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Filed on behalf of Dropbox, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.
Petitioner

v.

MOTION OFFENSE, LLC
Patent Owner

IPR2024-00286
U.S. Patent No. 11,611,520

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I. Introduction

The Petition demonstrates invalidity. Nothing in the Patent Owner's ("PO's") Response casts any doubt that claims 17-21 are unpatentable as obvious. The Board rejected PO's argument that Houston allegedly teaches away from the claims.

In its Response, PO proposes a strained construction of the term "representation of the at least one folder." But PO's proposed construction is incorrect and overly narrow, and even if it is adopted, the claims remain unpatentable.

II. Claim Construction

Term	PO's proposed construction	Petitioner's proposed construction
"representation of the at least one folder" (claims 17-21)	a folder that can be displayed at the user's node, but whose file contents are stored remotely and are not communicated to the user till the user initiates the communication	Plain and ordinary meaning

No construction is needed for the phrase a "representation of the at least one folder." PO takes this simple phrase and improperly stuffs limitations into it that are out of context and unsupported by the specification. POR, 28-38. This construction is premised, not on canons of claim construction, but on a mistaken belief that distorting the term can overcome the prior art's teachings that, when read under a

plain and ordinary meaning (and even under PO's stretched construction), render the '520 patent claims invalid as obvious. EX1034, ¶¶7-8.

First, no construction is needed. This straightforward 7-word claim term simply refers to some sign or symbol that stands in place of (i.e., represents) the “at least one folder” referred to in the claims. There is no reason this term requires construction, much less PO's proposed tortured 30-word construction. EX1034, ¶¶7-8.

Second, PO's proposed construction is facially illogical. PO equates a “representation” of a folder with the “folder” itself. *See* POR, 30. This is inconsistent with the claim language. Elements 17[e]-[g] discuss “display[ing]” the “representation of the at least one folder” on a webpage or file explorer application, suggesting that, consistent with the claim term's plain meaning, the “representation” of the folder is a stand-in image or symbol that depicts, but that is not itself, a folder. Indeed, PO's expert recognized that the representation of something—such as an image of a flag or a Microsoft word icon—is not the same as what that image represents, i.e., a nation or a computer application. *See* EX1028, 29:04-30:07, 32:15-36:01. PO's expert further agreed that “in the MacOS and 32-bit versions of Windows, and other operating systems, [a folder is defined as] a container for programs and files and graphical user interfaces, symbolized on the screen by a graphical image (icon) of a file folder.” *Id.*, 40:08-41:17, 36:07-37-12. EX1034,

¶¶9-10.

Third, PO's construction improperly inserts language from other portions of the claim into this simple term. POR, 29-32. PO's construction appears to be based on language from 17[d]—"permitting avoidance of at least one file from being communicated to and stored at the second node **until an initiation of the communication** of the at least one file **by a user** of the second node is detected."¹ *Id.*, 31-32. But PO provides no justification for why the phrase "representation of the at least one folder" that appears in elements 17[e]-[g] needs to incorporate concepts from 17[d] and cannot speak for itself. *Id.* Indeed, 17[d] relates to a different aspect of the claim than 17[e]-[g]: 17[d] involves the email that is generated to share the folder with the recipient (EX1001, 55:24-31), while 17[e]-[g]—where the claim term "representation of the at least one folder" appears—relate to later steps in the process when representations are created or displayed. Moreover, PO does not even faithfully transplant 17[d]'s language but instead transforms the *permissive* language of 17[d] (sending an email without an attachment "*for permitting avoidance*" of communicating the file until the user initiates the communication), to more restrictive language that *requires* avoidance of such communication ("*is stored remotely and is not communicated to the user till the user*

¹ Emphasis added unless otherwise stated.

initiates the communication").² EX1034, ¶¶11-12.

Fourth, the error of PO's construction is further exemplified by the other claims whose language PO's construction would render language superfluous. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314-15 (Fed. Cir. 2005) (en banc) (other claims "can also be valuable sources of enlightenment"). Disclaimed claim 1 specifies "where the storage at the second node does not store the at least one file when the creation of the representation of the at least one folder is caused." EX1001, 49:37-49. PO relies on this language for its construction (*see* EX1028, 78:19-22, 86:07-21; EX2051 ¶81; POR, 32-33), but this language would not be necessary if the definition of "a representation of the at least one folder"—which is part of 1[h]—**already** meant that the file contents are stored remotely and not communicated to the user until the user initiates communication. The same is true of disclaimed claims 7 and 8. EX1001, 51:8-20. Thus, contrary to PO's argument (POR, 32-34),

² PO's expert was unable to explain whether the proposed construction was permissive. EX1028, 67:15-68:02 ("Q: if somebody said that your construction meant that it was required that the file contents are not communicated to the user until the user initiates the communication, would that be correct? A: I haven't studied, at length, the issue of the transfer being required or not. I think that would require further analysis").

other claims support a broader reading of the claim term, not PO's proposed construction. *See* EX1034, ¶13.

