

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

MOTION OFFENSE, LLC,
Patent Owner

Patent No. 10,303,353

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 10,303,353**

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EX1006	U.S. Patent No. 9,633,125 (“Garcia”)
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EX1017	Lex Machina, 3,654 Federal District Court Cases for Alan D. Albright (July 24, 2022)
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I. INTRODUCTION

Google LLC (“Petitioner”) requests *inter partes* review (“IPR”) of claims 1-7 and 16 (“the challenged claims”) of U.S. Patent No. 10,303,353 (“the ’353 patent”) (EX1001) assigned to Motion Offense, LLC (“Patent Owner” or “PO”). For the reasons below, the challenged claims should be found unpatentable and canceled.

II. MANDATORY NOTICES

Real Parties-in-Interest: Pursuant to 37 C.F.R. § 42.8(b)(1), Petitioner identifies the following as the real parties-in-interest: Google LLC.¹

Related Matters: The ’353 patent is at issue in the following civil actions: *Dropbox, Inc. v. Motion Offense, LLC*, Case No. 6:20-cv-00251-ADA (W.D. Tex.); *Motion Offense, LLC v. Google LLC*, Case No. 6:21-cv-00514-ADA (W.D. Tex.).

The ’353 patent originated from U.S. Patent Application No. 15/984,407 (“the ’407 application”), filed on May 20, 2018, and claims priority to U.S. Patent Application No. 13/624,906 (“the ’906 application”), filed on September 22, 2012. (EX1001, Cover.) Petitioner is concurrently filing an IPR petition challenging U.S.

¹ Google LLC is a subsidiary of XXVI Holdings Inc., which is a subsidiary of Alphabet Inc. XXVI Holdings Inc. and Alphabet Inc. are not real parties-in-interest to this proceeding.

Patent No. 10,613,737 (“the ’737 patent”), which issued from a continuation of the ’407 application and is at issue in the above-noted civil actions.

The ’353 patent is also related to U.S. Patent No. 11,044,215 (“the ’215 patent”), which is at issue in *Motion Offense, LLC v. Google LLC*, Case No. 6:21-cv-00514-ADA (W.D. Tex.) and *Motion Offense, LLC v. Dropbox, Inc.*, Case No. 6:21-cv-00758-ADA (W.D. Tex.). Petitioner is concurrently filing an IPR petition challenging the ’215 patent.

Counsel and Service Information: Lead counsel: Naveen Modi (Reg. No. 46,224). Backup counsel: (1) Joseph E. Palys (Reg. No. 46,508) and (2) Phillip Citroën (Reg. No. 66,541).

Service information is Paul Hastings LLP, 2050 M Street NW, Washington, DC 20036, Tel.: 202.551.1700, Fax: 202.551.1705, email: PH-Google-MotionOffense-IPR@paulhastings.com. Petitioner consents to electronic service.

III. PAYMENT OF FEES

The PTO is authorized to charge any fees due during this proceeding to Deposit Account No. 50-2613.

IV. GROUNDS FOR STANDING

Petitioner certifies that the ’353 patent is available for review, and Petitioner is not barred/estopped from requesting review on the grounds herein.

V. PRECISE RELIEF REQUESTED

A. Claims for Which Review Is Requested

Petitioner requests review of claims 1-7 and 16 (“the challenged claims”) of the ’353 patent and cancellation of those claims as unpatentable.

B. Statutory Grounds of Challenge

The challenged claims should be canceled as unpatentable in view of the following ground:

Ground 1: Claims 1-7 and 16 are unpatentable as obvious under pre-AIA 35 U.S.C. § 103 over U.S. Patent No. 8,825,597 (“Houston”) (EX1005) in view of U.S. Patent No. 9,633,125 (“Garcia”) (EX1006).

For purposes of this proceeding only, Petitioner assumes the earliest effective filing date of the ’353 patent is September 22, 2012, which is the filing date of the ’906 application, to which the ’353 patent claims priority.

Houston issued from an application filed August 13, 2010. Garcia issued from an application filed August 10, 2012. Therefore, Houston and Garcia each qualify as prior art at least under 35 U.S.C. § 102(e)(2) (pre-AIA).

Neither of the references were considered during prosecution of the ’353 patent. (EX1001, Cover (“References Cited”); *see also generally* EX1004.)

VI. LEVEL OF ORDINARY SKILL

A person of ordinary skill in the art as of the claimed priority date of the '353 patent ("POSITA") would have had a bachelor's degree in electrical engineering, computer 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.² More education can supplement practical experience and vice versa. (EX1002 ¶¶19-20.)

VII. OVERVIEW OF THE '353 PATENT

The '353 patent relates to "sharing a data object in a data store via a communication" without including an attachment. (EX1001, Abstract, 2:7-8; EX1002 ¶¶21-27.) The exchange of data (*e.g.*, folders and their content) occurs via a communication between two nodes (*e.g.*, computers). (EX1001, FIG. 5, 16:57-67, 17:20-36.) Specifically, the '353 patent describes a "Second Node" sharing a data object. (*See id.*, FIG. 6D, 28:12-15.) To do so, at the Second Node, a user can create an email identifying the data object. (*Id.*, 18:31-34, 28:12-34.) The '353 patent further describes how a user of the Second Node can provide "one or more contactee identifier(s) identifying one or more communicants in the role of contactee(s) in the

² Petitioner submits the declaration of Dr. Henry Houh (EX1002), an expert in the field of the '353 patent. (EX1002 ¶¶1-20, 168-169; EX1003.)

communication.” (*Id.*, 18:38-42.) The user of the Second Node may finally select a “Send” button to initiate sending of the email message to the identified contactees via a network. (*Id.*, FIG. 5, 21:58-63.)

The ’353 patent describes a “First Node” receiving the email message. (*Id.*, FIG. 6B.) The user of the First Node can click on the folder to pull up a context menu from which the user can either retrieve the data object referenced in the email or store the data object on the First Node. (*Id.*, 24:22-33.) Alternatively, the user can drag and drop the folder to a file explorer navigation window to store the referenced data object at a particular location on the First Node. (*Id.*, 24:34-48.)

VIII. CLAIM CONSTRUCTION

Under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), claim terms are typically given their ordinary and customary meanings as understood by a POSITA at the time of the invention based on the claim language, specification, and the prosecution history of record. (*Phillips*, 415 F.3d at 1313; *see also id.*, 1312-16.) The Board, however, only construes the claims when necessary to resolve the controversy. (*Toyota Motor Corp. v. Cellport Sys., Inc.*, IPR2015-00633, Paper 11

at 16 (Aug. 14, 2015) (citation omitted).) No express constructions of any claim terms are necessary to resolve this Petition. (EX1002 ¶28.)³

IX. DETAILED EXPLANATION OF GROUNDS

A. Ground 1: Claims 1-7 and 16 Are Obvious Over Houston and Garcia

1. Summary of Combination and Obviousness Rationale

Houston teaches or suggests all but a few of the features recited in the challenged claims. As explained below, Garcia teaches the features that are not explicitly disclosed in Houston, and it would have been obvious to a POSITA to modify Houston to incorporate these features, as described in Garcia.

For example, Houston discloses a user inputting into client 108a one or more email addresses identifying the user(s) with whom to share a folder and a host system 110 communicating invitations to share the folder to the invited user(s) via an open network connection, but does not explicitly disclose “receiving” / “causing to be

³ Petitioner reserves all rights to raise claim construction and other arguments, including challenges under 35 U.S.C. §§ 101 or 112, in district court as relevant to those proceedings. *See, e.g., Target Corp. v. Proxicom Wireless, LLC*, IPR2020-00904, Paper No. 11 at 11-13 (Nov. 10, 2020). A comparison of the claims to any accused products in litigation may raise controversies that are not presented here given the similarities between the references and the patent.

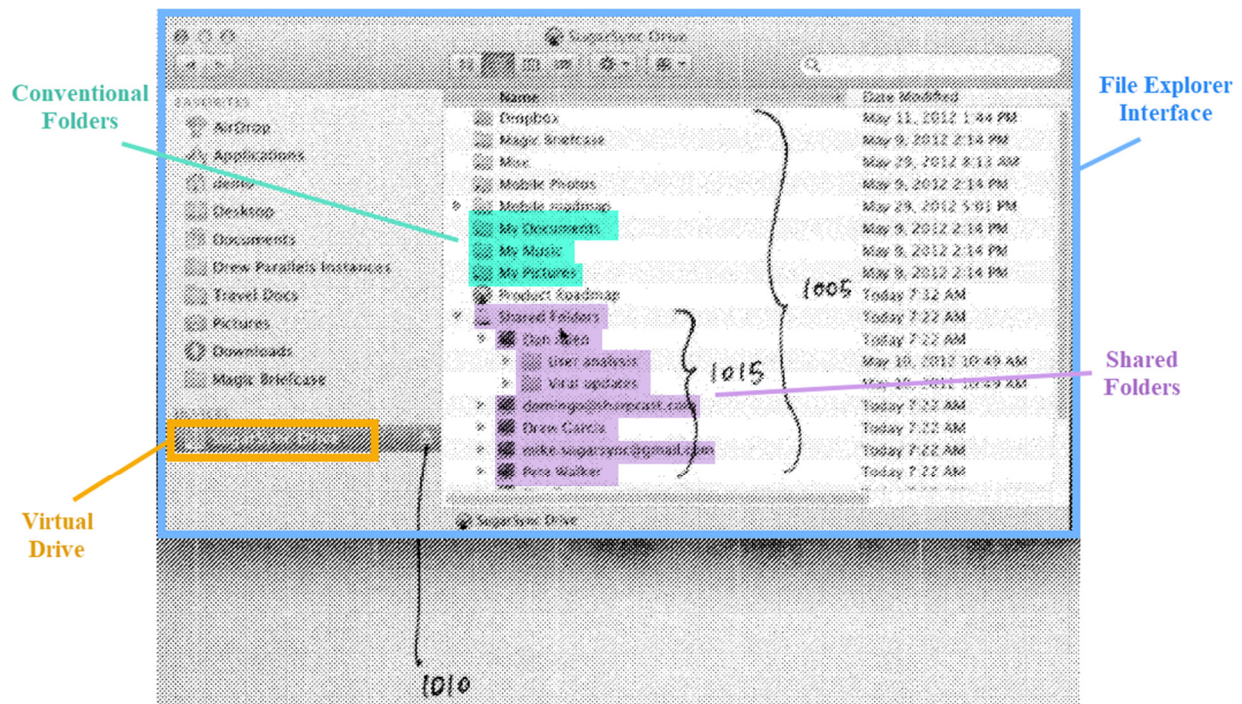
sent,” “via the at least one network,” “at least one email message identifying the at least one folder and including a reference to the at least one folder, without including [a file attachment / any file . . . as an attachment],” as recited in claims 1 and 5.⁴ Additionally, Houston discloses that users may access and modify files contained within a shared folder by obtaining a copy of the file and storing it locally, but does not explicitly disclose “in response to detection of the indication to open 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,” as recited in claim 5. Nor does Houston explicitly disclose “the storage at the second node does not store any file in response to the representation of the at least one folder being created, both for avoiding any file from having to be communicated to and stored at the second node until requested by at least one user at the second node,” as recited in claim 2, and “wherein, in response to the creation of the representation of the at least one folder being 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 16. These features, however, would have been obvious to a POSITA, based on the combined teachings of Houston and Garcia. (EX1002 ¶¶41-45, 47-58.)

⁴ For ease of reference, claim language is underlined in the instant petition.

Additionally, to the extent PO argues that Houston does not disclose “creating” / “creation of” and “displaying” / “display 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, these features would have also been obvious based on the combined teachings of Houston and Garcia. (*Id.*, ¶¶46-47, 54-58.)

For example, Garcia discloses the use of a “virtual drive” that allows folders that are stored remotely to be viewed and accessed using a device’s local file system (“utilizing code configured to be stored on a storage at the second node and further configured to cooperate with a file explorer interface”). (EX1006, 2:37-41 (“A user may be able to access, via the user interface, a virtual drive on the local device, where, via the virtual drive, a user is able to access items (e.g., files) in any object (e.g., folders), including objects located only on a remote device.”), 4:51-57; EX1002, ¶47.) According to Garcia, and as shown in Figures 10 and 20a below, a representation of such a folder and its contents may be created and viewed by a user (“creating” / “creation of” and “displaying” / “display of” “a representation of the at least one folder in a location among one or more folders on the file explorer interface”). (EX1006, 4:58-5:3 (“The virtual drive provides a file system representation, on the user’s local client device, of all objects, across a plurality of clients including the local client, which a user has synchronized or otherwise saved to the synchronization system.”), 5:27-35 (“A virtual drive is displayed on the user’s

local client device with the identified folders (step 2015).”), 2:66-3:3, 5:4-13, 6:5-27, 10:52-11:10 (“A virtual drive is a file representation view of non-file system data. That means that the folders 1005 may be viewed as if they resided on the hard drive of the local device[.]”), claim 4; EX1002, ¶47.)



(EX1006, FIG. 10 (annotated).)

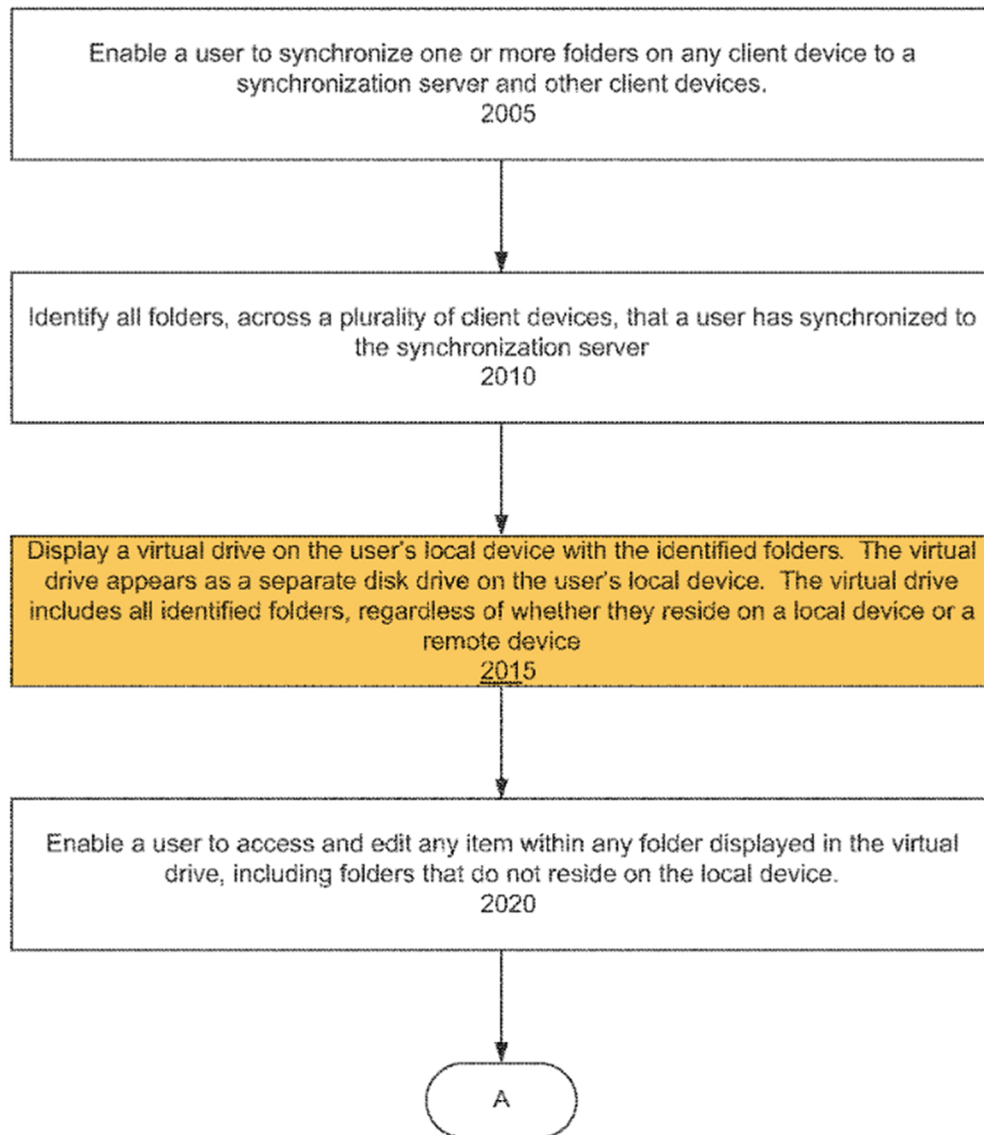
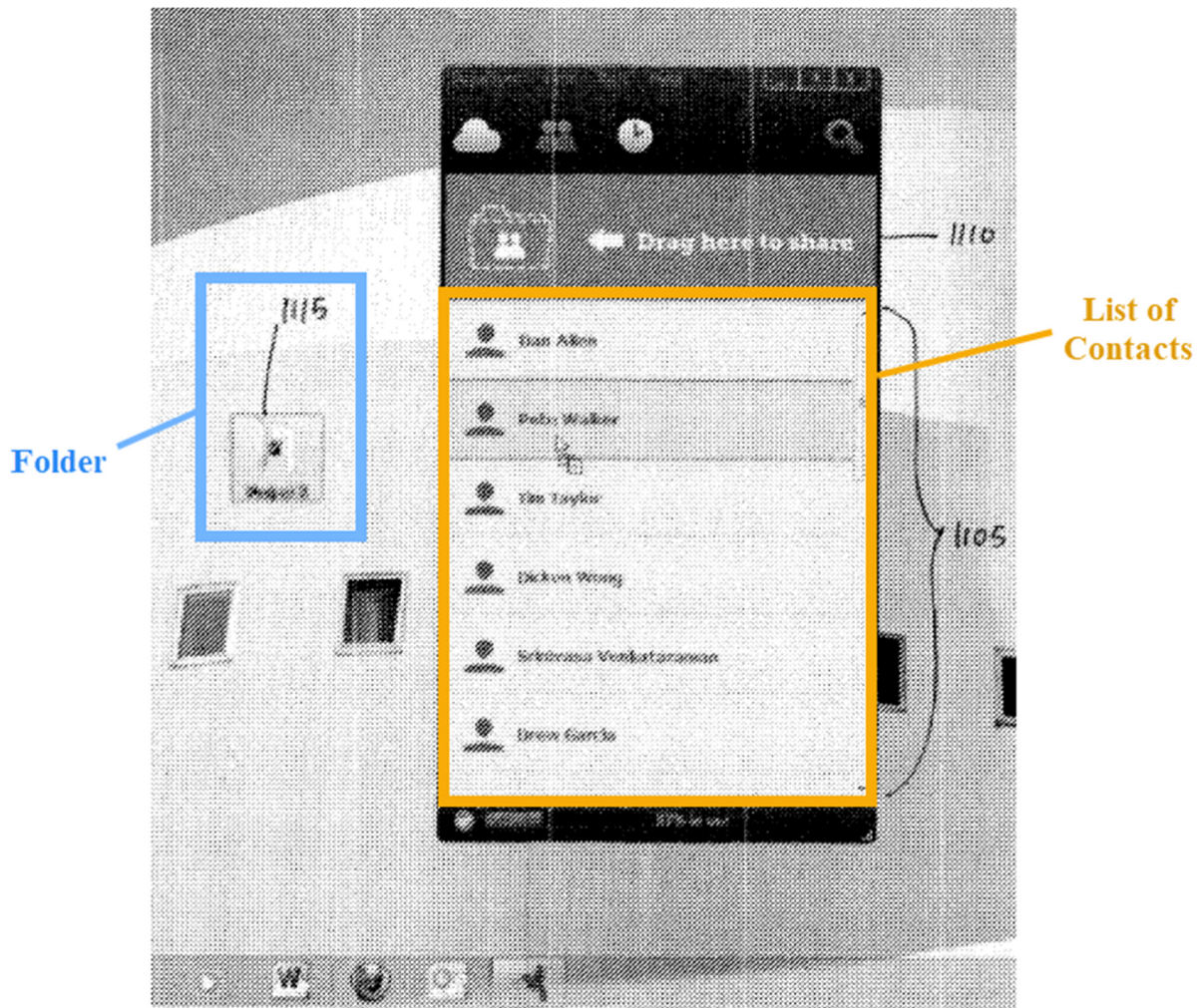


FIG. 20a

(*Id.*, FIG. 20a (annotated).)

