, of an indication of a selection of the third user interface element; and
- [h] cause to be sent, from the first node via the at least one network, the indication of the selection of the third user interface element;
- [i] after the information associated with the at least one folder, the object associated with the at least one email address, and the indication of the selection of the third user interface element are caused to be sent via the at least one network; allow receipt, at a second node via the at least one network, at least one email message identifying the at least one folder and including a reference to the at least one folder, without including a file attachment with the at least one email message;
- [j] after the information associated with the at least one folder, the object associated with the at least one email address, and the indication of the selection of the third user interface element are caused to be sent via the at least one network; cause creation, utilizing code sent to the second node to be stored on a storage at the second node and further to cooperate with a file explorer interface, of a representation of the at least one folder in a location among one or more folders on the file explorer interface, where the storage of the second node does not store any file in the at least one folder when the representation of the at least one folder is created; and

[k] cause display, at the second node, of the representation of the at least one folder in the location among the one or more folders on the file explorer interface.

2. The non-transitory computer readable storage medium of claim 1, [a] wherein the object associated with the at least one email address includes the at least one email address or an alias, and [b] the file explorer interface is caused to be displayed using a file explorer client application and not via a web page; [c] wherein the at least one email message is caused to be sent without including the file attachment with the at least one email message, and [d] the storage at the second node does not store any file when the representation of the at least one folder is created, both for avoiding the at least one file from having to be communicated to and stored at the second node until the at least one file is requested by a user at the second node.

Ex. 1001, 43:32–44:25 (formatting modified and Petitioner’s identification of limitations added in brackets).

VI. ASSERTED GROUND

Petitioner asserts that claim 14 is unpatentable on the following ground.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
14	103(a)	Houston ² , Garcia ³

In support of its patentability challenge, Petitioner relies on, *inter alia*, the Declaration of Henry Houh, Ph.D. Ex. 1002 (“Houh Decl.”).

VII. LEVEL OF ORDINARY SKILL

Petitioner states a

person of ordinary skill in the art . . . (‘POSITA’) would have had a bachelor’s degree in electrical engineering, computer

² U.S. Patent No. 8,825,597 B1 (Ex. 1005).

³ U.S. Patent No. 9,633,125 B1 (Ex. 1006).

engineering, computer science, or a related field, or an equivalent technical degree or equivalent work experience, and at least two years of experience in the field of software development.

Pet. 4. Patent Owner “agrees with Petitioner’s definition of a POSITA with one exception”—arguing for removal of the qualifier “at least” from the Petitioner’s above statement. Prelim. Resp. 27.

The level of ordinary skill in the art usually is evidenced by the references themselves. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

As Petitioner’s description of a person of ordinary skill appears commensurate with the subject matter before us, we apply Petitioner’s definition for purposes of this Decision.

VIII. 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) (2019). In this context, claim terms “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (citations omitted) (en banc). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is “less significant than the

intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317.

We construe only those claim terms that require analysis to determine whether to institute inter partes review. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that “only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy”). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner submits that “[n]o express constructions of any claim terms are necessary to resolve this Petition. (EX1002 ¶ 28.)” Pet. 5. Patent Owner does not respond (nor propose constructions). *See generally*, Prelim. Resp. For purposes of this Decision, we agree that no terms need be explicitly construed.

IX. ANALYSIS

A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

A claim is unpatentable under 35 U.S.C. § 103(a) if “the differences between the subject matter sought to be patented and the prior art are such that the subject 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) when in evidence, objective evidence of obviousness or nonobviousness, i.e., secondary considerations.⁴ See *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). An obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418.

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2016) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). Furthermore, Petitioner does not satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record, to support

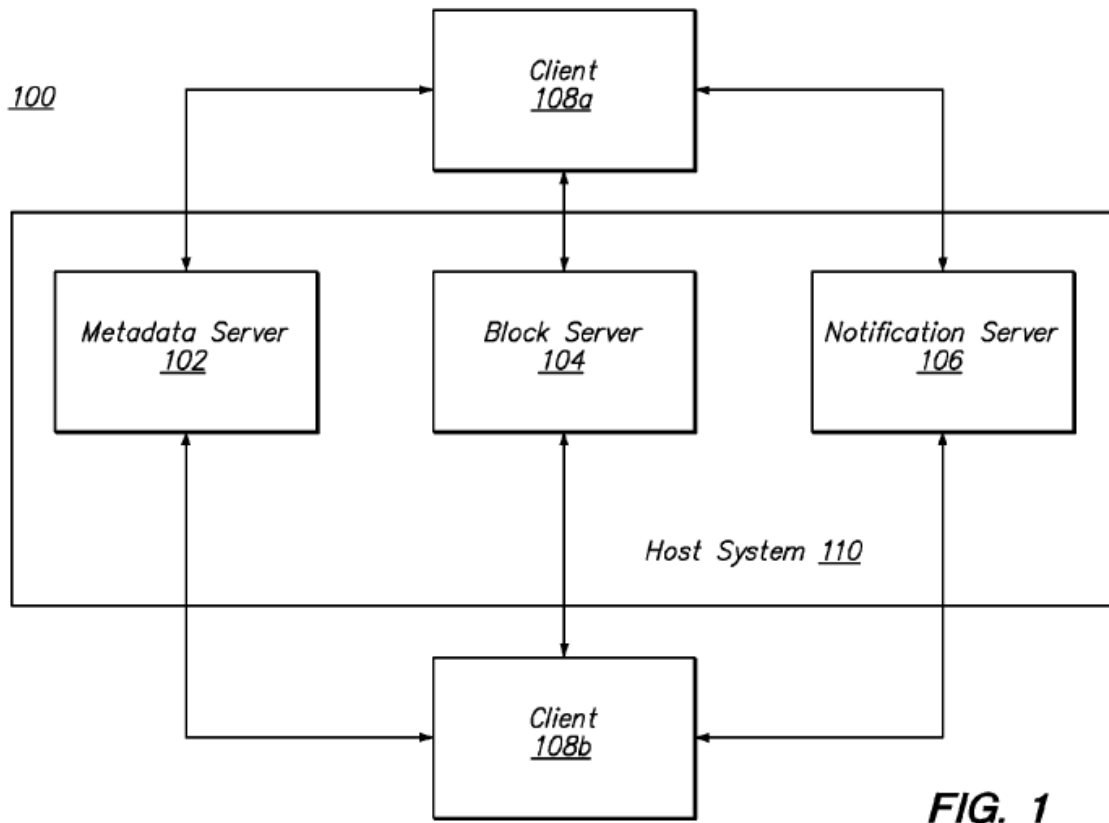
⁴ The record, at this point in the proceeding, does not contain evidence of secondary considerations.

the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Claim 14 As Obvious Over Houston and Garcia

1. Houston—Exhibit 1005

Houston “relates generally to sharing of data over a network” and “is directed to synchronization of a folder and its contents shared between multiple clients.” Ex. 1005, 1:15–18. Houston’s Figure 1, reproduced below (next page), “is a block diagram of a host system and clients for maintaining synchronized shared folders.” *Id.* at 2:22–23. System 100 includes clients 108a, 108b and a host system 110, and further includes a metadata server 102, a block server 104, and a notification server 106. *Id.* at 2:59–62.



Houston's Figure 1, reproduced above, "is a block diagram of a host system and clients for maintaining synchronized shared folders." *Id.* at 2:22–23.

Client 108 enables a user to create, modify and delete files on the client's local file system, and for those actions to be synchronized with versions of the same files on host system 110 and on one or more other client computers. Ex. 1005, 3:25–28. A user creates a folder and designates it as one that should be synchronized, and its contents are then managed by client 108 to maintain that synchronization. *Id.*, 3:29–31. A user can create a shared synchronized folder either through a user interface portion of client 108, or via a web server. *Id.* at 3:31–34.

Block server 104 receives, stores, and serves blocks of data constituting synchronized files. Ex. 1005, 2:66–67. Metadata server 102 receives requests from clients to update block server 104’s copy of synchronized folders and provides clients with a list of metadata for files being synchronized. *Id.* at 2:63–65. Notification server 106 provides updates to clients when a synchronized folder has been updated on the block server 104. *Id.* at 2:67–3:3.

Houston’s Figure 3, reproduced below (next page), “illustrates a user interface window for creating a shared synchronized folder” (Ex. 1005, 2:28–29), i.e., of existing folders to be shared. Houston’s Figure 4, reproduced below (next page), “illustrates a user interface window for sharing a folder.” *Id.* at 2:31–33. Once the user has chosen or created the folder to be shared, and via the user interface window 400, the user can invite those people with whom he would like to share the folder. *Id.* at 3:40–43.