Finally, PO's reliance on the '635 application, which is an abandoned related application incorporated by reference, fails to support its incorrect construction. POR, 34-38. PO appears to argue that because one claim in the '635 application allegedly required that a "data object" be stored "in the second execution environment" and "accessing the representation [by the first execution environment] includes accessing the data object from the second data store," that means the detailed claims of the '520 patent must be read to require a requested folder not be communicated to the requester "till the user initiates the communication." POR, 34-36. No claim construction principle supports importing limitations from abandoned related applications into the claims of a granted patent. Moreover, the cited portions of the application (POR, 36) do not support PO's construction: they do not indicate what initiates the "accessing" of the data object, and even if the accessing were described as being user-initiated, nothing in the application precludes communication of the data object separate from that accessing.³ EX1034, ¶¶14-16.

³ Further, the Board found the '635 application supports a broader reading than PO's claim construction. Paper 12 ("DI"), 42-43. It noted the application

Ultimately, no construction is needed for this basic phrase. Critically, the claims are invalid as obvious under either PO's erroneous construction or the plain and ordinary meaning. The Board need not and should not construe this term. EX1034, ¶17.

provides an example of a representation of a folder “as a window or other visual interface element displayed on a screen of a display presenting information representing a program entity such as a folder.” *Id.*, 42-43 (citing EX2004 ¶¶49-52, 69). PO ignores this. POR, 36-38. The Board also noted that the '635 application states “a representation of a data object may include and/or may otherwise be based on a replica of at least a portion of the data object”—which is inconsistent with PO's construction that would require the contents of files *not* to be part of the representation until a user interacts with it. DI, 43 (citing EX2004 ¶116). PO argues in response that “the representation could represent the data object itself or a replica of the data object, both of which are stored remotely.” POR, 37-38. But nothing in ¶116 suggests the contents of the data object are “not communicated to the user till the user initiates the communication.” EX1034 ¶¶14-15, n.3.

III. Claims 17-21 Are Unpatentable

Nothing in PO's Response casts any doubt that claims 17-21 are unpatentable as obvious.

A. Claim 17 is Obvious over Houston in view of Garcia (Ground1)

PO contests only whether Houston and Garcia disclose elements 17[d]-[g]. POR, 41-54. PO argues that Houston teaches away from Garcia's system. PO's arguments are wrong and the Board has already rejected them.

First, PO's argument is premised on its incorrect construction of "representation of the at least one folder" (which appears in 17[e]-[g]). PO argues Houston allegedly is a local storage system that "automatically" and "immediately" downloads local copies of files to the folder recipient—and thus does not disclose a remote storage system where a folder's content "is not communicated to the user till the user initiates the communication" (as required by PO's construction). POR, 42-43. But if the Board rejects PO's proposed construction—as it should—PO's argument as to elements 17[e]-[g] collapses.

Second, even under PO's construction and even assuming that 17[d] requires that at least one file not be downloaded until the folder recipient initiates the

communication of the file,⁴ Houston combined with Garcia teaches elements 17[d]-[g]. As Petitioner explained with respect to PO's other now disclaimed claims (*see* Pet., 26-27, 49, 57), Garcia discloses what PO's claim construction would require—a remote storage system in which files are stored remotely until a user initiates the downloading of the files. EX1004, 5:35-39 (“[W]hen a user double clicks on a file ... 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).”). Moreover, nothing in Houston teaches away from combining with Garcia.

1. A POSITA Would Have Been Motivated To Modify Houston Based On Garcia

PO argues a POSITA would not have combined Houston and Garcia. POR, 41-49. PO misstates Houston's teachings. There is nothing inconsistent about modifying Houston with a system like Garcia that initially downloads a folder locally only after the recipient clicks a link.

