

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,
Petitioner,

v.

ENTANGLED MEDIA, LLC
Patent Owner.

Case No. IPR2024-00284
U.S. Patent No. 8,296,338

**PETITIONER'S REQUEST FOR REHEARING FOLLOWING
INSTITUTION DECISION UNDER 37 C.F.R § 42.71(d)**

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PETITIONER’S EXHIBIT LIST

Exhibit	Description
Ex-1001	U.S. Patent No. 8,296,338 (the “’338 patent”)
Ex-1002	File History of the ’338 patent
Ex-1003	Declaration of Dr. Patrick McDaniel
Ex-1004	CV of Dr. Patrick McDaniel
Ex-1005	U.S. Patent No. 6,938,042 (“Aboulhosn”)
Ex-1006	U.S. Patent No. 7,058,696 (“Phillips”)
Ex-1007	U.S. Patent Publication No. 2005/0091595 A1 (“Shappell”)
Ex-1008	U.S. Patent No. 7,930,270 (“Tsang”)
Ex-1009	U.S. Patent Application No. 10/115,448 (“448 Application”)
Ex-1010	U.S. Patent No. 8,484,260 (the “’260 patent”)
Ex-1011	File History of the ’260 patent
Ex-1012	Microsoft Press. <i>Microsoft computer dictionary</i> . Microsoft Press, 2002.
Ex-1013	Steven M. Kaplan, Wiley Electrical and Electronics Engineering Dictionary, John Wiley & Sons, 2004.
Ex-1014	RFC 2616 – Hypertext Transfer Protocol – HTTP/1.1
Ex-1015	RFC 2818 – HTTP Over TLS
Ex-1016	Webpage printout – Rus Shuler, “How Does the Internet Work?” (2002)
Ex-1017	Wayback printout – “What do you need to know about how the Internet Works”

Ex-1018	Wayback printout – “File system,” Wikipedia
Ex-1019	U.S. Patent No. 9,400,884
Ex-1020	Merriam-Webster’s Collegiate Dictionary, Eleventh Edition, 2003
Ex-1021	Wayback printout – “Central processing unit,” Wikipedia
Ex-1022	U.S. Patent No. 6,351,776
Ex-1023	Good, Nathaniel S., and Aaron Krekelberg. “Usability and privacy: a study of Kazaa P2P file-sharing.” Proceedings of the SIGCHI conference on Human factors in computing systems. 2003.
Ex-1024	McCarty, William. “Learning Debian GNU/Linux.” (1999), Chapter 10 Setting Up a Linux-Based LAN, Section 10.3 Samba
Ex-1025	McCarty, William. “Learning Debian GNU/Linux.” (1999), Chapter 12 Setting Up a Linux-Based WAN, Section 12.2 Installing and Configuring a Web Server
Ex-1026	Wayback printout – “World Wide Web,” Wikipedia
Ex-1027	Wayback printout – “Hypertext Transfer Protocol,” Wikipedia
Ex-1028	Wayback printout – M.S. Schmalz, “Organization of Computer Systems: Introduction, Abstractions, Technology”
Ex-1029	Wayback printout – Chester F. Carlson, The Center for Imaging Science, Basics of File Structure
Ex-1030	Nagar, Rajeev. Windows NT file system internals: a developer’s guide. O’Reilly & Associates, Inc., 1997. (excerpted)
Ex-1031	Wayback printout – “Filesystems”
Ex-1032	Webpage printout – “Multics”

Ex-1033	Sandberg, Russel, et al. “Design and implementation of the Sun network filesystem.” Proceedings of the summer 1985 USENIX conference. 1985.
Ex-1034	[Reserved]
Ex-1035	Wayback printout – Napster
Ex-1036	Webpage printout - Peer-to-peer interactions in web brokering systems
Ex-1037	Wayback printout – Introduction to Linux Loadable Kernel Modules
Ex-1038	Webpage printout – Deploying your hardware and software systems
Ex-1039	Dolstra, Eelco, Eelco Visser, and Merijn De Jonge. “Imposing a memory management discipline on software deployment.” Proceedings. 26th International Conference on Software Engineering. IEEE, 2004.
Ex-1040	U.S. Patent Publication No. 2007/0283050 A1 (“Savage”)
Ex-1041	Foldershare Guide, available at: https://web.archive.org/web/20060313171107/https://www.foldershare.com/download/files/FolderShareGuide.pdf
Ex-1042	U.S. Patent No. 9,032,295 (“Patel”)
Ex-1043	Sotera Stipulation
Ex-1044	Wayback printout – net2ftp
Ex-1045	Wayback printout - TXFTP
Ex-1046	Wayback printout – Google Accounts

