

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,
Petitioner,

v.

ENTANGLED MEDIA, LLC,
Patent Owner.

IPR2024-00285
Patent 8,484,260 B2

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

DAYBELL, *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)

I. INTRODUCTION

Dropbox, Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–8 ("challenged claims") of U.S. Patent No. 8,484,260 B2 (Ex. 1001, "the '260 Patent") pursuant to 35 U.S.C. §§ 311–319. Paper 2 ("Pet."). Entangled Media, LLC ("Patent Owner") filed a Preliminary Response. Paper 6.

On June 6, 2024, we entered a Decision (Paper 7, “Dec.”) denying institution of *inter partes* review. As part of the Decision, we considered Petitioner’s arguments that Havewala (Ex. 1005) taught “accepting a request to operate on a file” and “intercepting the request.” Dec. 16–20; Pet. 20–22, 32–34. We further considered Petitioner’s arguments that Havewala taught “determining . . . if the file is a virtual file of a corresponding file physically stored on a second device by reviewing file metadata.” Dec. 20–23; Pet. 34–39. We considered Petitioner’s arguments as set forth in the Petition, along with Petitioner’s evidence in support and, where relevant, Patent Owner’s arguments in opposition. We concluded that Petitioner had not shown a reasonable likelihood that it would prevail in establishing unpatentability of any challenged claim of the ’260 Patent, and denied institution of *inter partes* review. Dec. 2.

Petitioner filed a Request for Rehearing (Paper 8, “Req.”) asking us to reconsider our analysis of Havewala and our decision to deny institution.

II. ANALYSIS

When reconsidering a decision on institution, we review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). 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, “and the place where each matter was

previously addressed” in the relevant briefing (here the Petition). See 37 C.F.R. § 42.71(d).

Petitioner contends that we misapprehended or overlooked two aspects of its arguments relating to Havewala. First, Petitioner contends that we failed to appreciate that Havewala broadly teaches a “request to access” that includes an “open” command, a “read” command, and the subsequent system messaging (including the “error” message) generated in processing the “request to access.” Req. 2–3, 8. Based on this alleged misapprehension, Petitioner contends that we failed to appreciate that Havewala teaches the claimed “intercepting the request by a software client” limitation of claim 1. *Id.* at 2.

Second, Petitioner contends that we failed to appreciate that Havewala’s ghosting filter does not “determine” that a file is “a virtual file of a corresponding file physically stored on a second device” until the ghosting filter “confirms” that the file is ghosted by identifying the specific location of that file using the ghosting information (i.e., file metadata) taught by Havewala. Req. 9. Based on this alleged misapprehension, Petitioner contends that we failed to appreciate that Havewala teaches the claimed “determining” step of claim 1. *Id.*

We address each contention in turn below.

A. *Petitioner’s Arguments Regarding the “Request” Limitations*

1. *The scope of Havewala’s “request to access”*

Limitation 1[A] recites “accepting a request to operate on a file at a first device.” Ex. 1001, 11:27. Limitation 1[C] recites “intercepting the request by a software client on the first device.” *Id.* at 11:34–35. With respect to Petitioner’s analysis of limitations 1[A] and 1[C], Petitioner contends that we misapprehended and overlooked “the Petition’s evidence of

the full scope of Havewala’s disclosed ‘request to access.’” Req. 2–3. Petitioner contends that Havewala’s “request to access . . . encompasses both Havewala’s ‘open’ and ‘read’ commands” and that these commands are “covered by the claimed ‘request to operate on a file.’” *Id.* Petitioner, however, fails to identify where this contention was previously discussed in the Petition. In its discussion of this issue, the Request cites to pages 20–21 of the Petition. *Id.* at 3–4 (citing Pet. 20–21). These pages cover Petitioner’s contentions that Havewala teaches limitation 1[A] of claim 1.

We have reviewed these pages of the Petition, and we see nothing therein which contends that Havewala’s request to access encompasses both Havewala’s “open” and “read” commands. Pet. 20–21. The Petition first identifies “a process for operating on files [e.g., Havewala’s ‘open’ commands].” *Id.* at 20. Lower on this same page, the Petition states:

To access the file, a user selects a file from the file system and an “application 30 begins the process by **issuing the open command with respect to a particular ghosted file 14** on the volume 12 and such **open command ultimately is received by the file system 16.**”

Pet. 20–21. Finally, on page 21, the Petition states “Havewala confirms that its system ‘receive[s] [a] request to access’ or open the file,” with a citation to step 501 of Figure 5 of Havewala. *Id.* at 21.

Indeed, on page 22 of the Petition (not cited by Petitioner in its Request), the Petition “summariz[es]” (*cf.* Req. 7) Petitioner’s argument for limitation 1[A], stating that “Havewala discloses ‘**accepting a request to operate on a file at a first device** [e.g., Havewala’s open command that is received and accepted by the first computing device . . .].” Pet. 22.