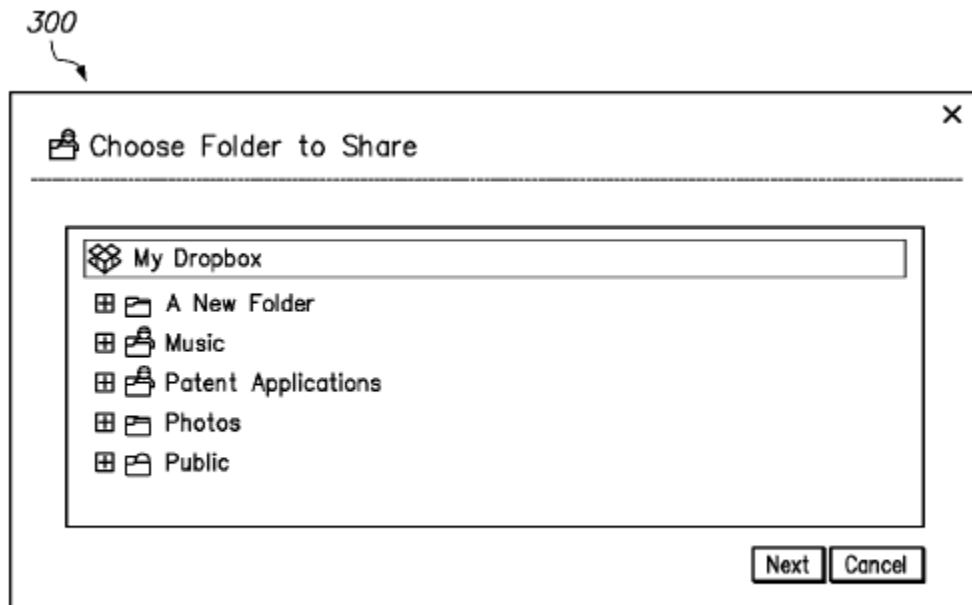


FIG. 3

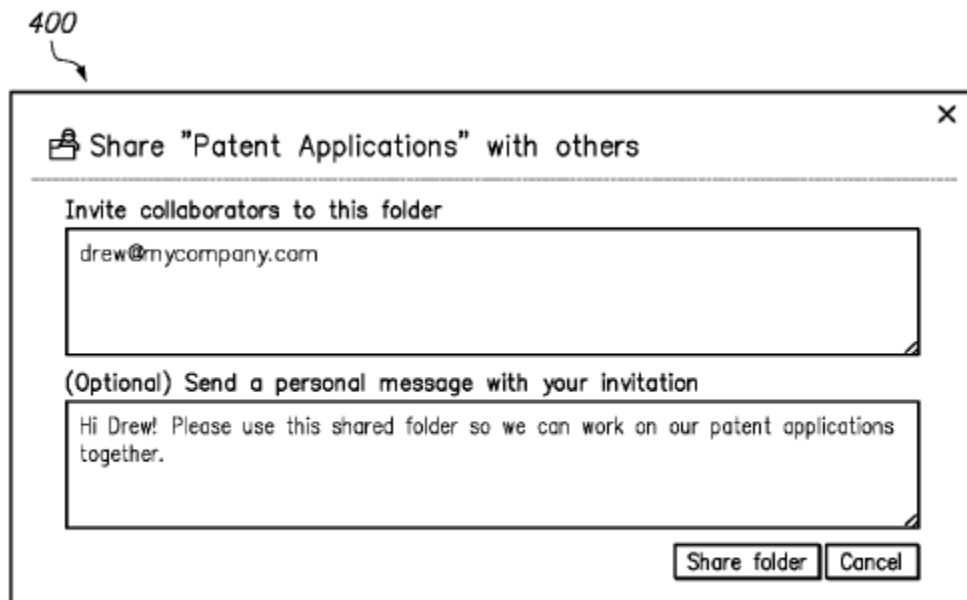


FIG. 4

Houston's Figure 3, reproduced above, "illustrates a user interface window for creating a shared synchronized folder" (*id.*, 2:28–29), i.e., of existing folders to be shared. Houston's Figure 4, reproduced above, "illustrates a user interface window for sharing a folder." *Id.*, 2:31–33.

Houston's Figure 10, reproduced below, "illustrates an interface for interacting with shared folders." *Id.*, 2:48–49. A first user has "My Dropbox" folder 1002 synchronized with a host system 110 that performs namespace mapping functions and allows users of system 100 to interact with shared folders through their operating system's standard user interface. *Id.*, 7:18–22.

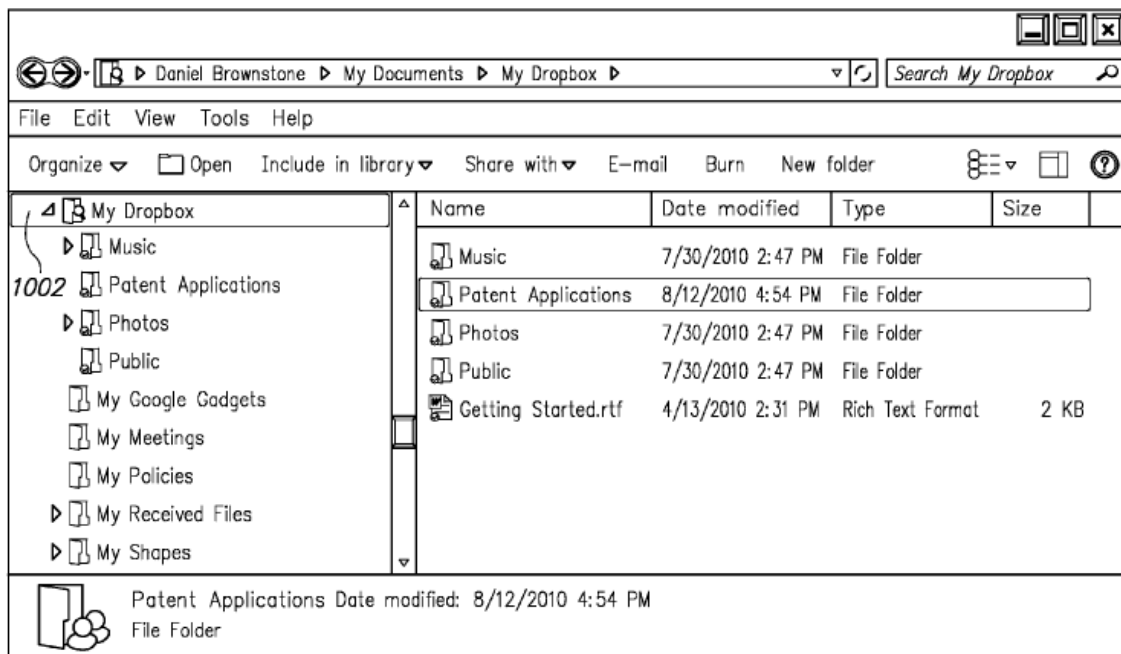
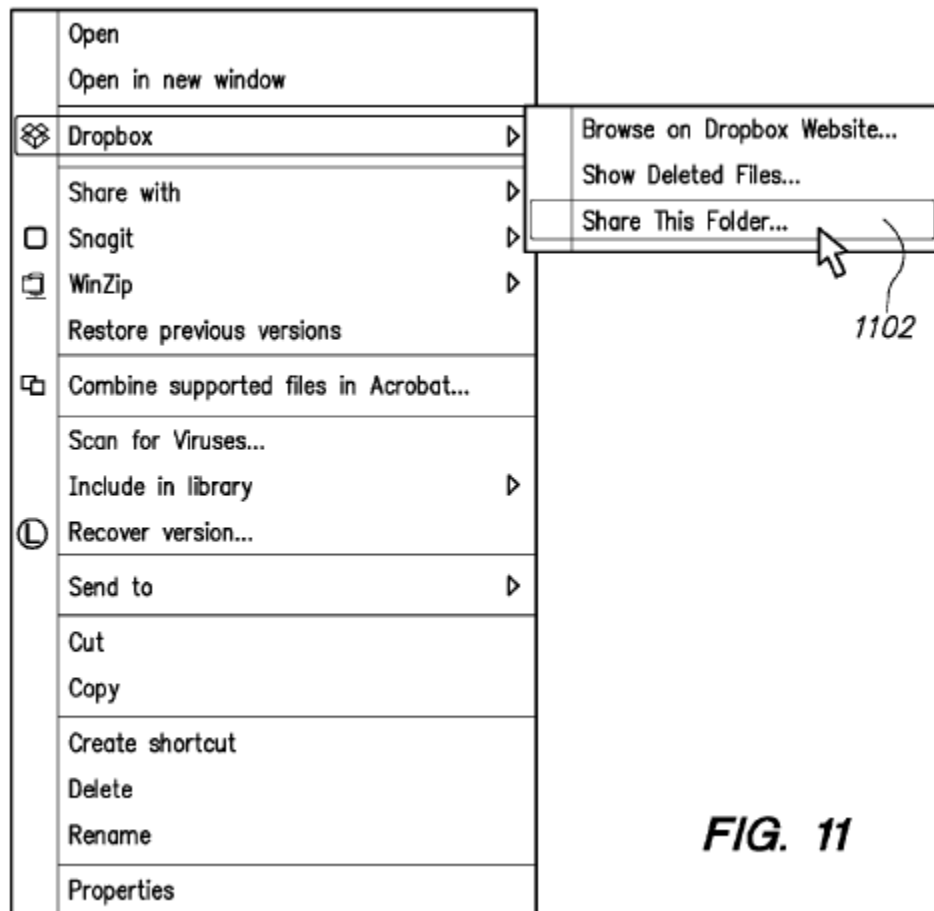


FIG. 10

Houston's Figure 10, reproduced above, "illustrates an interface for interacting with shared folders." *Id.*, 2:48–49.

Houston's Figure 11, reproduced below (next page), "illustrates a selection menu for sharing a folder." Ex. 1005, 2:51–52. By right-clicking on the folder name and selecting a "Share This Folder ..." option 1102, a user indicates that they wish to share the "Patent Applications" folder. *Id.* at 7:32–36. Alternatively, the user can use a web interface to communicate the share instructions to host system 110. *Id.* at 7:37–38. In either event, the



Houston’s Figure 11, reproduced above, “illustrates a selection menu for sharing a folder.” *Id.* at 2:51–52.

user also specifies the account identifier of the user(s) with whom the folder is to be shared. *Id.* at 7:38–40.