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Petitioner respectfully requests rehearing of the Board’s Decision (Paper 7) (“Decision”) denying institution of *inter partes* review for claims 1-14 of U.S. Patent No. 8,296,338 (the “’338 Patent”). In its Decision, the Board:

1. **Misapprehended** the claims by incorporating the “same locations” limitation into the separate “indistinguishability” limitation; and
2. **Misapprehended** or **overlooked** the combination of Aboulhosn and Phillips.

Petitioner sets forth the detailed basis for this Request for Rehearing below, as required by 37 C.F.R. § 42.71(d). This Request is timely filed and is permitted under 37 C.F.R. §§ 42.71(c) and 42.71(d) without prior authorization of the Board.

II. SPECIFIC BASIS FOR REQUESTED RELIEF

A. The Decision misapprehended the claims by incorporating the “same locations” limitation into the separate “indistinguishability” limitation

In the Decision, the only claim limitation identified as missing from the Aboulhosn-Phillips combination is that the virtual files be “indistinguishable” from local files by the local file system:

1[H]: integrating metadata from the meta-indices of each of the other multiple devices into a local file system of each of the multiple devices to [1.] generate virtual files stored in the same locations as local files of

the local file system, [2.] **the virtual files indistinguishable from the local files by the local file system** at each of the multiple devices;

Ex-1001, claim 1¹; *see* Decision at 19-20, 26-27.

For limitation 1[H], the Board made two findings regarding its scope:

- (i) “We find that these disclosures [in the challenged patent’s specification], taken together, indicate a disavowal of claim scope as to file systems where remote or virtual files are kept in a separate location, such as in a separate folder, device, or drive.” Decision at 16.
- (ii) “For similar reasons, we find that remote or virtual files that are kept in a separate folder, device, or drive are not ‘*indistinguishable*’ from local files as that term is used in the claims of the ’338 patent.” *Id.*

Petitioner agrees with the Board’s first finding that the claims do not cover file systems where remote or virtual files are kept in a separate location, such as in a separate folder, device, or drive. But Petitioner respectfully submits that the Board’s second finding misapprehends the claims because it incorrectly found a disavowal for the “indistinguishability” limitation, as the claim’s “same locations” limitation already excludes file systems where virtual files are kept in a separate location. In other words, the “same locations” limitation in the claim already covers

¹ Emphasis added throughout unless otherwise noted.

what the Board found was disavowed (or if there was a disavowal, it applies to the “same locations” limitation, not the “indistinguishable” limitation).

First, the Board does not dispute that the claim language of 1[H] clearly recites the “same locations” limitation ([1.] below) and the “indistinguishability” limitation ([2.] below) as two distinct and separate limitations:

1[H]: integrating metadata from the meta-indices of each of the other multiple devices into a local file system of each of the multiple devices to generate [1.] **virtual files stored in the same locations as local files of the local file system**, [2.] **the virtual files indistinguishable from the local files** by the local file system at each of the multiple devices;

Ex-1001, claim 1; Decision at 14 (“Regarding the specific language of the claims directed to **virtual files being ‘stored in the same locations as local files’** and **virtual files being ‘indistinguishable from the local files...’**). *See Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1119 (Fed. Cir. 2004) (“[W]hen an applicant uses different terms in a claim it is permissible to infer that he intended his choice of different terms to reflect a differentiation in meaning of those terms.”). Moreover, interpreting the “indistinguishability” limitation to include the “same locations” limitation would render the “same locations” limitation superfluous and is therefore not preferred. *See Merck & Co. v. Teva Pharm. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (“A claim construction that gives

meaning to all the terms of the claim is preferred over one that does not do so.”
(citation omitted)).

Second, the specification of the ’338 Patent discusses the “same locations” limitation and the “indistinguishability” limitation as distinct and separate limitations. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (“Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.”).