⁴ As explained above, *supra* § II, the language in 17[d] is *permissive* (“*for permitting avoidance*”)—creating a potential benefit of not including an email attachment (i.e., avoiding a file being communicated and stored at the second node until the recipient initiates the communication) but not requiring it. EX1034 ¶¶12, 34.

a) *Houston Does Not Require Automatically and Immediately Downloading a Shared Folder*

PO argues that “Houston’s system ‘automatically’ and ‘immediately’ synchronizes folders and their contents among multiple clients by downloading local copies of shared documents to each user’s client”—i.e., without the folder recipient clicking on a folder. POR, 42. PO’s citations do not support its argument. Houston is agnostic regarding how and when a shared folder is *initially* downloaded. Houston does not disclose any benefit to initially downloading a newly shared file without the user clicking on the file to request the download. EX1034, ¶19.

PO’s first citation (POR, 42 (citing EX1003, 2:17-18)) indicates only that “changes to files” are propagated to client local devices—i.e., files *already downloaded* to the folder recipient—not that folders are automatically and immediately downloaded locally when folders are initially shared with a second user. EX1003, 2:17-18 (“**Changes to files** are propagated ... by transferring only sets of blocks of a file that have undergone changes.”). EX1034, ¶20.

PO’s citation to Houston at 5:37-6:3 also does not support its argument. POR, 42. This passage refers to updating a “synchronized folder” on the second user’s machine. EX1003, 5:37-39 (“client 108 with a synchronized folder informs host system 110 when a *file in a synchronized folder* has been added, modified or

deleted.”). To the extent this passage is referring to an initial sharing of a folder, it indicates that the folder is first synchronized “on host system 110,” after which the second user might need to “register” with the server before any synchronization can happen—i.e., no automatic downloading. *Id.*, 5:41-51 (“user of a first client 108a has created a folder and invited a user of client 108b to share the folder. The folder is immediately synchronized on host system 110 as described above. ... In one embodiment, **each of the clients registers** with notification server 106.”).

EX1034, ¶21.

Finally, Houston's Figure 2, which PO also cites (POR, 42), simply says that “when someone joins a shared folder, the folder appears inside their Dropbox, and syncs to their computers automatically.” EX1003, Fig. 2. Figure 2 does not indicate how the user “joins a shared folder,” and does not preclude user action to initiate the download. Even if Figure 2 were understood to imply that folders are initially downloaded without the invited user initiating the download, nothing in Houston indicates this is a key feature or that Houston's system would not work if the initial sharing of the folder were deferred until the user initiated the communication. What Houston claims as its benefit is automatically updating *existing* shared folders already downloaded to client devices, not the initial downloading of files before the user initiates a communication. *See Id.*, Abstract (“As the contents of the synchronized folder are changed ... the changes are

propagated to the host system, which in turn delivers the changes to each of the clients In this way, each client participating in the share has a current version of the folder and its contents.”). EX1034, ¶22.

b) Houston Does Not Teach Away from Garcia

Nothing in Houston teaches away from a system (like Garcia's) where files are initially stored remotely until the user clicks on a folder to download the files locally. EX1034, ¶23.

PO incorrectly asserts that Houston “criticizes systems like Garcia that store documents remotely.” POR, 46. PO cites two lines in Houston:

Some methods exist to allow remote access to a computer, for example using a virtual private network (VPN) to access a corporate network from a remote location. However, if the user is accessing the document remotely and loses his connection, he may lose his changes, be unable to continue, and may end up with a corrupted document.

POR, 18 (citing EX1003, 1:29-35); *see also* POR, 42, 46. Houston is merely noting the potential instability of a VPN connection when editing a document remotely, not broadly criticizing all systems “that store documents remotely.”⁵

⁵ PO also cites Houston's provisional application. *See* POR, 18-19 (citing EX2026

Indeed, Dr. Smith acknowledges this passage may be addressing “changing a document that already exists.” EX1028, 90:18-91:17. And Houston itself stores files remotely on a host system so they are accessible to other clients. *See, e.g.*, EX1003, 1:54-64 (“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** Other clients ... **obtain** a current version of **the synchronized folder** and contents.”). EX1034, ¶¶24-25.