2. Garcia—Exhibit 1006

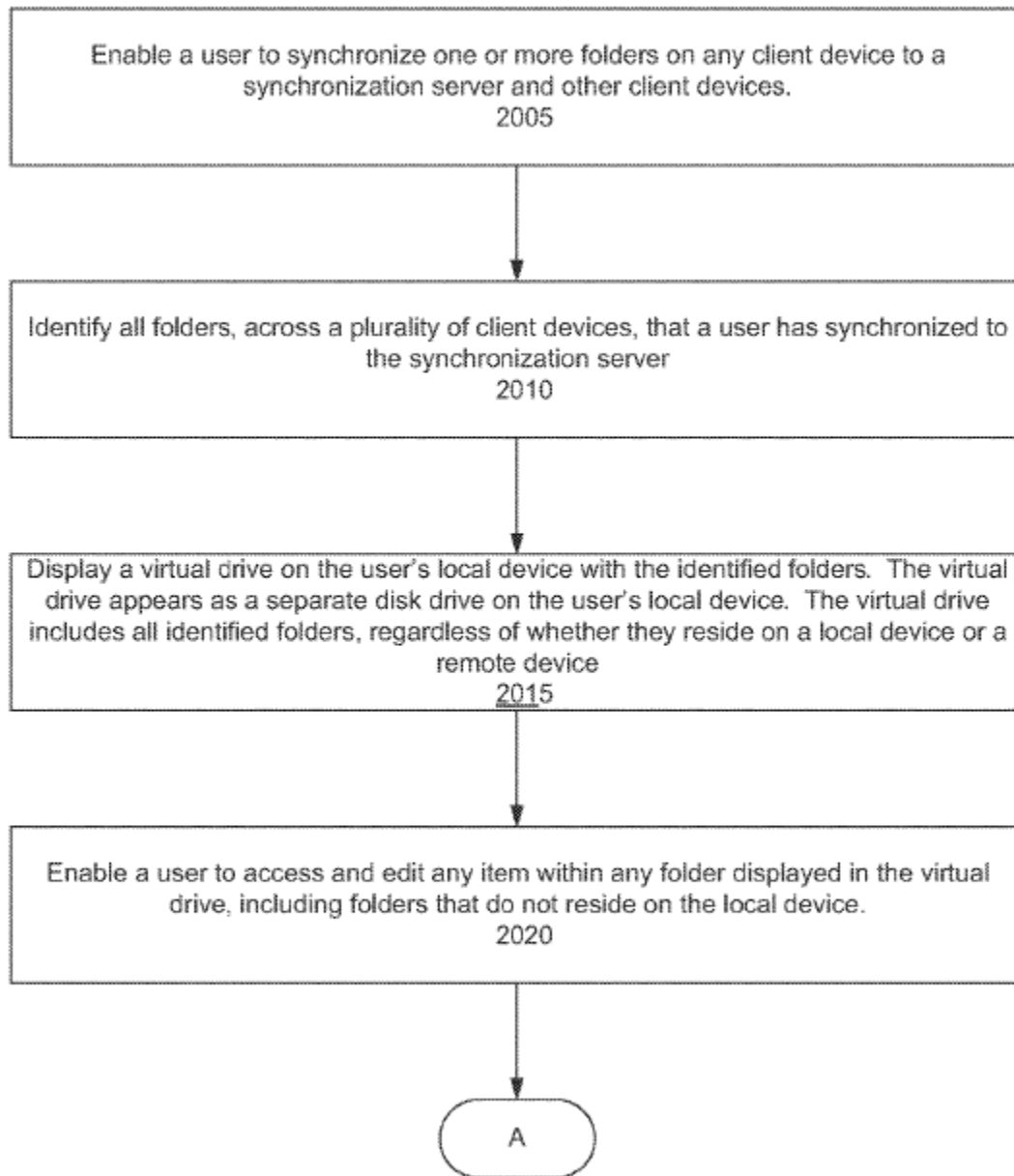
Garcia “relates generally to a synchronization system and, more particularly, to a system and method for enabling a user to synchronize, manage, and share folders across a plurality of client devices and a synchronization server.” Ex. 1006, 1:11–15. Garcia’s Figures 20a–b are, collectively, “a flowchart that illustrates a method . . . for enabling a user to access and edit, via a virtual drive, local and remote objects, including

objects synchronized to a plurality of synchronization software clients.” *Id.* at 2:66–3:1. Figure 20a is reproduced below. The subject matter of Figure 20b is not asserted by Petitioner (*see generally* Pet.) and thus not reproduced.

In step 2005, a user is enabled to synchronize one or more folders on any synchronization client to the synchronization server and other synchronization clients. *Id.* at 5:14–17.

In step 2010, all folders, across a plurality of synchronization clients that a user has backed up or synchronized to the synchronization server, are identified, as well as any folders that the user shares with other users. Ex. 1006, 5:17–20. Each of the synchronization clients stores metadata with information on all folders shared with or by the user and all folders that the user has backed up or synced to the synchronization server (including the contents of the folder). *Id.* at 5:20–24. The synchronization client on the client device uses this metadata to generate the virtual drive and the user interface. *Id.* at 5:24–26.

In step 2015, a virtual drive is displayed on the user's local client device with the identified folders. Ex. 1006, 5:27-28. The virtual drive appears as a separate disk drive on the user's local client device. *Id.* at 5:28–30. The virtual drive includes all of the user's synced folders, regardless of whether a folder resides on the local client or only on a remote client. *Id.* at 5:30–32.



Garcia’s Figure 20a, reproduced above, is “a flowchart that illustrates a method . . . for enabling a user to access and edit, via a virtual drive, local and remote objects, including objects synchronized to a plurality of synchronization software clients.” Ex. 1006, 2:66–3:1.

In step 2020, a user is enabled to access and edit any item within any folder displayed in the virtual drive, including folders that do not reside on the local client. Ex. 1006, 5:32-35. When a user double clicks on a file or

item in a remote folder in the virtual drive, the server downloads its copy of the file/item to the local synchronization software client (i.e., the client currently being used by the user). *Id.*, 5:35–39. The user can then edit the file/item as desired. *Id.*, 5:39–40. In one embodiment, when a user double clicks on a local folder, the user is taken to the folder in the local file system view. *Id.*, 5:40–42. In another embodiment, the server downloads its copy of the item/file in the local computer. *Id.*, 5:42–43.

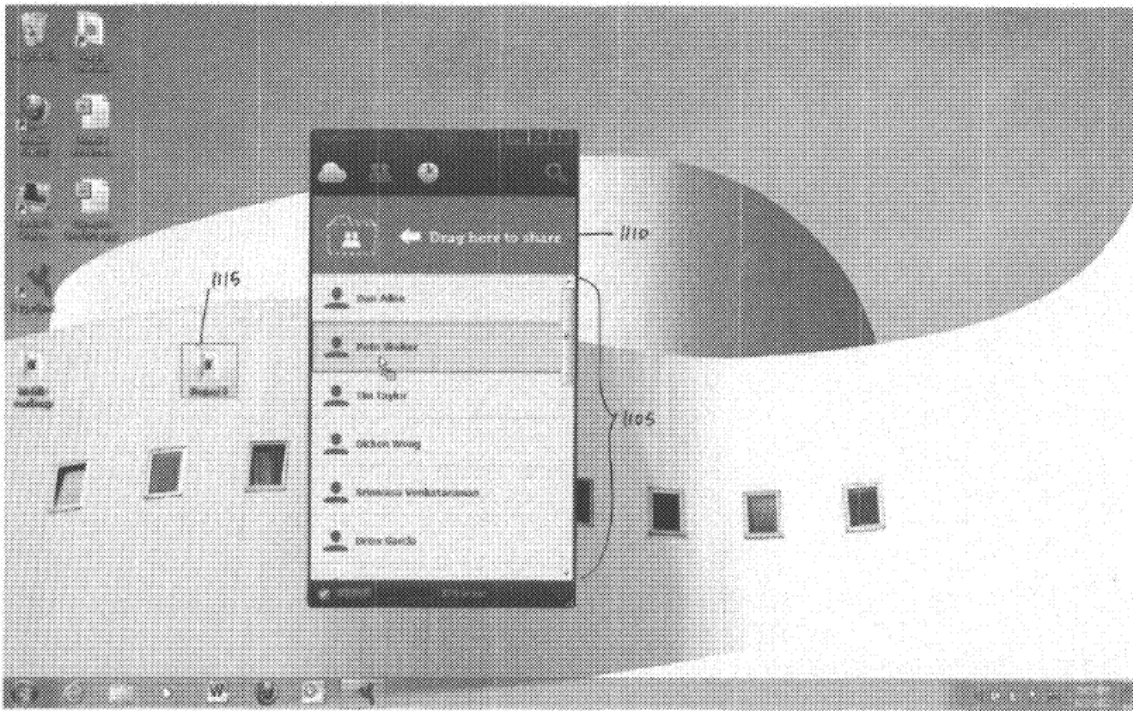
Garcia’s Figures 3–14 “are screenshots of an exemplary user interface in a synchronization system.” Ex. 1006, 2:60–61. Figure 10, reproduced below (next page), “illustrates one way in which a user may access items in objects displayed in the client sync application.” *Id.* at 2:60–62.



Garcia’s Figure 10, reproduced above, is a “screenshot[] of an exemplary user interface in a synchronization system” (*id.* at 2:60–61) and “illustrates one way in which a user may access items in objects displayed in the client sync application” (*id.* at 10:52–53).

In this particular example, the items are files and the objects are folders. Ex. 1006, 10:53–55. Items may not necessarily reside across a file or folder system, but also across an alternate organizational scheme. *Id.* at 10:57–59. Any file in folders 1005 in the synchronization system may be accessed through a virtual drive 1010, including folders located only on a remote device (e.g., work computer 240) or folders located only on the synchronization server 220. *Id.* at 10:60–64. A virtual drive is a file representation view of non-file system data. *Id.* at 10:64–65. That means that the folders 1005 may be viewed as if they resided on the hard drive of the local device (e.g., home computer 230) and the user may open, add, edit, delete, and move files within these folders, including files that reside on a remote device. *Id.* at 10:65–11:2. Changes made via the virtual drive are automatically synchronized with the synchronization server and applicable client devices. *Id.* at 11:2–4. In one embodiment, a user double clicks on a folder in the user interface of the client sync application, and the virtual drive is displayed. *Id.* at 11:4–7. Not only are all of the user's folders that have been synchronized to or stored on server 220 accessible through the virtual drive, but also all of the folders 1015 shared with the user by other users. *Id.* at 11:7–10.