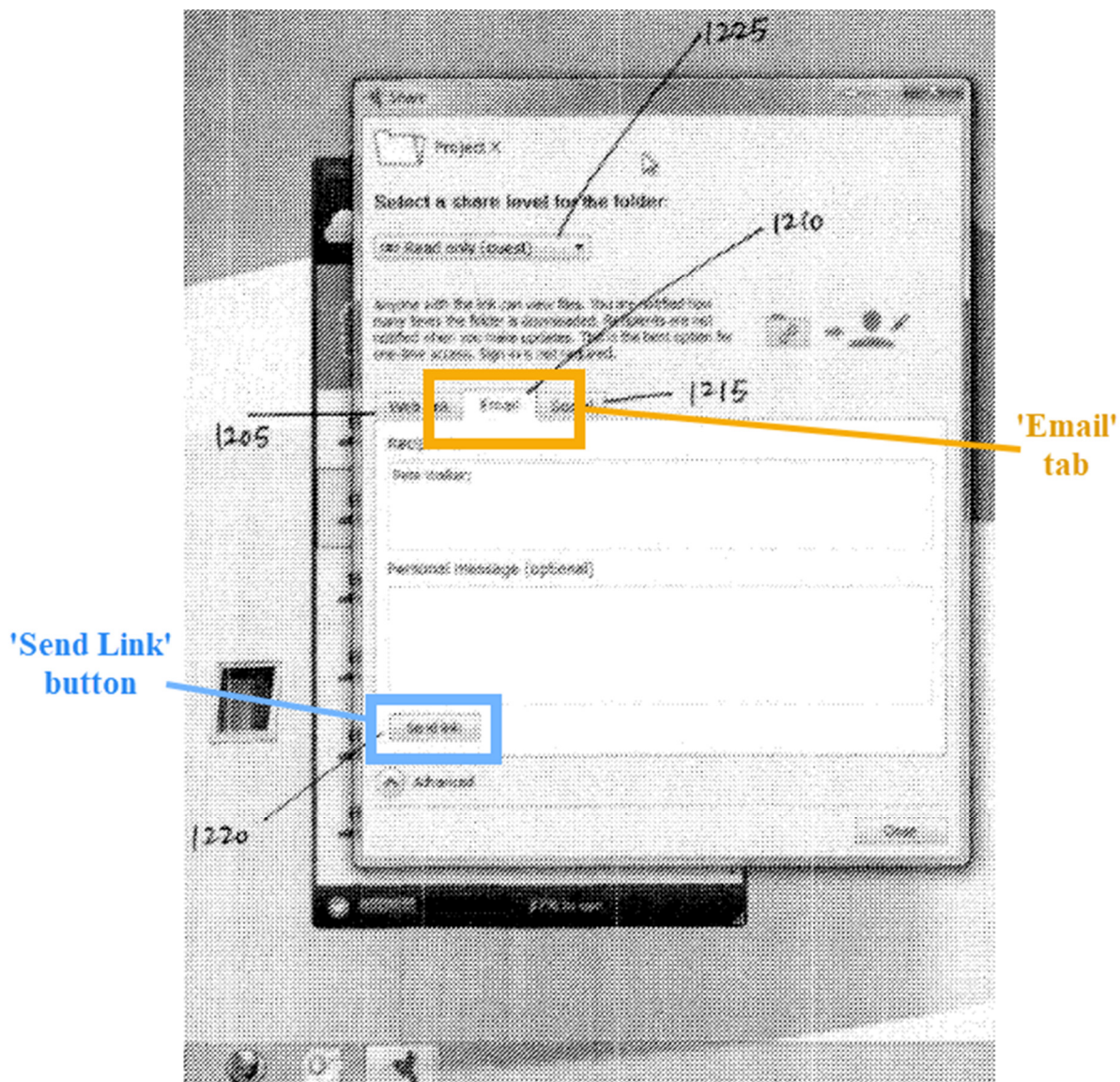
Garcia further discloses providing a web link in an email to share such a virtual folder. (EX1006, claim 3 (“The method of claim 1, further comprising providing a feature in the user interface that enables the user to generate a web link to any folder, or file therein, displayed in the user interface.”), 10:32-40, 11:39-43 (“The user may then type in the contact’s information (e.g., email address) in to the applicable field in the dialog box, and a link will be sent to the contact via web link 1205, email 1210, or by social networking 1215.”); EX1002, ¶¶48-49.) For example, as shown in Figure 11 below, Garcia discloses displaying a list of contacts 1105 and enabling a user to drag a folder 1115 to a particular contact, which shares the folder 1115 with the contact by automatically sending an email containing a link to the folder 1115 to that contact. (EX1006, 11:11-26.)



(*Id.*, FIG. 11 (annotated).)

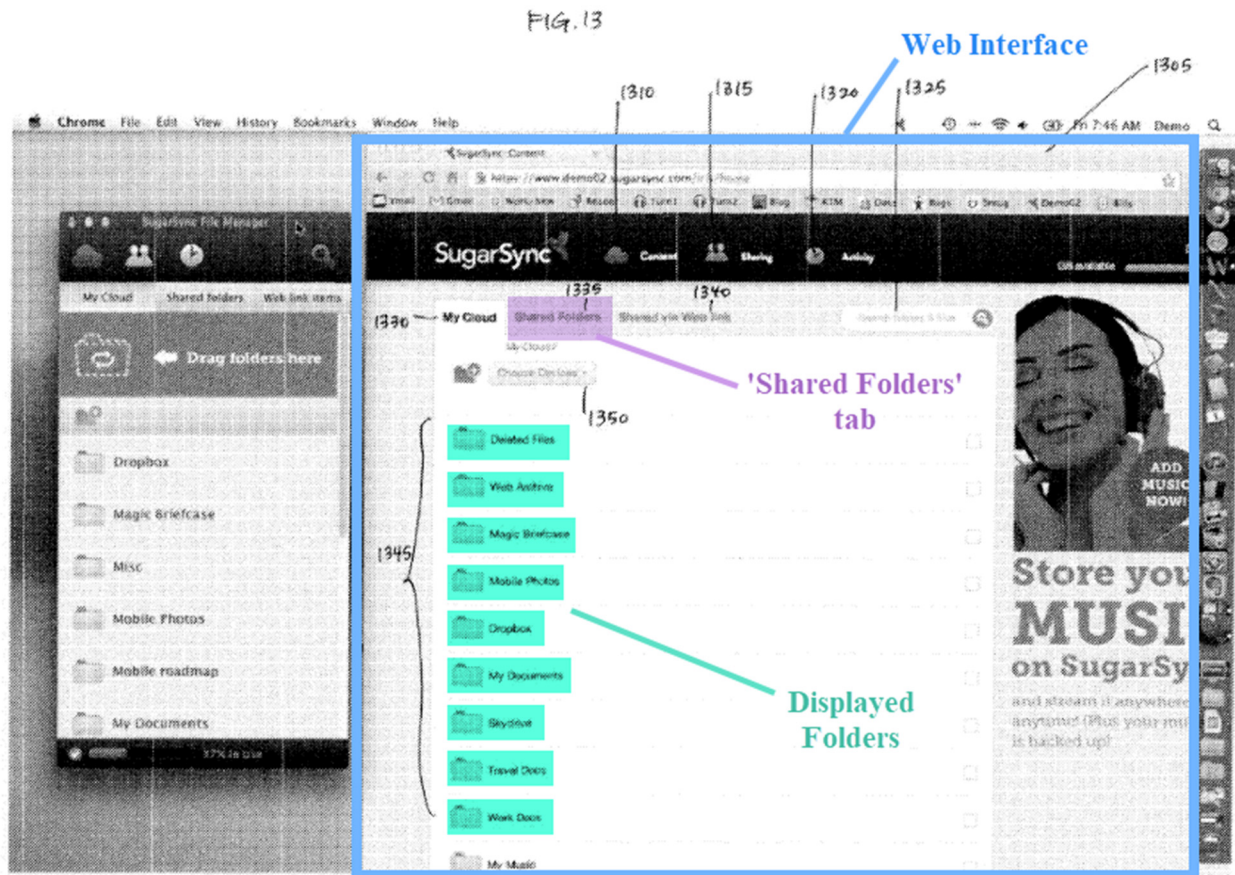
As demonstrated by Figure 12 below, Garcia discloses that, after a user drags a folder 1115 to a particular contact, a dialog box may be presented providing an option for the user to share a link to the folder via an email 1210 by clicking on a send link button 1220 (“email message identifying the at least one folder and including a reference to the at least one folder”). (*Id.*, 11:11-29, 11:35-43; EX1002 ¶¶50-51.) The user receiving the email may then remotely access the contents of the

folder by clicking on the link in the received email (“without including [a file attachment / any file . . . as an attachment],” “the storage at the second node does not store any file in response to the representation of the at least one folder being created, both for avoiding any file from having to be communicated to and stored at the second node,” “at the second node receiving an indication of a selection of the reference to the at least one folder”). (EX1006, 11:29-31; EX1002 ¶¶50-51.)



(EX1006, FIG. 12 (annotated).)

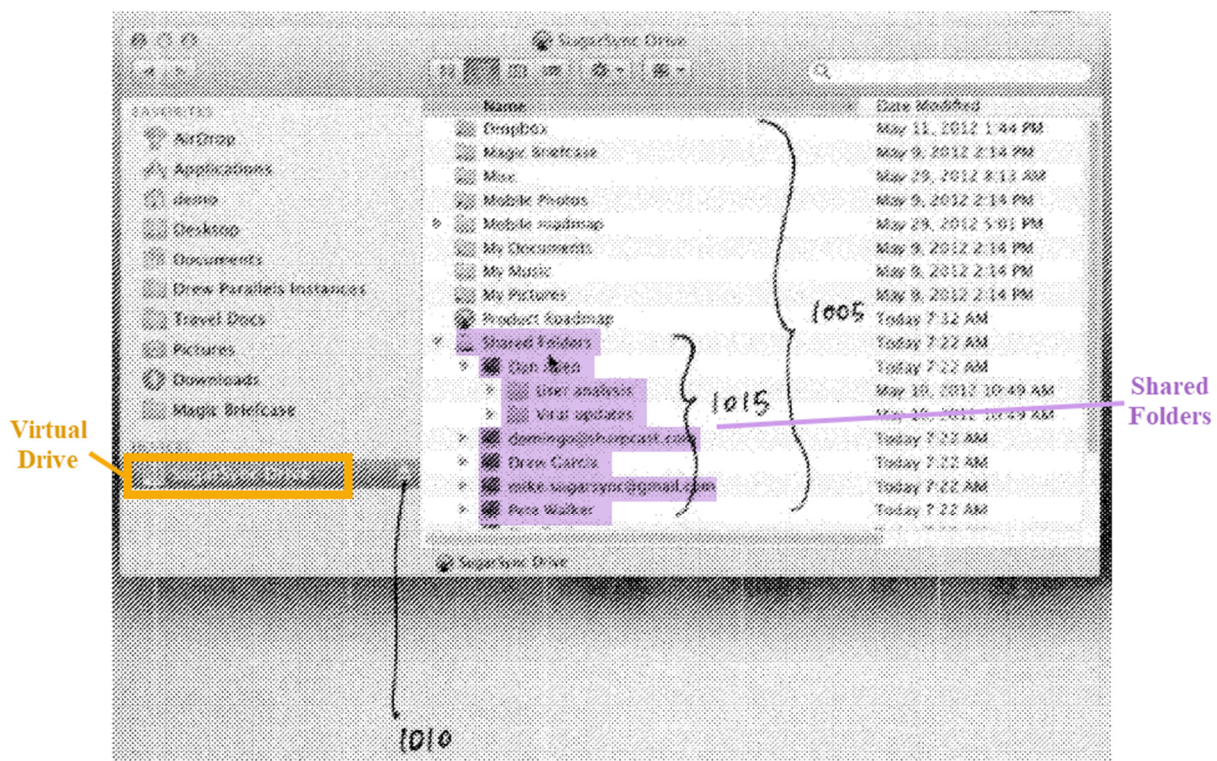
For example, as shown in Figure 13 below, Garcia discloses a web interface with a “Shared Folders tab” that displays shared folders. (*Id.*, 11:44-53.)



(*Id.*, FIG. 13 (annotated).)

According to Garcia, as shown in Figures 10 and 20a below, a representation of a file may be created and viewed by a user in response to the creation of a representation of a shared folder (“in response to the creation of the representation of the at least one folder being caused, an additional representation on the file explorer interface is caused to be created that represents the at least one file”). (*Id.*,

4:58-62 (“a virtual drive is a file system representation on the user’s local client device, of data from a source that is external to the local file system. The virtual drive provides a file system representation, on the user’s local client device, of all objects, across a plurality of clients”), 5:27-43, 6:6-9, 10:52-55, 10:59-65; *see also id.*, 2:66-3:3, 5:4-13, 6:5-27, 10:52-11:10, claim 4; EX1002 ¶52.) Thus, as disclosed by Garcia, a user is able to access a file within a folder that is accessible through the virtual drive without first needing to request the file. (EX1002 ¶52.)



(EX1006, FIG. 10 (annotated).)

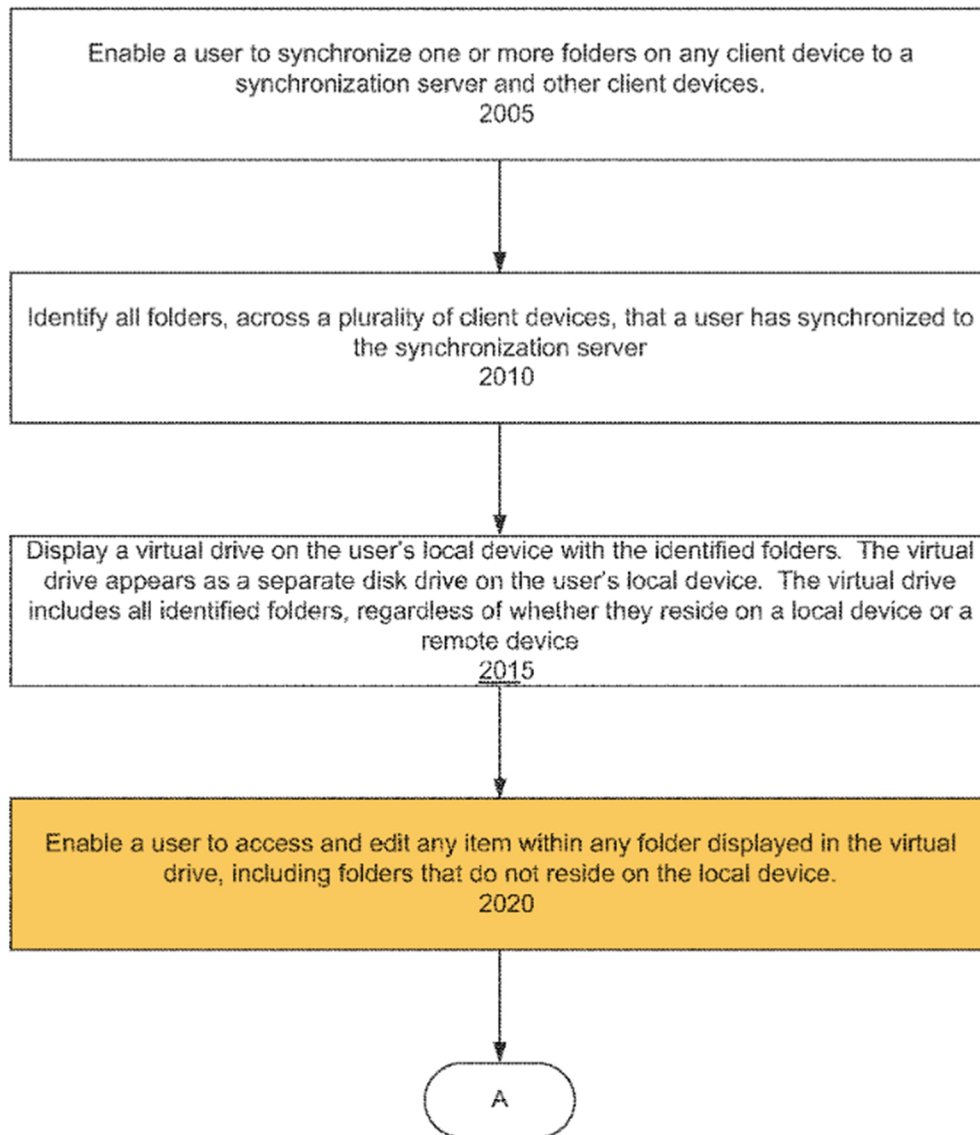


FIG. 20a

(*Id.*, FIG. 20a (annotated).)

As shown in Figure 20a below, Garcia explains that a user can double-click such a file within a shared folder (“detection of the indication to open at least one file in the at least one folder”), which causes the file to be downloaded (“causing retrieval of the at least one file via the at least one network for” and “until requested by at least one user at the second node”) in order for the user to view it (“permitting display of the at least one file”):

In one embodiment, 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). The user can then edit the file/item as desired. 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. In another embodiment, the server downloads its copy of the item/file in the local computer.

(*Id.*, 5:32-43; *see also id.*, 2:19-22, 2:37-41, 2:66-3:3, 4:53-57, 5:4-13, 6:5-27, 10:52-11:10, claim 4; EX1002 ¶53.)

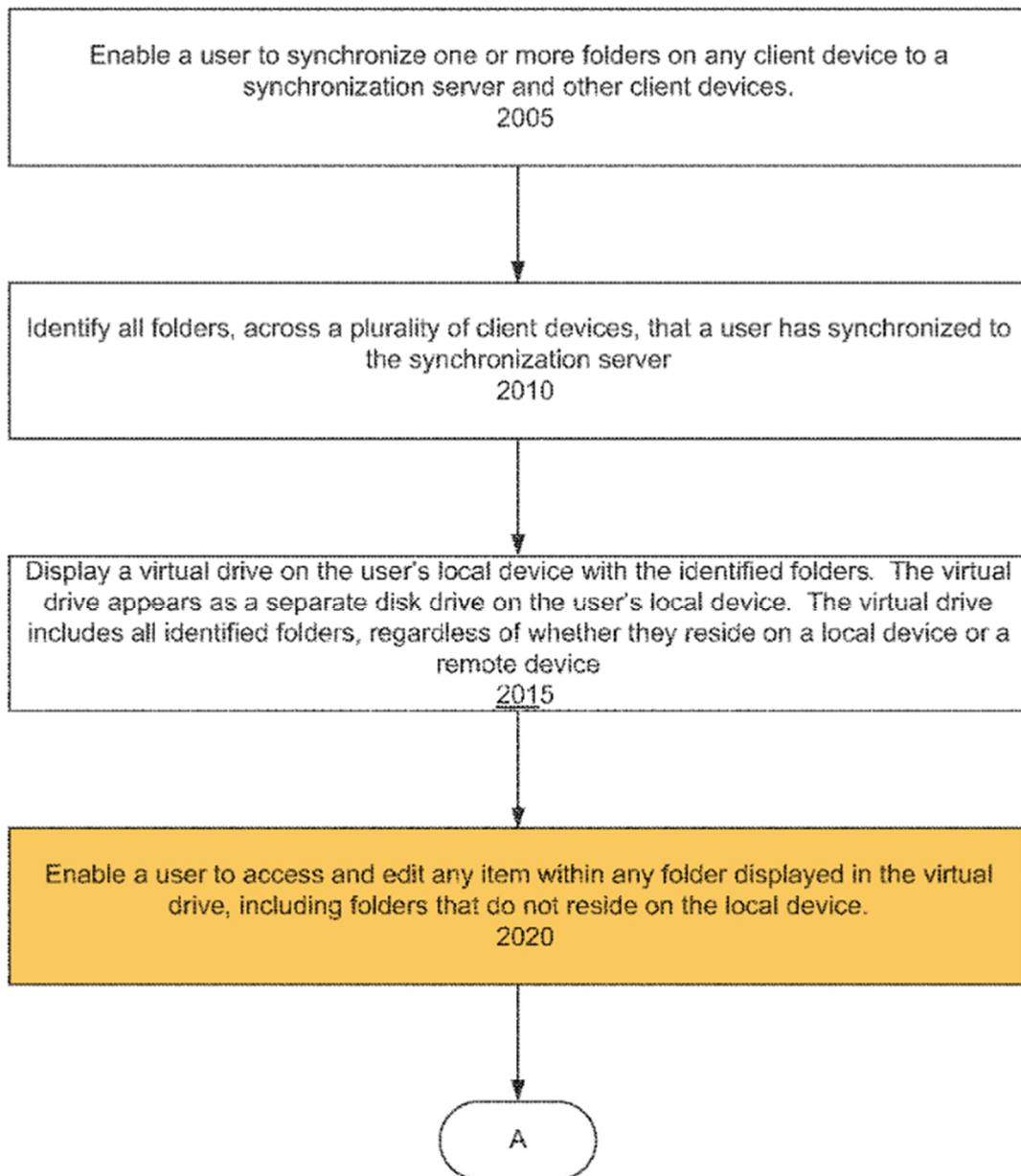


FIG. 20a

(*Id.*, FIG. 20a (annotated).)

It would have been obvious to modify Houston to incorporate the above-discussed features taught by Garcia. (EX1002 ¶¶54-58.) First, a POSITA would have been encouraged to look to Garcia when implementing Houston’s system of sharing folders and files, because Houston and Garcia disclose features in a common technical field and address similar problems. (*Id.*, ¶54.) For example, both Houston and Garcia relate to folder and file sharing across client devices over a network. (*See, e.g.*, EX1002, Abstract; EX1003, Abstract; EX1002 ¶54.)

Second, a POSITA would have had good reason, and found it predictable, to modify Houston’s system to incorporate such features, based on Garcia’s teachings. (EX1002 ¶¶55-57.) For example, a POSITA would have had good reason to modify Houston’s system such that (i) an invitation involves sending an email to identified recipients identifying and referencing (*e.g.*, a link) any shared folders, (ii) shared folders and files are stored virtually instead of locally and represented for display among other folders and files within a client’s file explorer interface, (iii) selecting the link causes the display of the shared folder in a web page, and (iv) selecting a shared file causes the retrieval of the at least one file via a network for display, because the inclusion of such features would have had the benefit of “enabling greater control and file management by the user” by allowing the user to “easily synchronize, manage, and share folders across a plurality of client devices.” (EX1006, 1:27-35; EX1002 ¶¶55-57.)

As Garcia explains, “sending links to folders or files to other users[] allows other users to access the folders or files without requiring the other user to create an account in the synchronization system.” (EX1006, 10:40-43.) Moreover, a POSITA would have understood that, with this modification, there would be no need to email folders or files or locally store such folders or files, which may be large. (*See id.*, 10:59-11:10 (discussing accessing folders that reside on a virtual drive of a device remote from the local device); EX1002 ¶56.) Instead, as Garcia teaches, the folders and files would be stored virtually on a server accessible over a network but displayed alongside other folders and files, as if stored locally, for selection and retrieval on demand, simplifying folder and file synchronization across clients and conserving valuable client resources. (EX1002 ¶56.) For example, as a POSITA would have recognized, by storing folders and files virtually on a server, a user may have access to the server’s greater storage capacity compared to the limited storage capacity of the user’s client, improving the user’s ability to share and access larger volumes of folders and files from any location. (*Id.*) Thus, a POSITA would have recognized the obvious and predictable benefits of the combined system, and that such a system would have better overcome the problems identified in Houston, including that “attaching files [is] cumbersome for many computer users” and, “where multiple iterations are involved, it is not difficult to end up with multiple

versions of the same document, perhaps having the same or a similar file name, located in various places on a user's hard drive.” (EX1005, 1:41-45; EX1002 ¶56.)