For example, as shown to the right, the portion of the ’338 Patent specification referenced in the Decision discusses the “same locations” limitation (green) separately from its separate “further” (red) discussion of the “indistinguishability”

At each registered local device, the software client integrates metadata from the remote device indices into the local device’s file system S22. The metadata instructs the software client where to store the data files, ensuring that a common view and storage location is maintained across all devices. At this point, the local operating system’s file system has been modified to include remote files in the same locations of the local device (such as the “My Documents” folder) as opposed to a separate and segregated location for such remote data (such as a synchronization folder or an additional hard drive “mounted” on the device.) Further, the software client facilitates the creation of a visual representation of the remote or virtual files on the local device, as if the files were indeed local, allowing the user to operate on them as if they were local to the device. The virtual files appear in essentially all ways the same as a local file, making them indistinguishable unless such a distinction is enabled as a separate option.

limitation (blue), including visual indistinguishability. Decision at 14 (citing Ex-1001, 6:20-36) (annotated). This is the only time that the term “indistinguishable” is used in the specification, and it is used to refer to how files appear or their visual

representation.

Therefore, the claimed “same locations” limitation and the claimed “indistinguishability” limitation are distinct and separate limitations that are independently taught by the prior art. As such, virtual and local files may still be “indistinguishable” regardless of whether they stored in the same or different locations.

In light of the above, it is respectfully submitted that the Decision erred in finding that the prior art’s virtual files that are kept in a separate folder, device, or drive (i.e., not stored in the same locations as local files) cannot be “indistinguishable” (i.e., appear visually the same) from local files. Decision at 16.

B. The Board misapprehended or overlooked the combination of Aboulhosn and Phillips

The Board determined that Petitioner failed to show that “the combination of Aboulhosn and Phillips teaches ‘the virtual files [being] indistinguishable from the local files by the local file system,’ as recited in claim 1.” Decision at 26. It reached this determination in two steps.

First, the Board found that “Phillips’s virtual storage device and its contents are segregated from local files in Phillips’s display window 1000.” *Id.* at 25. Specifically, Phillips’s virtual files “are *stored separately* in the virtual F: drive/storage device.” *Id.* at 26. The Board reiterated that “the patentees of the ’338 patent disavowed coverage for the term ‘*indistinguishable*’ as applied to virtual files

stored in a separate location, such as a separate folder, device, or drive.” *Id.* And, according to the Board, “that is exactly what Phillips teaches.” *Id.*

Second, the Board determined that “the same deficiencies...infect Petitioner’s rationale for combining Phillips with Aboulhosn.” *Id.* at 27. The Board, however, acknowledged Petitioner’s position that a POSITA seeking “a smoother and more seamless user experience with Aboulhosn’s system” would have been motivated to incorporate “Phillips’s visual indistinguishability feature (i.e., displaying virtual files to the user in the same way as local files).” *Id.* (citing Pet. 54-55). But the Board reiterated that “Phillips’s virtual files are **visually distinguishable** because they are **located in that separate virtual drive**.” *Id.* Thus, the Board did “not agree that Phillips’s presentation of virtual files in a separate virtual drive would have motivated an ordinarily skilled artisan to combine Phillips with Aboulhosn in the manner suggested by Petitioner.” *Id.*

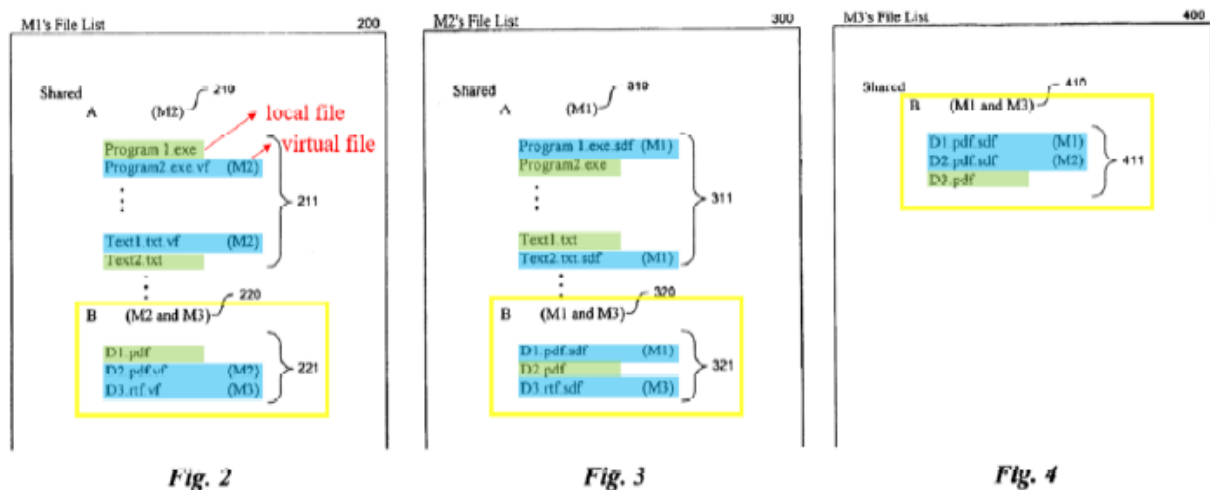
Respectfully, for both steps, the Board misapprehended or overlooked certain evidence and arguments.