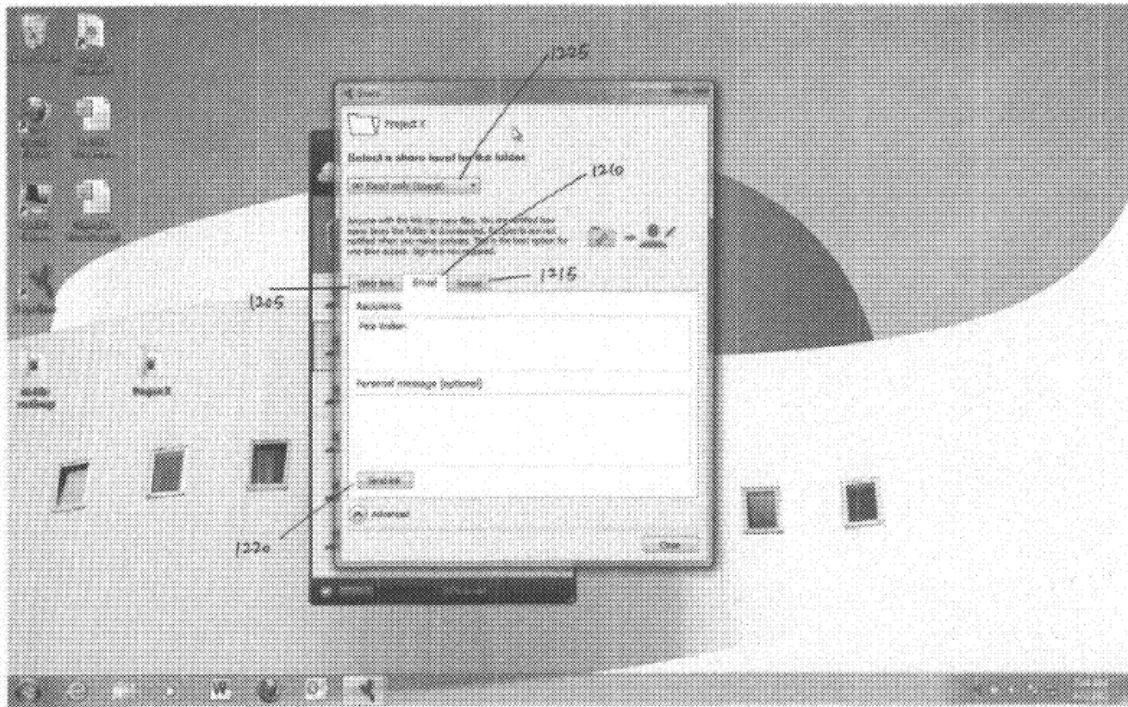
Garcia's Figures 11 and 12 illustrate the functionality of the sharing view 310. Ex. 1006, 11:11–12. Figure 11, reproduced below, has a list of contacts 1105, each of which is a drop-target zone, and a separate dedicated drop-target zone 1110. *Id.* at 11:12–14. The list of contacts 1105 may be compiled from the user's MICROSOFT OUTLOOK contacts, mobile device contacts, or any other contacts. *Id.* at 11:14–16. In one embodiment, when a



Garcia’s Figure 11, reproduced above, illustrates the functionality of the sharing view 310. *Id.*, 11:11–12.

user drags a folder to a particular contact, the folder or a link to folder 1115 is automatically sent (via email, text, or other means) to the contact. *Id.* at 11:16–19. In the preferred embodiment, when the user drags a folder 1115 to a particular contact in the contact list, a dialog box is automatically displayed that provides a user with options for sharing the folder with the contact. *Id.* at 11:19–23.

An example of such a dialog box is shown in Figure 12, reproduced below (next page). Ex. 1006, 11:23–24. In the illustrated example, sharing folder 1115 may be by web link 1205, by email 1210, or by social networking 1215. *Id.*, 11:24–26. The user contact information is automatically populated into the “Recipients” field. *Id.* at 11:26–27. When the user clicks on send link button 1220, a link to folder 1115 is sent to the contact. *Id.* at 11:27–29. When the contact clicks on the link to folder 1115,



Garcia's Figure 12, reproduced above, illustrates the functionality of the sharing view 310. *Id.*, 11:11–12.

the contents of the folder are shared with 30 the contact. *Id.* at 11:29–31. The user can control sharing level 1225 of the folder being sent to the contact (e.g., add and edit access or read-only access). *Id.* at 11:31–33. The user may also create groups of contacts and share folders with a designated group(s). *Id.* at 11:33–34.

Garcia's Figure 13, reproduced below, illustrates the web interface 1305 for the synchronization system. Ex. 1006, 11:44–45. The web interface 1305 has a content view 1310, sharing view 1315, activity view 1320, and search field 1325. *Id.* at 11:45–48. In a My Cloud tab 1330 (of the content view 1310) is a list of folders 1345 from all synchronized client devices and a filter drop-down menu 1350 for filtering by client device. *Id.* at 11:50–53.



Garcia's Figure 13, reproduced above, illustrates the corresponding web interface 1305 for the synchronization system. *Id.* at 11:44–45.

3. *Reasons to Combine the Teachings of Houston and Garcia*

As further explained below, Petitioner argues that

Houston teaches or suggests all but a few of the features recited in the challenged claims . . . [,] Garcia teaches the features that are not explicitly disclosed in Houston . . . [,] and [i]t would have been obvious to a POSITA to modify Houston to incorporate these features[] as described in Garcia.”

Pet. 6.

Petitioner contends the following is not explicitly disclosed by Houston but would have been achieved by obvious combinations of teachings from Houston and Garcia:

. . . “receipt [of]” / “cause generation of” “at least one email message identifying the at least one folder and including a reference to the at least one folder, without including [a file attachment with / at least one file in the at least one folder as an attachment of] the at least one email message,” as recited in claims 1-3.

. . . “in response to detection of the indication to open the at least one file in the at least one folder, causing retrieval of the at least one file via the at least one network for permitting display of the at least one file at the second node,” as recited in claim 3.

. . . “the storage [at / of] the second node does not store any file [in the at least one folder] when the representation of the at least one folder is created,” as recited in claims 1 and 2, and

“when the creation of the representation of the at least one folder is caused, an additional representation on the file explorer interface is caused to be created that represents the at least one file, where the file explorer interface is displayed by a file explorer client application without a web page,” as recited in claim 13.

Id. at 6–7 (citing Houh Decl. ¶¶ 43–45) (emphases and footnote omitted).

Petitioner further contends:

Additionally, to the extent PO argues that Houston does not disclose “cause creation, utilizing code sent to the second node to be stored on a storage at the second node and further to cooperate with a file explorer interface, of a representation of the at least one folder in a location among one or more folders on the file explorer interface,” as recited in claim 1 (*see also*

EX1001 claim 3), these features would have also been obvious based on the combined teachings of Houston and Garcia.

Id. at 7.

Petitioner argues that one of ordinary skill would have been motivated to modify Houston in light of Garcia’s disclosure of use of a “virtual drive” that allows folders that are stored remotely to be viewed and accessed using a file system representation provided to the user’s local client device. *Id.* 7–8 (citing Ex. 1006, 2:37–41, 4:51–57; Houh Decl. ¶ 46). Petitioner also relies on the disclosure in Garcia that a representation of a folder may be created and viewed by a user. *Id.* at 8 (citing Ex. 1006, 2:66–3:3, 4:51–5:13, 5:27–35, 6:5–27, 10:52–11:10, claim 4; Houh Decl. ¶ 46).

In addition, Petitioner cites the disclosure in Garcia in which a user with whom a folder is shared receives an email including a web link in order to share the virtual folder without sending the folder itself. *Id.* at 11 (citing Ex. 1006, 10:32–40, 11:39–43, claim 3; Houh Decl. ¶¶ 47–48. For example, Garcia discloses enabling a user to drag a folder to a particular contact on a list of contacts, which automatically shares the folder via email. *Id.* at 11–12 (citing Ex. 1006, Fig. 11, 11:11–26). Garcia also discloses that, after a user drags a folder to a particular contact, a dialog box may be presented providing an option for the user to share a link to the folder via an email by clicking on a send link button. and the user receiving the email may then access the contents of the folder by clicking on the link in the received email. *Id.* at 12–13 (citing Ex. 1006, Fig. 12, 11:11–31, 11:35–43; Hough Decl. ¶¶ 49–50).

Additional aspects of Garcia on which Petitioner relies include the fact that a user is able to access a file within a folder that is accessible

though the virtual drive. Pet. 13–16 (citing Ex.1006, Figs. 10, 20a, 2:66–3:3, 4:58–62, 5:4–13, 5:27–43, 6:5–27, 10:52–11:10, claim 4; Houh Decl. ¶ 51). In addition, Garcia discloses that a user with whom a folder is shared can double-click such a file within a shared folder causing it to be downloaded. *Id.* at 17–18 (citing Ex. 1006, Fig. 20a, 2:66–3:3, 5:4–13, 5:3–43, 6:5–27, 10:52–11:10, claim 4; Hough Decl. ¶ 52).

Petitioner argues that it would have been obvious to modify Houston to incorporate the above features of Garcia because both references are in a common technical field and address similar problems, that one of ordinary skill would have had good reason, and found it predictable, to modify Houston’s system to incorporate features of Garcia such as the use of emails to share folders and storing folders and file virtually instead of locally to avoid sending the actual contents until needed. Pet. 19–20 (citing Houh Decl. ¶¶ 53–56). In addition, one of ordinary skill would have known that the combination would have been nothing more than the combination and substitution of known elements to yield predictable results, and would have had a reasonable expectation of success in combining the references. *Id.* at 19–20 (citing Houh Decl. ¶ 54).

Patent Owner responds by alleging “Petitioner has not presented compelling **evidence** of unpatentability.” Prelim. Resp. 43.⁵ Patent Owner contends that one of ordinary skill would not have been motivated to combine Houston and Garcia, because numerous adjustments that would be required in order to modify Houston to incorporate the teachings of Garcia

⁵ Patent Owner presents its patentability arguments as part of its discussion of *Fintiv*’s factor 6. Prelim. Resp. 39–51.

would have taught away from the combination. Prelim. Resp. 46. For example, argues Patent Owner, the synchronization engine of Houston would have needed to be significantly redesigned, given Houston synchronizes folders shared among multiple clients, whereas Garcia is directed to actions taken by a single user at a single client device. *Id.* at 46–47. Patent Owner also argues that Petitioner does not explain how Houston can be redesigned to be compatible with a “virtual drive”-based system taught by Garcia. *Id.* at 47–50. In sum, Patent Owner argues that one of ordinary skill “would not have been motivated to combine the teachings of Houston and Garcia nor had any reasonable expectation of success and would have concluded that the two references teach away from being combined” *Id.* at 51.