Thus, a POSITA would have had good reason to combine the teachings of Houston and Garcia to arrive at the alleged invention recited in the challenged claims, as such a combination would have been nothing more than the combination and substitution of known elements (*e.g.*, Houston's synchronization system modified to incorporate the above-discussed features of Garcia's virtual drive synchronization system) to yield predictable results (*e.g.*, folder and file synchronization utilizing email invitations with links to virtual folders, which can be viewed and accessed on demand, as if stored locally). (*Id.*, ¶57.)

Third, a POSITA would have had a reasonable expectation of success in combining the teachings of Houston and Garcia in the way discussed above, because such a modification would have merely involved modifying Houston's system using well-known computer programming principles to implement Garcia's teachings. (*Id.*, ¶58.) Indeed, Houston already teaches a system for sharing and synchronizing a folder with a user identified by an email address and viewing and accessing such a folder using web- and/or device-based software, so programming the system to incorporate the above-discussed features taught by Garcia, such as sending an email including a link to a shared and synchronized virtual folder that can be viewed and accessed on demand using web- and/or device-based software, would have been a

straightforward extension of Houston's teachings. Additionally, Houston's system already includes search functionality, and so programming the system to have expanded capabilities for searching for a folder or file to share by enabling the search to be conducted based on a wide variety of criteria would have also been a straightforward extension of Houston's teachings.

2. Claim 1

a) A method, comprising:

To the extent the preamble of claim 1 is limiting, the combination of Houston and Garcia discloses the features therein. (EX1002 ¶¶29-40, 59-60.) For example, as discussed in more detail with respect to the remaining features of claim 1, Houston discloses "a method for synchronizing a shared folder." (EX1005, 9:44-10:14; *see also id.*, Abstract, 1:53-2:2, 3:25-28, 3:54-4:51, 7:17-8:5; *infra* Sections IX.A.2.b-m.)⁵ Houston further explains that "[s]ynchronization of folders shared among multiple clients over a network is provided." (EX1005, Abstract.)

b) at first node:

Houston discloses this feature. (EX1002 ¶¶61-62.) For example, as shown below in Figure 1, Houston discloses "a host system 110 and clients 108a, 108b." (EX1005, 2:60; *see also id.*, Abstract ("a first user of a first client"), 3:22-24, 5:42-

⁵ Emphasis is added unless otherwise stated.

51.) Houston discloses that “Client 108 may be a personal computer such as a desktop or laptop computer, a mobile device, or any other computer system having a file system.” (*Id.*, 3:12-22.) Client 108a constitutes “a first node.” (EX1002 ¶¶61.)

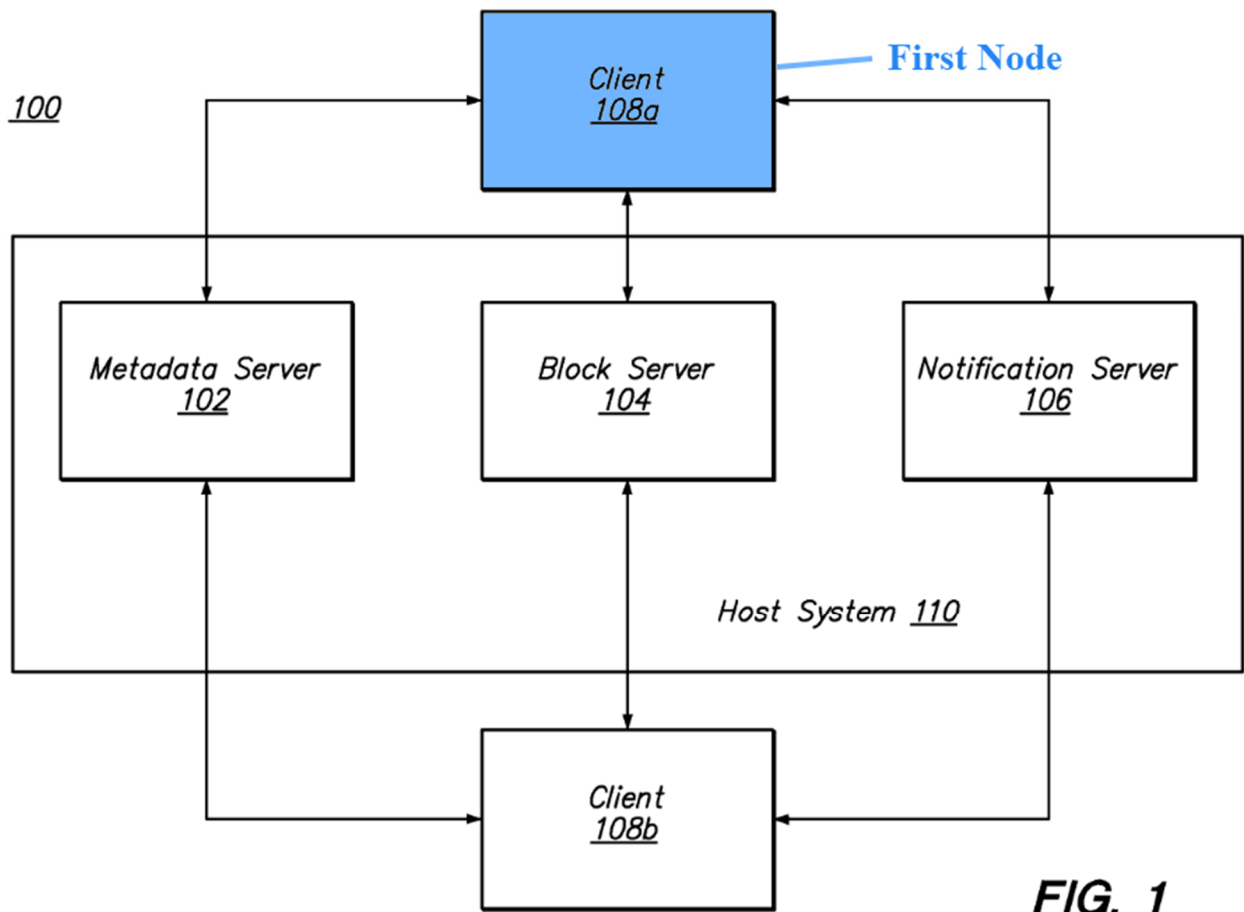


FIG. 1

(EX1005, FIG. 1 (annotated).)

Accordingly, Houston discloses this feature. (EX1002 ¶¶61-62.)

- c) **displaying a first user interface element, a second user interface element, and a third user interface element,**

Houston discloses this feature. (EX1002 ¶¶63-74.) For example, as discussed below, Houston discloses a window user interface (“UI”) that allows a user to select

a folder to share (“a first user interface element”), a text entry field for identifying recipients with whom to share the folder (“a second user interface element”), and a button for initiating sharing of the folder (“a third user interface element”). (*Id.*; see also *infra* Sections IX.A.2.d-1.)

With respect to “a first user interface element,” Houston discloses a window UI displaying existing folders selectable by a user for sharing with other users. For example, the “user interface window 300” illustrated in Figure 3 includes “Music,” “Photos,” “Patent Applications,” and “Public” folders, which a user can “select . . . to be shared.” (EX1005, 3:38-40; see also *id.*, 3:35-37, 7:18-40.)

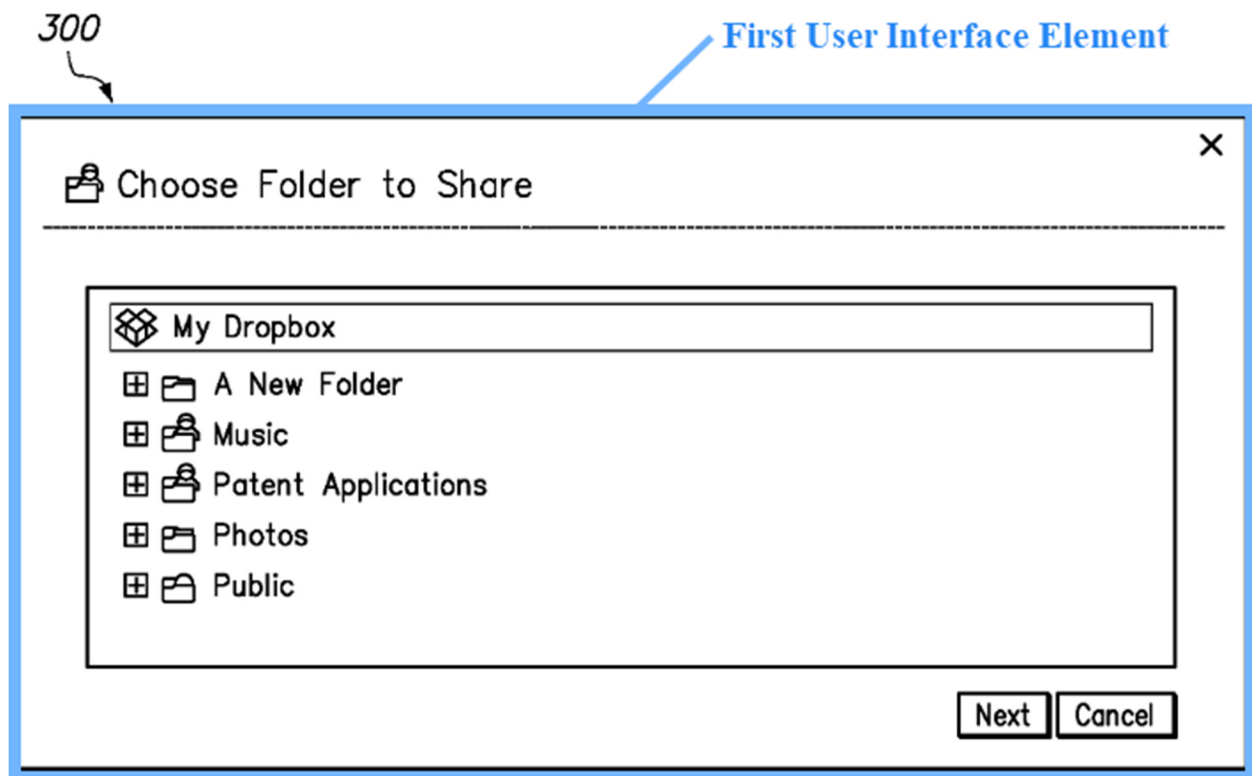


FIG. 3

(*Id.*, FIG. 3 (annotated).)

As another example, with respect to Figure 10 (shown below), Houston explains “how a folder can be shared using software on client 108.” (*Id.*, 3:43-46, 7:18-31.) For example, the user can “indicate[] that he wishes to share the ‘Patent Applications’ folder” by “right-clicking on the folder name and selecting a ‘Share This Folder . . .’ option 1102, as illustrated in FIG. 11.” (*Id.*, 7:32-36; *see also id.*, FIG. 10.) Figure 10 also illustrates a “Share with” dropdown menu, which a POSITA would have understood, based on at least Houston’s teachings relating to Figure 11, is another way to share a selected folder. (*Id.*, FIG. 10; EX1002 ¶65.)

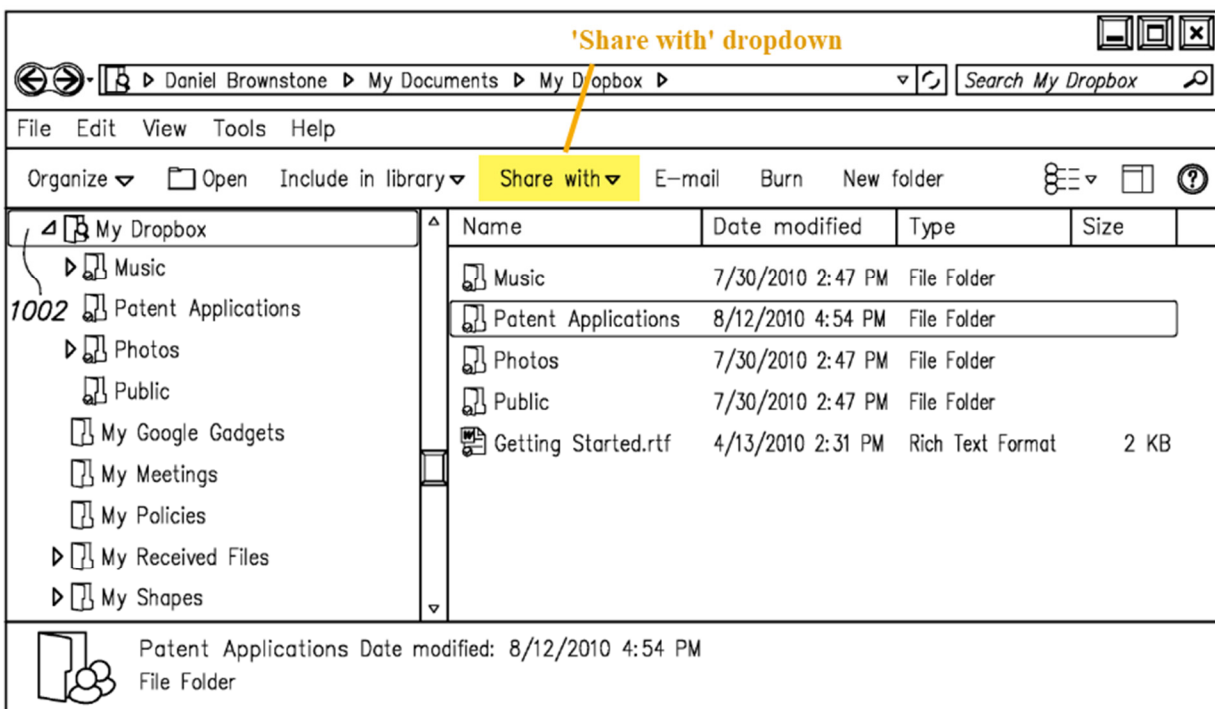
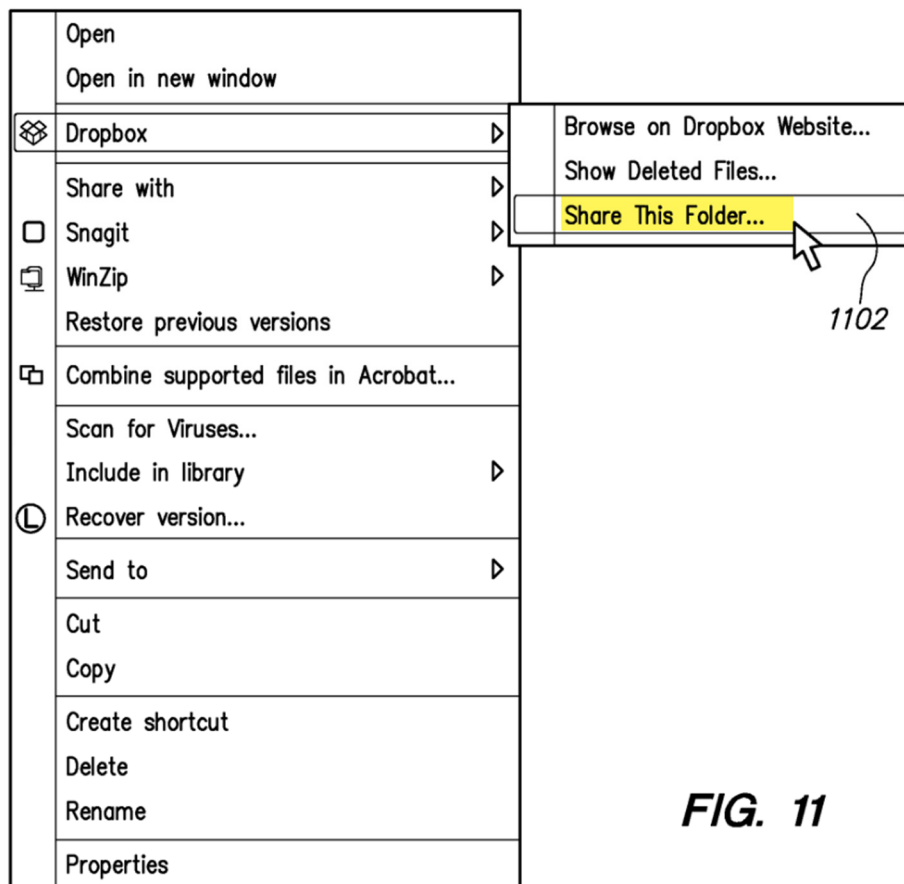


FIG. 10

(EX1005, FIG. 10 (annotated).)

**FIG. 11**

(*Id.*, FIG. 11 (annotated).)

Thus, Houston discloses a window UI (*e.g.*, as shown in Figures 3 and 10) that allows a user to select a folder to share (“a first user interface element”). (EX1002 ¶¶64-66.)

With respect to “a second user interface element,” Houston discloses a text entry field displayed in a window UI that allows a user to input email addresses with whom the selected folder will be shared. (*Id.*, ¶¶67-70.) For example, referring to Figure 4 below, Houston describes “a user interface window 400 via which the user

can invite those people with whom he would like to share the folder.” (EX1005, 3:41-46.)

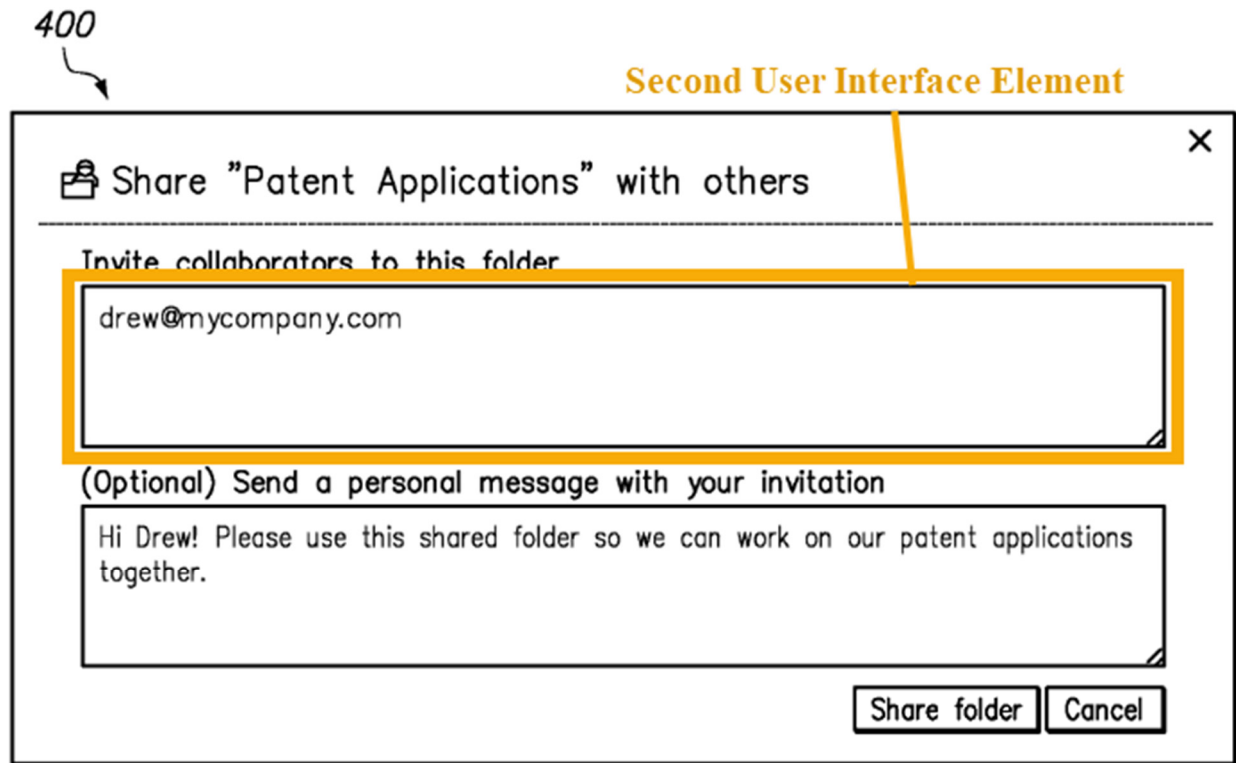


FIG. 4

(*Id.*, FIG. 4 (annotated).)

As additional examples, Houston explains that “FIG. 10 and FIG. 11 provide a view of how a folder can be shared using software on client 108.” (*Id.*, 3:43-46.) Figure 10 illustrates a “Share with” dropdown menu option, and Figure 11 illustrates a “Share This Folder . . .” option 1102, either of which can be selected by a user to share a selected folder. (*Id.*, 7:32-36, FIGs. 10-11.) Although Figures 10 and 11 do not illustrate a window UI with a text entry field that allows a user to input email

addresses with whom the selected folder will be shared, Houston explains that “the user also specifies the account identifier of the user(s) with whom the folder is to be shared.” (*Id.*, 7:38-40.) Thus, a POSITA would have understood that selecting either of the UI options would have displayed such a UI with a text entry field, consistent with Houston’s teachings discussed above. (*Id.*, 3:41-46, 7:38-40; EX1002 ¶¶68.) Or, at the very least, it would have been obvious to display such UIs with a text entry field, as Houston teaches using such a field for the same purpose with respect to Figure 4, and a POSITA would have recognized that such a field would have allowed a user to easily identify recipients using email addresses, which were well known and widely used at the time for communication. (EX1002 ¶¶69.)

Thus, Houston discloses a text entry field displayed in a window UI (*e.g.*, as shown in Figures 4, 10, and 11) that allows a user to input email addresses with whom the selected folder will be shared (“a second user interface element”). (*Id.*, ¶¶67-70.)

With respect to “a third user interface element,” Houston discloses displaying a button for initiating sharing of the folder. For example, UI window 400 in Figure 4 below shows a “Share Folder” button. Because Houston explains that UI 400 enables a user to “invite those people with whom he would like to share the folder,” a POSITA would have understood that Houston discloses the “Share Folder” button

is displayed to a user to initiate sharing with the indicated recipient(s) by clicking the button. (EX1005, 3:40-43; *see also id.*, FIG. 4; EX1002 ¶71.)