1. The Board misapprehended or overlooked the combined teachings of Aboulhosn as modified based on Phillips

The Board misapprehended or overlooked the evidence in concluding that the Aboulhosn-Phillips combination does not teach “the virtual files [being] indistinguishable from the local files by the local file system” because Phillips’s virtual files “are stored separately in the virtual F: drive/storage device.” *Id.* at 26.

Limitation 1[H] recites the step of “integrating metadata from the meta-indices of each of the other multiple devices into a local file system of each of the multiple devices to generate [1.] virtual files stored in the **same locations** as local files of the local file system, [2.] the virtual files **indistinguishable** from the local files by the local file system at each of the multiple devices.” The Petition relied on a combination Aboulhosn as modified by Phillips as meeting this limitation. Pet. 39-47.

For the **first limitation** of 1[H] that requires “virtual files stored in the **same locations** as local files of the local file system,” Petitioner demonstrated that **Aboulhosn’s virtual files appear in the same shared folder B** (i.e., “same location[.]”) as local files of the local file system. Pet. 43-44. The shared folder B is shown below with a yellow box. Virtual files are shown in blue, and local files are in green.



Pet. 44 (annotating Ex-1005, Figs. 2-4).

For the **second limitation** of 1[H] that requires “the virtual files **indistinguishable** from the local files by the local file system at each of the multiple devices,” Petitioner explained that Aboulhosn *alone* does not teach the indistinguishability because its virtual files use the “vf” extension—i.e., a distinguishing feature for virtual files. Pet. 44-45. But Petitioner demonstrated that Aboulhosn, as modified in view of Phillips, discloses both (1) visual indistinguishability and (2) transparent access. *Id.* at 45.

Focusing solely on the disavowal point (Decision at 25-26), the Board rejected *any* reliance on Phillips for the second limitation of 1[H] that requires “the virtual files indistinguishable from the local files by the local file system”: “[T]he patentees of the ’338 patent disavowed coverage for the term ‘indistinguishable’ as applied to virtual files **stored in a separate location**, such as a separate folder, device, or drive. And that is exactly what Phillips teaches.” *Id.* at 26 (citation omitted). As shown above, however, excluding files stored in separate locations is required by the first “separate location” limitation of 1[H], not the second “indistinguishable” limitation.

That Phillips’s “virtual files” are “**stored in a separate location**” is precisely why the Petition does not rely on Phillips *alone* as teaching limitation 1[H] that requires “virtual files **stored in the same locations** as local files of the local file system.” Instead, as discussed above, Petitioner relied on Aboulhosn’s virtual files that unquestionably appear in the same shared folder B (i.e., “same location[.]”) as

local files.

But by requiring through disavowal the “indistinguishability” limitation to also include the “separate location” limitation, the Board misapprehended the clear teachings in Phillips regarding *indistinguishability* of virtual and local files and improperly disregarded Petitioner’s arguments and supporting expert testimony explaining why a POSITA would have been motivated by these teachings to modify *Aboulhosn* (which teaches the *same location* limitation) to render limitation 1[H] obvious. Petitioner never relied on Phillips for the same location limitation, which is already disclosed by Aboulhosn.