In reply, Petitioner submits:

PO’s only substantive argument in response is the allegation that a POSITA would not have been motivated to combine Houston and Garcia. (POPR, 43-51.) But PO wrongly contends that Garcia is directed to “a single user at a single client device.” (*Id.*, 46.) To the contrary, Garcia explains that it enables “synchroniz[ing] . . . files and folders across a plurality of client devices,” including with multiple “user contacts.” (EX1006, Abstract (emphasis added).) PO also incorrectly claims that Garcia’s system “does not synchronize any files.” (POPR, 49) In fact, Garcia describes a “synchronization server” just like in Houston, which automatically synchronizes changes to a folder’s contents across all clients with access to that folder. (EX1006, 6:9-27.) Thus, the disclosures in Houston and Garcia are entirely compatible, which is unsurprising given both are assigned to Dropbox. (EX1005; EX1006.)

Pet. Reply 4–5 (emphasis omitted).

We agree that Patent Owner's contention that Garcia is directed to actions taken by a single user at a single client device is inconsistent with Garcia's description of a system "for enabling a user to synchronize, manage, and share files and folders across a plurality of client devices and a synchronization server." Ex. 1006, Abstract. Nor are Patent Owner's other attorney arguments persuasive. A teaching away requires a reference to actually criticize, discredit, or otherwise discourage the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Patent Owner does not point to aspects of the cited references that meet this criterion. "[T]hat two inventions were designed to resolve different problems . . . is insufficient to demonstrate that one invention teaches away from another." *Nat'l Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004).

In addition, Patent Owner's arguments are unpersuasive as relying on an alleged inability to modify the specific implementations disclosed in Houston in light of Garcia. However, "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) ("[c]ombining the *teachings* of references does not involve an ability to combine their specific structures"); *see also In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)) ("The test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art.").

Patent Owner’s attorney arguments are not persuasive evidence that the proffered combination of references would have been “uniquely challenging or difficult for one of ordinary skill in the art.” *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)).

Accordingly, for purposes of this Decision, we find Petitioner cites sufficient evidence to support its contention that a person of ordinary skill would have had reason to combine the teachings of Houston, Garcia, and Wu as described above.

4. *Independent Base Claim 3*

a) *Claim Elements 3.a–c*

Claim elements 3.a (preamble) and 3.b–c collectively recite an “apparatus, comprising . . . memory storing instructions . . . [and] processors execut[ing] the instructions to” perform the claimed features. Petitioner refers to the corresponding arguments for claim element 1.a (Pet. 22), which recites “computer . . . programs . . . caus[ing] the apparatus to” perform the claimed features. Pet. 62. Petitioner contends Houston discloses this limitation by disclosing an apparatus storing computer programs to perform the disclosed functions of Houston. Pet. 22 (citing Ex. 1005, 9:5–18, claim 5; Houh Decl. ¶¶ 58–60). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim elements 3.a–c.⁶

⁶ Based on the present record, we make no determination at this stage of the proceeding that the preamble of claim 3 is limiting.

b) Claim Element 3.d

Claim element 3.d recites that the instructions “send first hypertext markup language-equipped code via at least one network to a first node.” Petitioner contends that Houston discloses this feature. Pet. 63 (citing Houh Decl. ¶¶ 134–138). In particular, Petitioner relies on Houston’s client 108a as the recited “first node,” its web interface as the recited “hypertext markup language-equipped code,” and computers with network access as the recited “at least one network.” *Id.* at 63 (citing 1005, Fig. 1, 1:10–12, 2:11–12, 3:31–35, 7:37–40; Houh Decl. ¶ 135). Petitioner argues that web interfaces, such as that disclosed in Houston, “were widely known by POSITAs to require the use of HypterText Markup Language.” *Id.* at 64 (citing Houh Decl. ¶ 136, Ex. 1007, 347, 357; Ex. 1008, 381).

Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.d.

c) Claim Element 3.e

Claim element 3.e recites, at the first node, “causing, at the first node, display of at least one first interface with a first user interface element, utilizing the first hypertext markup language-equipped code that is sent via the at least one network.” Petitioner contends that Houston discloses this feature. Pet. 65 (citing Houh Decl. ¶¶ 139–142). In particular, Petitioner explains that Houston discloses a user interface window on a client device that allows a user to select a folder to share. Pet. 65–66 (citing Ex. 1005, 2:10-12, 2:28-30, 3:31-46, 7:18-21, 7:37-40, Figs. 2-4, 10, 11; Houh Decl. ¶¶ 139–142). Based on the evidence and arguments currently of record, for

purposes of institution, Petitioner has satisfied its burden for claim element 3.e.

d) Claim Element 3.f

Claim element 3.f recites “allowing receipt, from the first node via the at least one network, an indication of at least one folder that is received via the first user interface element of the at least one first interface.” Petitioner refers to the corresponding arguments for claim element 1.c (Pet. 30–35), which recites “allow receipt, at the first node, of information associated with at least one folder via the first user interface element.” In particular, Petitioner contends that “Houston discloses that the UIs illustrated in Figures 3, 10, and 11 allow a user to select a folder for sharing, which results in information associated with the selected folder being received by the client.” Pet. 67 (citing Houh Decl. ¶ 143), 30–35 (citing Ex. 1005, 3:38-45, 7:18-58, Figs. 3, 10, 11; Houh Decl. ¶¶ 74–81). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.f.

e) Claim Element 3.g

Claim element 3.g recites “send second hypertext markup language-equipped code via the at least one network to the first node.” Petitioner refers to the corresponding arguments for claim element 3.d (Pet. 35–37); the recitations and referenced arguments of claim element 3.d are described above at § IX.B.4.b. Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.g.

f) Claim Element 3.h

Claim element 3.h recites “causing, at the first node, display of at least one second interface with a second user interface element, utilizing the second hypertext markup language-equipped code that is sent via the at least one network.” Petitioner contends that Houston discloses this limitation. Pet. 67 (citing Houh Decl. ¶¶ 145–147). In particular, Petitioner contends that Houston discloses a user interface window, which can be implemented via a web interface on a client device including a text entry field that allows a user to input information identifying users with whom a folder may be shared. *Id.* at 67–68 (citing Pet. 23–30, 65–66; Houh Decl. ¶ 146). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.h.

g) Claim Element 3.i

Claim element 3.i recites “allowing receipt, from the first node via the at least one network, indicia associated with at least one email address that is received via the second user interface element of the at least one second interface.” Petitioner refers to the corresponding arguments for claim element 1.e (Pet. 38–40), which recites “allow receipt, at the first node, of an object associated with at least one email address via the second user interface element.” In particular, Petitioner contends that Houston discloses a user interface window with a display area including a text box that allows a user to input, and therefore cause the client to receive, a text string that contains one or more account identifiers, such as email addresses of a user with whom a folder may be shared. Pet. 69 (citing Houh Decl. ¶ 149), 38–40 (citing Ex. 1005, 2:31-33, 3:41-43, 7:18-40, Figs. 4, 10, 11;

Houh Decl. ¶¶ 86–90). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.i.

h) Claim Element 3.j

Claim element 3.j recites “allowing receipt, from the first node via the at least one network, an indication to share the at least one folder.” Petitioner refers to the corresponding arguments for claim element 1.g (Pet. 42–44), which recites “allow receipt, at the first node, of an indication of a selection of the third user interface element.” In particular, Petitioner contends that Houston discloses a share folder button, which allows a user to input a user interface command that is received by the client and sent to the host system. Pet. 68–69 (citing Houh Decl. ¶ 149), 42–44 (citing Ex. 1005, 1:53-54, 2:31-33, 2:56-3:46, 7:33-48, 6:5-8, 7:32-40; Houh Decl. ¶¶ 96–100). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.j.

i) Claim Element 3.k

Claim element 3.k recites

based on the receipt of the indication of the at least one folder, the indicia associated with the at least one email address, and the indication to share the at least one folder via the at least one network; cause generation of at least one email message identifying the at least one folder and including a reference to the at least one folder, without including at least one file in the at least one folder as an attachment of the at least one email message.

Petitioner refers to the corresponding arguments for claim elements 1.b–i and 3.e–j. Pet. 70. In particular, Petitioner contends that the combination of Houston and Garcia discloses client 108a sending to the host system 110 through a network connection a user’s selection of a folder designated by an identifier or name, entry of a text string containing one or more email addresses with whom the user wishes to share a folder, and a user’s selection of a share folder button to generate and email with a web link to the shared folder. Pet. 70. Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for these portions of claim element 3.k.

j) Claim Element 3.l

Claim element 3.l recites “cause to be sent, to a second node via the at least one network, the at least one email message, without including the at least one file in the at least one folder as an attachment of the at least one email message.” Petitioner refers to the corresponding arguments for claim element 1.i (Pet. 46–50). Pet. 71 (citing Houh Decl. ¶ 151). In particular, Petitioner argues that the combination of Houston and Garcia discloses that client 108b receives an email message sent from host system 110 through a network connection that identifies the folder selected for sharing by the user of client 108a and includes a web link to the shared folder, but does not attach the shared folder. Pet. 46–49 (citing Ex. 1005, Fig. 1, 1:29–32, 1:39–45, 1:53–54, 1:59–2:2, 2:60, 2:56–3:46, 5:42–44, 5:52–60, 6:5–8, 7:18–58; Houh Decl. ¶¶ 104–109).