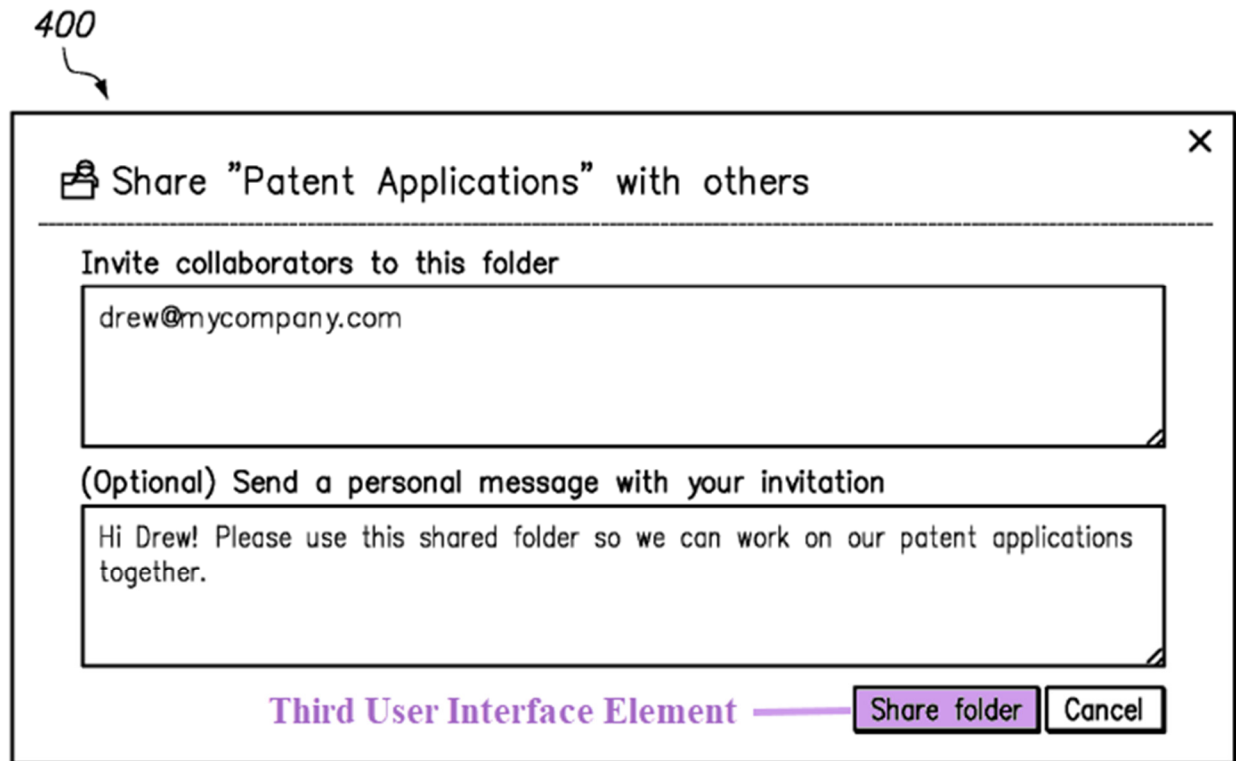


FIG. 4

(EX1005, FIG. 4 (annotated).)

As additional examples, with respect to Figures 10 and 11, although a button for initiating sharing of the folder is not shown, a POSITA would have understood that the client software would have provided such a button to initiate sharing once the user identifies all recipients, consistent with Houston's teachings. (*Id.*, 3:41-46, 7:38-40; EX1002 ¶72.) Or, at a minimum, it would have been obvious to provide such a button in such UIs, as Houston teaches using such a button for the same purpose with respect to Figure 4, and a POSITA would have recognized that UI

buttons were well known and widely used for initiating action in a software system.

(EX1002 ¶72.)

Thus, Houston discloses a button for initiating sharing of the folder with the identified recipients (“a third user interface element”). (*Id.*, ¶¶71-73.)

Accordingly, Houston discloses this feature. (*Id.*, ¶¶63-74.)

d) receiving information associated with at least one folder via the first user interface element,

Houston discloses this feature. (EX1002 ¶¶75-82.) As explained above with respect to claim element 1.c, Houston discloses a window UI with a display area presenting a plurality of selectable folders (“first user interface element”). As explained below, Houston also teaches “receiving information associated with at least one folder via the first user interface element.” (*Id.*; *see also infra* Section IX.A.2.c.)

For example, referring to Figure 3, the window UI 300 disclosed by Houston presents a plurality of folders (“at least one folder”) that a user may select from for sharing with other users (“first user interface element”). (EX1005, FIG. 3, 3:38-40; EX1002 ¶76.)

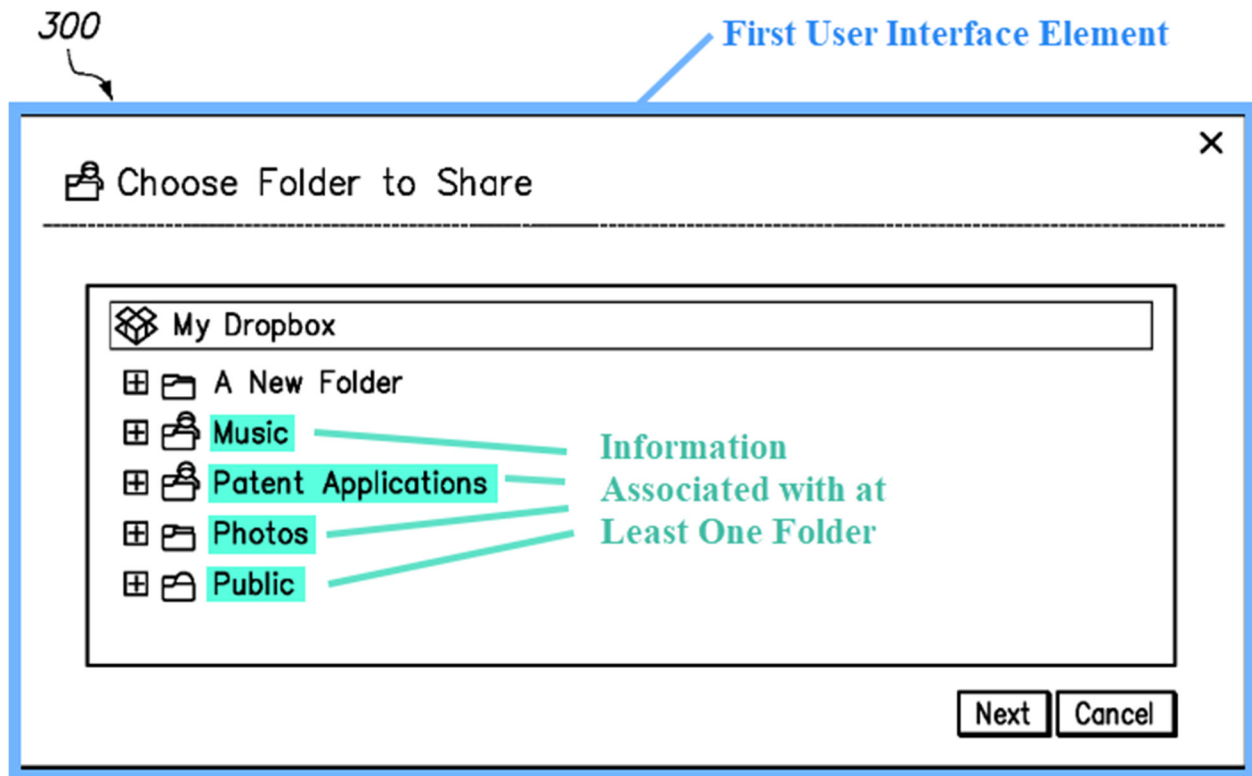


FIG. 3

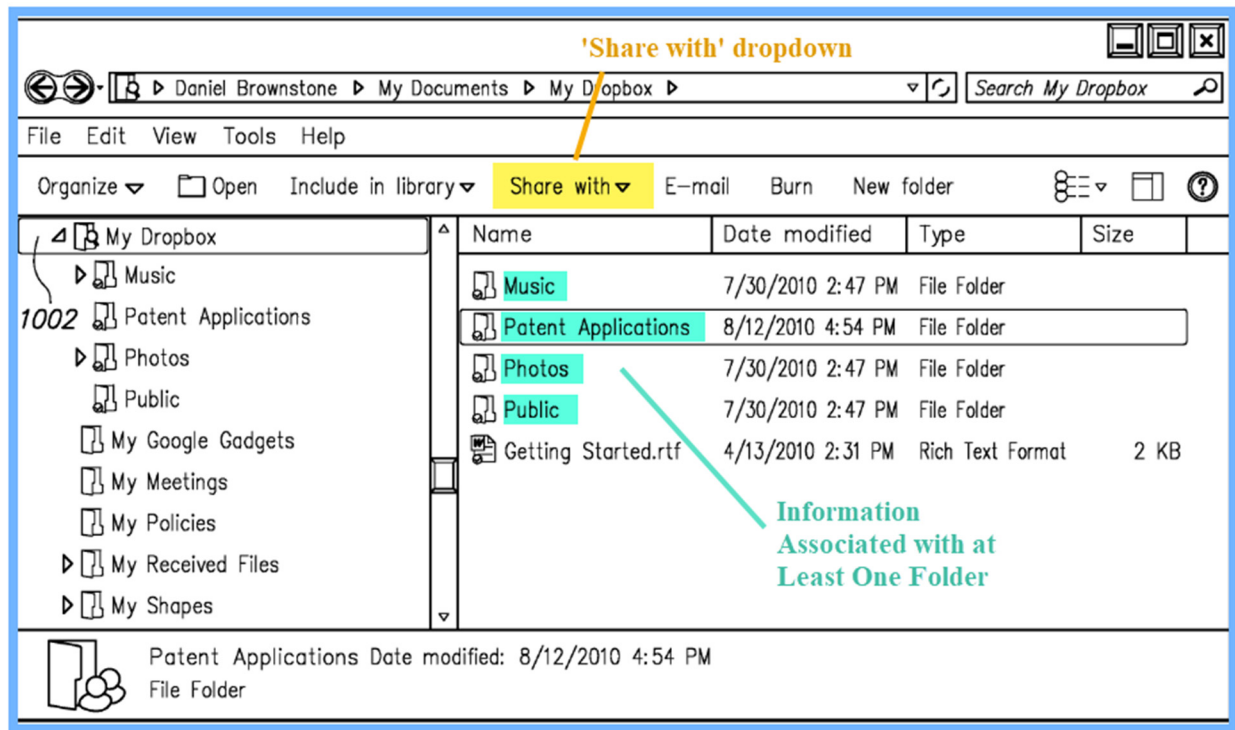
(EX1005, FIG. 3 (annotated).)

Each of the folders displayed in the window UI 300 is designated by an identifier or name, such as “Music,” “Patent Applications,” “Photos,” and “Public.” (*Id.*) Thus, “information” (*i.e.*, the name or identifier) is “associated with the at least one folder.” (EX1002 ¶77.) When a user selects a folder in window UI 300 and then clicks the “Next” button, client 108a receives (“receiving”) the information (*e.g.*, the folder’s name) that identifies which folder the user intends to share. (EX1005, 3:35-

45; *see also id.*, 7:18-58.) Thus, the information associated with the at least one folder is received “via the first user interface element.”⁶ (EX1002 ¶77.)

Similarly, as shown below, Figures 10 and 11 respectively show a file explorer UI window with selectable folders, a “Share with” dropdown menu (Figure 10), and a context menu UI window (Figure 11) that appears when a user right clicks on one of the folders displayed in the file explorer UI window:

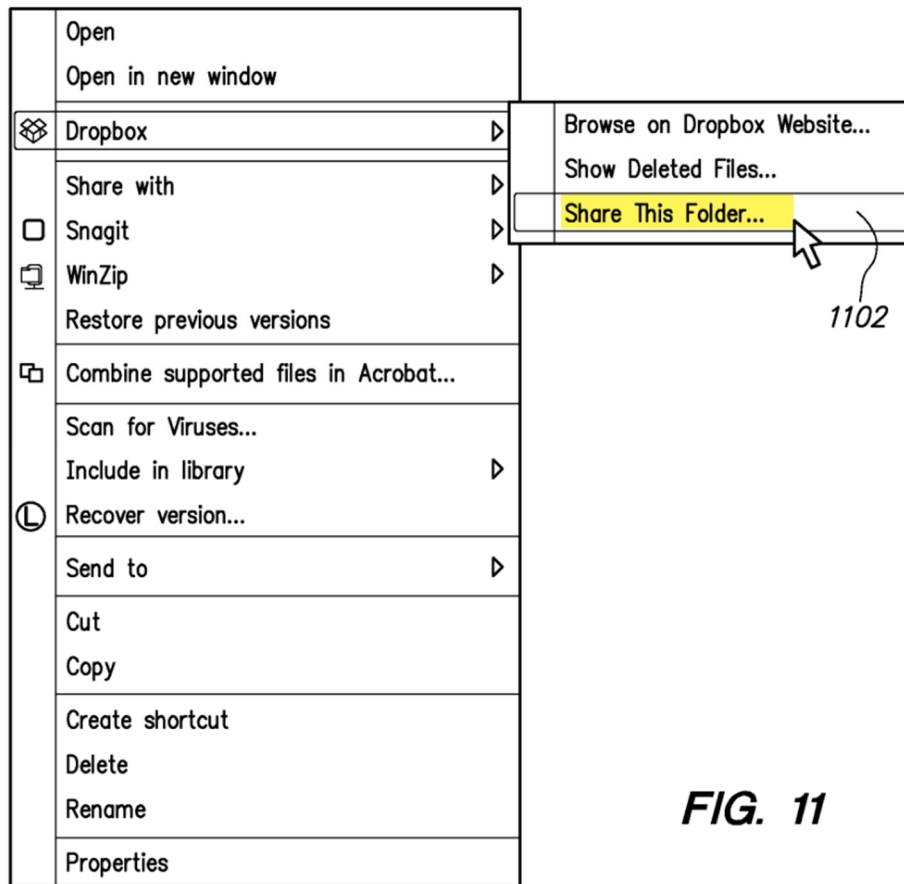
⁶ Indeed, in order for the client to execute the process of sharing the folder, it must necessarily receive the information identifying which folder to share. (EX1002 ¶77; *see also* EX1005, 3:35-43, 7:32-58.) Otherwise, Houston’s system would not operate as disclosed. (EX1002 ¶77.) Thus, in addition to being explicitly disclosed, the claimed feature is inherently disclosed or rendered obvious by Houston. (*Id.*)



First User Interface Element

FIG. 10

(EX1005, FIG. 10 (annotated).)

**FIG. 11**

(*Id.*, FIG. 11 (annotated).)

Houston discloses the context menu in Figure 11 can be used to initiate sharing of a folder. (*Id.*, 7:18-40 (“a user can . . . select[] a “Share This Folder . . .” option 1102, as illustrated in FIG. 11” to share a selected folder)) A POSITA would have understood based on Houston’s disclosure that the “Share with” dropdown menu in Figure 10 provides the same functionality for selected folders.⁷ (EX1002 ¶79.)

⁷ See also *supra* n.7.

Thus, when the user views a plurality of folders through a file explorer UI window like that shown in Figure 10 of Houston (“first user interface element”), where each folder is designated by a different name (“information associated with the at least one folder”), the user may right-click on one of the folders and select to share it with another user (as shown in Figure 11) or use the “Share with” dropdown menu to share a selected folder (as shown in Figure 10), said selection information being received by client 108a (“receiving . . . via the first user interface element”). (*Id.*, ¶81.)

Thus, for the reasons stated above, Houston discloses this feature. (*Id.*, ¶¶75-82; *supra* Section IX.A.2.c.)

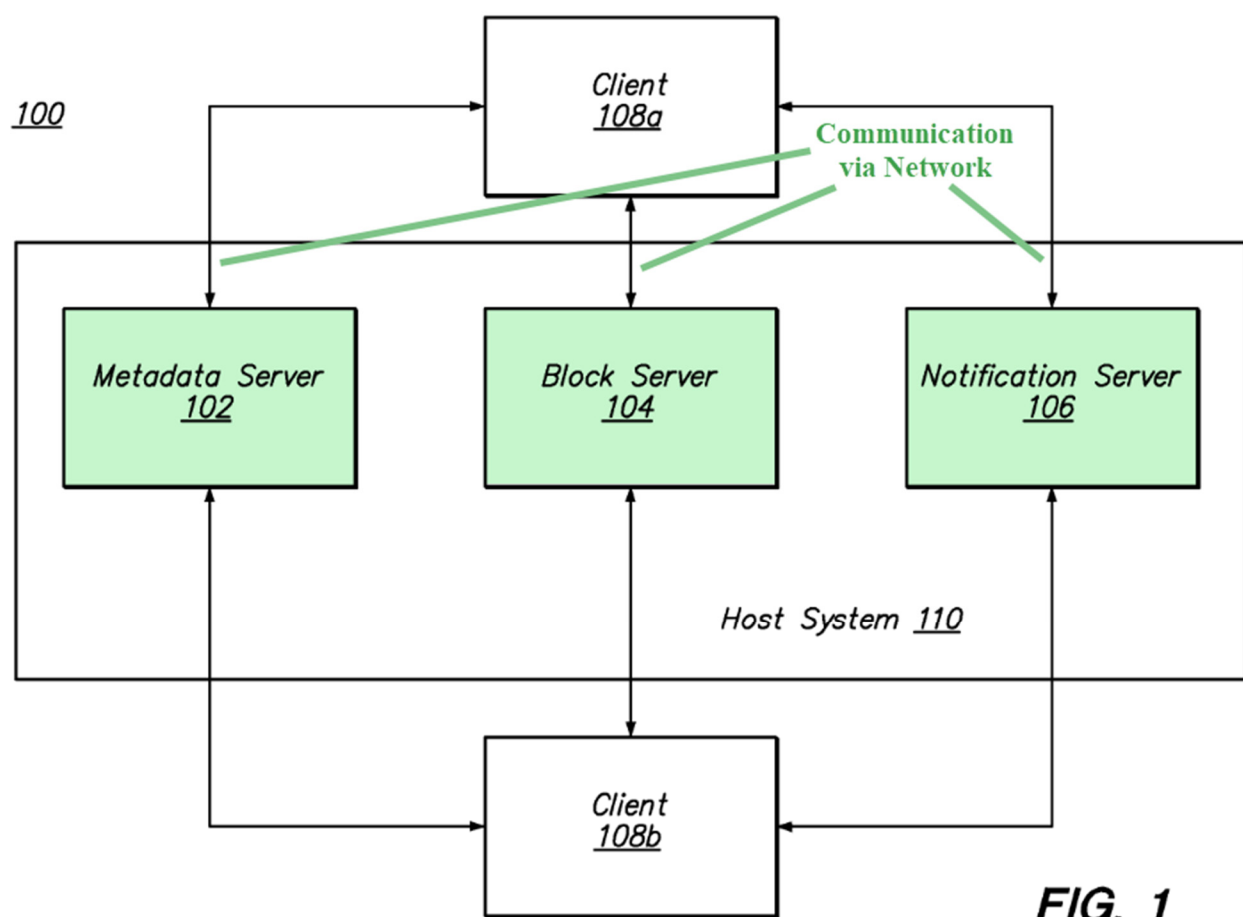
e) sending, via at least one network, the information associated with the at least one folder,

Houston discloses this feature. (EX1002 ¶¶83-86.) As explained below, Houston discloses sharing a folder and its contents with multiple clients (“sending”) through the use of multiple servers (“via at least one network”) that receive and maintain the folder’s name or identifier (“information associated with the at least one folder”). (*Id.*; *see also supra* Sections IX.A.2.c-d.)

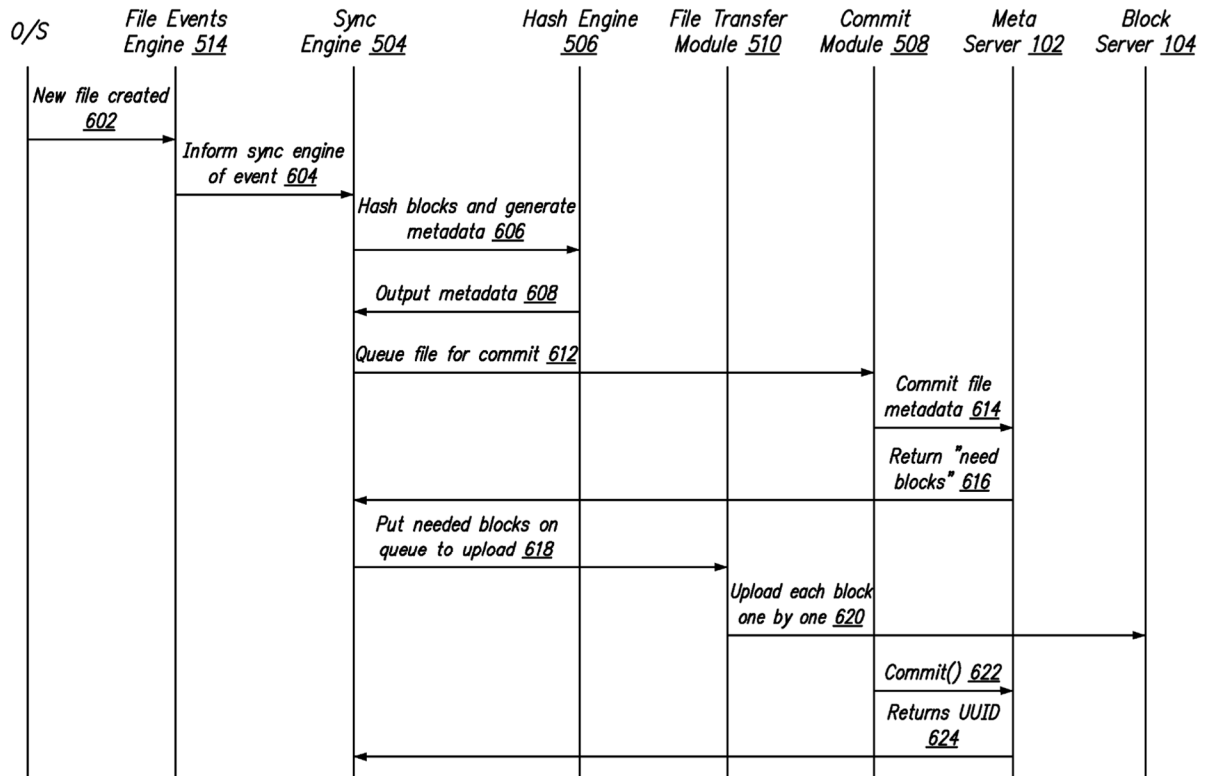
For example, Houston discloses an “invention [that] enables synchronization of folders shared among multiple clients over a network,” as shown by Figures 1 and 6 below. (EX1005, 1:53-54; *see also id.*, 6:5-8, 32-40.) The host system 110 of

Figure 1 “maintain[s] synchronized shared folders” accessed by multiple clients (e.g., clients 108a and 108b) and includes “a metadata server 102; a block server 104; and a notification server 106.” (*Id.*, 2:56-62.) These servers in host system 110 facilitate communication of information associated with folders among the multiple clients. (*Id.*, 2:63-3:46.)