Specifically, even if Phillips’s “virtual files” are “**stored in a separate location**,” Phillips must be considered for all that it teaches. *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 (Fed. Cir. 2018) (“a reference must [be] considered for all it taught...” (internal citation omitted)). As demonstrated in the Petition (at 44-47):

- Phillips’s system “access[es]...the designated files in a fashion which is **indistinguishable**, by users of, and applications executing at, the first client node, with access to one or more files stored on a physical storage device that is locally present at the first client node.” Ex-1006, claim 16.
- When Phillips’s “application causes an access to another file...[i]f the [virtual] file is contained in the virtual storage device, the client node

software intervenes and assists the operating system in identifying the appropriate file and in providing the data of the file to the operating system to complete the access to the file (i.e., read, write, modify, delete, etc.).]

The client node software does this **transparently and automatically without requiring intervention by the user.**” *Id.* at 14:48-60.

- Phillips teaches that “[a]ny file or directory information transfer and integrity maintenance is performed **transparently to the user and applications...as if they were locally present.**” *Id.* at 9:39-42.

It is respectfully submitted that PO misled the Board into misapprehending and overlooking this evidence, and, as a result, committed legal error in failing to consider Phillips for all that it teaches.

In addition, the Board also misinterpreted how Phillips was used to modify Aboulhosn’s system.² As demonstrated in the Petition, Aboulhosn already teaches virtual files and local files being stored in the **same locations**, which the Board does

² While the Board acknowledged that “Dr. McDaniel put forth evidence that Phillips teaches client node software that ‘transparently and automatically’ assists in accessing virtual files (i.e., ‘indistinguishable access’)” (Decision at 26), it failed to consider Dr. McDaniel’s opinions regarding Phillips in the context of the Aboulhosn-Phillips combination (Ex-1003 ¶¶ 154, 167-171).

not dispute. Pet. 43-44; Decision at 19-21, 25-27. Thus, to the extent 1[H]’s “indistinguishability” limitation requires virtual files and local files being stored in the same location, that limitation is already taught by Aboulhosn’s system before being modified by Phillips.

The Petition makes clear that Aboulhosn is modified by specific teachings regarding virtual and local files that are applicable regardless of whether the files are stored in the same or different locations. In particular, the Petitioner refers to modifications to Aboulhosn based on Phillips’s teachings that “[virtual] files ‘appear,’ i.e., entirely behave... as if locally present on the client nodes” and Phillips’s “client node software... complet[ing] the access to the file... transparently and automatically without requiring intervention by the user.” Pet. 45-46 (citing Ex-1006, 9:36-39, 14:48-60); *see also id.* at 47 (“Aboulhosn in view of Phillips discloses ‘...**virtual files** [e.g., Aboulhosn’s “virtual files”] **stored in the same locations** [e.g., in the same shared folder B] **as local files** [e.g., Aboulhosn’s “actual files”] **of the local file system, the virtual files indistinguishable from the local files by the local file system** [e.g., Aboulhosn’s virtual files as modified by Phillips to (1) appear visually indistinguishable to local files, and/or (2) be accessed transparently to the user, application, and operating system] **at each of the multiple devices.**’”) (emphasis and brackets original). In contrast, the Petition does not rely on Phillips’s use of a virtual drive to store its virtual files, but instead relied on Aboulhosn for this

limitation). Therefore, Phillip’s storage location of its files forms no part of the combined Aboulhosn-Phillips system having virtual files and local files stored in the same locations as disclosed in Aboulhosn.

2. The Board misapprehended or overlooked the motivation to combine Phillips and Aboulhosn

The Board acknowledged, but rejected, the evidence that a POSITA seeking “a smoother and more seamless user experience with Aboulhosn’s system” would have been motivated to incorporate “Phillips’s visual indistinguishability feature (i.e., displaying virtual files to the user in the same way as local files).” Decision at 27 (citing Pet. 54-55). In the Board’s view, because “Phillips’s virtual files are visually distinguishable” and “located in that separate virtual drive,” then “Phillips’s presentation of virtual files in a separate virtual drive” would not “have motivated an ordinarily skilled artisan to combine Phillips with Aboulhosn in the manner suggested by Petitioner.” *Id.*

Respectfully, however, the Board’s conclusion regarding a motivation to combine Aboulhosn and Phillips misapprehended or overlooked certain critical evidence and arguments.