Petitioner explains that although Houston does not explicitly disclose that the second node receives an email message identifying the shared folder

or including a shared folder in an email message without including a file attachment, Garcia discloses sending an email with a web link to a shared virtual folder to other clients. Pet. 49 (citing Ex. 1006, Figs. 11, 12, 10:32–40, 11:11–43, claim 3; Houh Decl. ¶¶ 47–50, 53–57). Petitioner asserts that a person of ordinary skill in the art “would have recognized the benefits (*e.g.*, no need to email and locally store folders and files, which may be large) and had a reasonable expectation of success combining these teachings of Houston and Garcia.” *Id.* (citing Houh Decl. ¶¶ 55, 57, 111). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.l.

k) Claim Element 3.m

Claim element 3.m recites “send particular code via the at least one network to the second node for storage at the second node and cooperation with a file explorer interface.” Petitioner contends that “Houston alone and in combination with Garcia discloses this feature” and refers to the analysis of claim element 1.j (Pet. 50–56). In particular, Petitioner contends that Houston discloses that the operations and functionality it discloses “are understood to be implemented by computer programs” and can be “embodied in software, firmware or hardware, and when embodied in software could be downloaded to reside on and be operated from different platforms used by real time network operating systems.” Pet. 51–52 (citing Ex. 1005, Fig. 5, 2:1–2, 3:18–20, 3:25–34, 3:47–53, 3:55–59, 5:36–6:8, 8:40–50, 8:64–9:4; Houh Decl. ¶¶ 115–116). Petitioner adds that Garcia discloses a virtual drive and a person of ordinary skill

would have found it obvious to modify Houston such that code sent to and stored on client 108b (*e.g.*, downloaded code

illustrated in Figure 5) creates a representation of a shared virtual folder in a location among one or more other virtual and/or local folders without storing the folder's contents, similar to that described in Garcia.

Id. at 56 (citing Ex. 1006, Figs. 10, 20a, 2:37–41, 2:66–3:3, 4:53–5:3, 4:51–57, 5:4–13, 5:27–32, 5:32–39, 6:5–27, 7:11–33, 10:52–11:10, claim 4; Houh Decl. ¶¶ 43–46, 120). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.m.

l) Claim Element 3.n

Claim element 3.n recites

causing, based on the receipt of the indication of the at least one folder, the indicia associated with the at least one email address, and the indication to share the at least one folder via the at least one network: creation of a representation of the at least one folder in a location among one or more folders on the file explorer interface, where the second node is not caused to store the at least one file when the creation of the representation of the at least one folder is caused.

Petitioner contends that “Houston alone and in combination with Garcia discloses this feature” and refers to the analysis of claim element 1.j (Pet. 50–56). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.n.

m) Claim Element 3.o

Claim element 3.o recites, at the second node, “causing, at the second node, display of the representation of the at least one folder in the location among the one or more folders on the file explorer interface.” Petitioner

contends that “the combination of Houston and Garcia discloses this feature” and refers to the analysis of claim element 1.k (Pet. 56–57). Pet. 72. In particular, Petitioner contends that Houston in combination with Garcia discloses a shared folder is made visible through the standard user interface of the local file system of the client with whom the folder is shared. Pet. 56–57 (citing Houh Decl. ¶¶ 46, 50–51, 121). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.o.

n) Claim Element 3.p

Claim element 3.p recites “allowing detection, at the second node, of an indication to open the at least one file in the at least one folder.” Petitioner contends Houston discloses this limitation in describing that the user with whom a folder is shared is able to access and modify files contained within the shared folder. Pet. 72–74 (Ex. 1005, 3:25–45, 6:3–4, 6:20–22, 6:38–40, 7:11–14, 7:18–58, 7:50–58, 8:14–21, Figs. 10, 11; Houh Decl. ¶¶ 155–158). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.p.

o) Claim Element 3.q

Claim element 3.q recites “in response to detection of the indication to open the at least one file in the at least one folder, causing retrieval of the at least one file via the at least one network for permitting display of the at least one file at the second node.” Petitioner contends that the combination of Houston and Garcia discloses this feature. Pet. 75 (citing Houh Decl. ¶¶ 159–162). In particular, Petitioner contends that users with whom a

folder is shared are able to access files contained within shared, virtual folders by obtaining a local version of the file from the host system when the user selects the file to view and/or modify. *Id.* (citing Ex. 1005, 3:25–28). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 3.q.

p) Conclusion for Claim 3

Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has demonstrated that a person of ordinary skill would have had reason to combine the teachings of Houston and Garcia and that their combined teachings would have taught or suggested the features recited in claim 3 to an ordinarily skilled artisan.

5. Intervening Claim 13

Disclaimed claim 13 depends from claim 3. Claim 13 recites the apparatus is configured such that, when the creation of the representation of the at least one folder is caused, an additional representation on the file explorer interface is caused to be created that represents the at least one file, where the file explorer interface is displayed by a file explorer client application without a web page.

Petitioner contends that Houston alone and in combination with Garcia discloses this limitation and refers to the analysis of claim element 1.j and 2b (Pet. 50–56, 58–60). Pet. 77. In particular, Petitioner asserts that Houston discloses that shared folders may contain files presented to a user with whom a folder is shared via the operating system of the user’s client through a standard user interface on the local file system and it would have been obvious “based on Garcia for such folders and files to comprise virtual files represented on the client.” *Id.* at 78–81 (citing Ex. 1005, Fig. 10, Abst.,

1:53–2:18, 3:5–10, 7:26–28, 7:49–53, 7:56–58, 8:16–18; Ex. 1006, Figs. 10, 20a, 2:19–22, 2:37–41, 2:66–3:3, 4:53–62, 5:4–13, 5:27–43, 6:5–27, 10:52–55, 10:59–65; Houh Decl. ¶¶ 46, 50–57, 166–168, 171). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim 13.

6. *Challenged Dependent Claim 14*

Challenged claim 14 depends from claim 13. Claim element 14.a recites “the apparatus is configured such that the at least one folder and the at least one file are stored and synchronized utilizing at least one server.” Petitioner contends Houston discloses this limitation in describing host system 110, which includes metadata server 102, block server 104, and notification server, which maintain synchronized shared folders accessed by multiple clients. Pet. 81–82 (citing Ex. 1005, 1:53–2:2, 2:57–3:46, 3:64–4:2, 4:60–64, 7:31–58, Fig. 1; Houh Decl. ¶¶ 172–173). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 14.a.

Claim element 14.b recites “the apparatus is further configured such that the at least one email message is caused to be sent without including the at least one file as an attachment of the at least one email message.” Petitioner contends that the combination of Houston and Garcia discloses this limitation and refers to the corresponding arguments for claim element 2.c (Pet. 60), which in turn refers to the corresponding arguments for claim 1.i (Pet. 46–50). Pet. 82–83 (citing Houh Decl. ¶ 174). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 14.b.

Claim element 14.c recites

the second node is not caused to store the at least one file when the creation of the representation of the at least one folder is caused, both for avoiding the at least one file from having to be communicated to and stored at the second node until the at least one file is requested by a user at the second node using the additional representation.

Petitioner contends that the combination of Houston and Garcia discloses this limitation and refers to the corresponding arguments for claim element 2.d (Pet. 61). Pet. 83. In particular, Petitioner asserts that Houston discloses that client 108b includes storage and executes an operating system and computer programs that enable client 108b to display a shared folder through a standard user interface of its local file system, and, “as modified based on Garcia, the shared folder (and the files it contains) represents a virtual drive stored remotely” and a person of ordinary skill in the art would have combined the systems in this manner. *Id.* at 61 (citing Houh Decl. ¶¶ 52–57, 126–127). Based on the evidence and arguments currently of record, for purposes of institution, Petitioner has satisfied its burden for claim element 14.c.

Accordingly, Petitioner has demonstrated that a person of ordinary skill would have had reason to combine the teachings of Houston and Garcia and that their combined teachings would have taught or suggested the features recited in claim 14 to an ordinarily skilled artisan.

X. EXERCISE OF DISCRETION

In the Preliminary Response, Patent Owner contends that we should exercise our discretion to deny the Petition in favor of the Dropbox Litigation and Google Litigation taking place in the U.S District Court for

the Western District of Texas (“the Texas court”). *See generally* Prelim. Resp. The Board has held that the advanced state of a parallel district court action is a factor that may weigh in favor of denying a petition under § 314(a). *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); Trial Practice Guide, 58 & n.2. We consider the following factors to assess “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding”:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). In evaluating these factors, we “take[] a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6. We consider each of these factors below.

On June 21, 2022, the Director of the USPTO issued several clarifications concerning the application of the *Fintiv* Factors. *See Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with*

Parallel District Court Litigation, issued June 21, 2022 (“Guidance Memo”)⁷.

The Guidance Memo states that “the precedential impact of *Fintiv* is limited to the facts of that case.” Guidance Memo 2. Under the Guidance Memo “the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution in view of parallel district court litigation where a petition presents compelling evidence of unpatentability.” *Id.*

Compelling, meritorious challenges will be allowed to proceed at the PTAB even where district court litigation is proceeding in parallel. Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.

Id. at 4.

The Guidance Memo further states,

[c]onsistent with *Sotera Wireless, Inc.*, the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.

Id. at 7–8. See *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

The Guidance Memo also states,

when considering the proximity of the district court’s trial date to the date when the PTAB final written decision will be due, the PTAB will consider the median time from filing to disposition of the civil trial for the district in which the parallel litigation resides.

⁷ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf.

Id. at 8–9.⁸ With these factors and guidance in mind, we consider the parties’ contentions.

A. *Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted*

Petitioner contends that (a) the Google Litigation will remain stayed while a respective motion of Patent Owner to the Federal Circuit remains pending (Pet. Reply 1 (citing Exs. 2037, 2038)); (b) “to the extent the stay concludes before institution, Petitioner intends to file a motion to stay pending resolution of Petitioner’s IPRs” (*id.*); and (c) “[i]f the [venue] transfer . . . is complete [before institution], the likelihood of a stay will only increase” (*id.*).

Patent Owner contends that the *Dropbox* Litigation is unlikely to be stayed (Prelim. Resp. 1), but for the reasons given in our analysis of factor 4 below, we do not accord weight to Patent Owner’s reliance on the *Dropbox* litigation because we do not agree that there is significant overlap in the issues between it and the *Google* litigation.