For example, a user may instantiate a folder, which is then synchronized to host system 110, and shared among other clients, after which it is kept synchronized across the clients by host system 110. (*Id.*, Abstract, 1:53-2:2, 3:5-11, 3:64-4:2 (“Upon determining that a change has occurred to the synchronized folder, file events engine 514 informs 604 synchronization engine 504 that a change has been detected, and the location (path) of the folder or file within the folder where the change has occurred.”), 4:60-64.) “In this way, each client participating in the share has a current version of the folder and its contents.” (*Id.*, Abstract.) Additionally, Houston discloses the use of folder names / identifiers when mapping namespaces (e.g., *id.*, 7:17-58) and displaying folders via a web interface (*id.*, 7:37-38, FIG. 10).



(*Id.*, FIG. 1 (annotated).)

**FIG. 6**

(*Id.*, FIG. 6.)

Thus, Houston discloses that client 108a sends the identifier or name of the folder selected for sharing via a network to host system 110.⁸ (EX1002 ¶85.)

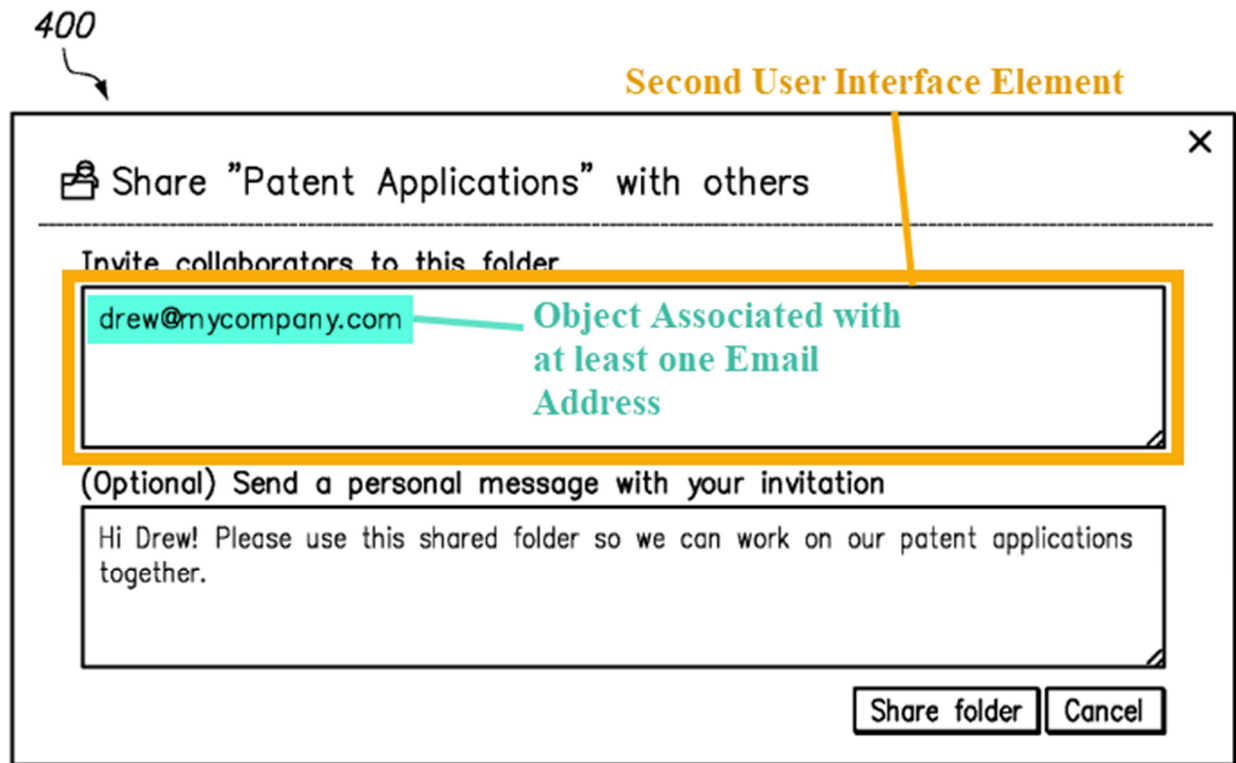
Accordingly, Houston discloses this feature. (*Id.*, ¶¶83-86.)

⁸ Indeed, such information is needed by the host system 110 in order to share and synchronize folders across clients, as described in Houston. (EX1002 ¶85.) Thus, in addition to being explicitly disclosed, the claimed feature is inherently disclosed or rendered obvious by Houston. (*Id.*)

f) receiving an object associated with at least one email address via the second user interface element,

Houston discloses this feature. (EX1002 ¶¶87-91.) For example, as discussed above in Section IX.A.2.c, Houston discloses a window UI with a display area including a text box (“second user interface element”), which allows client 108a to receive a text string inputted by a user that contains one or more account identifiers, such as email addresses or some other identifier associated with an email address (“receiving an object associated with at least one email address”). (*See supra* IX.A.2.c; *see also infra* Section IX.A.2.g.)

For example, as shown in Figure 4 below, Houston discloses a portion of a window UI labeled “Invite collaborators to this folder” that is capable of receiving as a text string the one or more email addresses. (EX1005, 2:31-33, 3:41-43.)

**FIG. 4**

(*Id.*, FIG. 4 (annotated).)

Such a received text string is “an object associated with at least one email address,” consistent with the specification and claims of the ’353 Patent, which explain that a text string, including a text string representing one or more email addresses, may be considered an “object.” (EX1001, claim 2, 39:60-63; EX1002 ¶89.)

Similarly, with respect to Figures 10 and 11, Houston discloses that, when a user wishes to share a folder, the user may do so by right-clicking on the folder name and selecting a “Share This Folder . . .” option 1102 (Figure 11) or via the “Share with” dropdown menu (Figure 10), after which the user must “specif[y] the account

identifier of the user(s) with whom the folder is to be shared.” (EX1005, 2:31-33, 3:41-43, 7:18-40.) And, as discussed above in Section IX.A.2.c, with respect to Figures 10 and 11, Houston discloses (or renders obvious) that identifiers (*e.g.*, email addresses) may be specified using a text box (“receiving an object associated with at least one email address via the second user interface element”). (EX1002 ¶90.)

Accordingly, Houston discloses this feature. (*Id.*, ¶¶87-91.)

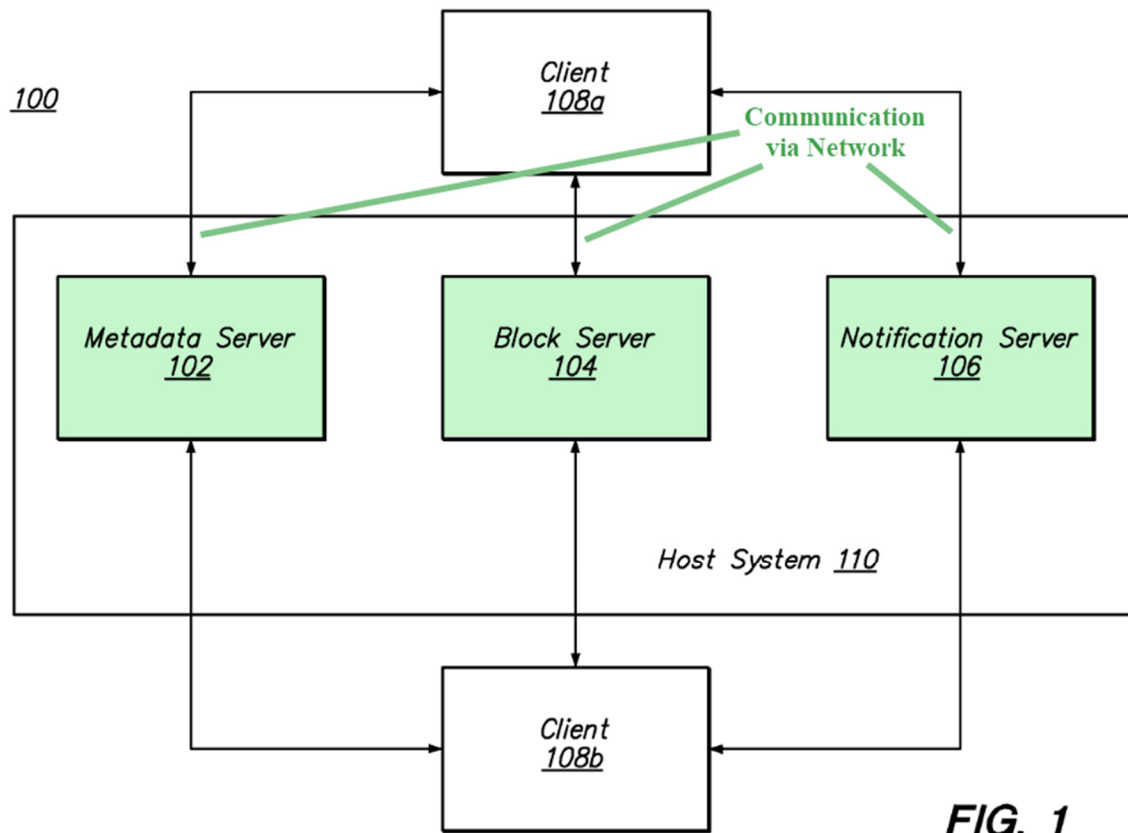
g) sending, via the at least one network, the object associated with the at least one email address,

Houston discloses this feature. (EX1002 ¶¶92-96.) For example, Houston discloses a user inputting a text string representing one or more email addresses (“the object associated with at least one email address”) and communicating (“sending”) that text string to host system 110 via a network connection (“via at least one network”), which then shares the folder with the user(s) identified by the one or more email addresses represented by the communicated text string. (*See supra* Sections IX.A.2.c, IX.A.2.e-f.)

For example, Houston discloses an “invention [that] enables synchronization of folders shared among multiple clients over a network,” as shown by Figure 1 below. (EX1005, 1:53-54; *see also id.*, 6:5-8.) Folders are shared and synchronized via host system 110, which includes “a metadata server 102; a block server 104; and a notification server 106,” and any number of clients 108 (*e.g.*, clients 108a and

108b). (*Id.*, 2:56-62, 3:22-24.) The servers of host system 110 facilitate communication and synchronization of information associated with folders among the multiple clients. (*Id.*, 2:63-3:46, 7:32-46.) Thus, Houston discloses that, via a network connection with the servers of host system 110 (“via the at least one network”), client 108a may communicate (“sending”) a text string containing the one or more email addresses of the users (“the object associated with at least one email address”) with whom the folder is to be shared.⁹ (EX1002 ¶93.)

⁹ Indeed, without such information, Houston’s system would not know which client(s) must receive the shared folder, as described in Houston. (EX1002 ¶94.) Thus, in addition to being explicitly disclosed, the claimed feature is inherently disclosed or rendered obvious by Houston. (*Id.*)



(EX1005, FIG. 1 (annotated).)

Accordingly, Houston discloses this feature. (EX1002 ¶¶92-96.)

h) receiving an indication of a selection of the third user interface element, and

Houston discloses this feature. (*Id.*, ¶¶97-101.) For example, Houston discloses a share folder button (“third user interface element”), a user’s selection of which is received by client 108a (“receiving indication of a selection”) as an indication the user wishes to share a selected folder with identified recipients. (*Id.*; *see also supra* Section IX.A.2.c; *infra* Section IX.A.2.i.)

For example, as shown in Figure 4 below, Houston discloses a window UI 400 with a button labeled “Share folder” that can be selected by a user to indicate to client 108a that the user wishes to share a folder. (EX1005, 2:31-33, 3:40-45, 7:32-38.)

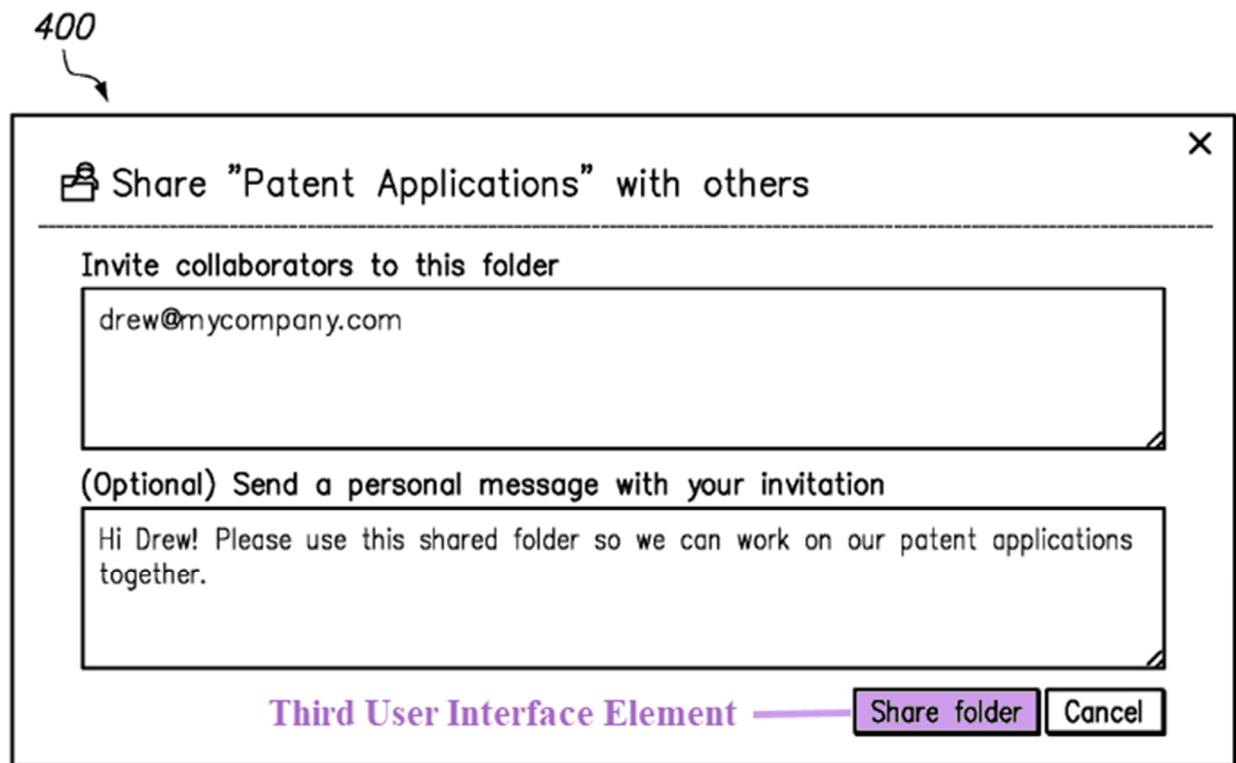


FIG. 4

(*Id.*, FIG. 4 (annotated).)

Additionally, with respect to Figures 10 and 11, although a button for initiating sharing of the folder is not shown, a POSITA would have understood that the client software would have provided such a button to initiate sharing after the “Share This Folder . . .” menu option 1102 or the “Share with” dropdown menu option is selected, consistent with Houston’s teachings. (*Id.*, 3:41-46, 7:38-40;

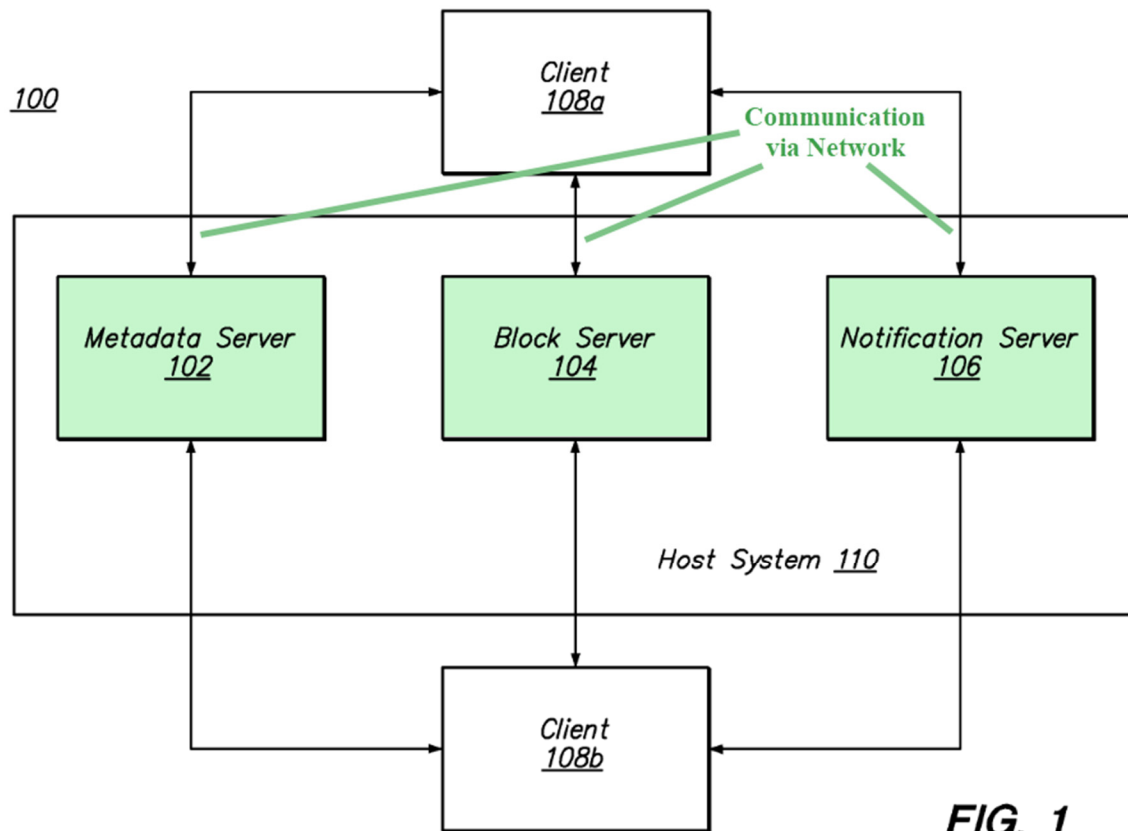
EX1002 ¶99.) Or, at a minimum, it would have been obvious to provide such a button, as Houston teaches using such a button for the same purpose with respect to Figure 4, and a POSITA would have recognized that UI buttons were well known and widely used for initiating action in a software system. (EX1002 ¶100.)

Accordingly, Houston discloses this feature. (*Id.*, ¶¶97-101.)

- i) **sending, via the at least one network, the indication of the selection of the third user interface element;**

Houston discloses this feature. (*Id.*, ¶¶102-104.) As discussed below, Houston discloses a share folder button (“third user interface element”) that is capable of being selected (“indication of a selection”) to initiate a communication (“sending”) to host system 110 through an open network connection (“via the at least one network”), indicating that the user wishes to share a selected folder with the identified recipients. (*See supra* Sections IX.A.2.c, IX.A.2.e, IX.A.2.h.)

For example, Houston discloses an “invention [that] enables synchronization of folders across multiple clients over a network,” as shown by Figure 1 below. (EX1005, 1:53-54, 6:5-8.) Folders are shared and synchronized through host system 110. (*Id.*, 2:56-62, 3:22-24.) The servers of host system 110 facilitate communication and synchronization of information associated with folders among the multiple clients. (*Id.*, 2:63-3:46.)

**FIG. 1**

(EX1005, FIG. 1 (annotated).)