The Petition demonstrated that a POSITA would have been motivated to incorporate Phillips’s virtual file features, such as visual indistinguishability of the file name and transparent access, into Aboulhosn’s system. Pet. 54. As discussed above, even if Phillips’ “virtual files” are “stored in a separate location,” that was

neither relied on to modify Aboulhosn, nor is it part of the combined system.

The Petition demonstrated that Phillips teaches displaying virtual files to the user in the same way as local files, including removing Aboulhosn's special virtual file extension "vf." Ex-1006, 15:4-7. It also teaches that "[t]he client node software" performs "transparently and automatically without requiring intervention by the user." *Id.* at 14:58-60. The effect is that Phillips provides the "perception that all the shared files are synced/stored locally while the local disk drive need only provide minimal space for the remote/virtual files." Pet. 55. And a POSITA incorporating these features into **Aboulhosn's system**, which stored actual and virtual files in the **same location**, would provide a smoother and more seamless user experience where all files have the same visual appearance. *Id.* at 54-55 (citing Ex-1003, ¶¶ 168-69).

The Petition further demonstrated that a POSITA would have been motivated to incorporate Phillips's transparent access feature into Aboulhosn's system, i.e., a user transparently accessing virtual files to provide a better, smoother, more efficient, and more seamless user experience as the user need not worry about, nor can they tell, if the file is local or virtual. Pet. 54-55; Ex-1003, ¶ 170. However, respectfully, the Board overlooked this argument and its supporting evidence. *See* Decision at 27.

For example, the Board failed to address that when accessing a remote file, both Aboulhosn and Phillips disclose retrieving the remote file to the local device to

allow operations (Ex-1005, 2:15-18; Ex-1006, 14:38-42, 28:21-31), but Aboulhoshn does not provide details on how such file retrieval is implemented. As such, a POSITA implementing Aboulhoshn's system would have been motivated to look to other references, like Phillips, for details of how to access remote files.³ As shown in the Petition (at 55-56), such details include:

- “[T]he application generat[ing] the appropriate request to the operating system to perform the appropriate file access operations” and “the client node software intervenes and assists the operating system in identifying the appropriate file and in providing the data of the file to the operating system to complete the access to the file (i.e., read, write, modify, delete, etc.).” Ex-1006, 14:52-58.
- “The client node software does this transparently and automatically without requiring intervention by the user,” and “[i]n essence, neither the client user nor the application executing at the client node is aware of the actual location or home of the files as the integration is perfectly transparent and seamless.” Ex-1006, 14:58-60, 15:4-7.

³ As Dr. McDaniel explains, when a user wishes to access a file stored remotely, Phillips automatically retrieves the file content on behalf of the user. In this way, the user need not be concerned whether the file is local or not. Ex-1003, ¶170.

Therefore, respectfully, the Board overlooked or misapprehended the evidence and arguments in concluding that “Phillips’s presentation of virtual files in a separate virtual drive” would not “have motivated an ordinarily skilled artisan to combine Phillips with Aboulhosn in the manner suggested by Petitioner.” Decision at 27. Specifically, the motivations to combine Aboulhosn and Philips are not dependent upon the location where Phillips stores its virtual files, and, therefore, do not rise or fall with “Phillips’s presentation of virtual files in a separate virtual drive.” The Petition demonstrated that there are several reasons a POSITA would have been motivated to combine Aboulhosn and Phillips, and, it is respectfully submitted, that the Board overlooked or misapprehended those reasons too.

III. CONCLUSION

For the foregoing reasons, and those discussed in the Petition, Petitioner respectfully request that a rehearing be granted and the Board institute trial.

Dated: July 8, 2024

Respectfully Submitted,

/ Dion M. Bregman /

Dion M. Bregman

Reg. No. 45,645

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, lead counsel for Petitioner hereby certifies that on July 8, 2024, copies of this PETITIONER'S REQUEST FOR REHEARING FOLLOWING INSTITUTION DECISION UNDER 37 C.F.R. § 42.71(d) was sent via email to counsel of record in this proceeding:

Skiermont Derby LLP

Rex Hwang

John E. Lord

Alexander E. Gasser

Jaime K. Olin

EntangledMedia_SDTeam@skiermontderby.com

Dated: July 8, 2024

Respectfully Submitted,

/ Dion M. Bregman /

Dion M. Bregman

Reg. No. 45,645