PO is wrong that combining Houston and Garcia would have “frustrated the heart of the inventions of Houston” and would “result in the loss of ‘key functions’ and ‘benefit’ of Houston, namely, in making a shared folder and its up-to-date contents available” to all devices with which the folder has been shared. POR, 46. The combination would not interfere with making a shared folder and its up-to-date contents available to all devices—because Garcia, like Houston, teaches that

at ¶¶8-14), 42 46. PO does not quote it. Nothing in the provisional teaches away from a system like Garcia that allows a user to control when the initial download of a file in a newly shared folder occurs. The provisional, like Houston, is focused on changes to shared folders that have already been downloaded. EX2026 ¶9 (“A file system is monitored for changes which takes place to a file. ..., synchronization (‘syncing’) is accomplished based on the identification of the changes.”).

changes made to an *existing* shared folder will be made automatically to the files stored locally at each device. *See* EX1004, 5:49-56 (“[C]lients that have an interest in **updates to the folder** ‘register’ for notices of changes to the folder In response to the change being a **change to content within the folder**, the content of the folder is **automatically updated** on any identified remote clients that have a corresponding folder.”); *id.*, 6:17-20.^{6,7} EX1034, ¶26.

⁶ Dr. Smith acknowledges Garcia’s teachings that remote folders may be automatically updated when content in a virtual folder is changed. *See, e.g.*, EX1028, 94:12-95:4, 100:14-21 (“The content of the folder is automatically updated. That’s important. On any identified remote clients. That’s important.... And by ‘important’ I mean it's important to the sentence.”).

⁷ Petitioner is permitted to reply to PO’s new claim construction by citing additional portions of the same prior art. *See Rembrandt and Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1383 (Fed. Cir. 2023) (“petitioner must be afforded a reasonable opportunity in reply to present argument and evidence under that new construction.”) Petitioner may also provide “further detail for how a person of ordinary skill in the art would have modified” the prior art when PO argues that a combination would have been inoperable. *See Apple Inc. v. Masimo Corp.*, No. IPR2022-01465, Paper 73 (PTAB Feb 20, 2024) at 61.

The only change that would result from the combination would be that a user controls when a *newly shared folder* is *initially* downloaded—so that the file is not downloaded until the user clicks on a file. *See* Pet., 9, 40, 41, 42 (citing EX1004, 5:35-39 (“when a user **double clicks on a file** ... the **server downloads its copy**”)). As explained above, nothing in Houston teaches against such a system. Houston does not disclose any benefit to downloading a newly shared file before a user has even clicked on the folder, and instead is focused on ensuring already-downloaded files are automatically updated. EX1003, 2:13-18 (“**Changes to files** are propagated to and from the host system”). EX1034, ¶27.

A POSITA would have understood that providing an invited user with control over when a newly shared folder is initially downloaded (as taught in Garcia) would have provided significant advantages. As Dr. Mowry explains, the combination would give the invited user flexibility about whether and when to download a file in the shared folders depending, for example, “on whether the user’s device has **sufficient storage space** or whether the file **looks secure to the user or passes security checks.**” EX1002, ¶106; *see also id.*, ¶176; Pet., 40-41 (“This would have provided the **added benefit** of allowing the invited user to have **more control** over what is downloaded from the shared folder **and when**, rather than letting the system download any file in the shared folder automatically onto

the invited user's client from the host system 110.”), *id.*, 71.⁸ EX1034, ¶28.

2. Garcia Teaches a “Representation of the at Least One Folder” at the Node Where the Invitation Is Received

PO argues Houston and Garcia do not disclose elements 17[d]-[g]⁹ because Garcia allegedly does not teach creation of “a representation of the at least one folder” at the node where the invitation is received, but rather only at “the user's *other* devices (e.g., different nodes).” POR, 47. PO misreads Garcia. EX1034, ¶35.

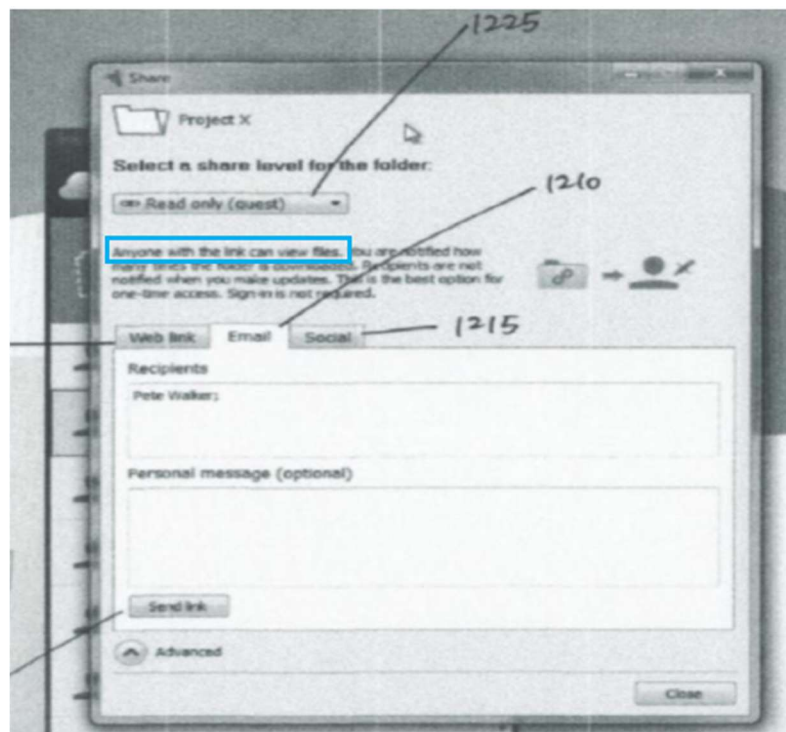
PO's argument is based on Garcia's disclosure that when a first user wants to share a folder with a second user, a link to the folder can be sent to the second user, and “when the contact clicks on the link to folder [1]115, the *contents* of the folder are shared with the contact.” POR, 47 (citing EX1004, 11:29-31) (emphasis in original). PO also cites Garcia's Figure 12, which says “[a]nyone with a link