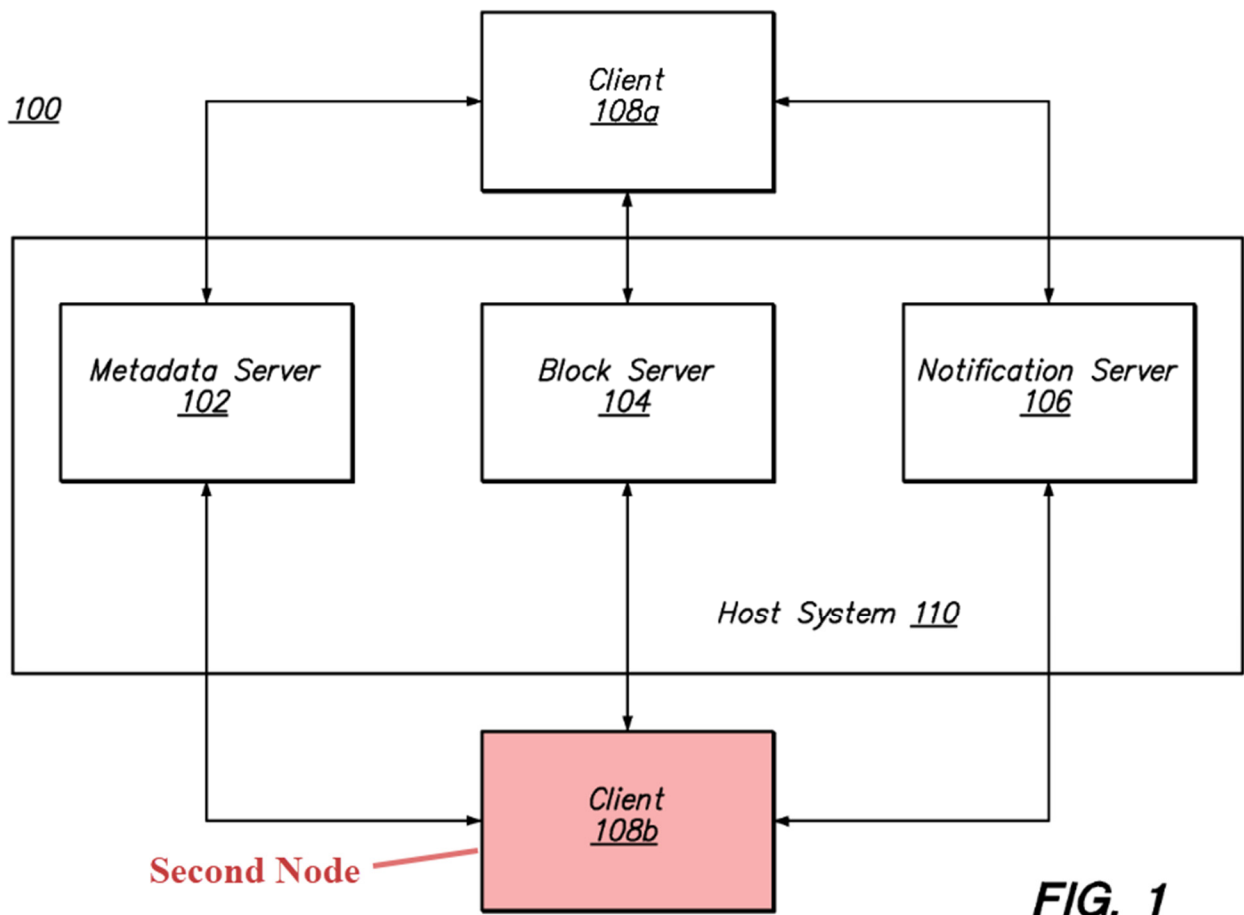
Houston thus discloses that, when a user selects the share folder button, such as (i) the “Share folder” button shown in Figure 4 or (ii) the share folder button shown after the user selects the “Share This Folder . . .” option 1102 (Figure 11) or the “Share with” dropdown menu option (Figure 10) (“the third user interface element”), an indication to share the folder with the identified user(s) is communicated (“sending”) through a network such as the Internet (“via the at least

one network”) to the servers of host system 110, so that the system can then share the folder with other clients.¹⁰ (*Id.*, 3:41-46, 7:33-48; EX1002 ¶104.)

j) at a second node:

Houston discloses this feature. (EX1002 ¶¶105.) As shown in connection with Figure 1, Houston discloses “a host system 110 and clients 108a, 108b.” (EX1005, 2:60; *see also id.*, 3:22-24, 5:42-44.) Client 108b constitutes a “second node.” (EX1002 ¶105.)

¹⁰ Indeed, without sending such an indication, there would be no way for Houston’s system to know that a selected folder should be shared, as described in Houston. (EX1002 ¶104.) Thus, in addition to being explicitly disclosed, the claimed feature is inherently disclosed or rendered obvious by Houston. (*Id.*)



(EX1005, FIG. 1 (annotated).)

- k) 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 is sent from the first node via the at least one network: receiving, 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,

The combination of Houston and Garcia discloses or suggests this feature.

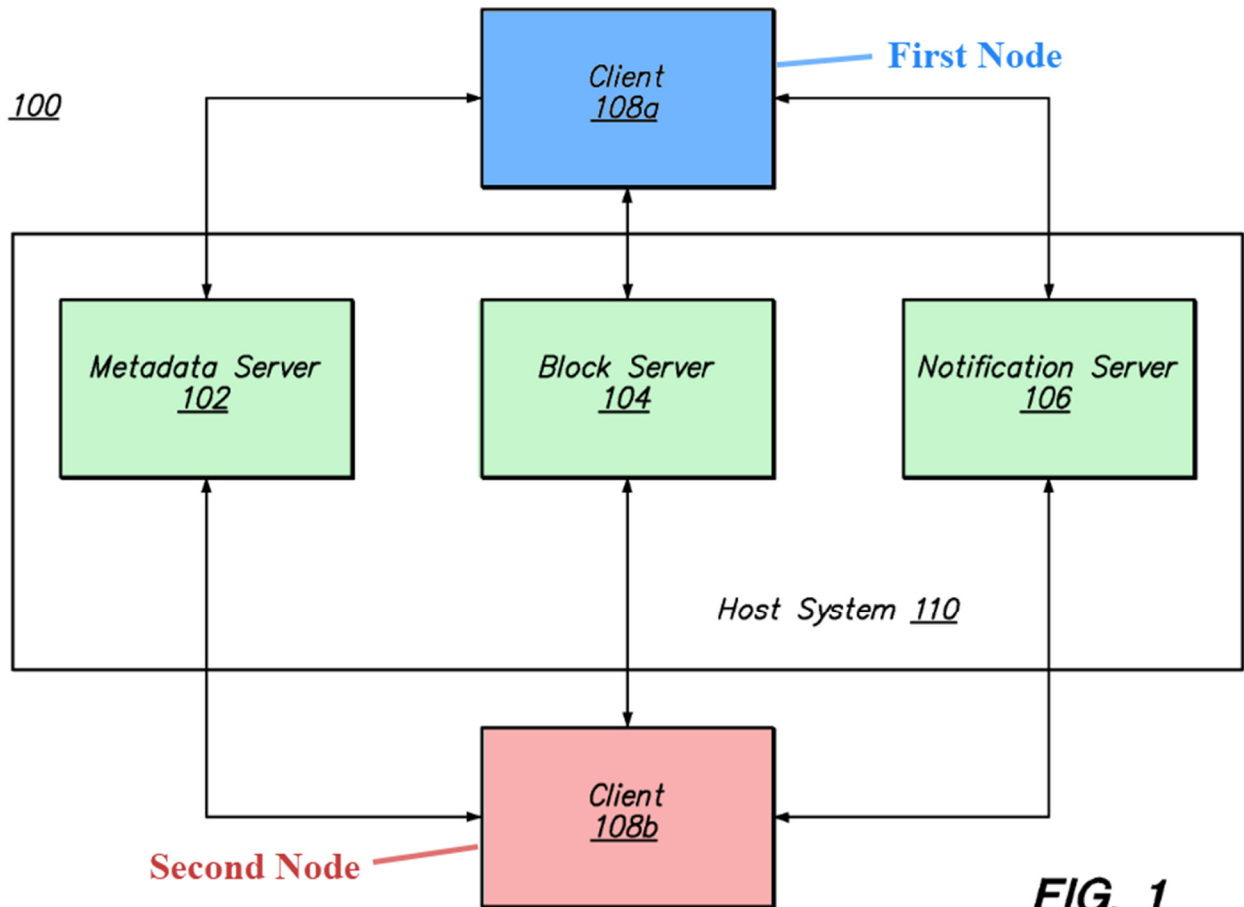
(EX1002 ¶¶106-113.) For example, as explained above, Houston discloses client 108a (“first node”) receiving a user’s selection of a folder designated by an identifier

or name (“information associated with the at least one folder”), entry of a text string containing one or more email addresses (“the object associated with at least one email address”) with whom the user wishes to share a folder, and click of a share folder button (“indication of the selection of the third user interface element”). (*Id.*; *see also supra* Sections IX.A.2.b-i.) As further explained above, Houston discloses client 108a communicating the above items received from the user (“sent from the first node”) to host system 110 through a network connection (“via the at least one network”) to initiate sharing of the selected folder with the users / clients identified by the email addresses. (EX1002 ¶106; *see also supra* Sections IX.A.2.b-i.)

As explained below, the combination of Houston and Garcia discloses a client 108b (“a second node”) receiving an email message sent from host system 110 through a network connection (“receiving, via the at least one network, at least one email message”) that identifies the folder selected for sharing by the user of client 108a (“identifying the at least one folder”) and includes a web link to the shared folder (“including a reference to the at least one folder”) but does not attach the shared folder (“without including a file attachment with the at least one email message”). (EX1002 ¶107.) For example, as shown in Figure 1 below, Houston discloses “a host system 110 and clients 108a, 108b.” (EX1005, 2:60; *see also id.*, 3:22-24, 5:42-44.) The host system 110 maintains synchronized shared folders across multiple clients through the use of multiple servers that facilitate

communication of information associated with folders among the multiple clients.

(*Id.*, 1:53-54, 2:56-3:46.)



(*Id.*, FIG. 1 (annotated).)

Houston discloses that when a user of client 108a initiates sharing of a folder, client 108a communicates the related information received from the user (*e.g.*, a name or identifier of the folder to be shared and a text string containing the one or more email addresses with whom the folder is to be shared) to host system 110 through a network connection. (*Id.*, 3:41-46, 6:5-8, 7:32-48.) Houston discloses the user(s) whom host system 110 invites to share the folder (*e.g.*, the user of client

108b) may then accept the invitation to share the folder, after which metadata server 102 creates a link to the shared folder, notification server 106 provides notifications to the user(s), and the user(s) obtain access to the folder by creating a copy of the folder on client 108b. (*Id.*, 5:52-60, 7:18-58; *see also id.*, 1:29-32, 1:39-45, 1:59-2:2, 2:67-3:3, 7:1-3.)

Houston does not, however, explicitly disclose that the second node receives an email message identifying and referencing (*e.g.*, a link) the shared folder without including a file attachment. Nevertheless, as discussed in more detail above in Section IX.A.1, Garcia discloses such features. (EX1002 ¶¶47-51, 110-111.) For example, Garcia discloses sending an email with a list of virtual folders or files as a web link (instead of an attachment) to other clients. (EX1006, 10:32-40 (“The Web link tab 335 includes a list of folders or files that have been shared as a link with other users . . . and an icon 915[] places the link onto the clipboard to be copied into an email, text, or other transmittal.”), 11:11-43, claim 3, FIGS. 11, 12; *see also supra* Section IX.A.1.) And, as discussed in more detail above in Section IX.A.1, it would have been obvious to a POSITA to modify Houston such that client 108b receives an email message from client 108a that identifies and includes a link to a shared folder without including a file attachment, similar to as described in Garcia. (EX1002 ¶¶54-57, 112; *see supra* Section IX.A.1.) Such a POSITA would have recognized the benefits (*e.g.*, sharing folders and files via email, a well-known,

widely-used, and convenient form of communication, without needing to transmit and/or locally store such folders and files, which may be large) and had a reasonable expectation of success combining these teachings of Houston and Garcia. (EX1002 ¶¶54-57, 112; *see supra* Section IX.A.1.)

Accordingly, the combination of Houston and Garcia discloses this feature. (EX1002 ¶¶106-113.)

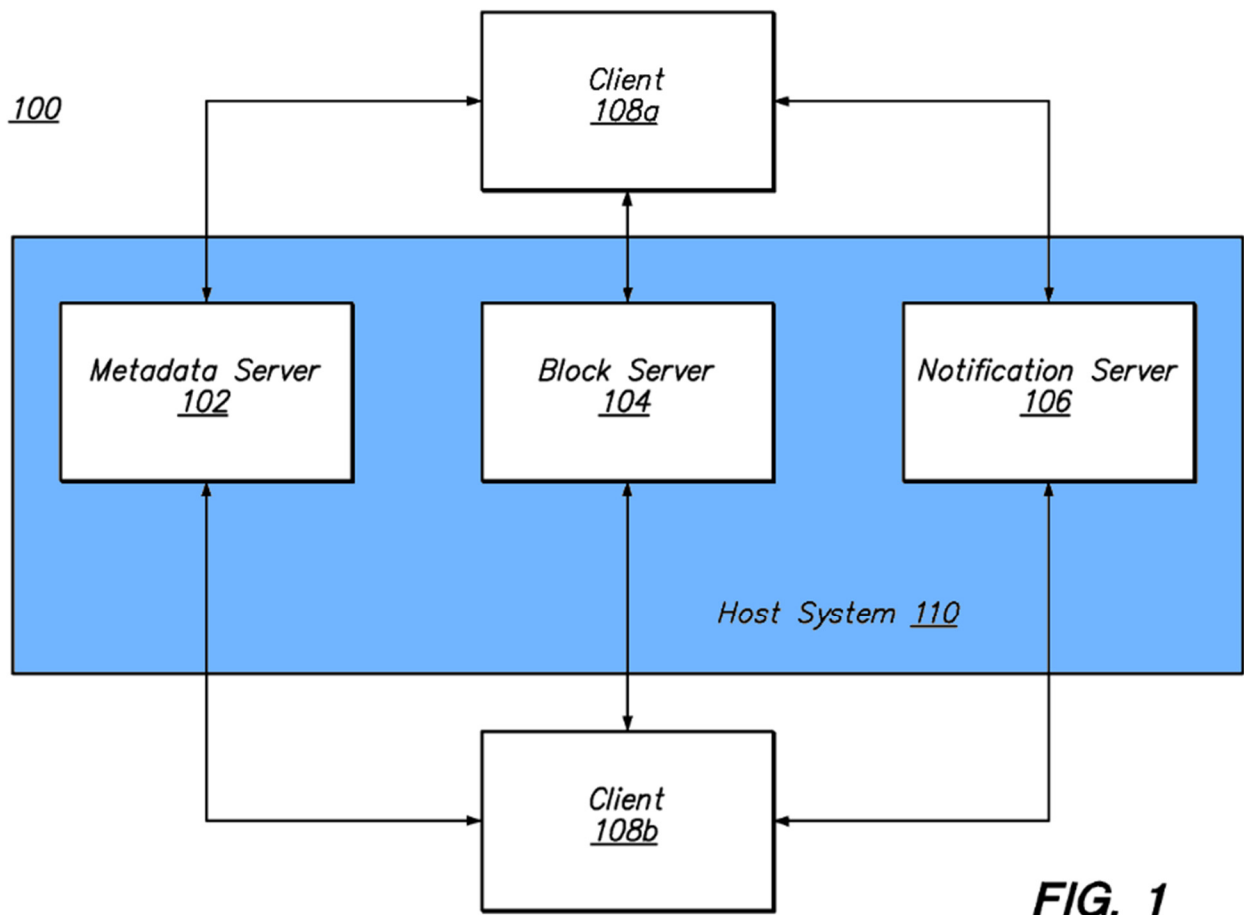
- l) after the information associated with the at least one folder, the object associated with the at least one email address, and the indication of the selection of the third user interface element is sent from the first node via the at least one network: creating, utilizing code configured to be stored on a storage at the second node and further configured to cooperate with a file explorer interface, a representation of the at least one folder in a location among one or more folders on the file explorer interface, and**

Houston alone and in combination with Garcia discloses this feature. (EX1002 ¶¶114-123.) For example, as discussed above in Sections IX.A.2.b-k, Houston discloses “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 is sent from the first node via the at least one network.” (*See supra* Sections IX.A.2.b-k; EX1002 ¶¶114-123.) As discussed below, the remaining features are disclosed by Houston alone or in combination with Garcia. (EX1002 ¶¶114-123.)

(1) Houston Discloses this Feature

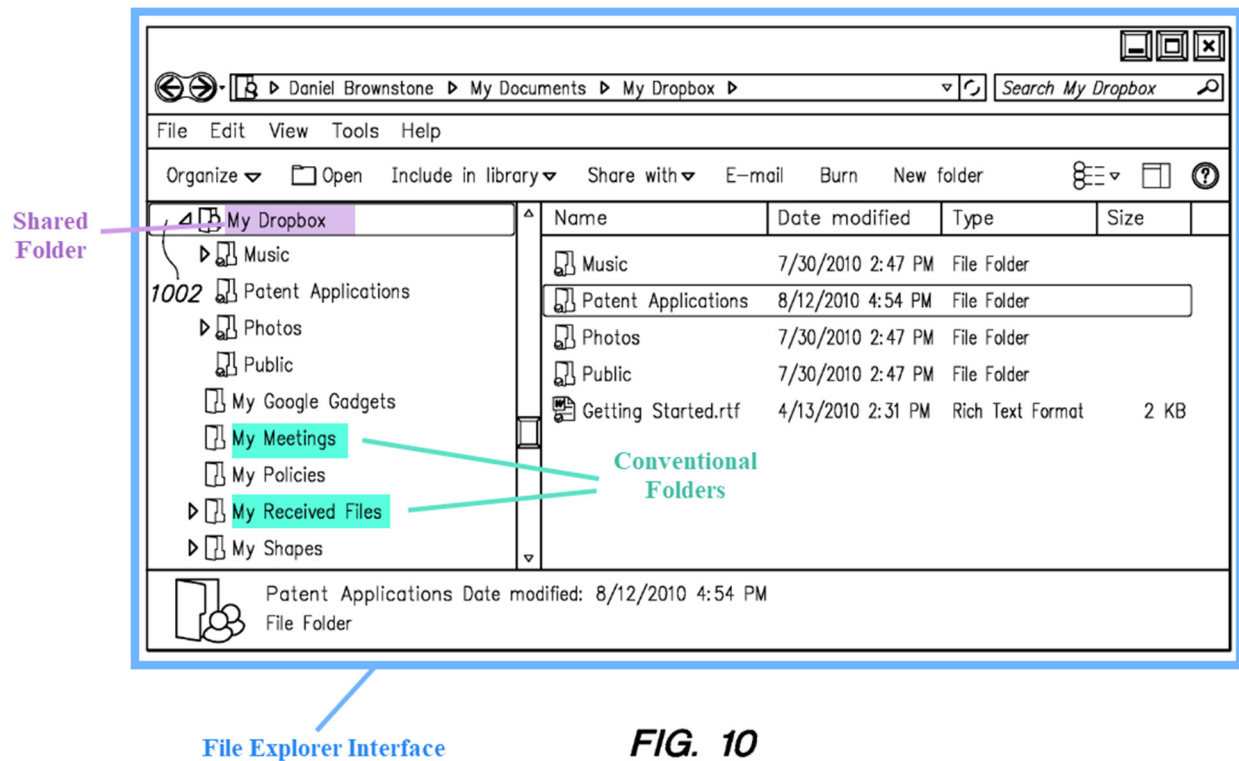
Houston discloses that “[c]lient 108 executes an operating system . . . and includes memory, storage, a network interface, and other conventional computer hardware . . .” (“code configured to be stored on a storage at the second node”). (EX1005, 3:11-17; EX1002 ¶¶115-116.) And Houston discloses that client 108b enables a user to add files and folders (“creating”) on its local file system in a conventional manner via its operating system (“further configured to cooperate with a file explorer interface”). (EX1005, 3:18-20, 3:25-34, 3:55-59, 5:42-44; EX1002 ¶117.) For example, Houston explains that “[c]lient 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.” (EX1005, 3:25-28; *see also id.*, 2:1-2, 5:36-6:8.) Further, the “My Dropbox” folder 1002 shown in Figure 10 is a created and shared folder that “is displayed next to other conventional folders such as ‘My Meetings’, ‘My Received Files,’ and others” (“a representation of the at least one folder in a location among one or more folders on the file explorer interface”). (*Id.*, 7:30-31; EX1002 ¶¶117.)

Houston discloses using host system 110, as shown in Figure 1 below, to synchronize a folder created by one client and shared among one or more additional clients. (EX1005, Abstract, 3:22-24.)



(*Id.*, FIG. 1 (annotated).) Specifically, “a user creates a folder and designates it as one that should be synchronized” after which “its contents are synchronized with a host system.” (*Id.*, 3:25-30; *see also id.*, 1:53-67, 2:57-62, 3:5-8.) When a user of client 108a invites a user of client 108b to share a folder, share instructions are communicated to, and the folder is synchronized on, host system 110. (*Id.*, 3:41-43, 5:42-45, 7:32-40.) The host system 110 can then perform a namespace mapping function to link the folder at client 108a with host system 110. (*Id.*, 7:18-48.)

In order to access the contents of the synchronized folder, Houston discloses that a user must either accept an invitation to share the folder and/or must “register” with the host system 110. (*Id.*, Abstract, 1:59-2:2, 7:49-58.) When a user accepts an invitation to share a folder, host system 110 performs a namespace mapping function to link the folder at the host system 110 with the invited user’s client 108b, and the invited user receives a version of the folder that reflects the version at the host system 110 (“a representation of the at least one folder”). (*Id.*, Abstract, 1:59-2:2, 3:25-28, 5:37-6:4, 7:49-58; EX1002 ¶119.) The version of the shared folder received by the invited user is then displayed and the user may access it through the standard user interface of client 108b’s operating system, including its file explorer user interface. (EX1005, 3:31-45, 5:42-51, 6:20-22, 7:18-58.)

**FIG. 10**

(*Id.*, FIG. 10 (annotated).)

Thus, Houston discloses this feature. (EX1002 ¶¶115-120.)

(2) The Combination of Houston and Garcia Discloses this Feature

To the extent PO argues that Houston does not disclose this feature, it would have been obvious based on the combination of Houston and Garcia. (EX1002 ¶¶121-123.) For example, as discussed in more detail above in Section IX.A.1, Garcia discloses a “virtual drive” folder (among other local and remote folders) and the creation of a representation of such a folder for viewing by a user, which discloses the claimed feature. (EX1006, 2:37-41 (“A user may be able to access, via the user interface, a virtual drive on the local device, where, via the virtual drive, a

user is able to access items (e.g., files) in any object (e.g., folders), including objects located only on a remote device.”), 2:66-3:3, 4:58-5:3, 4:51-57, 5:4-13, 5:27-35, 6:5-27, 10:52-11:10, claim 4, FIGS. 10, 20a; EX1002 ¶¶47, 122.) And, as discussed in more detail above in Section IX.A.1, based on such teachings, a POSITA would have found it obvious to modify Houston such that code on client 108b creates a representation of a shared virtual folder in a location among one or more other virtual and/or local folders, similar to as described in Garcia. (*See supra* Section IX.A.1; EX1002 ¶¶54-57, 123.) Such a POSITA would have recognized the benefits (e.g., enabling greater control and file management) and had a reasonable expectation of success combining these teachings of Houston and Garcia. (EX1002 ¶¶54-58, 123; *see supra* Section IX.A.1.)

m) displaying the representation of the at least one folder in the location among the one or more folders on the file explorer interface.

