

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,
Petitioner,

v.

ENTANGLED MEDIA, LLC,
Patent Owner.

IPR2024-00284
Patent 8,296,338 B2

Before MICHELLE N. WORMMEESTER, JOHN A. HUDALLA, and
DONALD E. DAYBELL, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

Dropbox, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 1–14 of U.S. Patent No. 8,296,338 B2 (Ex. 1001, "the '338 patent"). Petitioner filed a Declaration of Patrick D. McDaniel, Ph.D. (Ex. 1003) with its Petition. Entangled Media, LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.").

On June 6, 2024, we entered a Decision (Paper 7, “Dec.”) denying institution of *inter partes* review. As part of the Decision, we construed certain aspects of limitation 1[H] in claim 1: “virtual files stored in the same locations as local files of the local file system, the virtual files indistinguishable from the local files by the local file system at each of the multiple devices.” See Dec. 13–16 (quoting Ex. 1001, 11:47–50). We found that Petitioner had not shown sufficiently that the combination of Aboulhosn (Ex. 1005) and Phillips (Ex. 1006) teaches “the virtual files [being] indistinguishable from the local files by the local file system.” See *id.* at 25–26. We also found deficiencies with Petitioner’s stated rationale for combining Phillips with Aboulhosn. See *id.* at 27. Thus, we determined that Petitioner had not established a reasonable likelihood that it would prevail in showing that the subject matter of claim 1 would have been obvious over the combination of Aboulhosn and Phillips. See *id.* We made similar determinations for all remaining challenged claims and grounds. See *id.* at 27–32.

Petitioner filed a Request for Rehearing (Paper 8, “Req. Reh’g”) asking us to reconsider our analysis of the merits and to grant institution of *inter partes* review. For the reasons stated below, we *deny* the Request for Rehearing.

I. ANALYSIS

When reconsidering a decision on institution, we review the decision for an abuse of discretion. See 37 C.F.R. § 42.71(c) (2024). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial

evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The party requesting rehearing has the burden of showing the decision should be modified, which includes specifically identifying all matters the party believes we misapprehended or overlooked. *See* 37 C.F.R. § 42.71(d).

Petitioner contends that we:

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.

Req. Reh’g 1. We now consider Petitioner’s arguments about these two issues.

A. *Petitioner’s Arguments Regarding the Construction of “Indistinguishable”*

Petitioner agrees with our determination that the patentees disavowed 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. Req. Reh’g 2 (citing Dec. 16). Nevertheless, Petitioner disputes our determination that, based on disavowal, remote or virtual files that are kept in a separate folder, device, or drive are not “indistinguishable” from local files. *Id.* Petitioner argues that the “indistinguishable” limitation is separate and distinct from the “same locations” limitation. *Id.* at 3–5. In particular, Petitioner stresses that “indistinguishable” includes visual indistinguishability of the files

themselves, and “is used to refer to how files appear or their visual representation.” *Id.* at 3–4.

We do not agree that we misapprehended these claim limitations and how to construe the term “indistinguishable.” At the outset, we note that Petitioner concedes a disavowal of claim scope as to the “same locations” limitation, but disputes that disavowal applies to the “indistinguishable” limitation. *See* Req. Reh’g 2–3. Yet, despite highlighting the difference in language between these limitations (*see id.* at 3–5), Petitioner does not put forth any argument as to what we overlooked or misapprehended that suggests these limitations should be treated differently with respect to disavowal.

Our finding of disavowal with respect to the “indistinguishable” limitation is supported by numerous citations to the Specification of the ’338 patent. In particular, we cited the Specification’s statement that “it is ‘[c]ritical to the unique nature of this system’ that its shared file system is ‘totally transparent, not requiring the user to interact with software, nor distinguish files in local vs. remote locations.’” Dec. 15 (quoting Ex. 1001, 5:24–26). We also noted how the disclosed system of the ’338 patent modifies “the local operating system’s file system . . . 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).” *Id.* (quoting Ex. 1001, 6:25–30 (emphasis added)). These passages support disavowal with respect to the term “indistinguishable” because they expressly describe how—in prior art file systems—virtual files kept in a “separate and segregated location,” “synchronization folder,” or

“mounted” drive are necessarily distinguishable from local files by the local file system. Further, a file kept in a location separate, segregated, or remote from local files would require a user to distinguish between such locations, which is antithetical to the critical feature of total transparency described in the ’338 patent.

Petitioner’s arguments also imply that we did not consider the visual aspect of indistinguishability separate and apart from the “same locations” limitation. *See* Req. Reh’g 4. Yet our claim construction analysis quoted the Specification of the ’338 patent and stated that “remote or virtual files in the disclosed system are visually represented ‘as if the files were indeed local, allowing the user to operate on them as if they were local to the device,’ thus making their appearance ‘indistinguishable’ from that of local files.” Dec. 15–16 (quoting Ex. 1001, 6:30–36). In light of our disavowal analysis, this passage supports our determination that files 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. *See id.* at 16. And, even if we were to focus on visual indistinguishability, as Petitioner stresses, our construction still holds true because files that are kept *visually* in a separate folder, device, or drive are not “indistinguishable” from local files by the local file system.¹

For these reasons, we did not misapprehend the meaning of “indistinguishable” in the challenged claims.