⁸ Dr. Smith acknowledges similar advantages of having control over downloading a folder, including whether the user even wants to download the folder, whether sufficient bandwidth is available for the download, and whether the user's machine has enough local storage for the download. *See* EX1028, 69:9-70:5, 71:5-71:17. EX1034, ¶29.

⁹ As Dr. Mowry explains, Houston alone also renders obvious element 17[g]. EX1034, ¶30-34.

can view files. You are notified how many times the folder is downloaded.” POR, 48. PO appears to argue that the contents are automatically downloaded at the node where the invitation (*i.e.*, the link) is received without the user being presented with the representation. *Id.* EX1034, ¶36.

First, PO mischaracterizes Garcia's disclosure at 11:29-31 and Figure 12. Nothing in Garcia's specification indicates clicking on the link causes downloading to occur. Garcia states “the contents of the folder are *shared* with the contact”—***not downloaded***. EX1004, 11:29-31. The plain text clearly shows Garcia is simply saying that the second user can access the contents of the folder. Likewise, Figure 12 states that “**Anyone with the link can view files**”—it does not say that when a user clicks the link, files are immediately ***downloaded***:



EX1004, Fig. 12 (annotation added); *see also* EX2052. EX1034, ¶37.

Moreover, nothing in Garcia suggests that if the second user clicks on the email link, the second user receives an immediate download of files without using the virtual interfaces and synchronization features in Garcia. Indeed, a POSITA would have known the second user still needs to access the folder by going through a virtual interface. And a POSITA would have understood that clicking on a link, such as the link in the email of Garcia, will typically take a user to a webpage. Indeed, Garcia expressly envisions accessing the folder through *either* a file explorer interface (as shown in Garcia's Figure 10) or a web interface (as shown in Figure 13). *See, e.g.*, EX1004, 10:52-53 ("FIG. 10 illustrates one way in which a user may access items in objects displayed in the client sync application."), 11:44-45 ("FIGS. 13-14 illustrate the corresponding web interface 1305 for the synchronization system."). EX1034, ¶38.

Second, PO's suggestion that only *other devices* (i.e., devices other than the device that receives the email) would show representations is an unsupported overly narrow interpretation of Garcia. POR, 47. Garcia explicitly discloses that "a user" double clicks on a file in a folder of the virtual drive to download a copy and does not limit this to the "user's other devices (e.g., different nodes)." *See* Pet., 9, 40, 41, 42 (citing EX1004, 5:35-39 ("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).”). Thus, regardless of user device, Garcia teaches that a folder or file is downloaded by clicking on a representation of the file or folder in a virtual drive. EX1034, ¶39.

PO's suggestion is also contrary to the intent of Garcia. Garcia provides benefits of allowing users to choose whether and when to download. It would not make sense—and nothing in Garcia suggests it would—to limit this benefit only to certain devices and not the device that received the folder sharing email, such that the device receiving the email would be required to download everything immediately and not be able to take advantage of the benefits of Garcia described above. EX1034, ¶40.