Houston alone and in combination with Garcia discloses this feature. (EX1002 ¶124.) For example, as discussed in Section IX.A.2.1., Houston alone and in combination with Garcia discloses that a shared folder (“representation of the at least one folder”) may be created through the standard user interface of the local file system of a user’s client with whom the folder is shared (“in the location among the one or more folders on the file explorer interface”). (*Id.*; *see also supra* Section IX.A.2.1.) As the discussion in Section IX.A.2.1 also demonstrates, Houston alone

and in combination with Garcia further discloses that such a shared folder is made visible (“displaying”) through the standard user interface of the local file system of a user with whom the folder is shared. (EX1002 ¶124; *see also supra* Section IX.A.2.1.)

3. Claim 2

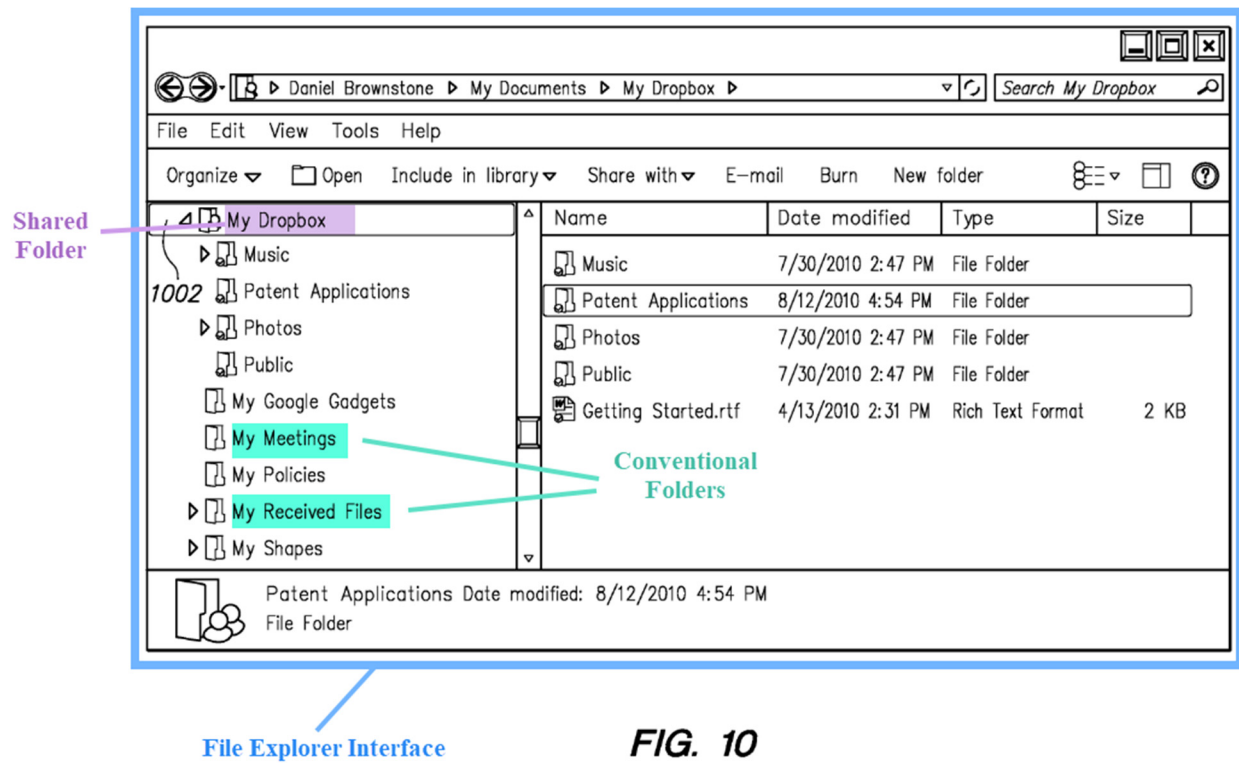
- a) **The method of claim 1, wherein the object associated with the at least one email address includes the at least one email address or an alias, and**

Houston discloses this feature. (EX1002 ¶¶125-126.) For example, as discussed above in Section IX.A.2.f, Houston discloses a window UI with a text box that allows a user to input a text string that identifies the user(s) with whom to share a folder, such as one or more email addresses or other account identifiers associated with email addresses (“the object associated with the at least one email address includes the at least one email address or an alias”). (EX1002 ¶125; *see also supra* Section IX.A.2.f.) Because the one or more email addresses are part of the text string, Houston discloses “wherein the object associated with the at least one email address includes the at least one email address.” (EX1002 ¶125; EX1005, 3:41-43, FIG. 4; *supra* Section IX.A.2.f.) This is consistent with the specification and claims of the ’353 Patent, which demonstrate that a text string representing an email address may be considered an “object.” (EX1001, claim 2, 39:60-63; EX1002 ¶126.) Houston further discloses that the object includes an “alias.” (EX1005, 7:39-40 (“[T]he user

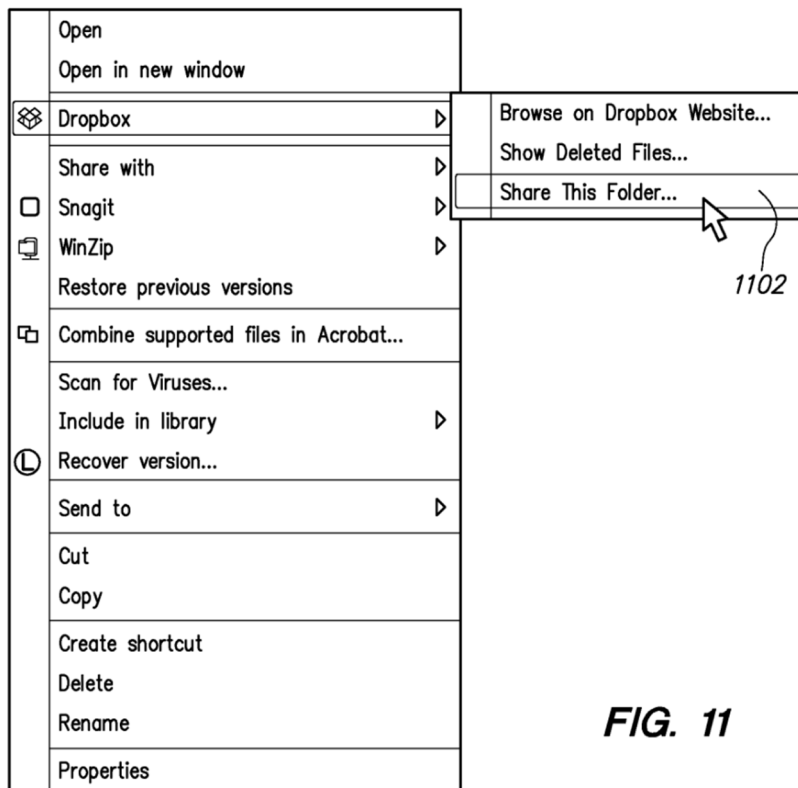
also specifies the account identifier of the user(s) with whom the folder is to be shared.”), 7:53-54.)

b) the file explorer interface is displayed using a file explorer client application and not via a web page;

Houston discloses this feature. (EX1002 ¶127; *see also supra* Sections IX.A.2.1-m; *see infra* Section IX.A.6.c.) For example, Houston discloses that shared folders may be accessed using a web interface or using the local file system of client 108 via its operating system in a conventional manner. (EX1005, 2:10-12, 3:18-46 (“In one embodiment, a user can create a shared synchronized folder either through a user interface portion of client 108, or via a web server.”), 7:19-21, 7:37-40.) Further, Houston discloses that “FIG. 10 and FIG. 11 provide a view of how a folder can be shared using software on client 108.” (*Id.*, 3:43-45.)



(*Id.*, FIG. 10 (annotated).)

**FIG. 11**

(*Id.*, FIG. 11.)

- c) wherein the at least one email message is sent without including the file attachment with the at least one email message, and**

Claim element 2.c recites features that substantially the same as those recited in claim element 1.k. Thus, for at least the same reasons as discussed for claim element 1.k, the combination of Houston and Garcia discloses this feature. (EX1002 ¶128; *supra* Section IX.A.2.k.)

- d) **the storage at the second node does not store any file in response to the representation of the at least one folder being created, both for avoiding any file from having to be communicated to and stored at the second node until requested by at least one user at the second node.**

The combination of Houston and Garcia discloses this feature for at least the same reasons as discussed for claim elements 1.k and 1.l. (EX1002 ¶¶129-131; *supra* Sections IX.A.2.k-l.) For example, as explained above with respect to claim element 1.k and 1.l, Houston discloses that client 108b includes storage (“the storage at the second node”) and executes an operating system and computer programs that enable client 108b to display a shared folder (“the representation of the at least one folder being created”) 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 that is not stored at node 108b. (EX1002 ¶129; *supra* Sections IX.A.1, IX.A.2.k, IX.A.2.l.) As Garcia further explains, and as would have been obvious to implement in Houston’s system, only “when a user double clicks on a file or item in a remote folder in the virtual drive” does “the server download[] its copy of the file/item to the local synchronization software client (i.e., the client currently being used by the user).” (EX1006, 5:32-39; *see also id.*, 2:66-3:3, 4:32-35 (“If the user elects to synchronize the remote object to the local device, a copy of the remotely located object is downloaded to the local device[.]”), 7:11-33, 10:52-11:10, claim

4.) Such a combination would have been obvious for the same reasons provided above for claim element 1.1. (EX1002 ¶¶129-130; *supra* Section IX.A.2.1.)

4. Claim 3

- a) **The method of claim 1, wherein the file explorer interface is displayed by a client-based file explorer application, and**

Claim element 3.a recites features that are substantially the same as those recited in claim element 2.b. Thus, for at least the same reasons as discussed in claim element 2.b, Houston discloses this feature. (EX1002 ¶132; *supra* Section IX.A.3.b.)

- b) **where the storage of the second node does not store any file in the at least one folder in response to the representation of the at least one folder being created.**

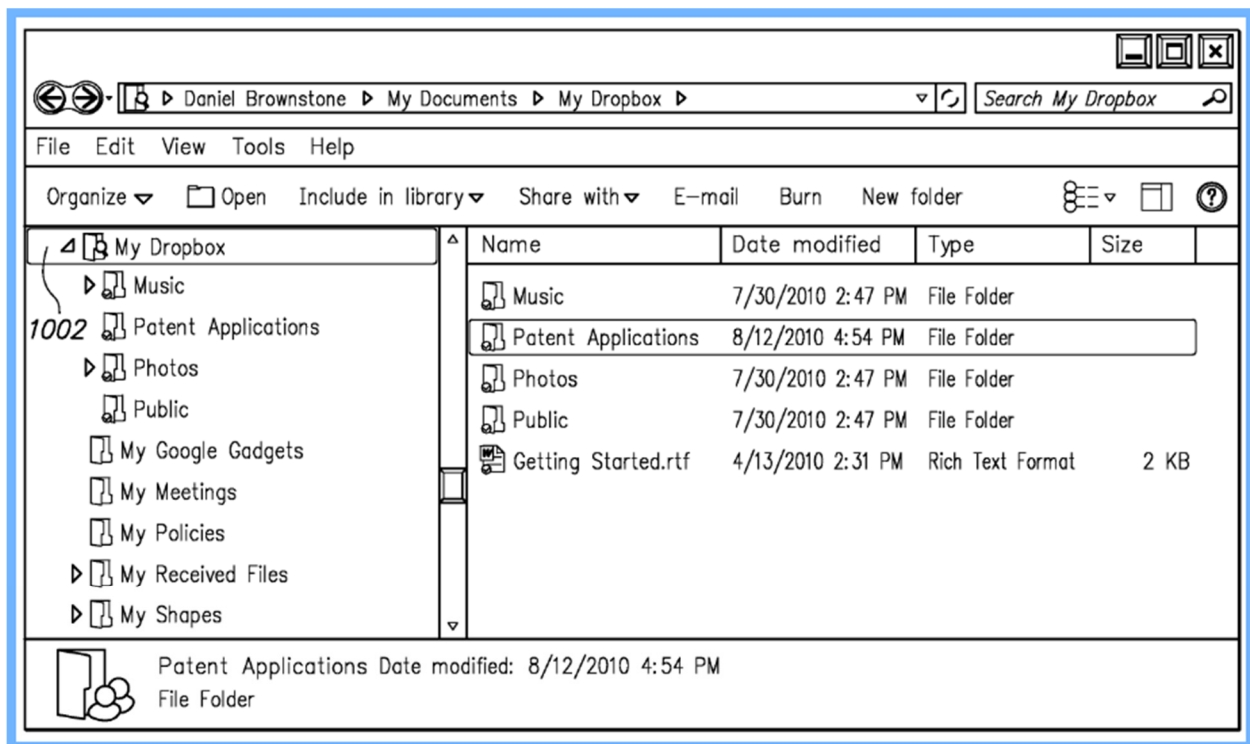
Claim element 3.b recites features that are substantially the same as those recited in claim elements 1.1 and 2.d. Thus, for at least the same reasons as discussed for claim elements 1.1 and 2.d, the combination of Houston and Garcia discloses this feature. (EX1002 ¶133; *supra* Sections IX.A.2.1, IX.A.3.d.)

5. Claim 4

- a) **The method of claim 1, wherein the file explorer interface is displayed by a client-based file explorer application associated with an operating system.**

Claim 4 recites features that are substantially the same as those recited in claim element 2.b. Thus, for at least the same reasons as discussed for claim element 2.b, Houston discloses this feature. (EX1002 ¶¶134-135; *supra* Section IX.A.3.b.)

Further, Houston discloses that client 108 may be executed on a variety of different operating systems. (EX1005, 3:12-13, 8:6-15.) Houston also notes that many of the features and functionalities it discloses are accessible through the operating system of client 108, including the file explorer interface shown in Figure 10 below. (*Id.*, 3:11-24 (“Client 108 creates, modifies and deletes files on its storage system in a conventional manner *via its operating system*”), 3:60-62, 7:19-21.)



File Explorer Interface

FIG. 10

(*Id.*, FIG. 10 (annotated).)

6. Claim 5**a) A method, comprising:**

Claim element 5.a recites features that are the same as those recited in claim element 1.a. Thus, for at least the same reasons as discussed in claim element 1.a, Houston discloses this feature. (EX1002 ¶136; *see also supra* Section IX.A.2.a; *infra* Sections IX.A.6.b-1.)

b) at a first node:

Claim element 5.b recites features that are substantially the same as those recited in claim element 1.b. Thus, for at least the same reasons as discussed in claim element 1.b, Houston discloses this feature. (EX1002 ¶137; *supra* Section IX.A.2.b.)

c) causing display of at least one first interface with a first user interface element, utilizing first hypertext markup language-equipped code,

Houston discloses this feature. (EX1002 ¶¶138-141.) For the reasons discussed above with respect to claim element 1.c, Houston's teachings relating to Figures 3 and 10 each discloses a user interface window ("causing display of at least one first interface") that allows a user to select a folder to share ("with a first user interface element"). (*Id.*, ¶138; *see also infra* Section IX.A.6.d.) As discussed below, Houston teaches that Figures 3 and 10 can be implemented via a web interface ("utilizing first hypertext markup language-equipped code"). (EX1002 ¶138; *see also infra* Sections IX.A.6.d, IX.A.6.e.)

Regarding Figure 3, while Houston does not explicitly state how UI window 300 is implemented (EX1005, 2:28-30; 3:38-40, FIG. 3),¹¹ a POSITA would have understood that Houston discloses that UI window 300 could have been implemented via a web server. (EX1002 ¶139.) And while Houston explains that the interfaces in Figures 10 and 11 are implemented “using software on client 108” (EX1005, 3:43-46), a POSITA would have understood that Houston discloses that those interfaces could have also been implemented via a web server. (EX1002 ¶139.) Indeed, according to Houston, each of the disclosed user interface elements discussed above with respect to claim element 1.c can be implemented on a client using either (i) software embodied on the client, such as a standard user interface of the client’s operating system, or (ii) via a web interface. (EX1005, 2:10-12, 3:31-43, 3:43-46, 7:18-21, 7:37-40, 8:33-36, FIGs. 2-4, 10, 11.) For example, Houston explains that “a user can create a shared synchronized folder either through a user interface portion of client 108, or via a web server.” (*Id.*, 3:31-34.)

Such web interfaces were widely known by POSITAs to require the use of HyperText Markup Language, which satisfies “hypertext markup language-equipped code.” (EX1002 ¶140; EX1007, 347 (defining “web” as, in part, a “global

¹¹ Figure 3, however, is described in the context of Figure 2, which “illustrates a user interface window 200 accessed via a web server.” (EX1005, 3:34-35.)

hypertext-based structure that can be navigated and browsed,” defining “World Wide Web” as, in part, “a global hypertext-based structure that can be navigated and browsed,” and explaining that the web’s “underlying code or glue is HTML”); EX1008, 381 (defining “web or www or world wide web” as, in part, a “collection of the millions of websites and web pages that together form the part of the Internet that is most often seen by users,” where “[e]ach page is created using the HTML language”).) But, even if PO argues that Houston does not teach such code, it would have been obvious to a POSITA to implement the use of such code, as it would have enabled users to access virtual folders over a network like the Internet using the standard markup language used for web browsers. (EX1002 ¶140.)

Thus, Houston discloses (or at least renders obvious) this feature. (*Id.*, ¶¶138-141.)

d) receiving an indication of at least one folder via the first user interface element, utilizing the at least one first interface,

Claim element 5.d recites features that are substantially the same as those recited in claim element 1.d. Thus, for at least the same reasons as discussed in claim element 1.d, Houston discloses this feature. (EX1002 ¶142; *see supra* Section IX.A.2.d.) For example, 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 (“an indication of at least one folder via the first

user interface element, utilizing the at least one first interface”) being received by the client (“receiving”). (EX1002 ¶142; *see also supra* Sections IX.A.2.d, IX.A.6.c; *infra* Section IX.A.6.f.)

- e) **causing display of at least one second interface with a second user interface element, utilizing second hypertext markup language-equipped code,**

Claim element 5.e recites features that are substantially the same as those recited in claim element 1.c. Thus, for at least the same reasons as discussed in claim element 1.c, Houston discloses those features. (EX1002 ¶¶143-145; *see supra* Section IX.A.2.c.) For example, Houston’s teachings relating to Figures 4, 10, and 11 each discloses a user interface window (“causing display of at least one second interface”) including a text entry field (“with a second user interface element”) that allows a user to input information identifying a user with whom a folder may be shared. (EX1002 ¶143; *see also supra* Sections IX.A.2.c, IX.A.6.c; *infra* Section IX.A.6.f.)

Houston further teaches that Figures 4, 10, and 11, including the text entry field, can be implemented via a web interface (“utilizing second hypertext markup language-equipped code”). For example, similar to UI window 300 in Figure 3, while Houston does not explicitly state how UI window 400 in Figure 4 is

implemented (EX1005, 2:31-33, 3:40-43, FIG. 4),¹² a POSITA would have understood that Houston discloses that UI window 400 could have been implemented via a web server. (EX1002 ¶144.) And while Houston explains that the interfaces in Figures 10 and 11 are implemented “using software on client 108” (EX1005, 3:43-46), a POSITA would have similarly understood that Houston discloses that those interfaces could have also been implemented via a web server. (EX1002 ¶¶144-145.) Indeed, as discussed above with respect to claim element 5.c, according to Houston, each of the disclosed user interface elements discussed above with respect to claim element 1.c, including the second user interface element illustrated in Figures 4, 10, and 11, can be implemented on a client using either (i) software embodied on the client, such as a standard user interface of the client’s operating system, or (ii) via a web interface. (EX1005, 3:31-34; *supra* Section IX.A.6.c.)

- f) receiving indicia associated with at least one email address via the second user interface element, utilizing the at least one second interface, and**

Claim element 5.f recites features that are substantially the same as those recited in claim element 1.f. Therefore, for at least the same reasons as discussed for

¹² Figure 4, however, is described in the context of Figure 2, which “illustrates a user interface window 200 accessed via a web interface.” (EX1005, 3:34-35.)

claim element 1.f, Houston discloses this feature. (EX1002 ¶146; *see supra* Section IX.A.2.f.) For example, Houston’s teachings relating to Figures 4, 10, and 11 each discloses a user interface window with a display area including a text box (“second user interface element”) that allows a user to input, and therefore causing the client to receive (“receiving”), a text string (“utilizing the at least one second interface”) that contains one or more account identifiers, such as email addresses or some other identifier associated with an email address (“indicia associated with at least one email address”) of a user with whom a folder may be shared. (EX1002 ¶146; *see also supra* Sections IX.A.2.f, IX.A.6.d, IX.A.6.e.)