For the *Google* Litigation, Patent Owner contends:

The district court rarely grants stays. (Ex2058.) It is less likely here. Three of the five granted [stays] involved instituted IPRs on all asserted claims. *Sonrai Memory Ltd. v. Western Digital Techs. Inc.*, No. 21-cv-1168, Dkt. 104 (W.D. Tex. Aug. 04, 2022); *Kirsch R&D. LLC v. IKO Indus.*, No. 20-cv-317, Dkt. 81 (W.D. Tex. Oct. 5, 2021); *Kirsch R&D LLC v. Tarco Spec. Prods., Inc.*, No. 20-cv-318, Dkt. 62 (W.D. Tex. Oct. 4, 2021). In the Google Litigation, three patents were never

⁸ See <https://www.uscourts.gov/statistics-reports/analysis-reports/federal-court-management-statistics>.

challenged. (Ex2021.) At most this factor is neutral for the Google Litigation.

Sur-Reply 2.

Because the earliest that the *Google* litigation will proceed to trial is April 2024, after the date of any Final Written Decision in this IPR, and given that the district court has granted a motion to transfer the *Google* litigation, has vacated all deadlines in that case, and has stayed the case pending Federal Circuit review (Ex. 2037; Ex. 2038), we find that factor 1 weighs against exercising discretion to deny institution.

B. Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

Petitioner contends:

If the district court transfers the case pursuant to its order, the NDCA trial date will almost certainly come after any FWD.

...

Even if the case is not transferred, trial in WDTX would likely be after any FWD. As it stands, because of the motion to transfer and the stay order, the district court case has been delayed four months since this IPR was filed. (EX1011; EX1023; EX2038.) And if the case is not transferred, the district court will need to lift the stay, reschedule and conduct the Markman hearing, and issue a claim construction order. Thus, assuming (1) the court moves quickly and issues a claim construction order by April 2023, and (2) a twelve-month average time to trial from claim construction in WDTX, the earliest that the case would likely proceed to trial is April 2024, after any FWD in this IPR. (EX1024.)

Pet. Reply 2–3.

Patent Owner responds that Patent Owner's contentions are based only on the *Google* litigation, and not on the *Dropbox* litigation. Sur-Reply 2–3.

Again, Patent Owner’s reliance on the *Dropbox* litigation is based on the premise that there is significant overlap in the issues between it and the *Google* litigation. We disagree with Patent Owner for the reasons given in our analysis of factor 4 below. We agree with Petitioner, that the earliest that the *Google* litigation will proceed to trial is April 2024, after the date of any Final Written Decision in this IPR. Under these circumstances, we find that factor 2 weighs against exercising discretion to deny institution.

*C. Factor 3: investment in the parallel proceeding
by the court and the parties*

Petitioner contends that “the district court case remains in its early, pre-*Markman* stages and is stayed. . . . [A]nd as explained in the context of Factor 4 below, there is no overlap in the issues between the Dropbox litigations and this proceeding.” Pet. Reply 3–4.

Patent Owner contends that “Petitioner still omits any explanation why it waited until the very last day to file the Petition despite having served contentions 7 months before with both references. (POPR, 34 (Petitioner never explains delay); Pet. Reply 3–4 (still never explains delay).” Sur-Reply 3.

We find that Petitioner waiting until the last day to file the Petition without explaining the delay is neutral. We agree with Petitioner, that much work remains in the district court case as it relates to invalidity, because fact discovery is in its early stages and a *Markman* hearing has not yet occurred. Further, as we stated above in our analyses of factors 1 and 2, the district court has granted a motion to transfer the *Google* litigation, has vacated all deadlines in that case, and has stayed the case pending Federal Circuit

review, and the earliest that the *Google* litigation will proceed to trial is April 2024.

Under these circumstances, we find that factor 3 weighs against exercising discretion to deny institution.

*D. Factor 4: overlap between issues raised
in the petition and in the parallel proceeding*

Petitioner contends:

The fourth factor (overlap) weighs against discretionary denial. Given the early stage of the *Google* litigation, it is unclear how much overlap, if any, there will be between the two proceedings. For example, this Petition may challenge claims that are not at issue in the litigation, because Judge Albright’s standing orders require multiple meet and confers to discuss “significantly narrowing the number of claims asserted and prior art references at issue.” (EX1013, 13–14.)

Pet. 86 (emphasis omitted).

Patent Owner responds: “Petitioner’s argument is baseless speculation. Petitioner also *omits* that it is asserting the same art against the same claim in its contentions in the *Google* Litigation.” Prelim. Resp. 37; *see also id.* at 36 (“The Petition and the *Google* Litigation also reference Houston and Garcia expressly.” (emphasis omitted)). Patent Owner also contends that the Petition “is asserting two Dropbox patents in the Petition” (*id.* at 29) and:

[claim 14 is] the only claim[] of the ’737 patent that PO is asserting in both of the parallel district court cases[—the Dropbox Litigation and *Google* Litigation—]after its statutory disclaimer. The Petition and the two parallel district court cases are all challenging claim 14 using Dropbox art from the 2009-2012 period. All three reference Houston expressly. (Ex2030; Ex2017; Pet.) . . .

... Garcia is a patent owned by Dropbox that was filed in 2012. ... PO submits the issues raised by the Petition are identical to issues raised in the district court cases. The subject matter of claim 16 is involved. To the extent Dropbox's Garcia patent presents different issues than what is covered by Dropbox's own prior systems, they are still substantially the same.

Id. at 36–37 (emphasis omitted).

Petitioner contends that “Petitioner has stipulated that, if the Board grants institution, Petitioner will not pursue the same ground raised in its Petition in the district court case. (EX1026.) As a result, no overlap exists between the issues in this IPR and in the district court.” Pet. Reply 4. Petitioner further contends that, although Houston is identified in the *Dropbox* litigation, the *Dropbox* litigation does not rely on the Garcia reference at all. *Id.*

In the Sur-Reply, Patent Owner responds:

Petitioner ***deliberately*** decided not to do a full *Soltera* stipulation. It cannot say no overlap exists. (Reply, 4.) It also waited until ***after*** seeing the POPR. (Ex1026.) ... PO submits *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 ([PTAB] September 7, 2022) does not allow stipulations after the Petition is filed. *Id.* at 4; Director Guidance at 7–8 (“[W]here a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.”). ... The need to file a stipulation was reasonably foreseeable when Petitioner filed the Petition.

Sur-Reply 3–4 (third alteration in original). Patent Owner also contends that the fact that Houston is included in the *Dropbox* litigation is evidence of overlap. *Id.* at 4. Patent Owner contends that Petitioner “cannot credibly

argue that any issues relevant to *Garcia* – a Dropbox patent – are not involved.” *Id.*

We find that the unpatentability issue raised here, which is based on the combination of Houston and Garcia, does not overlap with those raised in the *Dropbox* litigation, because Garcia is not included in that litigation.

With respect to Patent Owner’s contention that “Petitioner deliberately decided not to do a full *Sotera* stipulation⁹,” we highlight that in *Sand Revolution II*, the panel found Petitioner’s stipulation that it would not pursue in district court litigation the same grounds as those asserted in the IPR “mitigates to some degree the concerns of duplicative efforts” and “weighs marginally in favor of not exercising discretion to deny institution.” *Sand Revolution II, LLC v. Continental Intermodal Group Trucking LLC*, IPR201901393, Paper 24 at 11–12 (June 16, 2020) (informative). Also, we disagree with Patent Owner’s contention that *NXP USA* does not allow stipulations after the Petition is filed. *NXP USA* states that “the only appropriate time for a petitioner to offer a stipulation . . . is prior to the Board’s decision of whether to institute review” (*NXP USA*, Paper 13, 4), which is the case here.

Under these circumstances, we find that factor 4 weighs against exercising discretion to deny institution.

*E. Factor 5: whether the petitioner and the defendant
in the parallel proceeding are the same party*

As to factor 5, Petitioner contends:

⁹ In a conference call with the parties and the Board on December 28, 2022, Petitioner said that it would submit “a Sand-Revolution-type stipulation” in its Preliminary Reply. Ex. 2042, 12:19–20; see Prelim. Reply 4.

For the fifth factor (parties), Petitioner is the defendant in the related litigation. But under the “holistic view of whether the efficiency and integrity of the system are best served,” the factors here indicate that institution is proper. *Samsung Elecs. Co. Ltd. v. Dynamics Inc.*, IPR2020-00505, Paper 11 at 15 (Aug. 12, 2020).

Pet. 86 (emphasis omitted).

Patent Owner contends that Petitioner waived the right to address the Dropbox litigation because the issues there are the same as the issues in this Petition and Petitioner had the opportunity to address the Dropbox litigation in the Petition. Prelim. Resp. 37–38; Sur-Reply 1. Patent Owner contends that “[i]t does not matter whether Dropbox and Petitioner are different parties. . . . Both are coordinating activities.” Prelim. Resp. 38. Patent Owner also contends that Dropbox is a real party-in-interest in the *Google* litigation. Sur-Reply 4–5.

We disagree with Patent Owner. As discussed above, the issues in the Dropbox litigation do not overlap with the issues raised in the Petition, therefore, Petitioner did not waive its right to provide evidence related to the Dropbox litigation. Further, Petitioner and Dropbox are not the same party. With respect to Patent Owner’s contentions regarding real-party-in-interest, we address this issue separately, because it relates to whether the Petition is time-barred by statute, not to whether the Board has discretion to deny institution.

Under these circumstances, we find that factor 5 weighs against exercising discretion to deny institution.

F. Factor 6: other circumstances that impact the Board's exercise of discretion, including the merits

Patent Owner contends that Petitioner inexplicably delayed filing its Petition until one day before the statutory deadline. Prelim. Resp. 38. We find this timing to be neutral, as we discussed above in our analysis of factor 3.

Patent Owner contends that Dropbox and Petitioner are in privity and the Petition is time-barred. Prelim. Resp. 39–40; Sur-Reply 5. We address the issue of privity separately, because it relates to whether the Petition is time-barred by statute, not to whether the Board has discretion to deny institution.