These passages in the Petition consistently rely on Havewala’s “open” command as allegedly satisfying the “accepting a request to operate on a

file” limitation of claim 1. Pet. 20–21. There is nothing in these pages that even mentions Havewala’s “read” command, much less contends that Havewala’s “open” and “read” commands are part of an overall “request to access” as Petitioner now contends in the Request. Req. 2–3.¹ We could not have misapprehended or overlooked an argument that Petitioner failed to make. *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1369 (Fed. Cir. 2014) (“An argument made for the first time in a motion for reconsideration comes too late and is ordinarily deemed waived.”); *United Services Automobile Ass’n v. Auto Telematics, Ltd.*, IPR2023-00519, Paper 13 at 9 (PTAB Nov. 27, 2023) (finding that arguments not made in the briefing or adopted in the decision could not be a basis for rehearing); *Roku Inc. v. Ioengine, LLC*, IPR2022-01257, Paper 14 at 6 (PTAB Oct. 11, 2023) (finding that a new argument “could not have been misapprehended or overlooked by the Board”).

2. *Limitation 1[C]: Intercepting the request*

Petitioner contends that we misapprehended or overlooked the Petition’s evidence that Havewala discloses limitation 1[C], “intercepting the request by a software client on the first device.” Req. 5. Petitioner contends that we misapprehended that Havewala’s “open” and “read” commands are part of the same “request.” *Id.* at 6. Here, Petitioner relies on

¹ The Request contends that the Petition cited to paragraphs 59 and 66 of Havewala and that those paragraphs contain text which supports Petitioner’s argument as presented in the Request. Req. 4. Petitioner, however, must set forth *in the Petition* the arguments it wishes to make. Citations to the evidence without explanation of the import of that evidence are insufficient to discharge Petitioner’s burden. 37 C.F.R. § 42.22(a)(2); *First Alert, Inc. v. Walter Kidde Portable Equip., Inc.*, IPR2023-00896, Paper 14 at 13 (PTAB Dec. 13, 2023).

its previous discussion of this issue for limitation 1[A], as well as on its arguments set forth on pages 33–34 of the Petition. Req. 6–7 (citing Pet. 33–34). These pages cover Petitioner’s contention that Havewala teaches limitation 1[C] of claim 1. Pet. 33–34.

We have reviewed these pages of the Petition, and we see nothing therein which contends that Havewala’s request to access encompasses both Havewala’s “open” and “read” commands. Pet. 33–34.

The Petition first points to a passage from Havewala that recites in relevant part:

when a user or application 30 tries to access the removed data 20 of a ghosted file 14, the file system 16 upon receiving a **request for** such **access** will discover that the ghosted file 14 does not contain the removed data 20 and thus return an error which the **ghosting filter 26 will intercept**.

Pet. 33 (citing Ex. 1005 ¶ 64). The Petition then states, “Havewala further discloses that ‘the ghosting filter stores the read command in a queue or the like for awaiting further processing (step 613).’”² *Id.* at 34. Finally, the Petition concludes with a “summar[y]” (*cf.* Req. 7) of Petitioner’s position for limitation 1[C], stating: “Havewala discloses ‘**intercepting the request** [e.g., ghosting filter 26 intercepting an access request].’” Pet. 34.

There is nothing in the discussions on pages 33–34 that even mentions Havewala’s “open” command, much less contends that Havewala’s “open” and “read” commands are part of an overall “request to access” as Petitioner now contends in the Request. Req. 6–7. Here again, we could not have misapprehended or overlooked an argument that Petitioner failed to make.

² Contrary to Petitioner’s contention, we did not overlook this teaching of Havewala. Req. 6–7. Indeed, we specifically pointed to this teaching in our Decision, as Petitioner recognizes. *Id.* at 6 (citing Dec. 19).

Golden Bridge Tech., 758 F.3d at 1369; *United Services Automobile Ass’n*, IPR2023-00519, Paper 13 at 8; *Roku Inc.*, IPR2022-01257, Paper 14 at 6.

Lastly, Petitioner contends that in addition to the “open” and “read” commands, Havewala’s “error” message is also part of Havewala’s “request to access.” Req. 8. The Request, however, fails to identify anywhere in the Petition where Petitioner contended that the “error” message was part of the “request to access.” *Id.* at 8–9. Nor does the Request point to any evidence that would support the contention that an “error” message, generated by the file system in response to an “open” command, could be considered as part of any request. *Id.* at 8–9. Furthermore, as we found in our Decision, Havewala’s error message is not a request. Dec. 19. It is, instead, a response to a request. *Id.* Petitioner does not provide, nor do we see, any basis for reconsidering this finding.

B. Petitioner’s Arguments Regarding the “Determining” Limitation

Petitioner contends that we misapprehended or overlooked the Petition’s evidence that Havewala discloses limitation 1[D], i.e., “determining by the software client . . . if the file is a virtual file of a corresponding file physically stored on a second device by reviewing the file metadata.” Req. 9. Petitioner contends in the Request that Havewala’s ghosting filter does not determine whether a file is a ghosted file until after Havewala’s ghosting filter retrieves the ghosting information for a file. *Id.* at 10.