- g) receiving an indication to share the at least one folder for causing to be sent, to a second node via 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 any file in the at least one folder as an attachment of the at least one email message; and**

Claim element 5.g recites features that are substantially the same as those recited in claim elements 1.h-k. Therefore, for at least the same reasons as discussed for claim element 1.h-k, Houston discloses this feature. (EX1002 ¶147; *see supra* Sections IX.A.2.h-k.) For example, the combination of Houston and Garcia discloses a share folder button (*e.g.*, the “Share Folder” button shown in Houston’s Figure 4), which allows a user to input a user interface command (“indication to share the at least one folder”) that is received by the client (“receiving”) and sent to the host

system, which then sends an email to the user(s) / clients (“second node”) identified as those with whom the folder is shared (“causing to be sent, to a second node via at least one network, at least one email message”) that identifies and includes a web link to the shared folder (“identifying the at least one folder and including a reference to the at least one folder, without including any file in the at least one folder as an attachment of the at least one email message”). (EX1002 ¶147; *see supra* Sections IX.A.2.h-k.)

h) at the second node:

Claim element 5.h recites features that are substantially the same as those recited in claim element 1.j. Thus, for at least the same reasons as discussed in claim element 1.j, Houston discloses this feature. (EX1002 ¶148; *see also supra* Sections IX.A.2.h-k.)

i) causing, via particular code configured to be stored on a storage at the second node and further configured to cooperate with a file explorer interface, creation of a representation of the at least one folder in a location among one or more folders on the file explorer interface,

Claim element 5.i recites features that are substantially the same as those recited in claim element 1.l. Thus, for at least the same reasons as discussed in claim element 1.l, Houston alone and in combination with Garcia discloses this feature. (EX1002 ¶149; *supra* Section IX.A.2.1.) Additionally, Houston’s broad disclosures

are not limited to any specific combination of web-based or client software-based implementation of the interfaces the users use to perform its folder-sharing methods. (EX1002 ¶149; *see also* EX1005, 2:10-12, 2:25-33, 2:48-52, 3:25-45, 7:18-40, 8:33-36 (“the particular division of functionality between the various system components described herein is merely exemplary, and not mandatory”), FIGs. 2-4, 10, 11.) Thus, based on Houston’s teachings, one client (*e.g.*, the disclosed “first node”) can utilize web-based interfaces while another client (*e.g.*, the disclosed “second node”) can utilize client software-based interfaces. (EX1002 ¶149.)

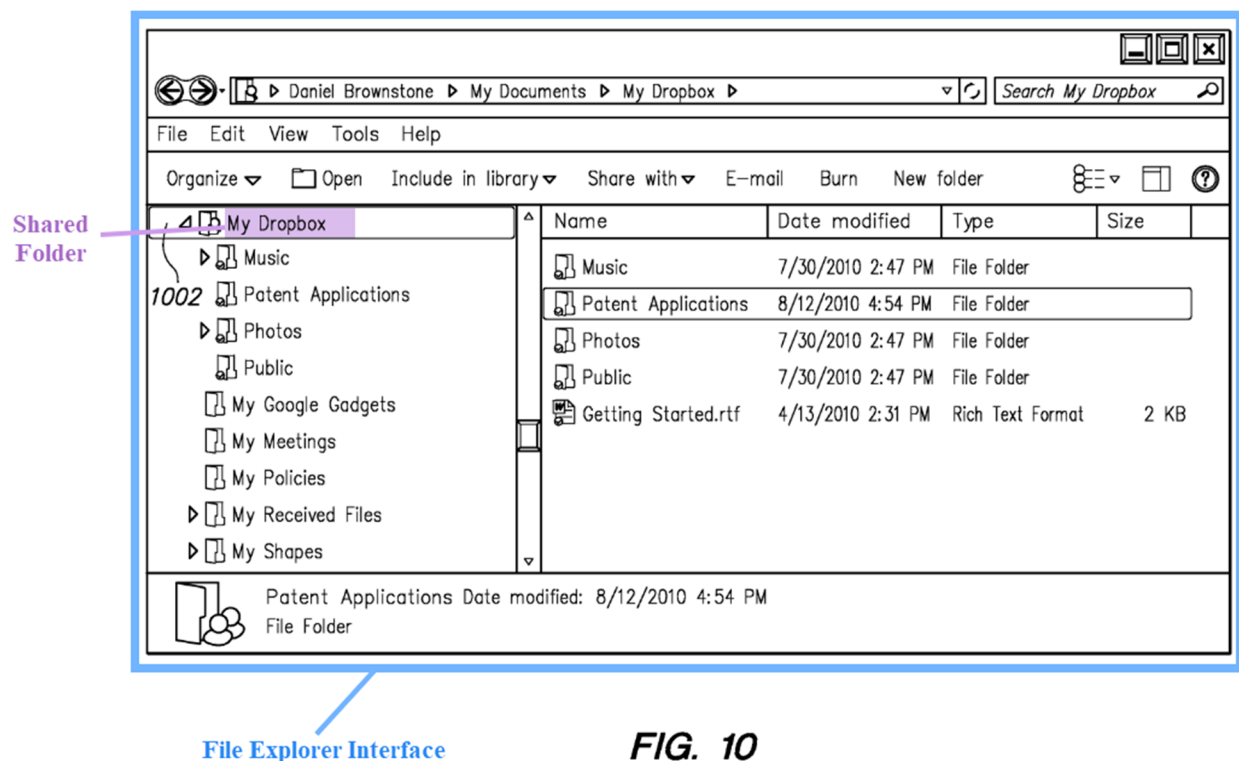
j) causing display of the representation of the at least one folder in the location among the one or more folders on the file explorer interface,

Claim element 5.j recites features that are substantially the same as those recited in claim element 1.m. Thus, for at least the same reasons as discussed in claim element 1.m, Houston alone and in combination with Garcia discloses this feature. (EX1002 ¶150; *supra* Section IX.A.2.m.)

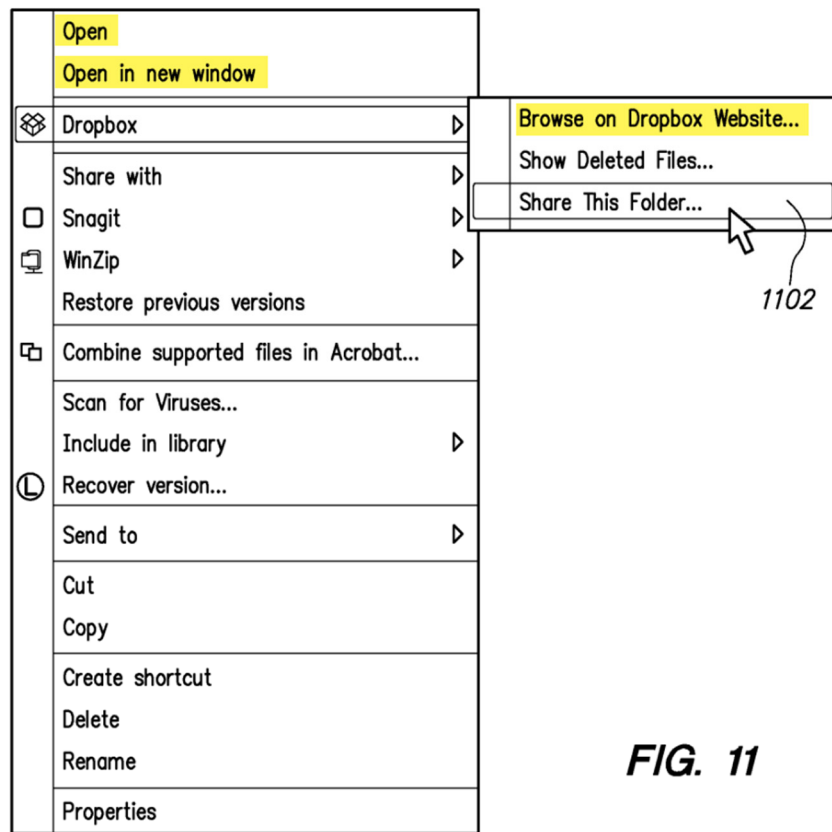
k) receiving an indication to open at least one file in the at least one folder, and

Houston discloses this feature. (EX1002 ¶¶151-154.) Houston discloses that the user(s) with whom the folder is shared are able to access and modify (“receiving an indication to open”) files contained within shared folders (“at least one file in the at least one folder”). (*Id.*; *see also infra* Section IX.A.6.l.)

For example, Houston discloses that users with whom a synchronized folder is shared may access and modify files contained within the folder. (EX1005, 3:25-28 (“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.”), 6:3-4, 6:20-22, 6:38-40.) As shown in Figures 10 and 11 below, a user may use its operating system’s file explorer interface or a web interface in order to open a shared folder and access and/or modify the file(s) within it. (*Id.*, 3:25-45, 6:20-22, 7:18-58.)



(*Id.*, FIG. 10 (annotated).)

**FIG. 11**

(*Id.*, FIG. 11 (annotated).)

In order to modify a file within a shared folder, a user must open the file, which requires that the client receive an indication to open the file. (*See id.*, 7:10-14 (“[U]pon instruction from a user of a client 108, metadata server 102 instructs block server 104 to provide a file consisting of the blocks in the previous version. This enables a user to preview an earlier version, and if desired, to restore it to the current version”), 7:50-58, 8:14-21; EX1002 ¶154.)

- l) in response to detection of the indication to open 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.**

The combination of Houston and Garcia discloses this feature. (EX1002 ¶¶155-158.) For the reasons discussed above with respect to claim elements 1.1 and 2.d, and as further discussed below, the combination of Houston and Garcia discloses that the user(s) with whom the folder is shared are able to access (“detection of the indication to open”) files contained within shared, virtual folders (“at least one file in the at least one folder”) by obtaining a local version of the file (“causing retrieval of the at least one file”) from the host system (“via the at least one network”) when the user selects the files to view and/or modify (“permitting display of the at least one file”). (*Id.*; see also *supra* Sections IX.A.2.1, IX.A.3.d, IX.A.6.k.)

For example, Houston discloses that users may access and modify files contained within a shared folder by obtaining a copy of the file and storing it locally. (EX1005, 3:25-28, 6:3-4, 6:20-28, 6:38-40, 7:11-14, 7:50-58.) But Houston does not disclose “in response to detection of the indication to open 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.” However, this feature would have been obvious based on the combination of Houston and Garcia. (EX1002 ¶¶53, 157.)

For example, as discussed in more detail above in Section IX.A.1, Garcia discloses a user double-clicking a file within a shared folder (“detection of the indication to open at least one file in the at least one folder”), which then causes the file to be downloaded (“causing retrieval of the at least one file via the at least one network for”) so that it can be viewed by the user (“permitting display of the at least one file”). (EX1006, 2:66-3:3, 5:4-13, 5:32-43 (“In one embodiment, 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).”), 6:5-27, 10:52-11:10, claim 4, FIG. 20a.) And, as discussed in more detail above in Section IX.A.1, it would have been obvious for a POSITA to modify Houston’s system such that client 108b only retrieves files when needed, such as when selected, similar to as taught by Garcia. (EX1002 ¶¶54-57, 158; *supra* Section IX.A.1.) Such a POSITA would have recognized the benefits (e.g., no need to locally store folders and files, which may be large, until needed) and had a reasonable expectation of success combining these teachings of Houston and Garcia. (EX1002 ¶¶54-57, 158; *see supra* Section IX.A.1.)

7. Claim 6

- a) **The method of claim 5, wherein the indicia associated with the at least one email address includes an alias associated with the at least one email address.**

Claim 6 recites features that are substantially the same as those recited in claim element 2.a. Thus, for at least the same reasons as discussed in claim element 2.a, Houston discloses this feature. (EX1002 ¶159; *supra* Section IX.A.3.a.)

8. Claim 7

- a) **The method of claim 5, wherein the indicia associated with the at least one email address includes the at least one email address.**

Claim 7 recites features that are substantially the same as those recited in claim elements 1.f and 2.a. Thus, for at least the same reasons as discussed in claim elements 1.f and 2.a, Houston discloses this feature. (EX1002 ¶160; *supra* Sections IX.A.2.f, 3.a.)

9. Claim 16

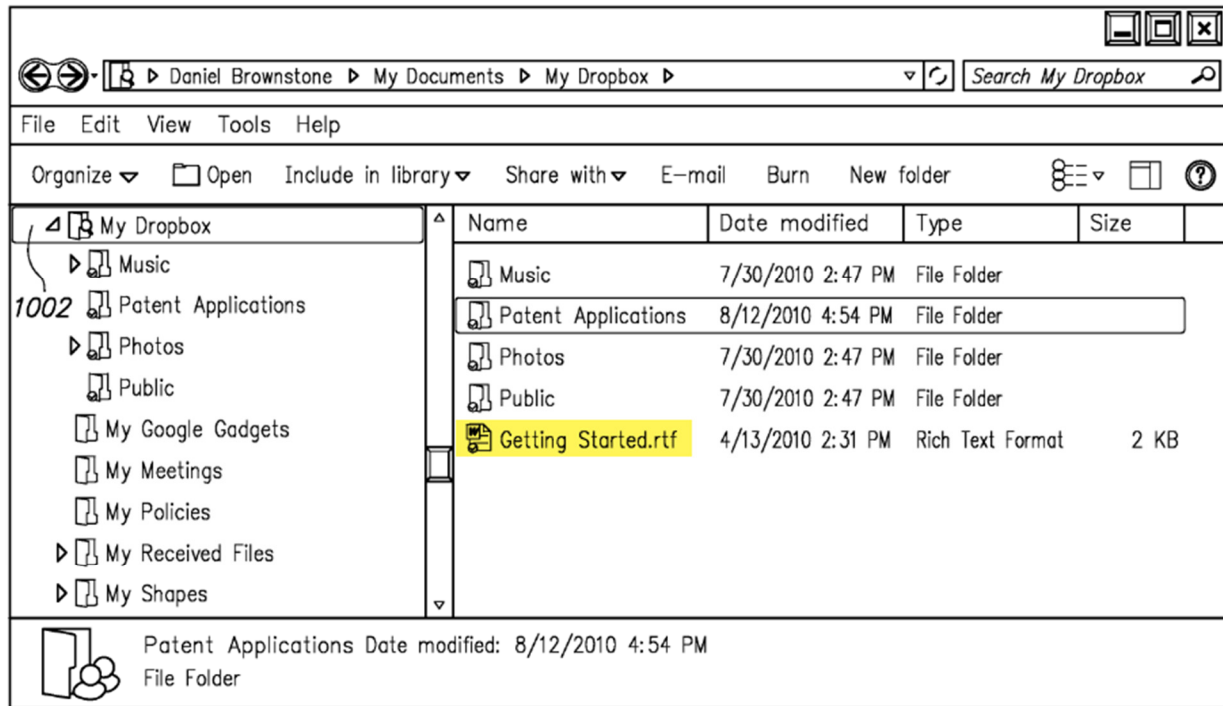
- a) **The method of claim 5, wherein, in response to the creation of the representation of the at least one folder being caused, an additional representation on the file explorer interface is caused to be created that represents the at least one file, where the file explorer interface is displayed by a file explorer client application without a web page.**

Claim 16 recites “the creation of the representation of the at least one folder being caused” and “the file explorer interface is displayed by a file explorer client”

application without a web page,” which are features that are substantially the same as those recited in claim elements 1.1 and 2.b, respectively. Thus, for at least the same reasons as discussed for claim elements 1.1 and 2.b, the combination of Houston and Garcia discloses this feature. (EX1002 ¶¶161-167; *supra* Sections IX.A.2.1, IX.A.3.b.)

As explained below, Houston discloses that shared folders may contain files (“the at least one file”) 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 of the client (“an additional representation on the file explorer interface is caused to be created”). (EX1002 ¶¶162-165.) It would have been obvious based on Garcia for such folders and files to comprise virtual files that are represented on the client, as discussed below. (EX1002 ¶¶52-53, 166-167.)

For example, Houston specifically discloses shared folders containing files, such as “Getting Started.rtf” shown in Figure 10 below. (EX1005, Abstract (“A first user of a first client instantiates a folder to be shared, and the folder and its contents are synchronized with a host system.”), 1:53-2:18, 3:5-10, 3:25-28, 7:26-28, 8:16-18.)

**FIG. 10**

(*Id.*, FIG. 10 (annotated).)

Houston discloses that when a user accepts an invitation to share a folder, metadata server 102 of host system 110 then creates a mapping between the namespace of the host system where the folder is located and the namespace of the user's client in order to allow the invited user to access the shared folder (“in response to the creation of the representation of the at least one folder being caused”). (*Id.*, 7:49-53.) When this occurs, “[t]he invited user's client then obtains the latest version of the synchronized file according to the methods described above”

(“an additional representation on the file explorer interface is caused to be created that represents the at least one file”). (*Id.*, 7:56-58.)

Additionally, Houston discloses that client 108b enables a user to create files and folders (“an additional representation on the file explorer interface is caused to be created”) on its local file system in a conventional manner via its operating system. (*Id.*, 3:11-34; *see also id.*, 8:64-9:4.) Houston further discloses that many of its functions can be performed using “software on client 108.” (*Id.*, 8:64-9:4.)

However, Houston does not explicitly disclose that a representation of a file within a shared folder is created on a file explorer interface in response to the creation of a representation of the shared folder. Nevertheless, it would have been obvious to a POSITA, based on Houston in view of the teachings of Garcia, to create a representation of a file in response to the creation of a representation of a shared folder. (EX1002 ¶¶52-53, 166.)

For example, as discussed in more detail above in Section IX.A.1, Garcia discloses accessing a file contained within a shared folder. (EX1006, 2:19-22, 2:37-41, 2:66-3:3, 4:53-62, 5:4-13, 5:27-43 (“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 (step 2020).”), 6:5-27, 10:52-55, 10:59-65, FIGS. 10, 20a.) And, as discussed in more detail above in Section IX.A.1, it would have been obvious to modify Houston such that a representation of a file within a shared folder

is also displayed, similar to as taught by Garcia. (EX1002 ¶¶54-57, 167; *see supra* Section IX.A.1.) Such a POSITA would have recognized the benefits (e.g., greater control and file management) and had a reasonable expectation of success combining these teachings of Houston and Garcia. (EX1002 ¶¶54-57, 167; *see supra* Section IX.A.1.)

X. DISCRETIONARY DENIAL IS NOT APPROPRIATE

The '353 patent is not at issue in any other Board proceeding and the *General Plastic* factors concerning discretionary denial are not applicable. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19 at 3, 8, 15-19 (Sept. 6, 2017). Nor does Petitioner rely on any art or arguments that are the same or substantially the same as those previously presented to the Office.

The six-factor test addressed in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 3 (Mar. 20, 2020) favors institution, particularly in light of the recent guidance provided by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, Katherine Vidal, issued on June 21, 2022 (“Guidance”). (EX1010.)

The Guidance provides that the PTAB will not deny institution of an IPR under *Fintiv* when a petition presents compelling evidence of unpatentability. (*Id.*, 9.) “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.*, 4.) This petition presents compelling evidence of unpatentability because, as discussed above, the prior art discloses all elements of the challenged claims.

Notwithstanding the compelling evidence of unpatentability, as a whole, the *Fintiv* factors also favor institution.

The **first factor (stay)** is neutral or favors institution, as Google currently intends to file a motion to stay after institution. *See, e.g., Hulu LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11 at 10-11 (PTAB May 19, 2021); *Google LLC v. Parus Holdings, Inc.*, IPR2020-00847, Paper 9 at 12 (PTAB Oct. 21, 2020).

The **second factor (proximity of trial dates)** is neutral. Trial in the parallel district court case will not begin until September 7, 2023, and the *Markman* hearing will be held no earlier than August 25, 2022. (EX1011.) While the FWD in this IPR is expected in January 2024, less than five months after the scheduled trial date, the Guidance recognizes that “scheduled trial dates are unreliable and often change,” and thus “[a] court’s scheduled trial date...is not by itself a good indicator of whether

the district court trial will occur before the statutory deadline for a final written decision.”¹³ (EX1010, 8.)

Here, trial may be delayed due to, for example, a pending motion to transfer (EX1012), given Judge Albright’s standing orders require that a *Markman* hearing will not take place until there is a ruling on any pending motion to transfer. (EX1013, 6.) To date, the *Markman* hearing, originally scheduled for March 31, 2022 (EX1014), has already been delayed three times (EX1011, EX1015, EX1016). Trial may also be delayed because of the staggering number of open cases (1,188) on Judge Albright’s docket. (EX1017.). Indeed, Judge Albright’s Court has become a congested center for patent litigation. (EX1018, 5-7 (showing the Western District of Texas as the most congested court in the country and that Judge Albright presides over 19% of all patent cases in Q1 2022).)

Even if the trial is not delayed, this factor does not weigh against institution, as PTAB cases analyzing similar schedules have weighted this factor as neutral or, at most, slightly in favor of denial. *See, e.g., Google LLC et al. v. Parus Holdings*,

¹³ According to the statistics cited in the Guidance (EX1010, 9 n.12), the median time to trial in the Western District of Texas for the year ending March 31, 2022, is 27.2 months (EX1019, 37). The earliest the parallel district court case could go to trial is September 2023, which is already beyond the median time to trial.

Inc., IPR2020-00847, Paper 9 at 12 (PTAB Oct. 21, 2020) (trial scheduled for three months before FWD weighs “at best, neutral”); *Apple Inc. v. Koss Corp.*, IPR2021-00305, Paper 14 at 13-14 (PTAB, June 3, 2021) (trial scheduled for two months before FWD weighs “at most, minimally in favor” of denial).

The **third factor (investment in parallel proceedings)** also favors institution. The parties and the district court have not heavily invested in the district court litigation. *Apple Inc. v. Koss Corp.*, IPR2021-00305, Paper 14 at 14-16 (PTAB June 3, 2021). Fact discovery is in its early stages and the *Markman* hearing has not yet occurred. (EX1011.)

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.)

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).

The **sixth factor (other circumstances)** weighs in favor of institution given the substantial similarity between the prior art not considered during prosecution and the '353 patent. Institution is therefore consistent with the significant public interest against “leaving bad patents enforceable.” *Thryv, Inc. v. Click-To-Call Techs., LP*, 140 S. Ct. 1367, 1374 (2020).

Accordingly, instituting here would enhance the integrity of the patent system, and could save district courts, future parties, and the Board—if a future defendant files an IPR because this one was not considered—significant resources.

XI. CONCLUSION

For the reasons given above, Petitioner requests institution of IPR for the challenged claims based on the specified ground.

Respectfully submitted,

Dated: July 26, 2022

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Petition for *Inter Partes* Review of U.S. Patent No. 10,303,353 contains, as measured by the word-processing system used to prepare this paper, 13,467 words. This word count does not include the items excluded by 37 C.F.R. § 42.24 as not counting towards the word limit.

Respectfully submitted,

Dated: July 26, 2022

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on July 26, 2022, I caused a true and correct copy of the foregoing Petition for *Inter Partes* Review of U.S. Patent No. 10,303,353 and supporting exhibits to be served via express mail on the Patent Owner at the following correspondence address of record as listed on PAIR:

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