Patent Owner contends that Petitioner's unpatentability theory lacks merit. Prelim. Resp. 43–51. We disagree with Patent Owner's contention, for the reasons given in the unpatentability analysis in Section IX above.

Under these circumstances, we find that factor 6 weighs against exercising discretion to deny institution.

G. Conclusion

Having weighed the factors above, including the relative timing of the proceedings, the amount of effort that has been and is yet to be expended in the above-discussed litigations and in this proceeding, Petitioner's stipulation, and the relative merits of Petitioner's challenge, we find that, taken as a whole, the factors do not favor exercising discretion to deny institution. In consideration of the above, we decline to exercise discretion to deny institution.

XI. REAL-PARTY-IN-INTEREST

Patent Owner contends Petitioner is collaborating with the complainant—Dropbox—and therefore the Petition is time-barred by the Dropbox Litigation. *See generally* Prelim. Resp..

Under 35 U.S.C. § 315(b), an *inter partes* review may not be instituted “if the petition requesting the proceeding [wa]s filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner [wa]s served with a complaint alleging infringement of the patent.” It is “the IPR petitioner [who] bears the burden of persuasion to demonstrate that its petitions are not time-barred under § 315(b) based on a complaint served on a real party in interest more than a year earlier.”

Worlds Inc. v. Bungie, Inc., 903 F.3d 1237, 1242 (Fed. Cir. 2018). The same logic requires placing the burden on IPR petitioners to demonstrate that their petitions are not time-barred under § 315(b) based on a complaint served on a real party in interest or a privy more than a year before a petition is filed. *See Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152, 4–5 (PTAB Jan. 24, 2019) (precedential) (citing *Worlds*, 903 F.3d at 1242).

Whether a non-party is a real party in interest is a “highly fact-dependent question.” *Ventex*, Paper 152 at 6 (quoting Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012)); *see also* Consolidated Trial Practice Guide 13 (“Whether a party who is not a named participant in a given proceeding nonetheless constitutes a ‘real party-in-interest’ or ‘privy’ to that proceeding is a highly fact-dependent question.”). In *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018) (“*AIT*”), the Federal Circuit held that “Congress intended

that the term ‘real party in interest’ have its expansive common-law meaning.” 897 F.3d at 1351. According to the Federal Circuit:

Determining whether a non-party is a “real party in interest” demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner. Indeed, the Trial Practice Guide . . . suggests that the agency understands the “fact-dependent” nature of this inquiry, explaining that the two questions lying at its heart are whether a non-party “desires review of the patent” and whether a petition has been filed at a nonparty’s “behest.”

Id. (quoting Trial Practice Guide, 77 Fed. Reg. at 48,759); *accord* Consolidated Trial Practice Guide 13–14.

We must ask “who, from a ‘practical and equitable’ standpoint, will benefit from the redress” that the *inter partes* review might provide. *AIT*, 897 F.3d at 1349 (quoting Trial Practice Guide, 77 Fed. Reg. at 48,759); *accord* Consolidated Trial Practice Guide 14–15. In addition, we must “inquire whether [Petitioner] can be said to be representing [the asserted RPI’s] interest after examining its relationship with [the asserted RPI].” *AIT*, 897 F.3d at 1353; *see also Ventex*, Paper 152 at 8 (determining that Seirus was a real party in interest, in part because the petitioner “Ventex represents Seirus’s interests in this proceeding”).

As *AIT* explained, there is extensive support in the legislative history for the traditional expansive common-law meaning of RPI, noting that there is “nothing that suggests Congress intended for the term ‘real party in interest’ to have a meaning that departs from its common-law origins. Instead, it reveals that Congress intended for it to have an expansive formulation.” 897 F.3d at 1350. To that end, a 2011 House Report on

the AIA explains that the RPI and privity requirements are designed to prevent parties “from improperly mounting multiple challenges to a patent or initiating challenges after filing a civil action challenging the validity of a claim in the patent.” *Id.* (quoting H.R. Rep. No. 112-98, at 48 (2011), reprinted in 2011 U.S.C.C.A.N. 67, 78). The report also “makes clear that Congress ‘recognizes the importance of quiet title to patent owners to ensure continued investment resources.’” *Id.* (quoting H.R. Rep. No. 112-98, at 48 (2011)). Likewise, the RPI and privity requirements are designed to ensure that AIA trials “are not to be used as tools for harassment” of patent owners or to permit “repeated litigation and administrative attacks on the validity of a patent.” *Id.* (quoting H.R. Rep. No. 112-98, at 48).

AIT concluded that the legislative history reveals “two related purposes” for the RPI and privity requirements:

(1) to ensure that third parties who have sufficiently close relationships with IPR petitioners would be bound by the outcome of instituted IPRs under § 315(e), the related IPR estoppel provision; and (2) to safeguard patent owners from having to defend their patents against belated administrative attacks by related parties via § 315(b).

AIT, 897 F.3d at 1351 (quoting Senators Kyl and Schumer). In other words, the RPI and privity requirements were designed to avoid harassment and preclude parties from getting “two bites at the apple” by allowing such parties to avoid either the estoppel provision or the time-bar.¹⁰

¹⁰ The Federal Circuit analogized to Federal Rule of Civil Procedure 17(a), titled “Real Party in Interest,” which was codified to: “protect the defendant against a subsequent action by the party actually entitled to recover, and to ensure generally that the judgment will have its proper effect as res judicata.” *Id.* at 1348.

Patent Owner presents the real-party issue, in addressing *Fintiv* factor 6, by contending:

Petitioner's actions suggest gamesmanship and improper use of the IPR process. . . . Petitioner's discussion in its Petition includes no discussion of the Dropbox Litigations. . . . The lack of candor is consistent with Petitioner failing to mention Dropbox's arguments regarding invalidity or even discuss the Dropbox Litigations in any meaningful way. Adding the fact that PO has been stonewalled regarding any communications shared between Dropbox and Petitioner concerning this IPR, the totality of the circumstances points firmly towards Petitioner and Dropbox coordinating for some improper tactical advantage.

Prelim. Resp. 39. Patent Owner further contends:

Petitioner and Dropbox appear to be coordinating their activities. Petitioner filed for IPR even though a FWD would issue 4-5 months after trial. (Pet. at 82 ("the FWD in this IPR is expected in January 2024, less than five months after the scheduled trial date . . .").) Institution would be around the end of fact discovery at the earliest. Petitioner also only filed Petitions against the asserted patents that overlap with Dropbox. With three other unrelated patents remaining unchallenged, and the case that far advanced, it could be difficult to obtain a stay.

While the benefit of the IPR challenges is less clear for Petitioner, it could provide Dropbox a strategic advantage. The Petitions were filed at a time when the schedule in the Dropbox Litigations would have likely resulted in the POPRs being due around the same time as dispositive motions. The Petitions all challenge PO's patents using Garcia, which has an August 10, 2012 priority date. Both Petitioner and Dropbox are aware that PO is asserting a July 25, 2012 priority date. (Ex2029; Ex 2049)

[The Petition challenges] the '737 patent using two Dropbox patents. (Ex2022; Ex2023.) PO has requested Dropbox provide communications with third parties, such as

Petitioner, but Dropbox objects and claims they are privileged. . . . This is improper. Dropbox is barred from filing petitions for IPR. That suggests Dropbox and Petitioner are in privity and the petitions are barred. At a minimum, it implicates the Board's concerns regarding abuse and strategic advantage between significantly related parties that warrants denial under § 314(a).

Dropbox attempted to . . . circumvent the rules before. Early in the Dropbox Litigation, Dropbox was similarly barred because it filed a declaratory judgment claim of invalidity against PO. It had Unified Patents LLC file a petition on its behalf that omitted it as a real party-in-interest. When PO challenged them, Unified Patents withdrew the petition.

Prelim. Resp. 42–43.

Petitioner contends:

PO also alleges that Petitioner coordinated its activities with Dropbox, yet provides no supporting evidence. (POPR, 42-43.) Nor could it, as there has been no such coordination. Any and all communications between Petitioner and Dropbox are unrelated to this IPR, as Petitioner has represented to PO. As for the Unified Patents IPR referenced by PO, it involved a patent not asserted against Petitioner and was dismissed long before PO sued Petitioner. (EX2011; EX2020.) PO's allegation of Dropbox coordinating with Unified Patents does not evidence or indicate similar coordination with Petitioner.

Pet. Reply 5.

In the Sur-Reply, Patent Owner contends:

Petitioner does not deny it and Dropbox are claiming common interest privilege on communications pre-dating the Petition by a year. (Ex2050.)[] Both asserted patents are owned by Dropbox. Out of six patents, Petitioner only filed petitions on the three also asserted against Dropbox. Petitioner and Dropbox are also business partners on the **same** subject matter accused in the litigations. (Ex2061; Ex2062.) Petitioner

never mentioned that. Both know PO claims priority to July 25, 2012. (Ex2049; Ex2029.) *Garcia* appears deliberately chosen to elicit PO's litigation positions—swearing behind—for Dropbox's benefit.

Sur-Reply 5 (emphasis omitted; footnote omitted (stating that “PO can provide redacted communications once Petitioner and Dropbox agree”)).

We agree with Patent Owner that discovery is warranted to determine whether Petitioner has met its burden to establish that the Petition is not time barred under 35 U.S.C. § 315(b). Prelim. Resp. 39–40. Accordingly, we entered an order for discovery concurrently with this Decision. Because discovery has not yet been completed, we will not resolve this issue before institution.

XII. CONCLUSION

Based on the arguments presented in the Petition, we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the '737 patent challenged in the Petition. Accordingly, we institute a trial on all claims and all grounds asserted in the Petition. The Board has not made a final determination under 35 U.S.C. § 318(a) with respect to the patentability of the challenged claim.

XIII. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claim 14 of the '737 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '737 patent shall commence

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on the entry date of this Decision, and notice is hereby given of the
institution of a trial.

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