The crux of Petitioner’s position is that the claim includes a “requirement to determine the virtual file has ‘a corresponding file physically stored on a second device by reviewing file metadata.’” Req. 11. That is, according to Petitioner, the claim requires not only a determination

that the file is a virtual file, but also requires a determination of the location of the corresponding physical file. *Id.*

Even if we were to agree with Petitioner, Havewala still does not teach limitation 1[D] according to Petitioner's reading of the limitation. Determining that a file *is* a virtual file of a corresponding file physically stored on a second device and determining *the precise location* of that physical file are two different concepts. We agree with Petitioner that Havewala's ghosting filter relies on file metadata to determine the location of a physical file that corresponds to a virtual file. Req. 10–13 (citing Pet. 37–39). However, Havewala's ghosting filter does not rely on file metadata to determine that a file is a ghosted file (i.e., a virtual file). Dec. 20–22. Instead, as Petitioner concedes, “the ghosting filter 26 intercepts such returned error and ***perceives based thereon*** that the file 14 at issue is in fact in a **ghosted format** (step 605).” Req. 11 (citing Dec. 22; Ex. 1005 ¶ 68). That is, Havewala's ghosting filter determines that the file is a virtual file based on receiving an error message, not on analysis of any file metadata. Dec. 21. The only virtual files that Havewala teaches are “ghosted” files that have a corresponding physical file stored elsewhere. *See, e.g.*, Ex. 1005 ¶ 8 (“The present invention relates to an architecture and methods that allow data from a computer file stored on a storage volume to be moved or ‘ghosted’ to an alternate location to free space on the storage volume.”). Therefore, once Havewala's ghosting filter has determined that a file is “ghosted,” it has necessarily also decided that this “ghosted” file is a file that has a corresponding physical file stored elsewhere. This determination does not involve any analysis of a file's location.

It is true that Havewala's system, once it identifies a “ghosted” file, retrieves the contents of that file using file metadata. Ex. 1005 ¶ 64

(describing how Havewala reconstitutes files using metadata). But this step is not part of Havewala's (or the claim's) "determining" whether a file is virtual. It is simply the next step in processing of a file that Havewala's ghosting filter has already determined is virtual. *Id.* ¶ 64 ("[T]he file system 16 upon receiving a request for such access will discover that the ghosted file 14 does not contain the removed data 20 and thus return an error which the ghosting filter 26 will intercept."). Thus, Havewala does not teach determining whether a file is a virtual file "by reviewing the file metadata," as is required by limitation 1[D]. Dec. 20–22.

Regardless, in order to prevail on a request for rehearing, the petitioner must establish that we overlooked or misapprehended an argument that the petitioner made. In the Request, Petitioner contends that the "claimed 'virtual file' is a specific type of file" and that limitation 1[D] "requires the software client to determine whether the virtual file is the claimed virtual file by using metadata to determine the location of the virtual file's corresponding physical file at a second device." Req. 11. That is not what the claim says. Nor did Petitioner propose that construction for limitation 1[D].³ Pet. 11. Petitioner points to pages 37–38 of the Petition as the location where it contends that it previously made this argument. Req. 11. Nowhere in these pages does Petitioner argue that limitation 1[D] requires the two-step determining process it advocates for now, where the software client first identifies a virtual file corresponding to a file physically stored at a second device, and then confirms using metadata that the identified virtual file accurately corresponds with a physical file at a second

³ We note that Petitioner did not seek leave to file a Reply to address any nascent claim construction issue presented in the Preliminary Response.

device. *Id.* at 10 (arguing that “the only way that the ghosting filter can determine whether a file is virtual, *and if so*, the location of its corresponding physical file, is by examining the file’s metadata”) (emphasis added). Given that Petitioner never set forth this argument prior to the Request, we could not have overlooked or misapprehended it.

C. Petitioner’s Arguments Regarding the Interplay of Limitations 1[A] and 1[C] with Limitation 1[D]

Finally, Petitioner contends that the Board improperly tied the “determining” limitation 1[D] to the “request” limitations 1[A] and 1[C], by requiring an order of operations between limitations 1[A], 1[C], and 1[D]. *See* Req. 14–15. We did not interpret claim 1 to require any such ordering of operations. We merely observed that, even in a hypothetical situation where limitation 1[D] were interpreted (incorrectly) to require determining the *location* of files, Havewala (in combination with the other asserted references) still would not have rendered obvious claim 1 because Havewala does not teach any request that is intercepted by the client software, as required by limitation 1[C]. Dec. 23. As such, Petitioner’s comments regarding this observation do not form a basis for rehearing.

III. CONCLUSION

For the reasons above, we conclude that the Petitioner has not met its burden of showing that the Board abused its discretion in evaluating Petitioner’s arguments and the teachings of Havewala. Therefore, we deny Petitioner’s requests to consider Petitioner’s arguments presented for the first time in the Request, re-evaluate the teachings of Havewala, and institute *inter partes* review in this proceeding.

IV. ORDER

Accordingly, it is

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

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