¹ In the Decision, we made express findings about how Petitioner’s obviousness combinations do not teach *visual* indistinguishability. *See infra* § II.B.

B. Petitioner’s Arguments Regarding Our Analysis of the Combination of Aboulhosn and Phillips

Petitioner argues that it “demonstrated that Aboulhosn, as modified in view of Phillips, discloses both (1) visual indistinguishability and (2) transparent access.” Req. Reh’g 8. In particular, Petitioner argues that we erred in extending the patentee’s disavowal to Petitioner’s cited teachings from Phillips on indistinguishability. *Id.* at 9–10. Petitioner notes how it cited various teachings from Phillips, including certain passages touching on “indistinguishable” and “transparent[]” access, and Petitioner contends that we failed to consider this evidence for all that it teaches. *Id.* at 9–10 & n.2 (citing Pet. 44–47; Ex. 1003 ¶¶ 154, 167–171; Ex. 1006, 9:39–42, 14:48–60, claim 16; *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 (Fed. Cir. 2018)).

We disagree that we misapprehended or overlooked any of Petitioner’s arguments or evidence. Our Decision specifically cites and discusses the passages from Phillips mentioned by Petitioner in its Request for Rehearing, so we did not overlook those passages. *See* Dec. 22 (citing Ex. 1006, 9:39–42, 14:48–60, claim 16), 25–26 (citing same). Petitioner’s remaining arguments relate to the interplay between the patentees’ disavowal for the “indistinguishable” limitation and Petitioner’s cited modifications of Aboulhosn based on Phillips. *See* Req. Reh’g 10–12. As discussed above (and in the Decision), the patentees disavowed coverage for the “indistinguishable” limitation to the extent it relates to files kept in a folder, device, or drive separate from local files. *See supra* § I.A. In the Decision, we discussed with reference to Phillips’s Figure 4 how “Phillips’s virtual storage device and its contents are segregated from local files in Phillips’s display window 1000.” Dec. 25 (citing Ex. 1006, 13:44–50, Fig.

4). We also noted how Phillips’s teachings amount to nothing more than “files in a segregated virtual drive *appearing to be locally present.*” *Id.* at 26 (emphasis added); *see also id.* at 27 (“Phillips’s virtual files are *visually distinguishable* because they are located in that separate virtual drive” (emphasis added)). As such, we concluded that “Phillips’s virtual files are distinguishable from local files because virtual files are segregated in a separate, virtual drive.” *Id.* at 26. Thus, we considered Phillips’s teachings to the extent they pertain to indistinguishability, including visual indistinguishability, but we determined they teach nothing more than what the patentees had disavowed.

Regarding Phillips’s cited teachings on “transparently and automatically” assisting in accessing virtual files (*see* Req. Reh’g 9–10 & n.2), we noted in the Decision how such teachings do not change the fact that virtual files are distinguishable from local files in Phillips’s system. Dec. 26. Even if Phillips teaches that a user or application may access a virtual file in the same manner as with a local file, the virtual file is still distinguishable by the local file system because it is stored in a separate, virtual drive. *See id.* at 26–27. Thus, we do not discern any error in our conclusion that Phillips’s alleged transparent access does not teach “the virtual files [being] indistinguishable from the local files by the local file system.” *See id.* at 26.

Petitioner also argues that we overlooked certain aspects of its rationale for combining Phillips with Aboulhosn. Req. Reh’g 12–15. Among other things, Petitioner contends that it demonstrated that an ordinarily skilled artisan “would have been motivated to incorporate Phillips’s virtual file features, such as visual indistinguishability of the file

name and transparent access, into Aboulhosen's system." *Id.* at 12 (citing Pet. 54). As discussed above, however, Phillips's alleged "visual indistinguishability" amounts to displaying virtual files in a virtual drive that is separate from local files. *See* Dec. 26–27. This is within the scope of the patentees' disavowal regarding the "indistinguishable" limitation. Phillips's alleged "transparent access" (*see* Req. Reh'g 13–14) similarly amounts to using the same access paradigms on virtual files stored in a separate folder. This too is within the scope of patentee's disavowal.

Given the visual and operational distinguishability of Phillips's virtual files, we rejected the notion that "Phillips's presentation of virtual files in a separate virtual drive would have motivated an ordinarily skilled artisan to combine Phillips with Aboulhosen in the manner suggested by Petitioner." Dec. 27. Petitioner's arguments for rehearing do not undermine this assessment.

II. CONCLUSION

For the reasons above, we conclude that Petitioner has not met its burden of showing that we (1) misapprehended the proper interpretation of the term "indistinguishable"; or (2) misapprehended or overlooked Petitioner's obviousness contentions regarding the combination of Aboulhosen and Phillips. Therefore, we *deny* Petitioner's Request for Rehearing.

III. ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing is *denied*.

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