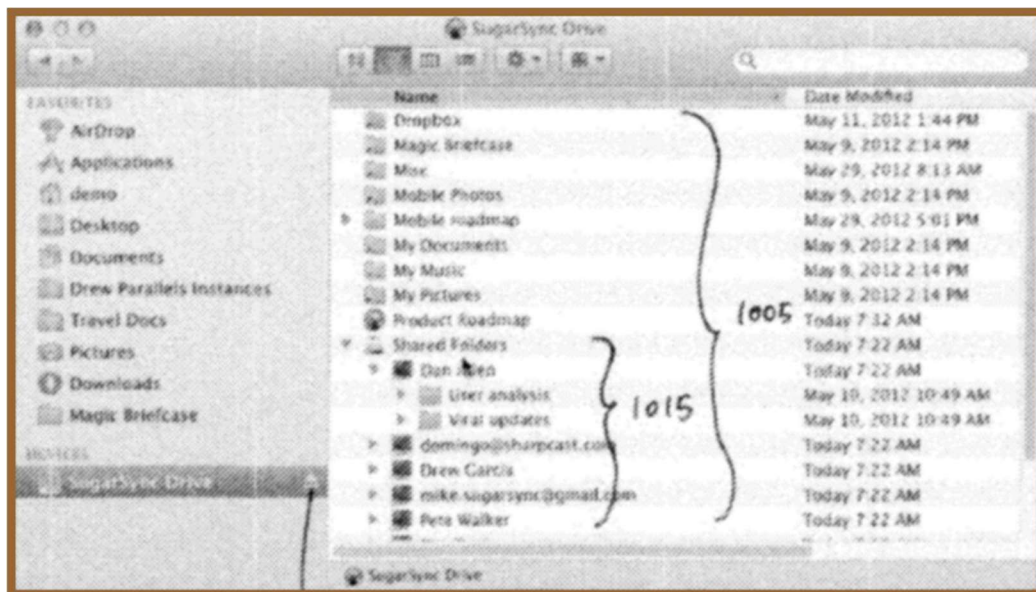
B. Claim 18 is Obvious over Houston in view of Garcia (Ground 1)

PO incorrectly argues Petitioner did not “analyze the ‘interface’ on which the email is ‘displayed,’ nor whether it is a ‘separate interface’ from the ‘file explorer interface’,” as recited in claim 18. POR, 49. Petitioner did analyze these features, and PO's arguments are similar to arguments the Board already rejected. *See* POPR, 37-39; DI, 45-47. EX1034, ¶41.

First, Petitioner explained that Garcia discloses the required email that “includes an Hypertext Transfer Protocol (HTTP) link.” Pet., 57, 60. A POSITA would have understood that such an email would necessarily have been displayed

to the recipient *via an interface*, without which neither the email nor the HTTP link could be presented to the recipient for use. Further, Dr. Smith acknowledges that a “user interface” is “a means by which a user of a computer system interacts with that computer system.” EX1028, 44:6-9. Since Garcia teaches interacting with a computer using a link in the email, Garcia teaches using an email interface. *See, e.g.*, EX1004, Fig. 12 (“Anyone with the link can view files.”). EX1034, ¶42.

Second, Petitioner made clear that the email and file explorer are displayed in separate interfaces. Petitioner explained that by clicking the emailed HTTP link in Garcia, the recipient “would have opened a web page in a web browser” and the recipient could then “access the shared folder from the web page or the file explorer interface.” Pet., 61. The file explorer interface is shown below in Garcia’s Figure 10; it clearly does not include the email with the HTTP link.



EX1004, FIG. 10

Pet., 61. Accordingly, the email must have been displayed via a separate interface from the file explorer interface. EX1034, ¶43.

Third, PO wrongly argues Garcia teaches accessing the shared folder only “via the virtual drive, not via a web page” and thus not via “‘multiple different interfaces’ as the claim requires.” POR, 50. PO argues that by clicking on the email link, the folder recipient causes “the contents of the folder [to be] downloaded at the recipient’s device” (POR, 49), making the folder available “locally ... in the recipient’s virtual drive” but not via a webpage. But PO’s own expert agreed Garcia discloses both a user interface for the desktop client and a web interface and that the web interface has a “shared folders” tab. EX1028, 107:11-109:5, 108:10-109:5; *see also* EX1004, 11:44-46 (Figures 13 and 14 “illustrate the corresponding web interface 1305” that is “[s]imilar to the user interface for the desktop client”); *id.* 11:50-56. And, as explained above, nothing in Garcia suggests clicking on the email link causes an immediate download, or that this would be the only way for the recipient to access the files. To the contrary, as Petitioner explained, “a POSITA would have known that (1) clicking the HTTP link would have opened a web page in a web browser that is separate from a file explorer interface ... and (2) the user would be able to access the shared folder from the web page or the file explorer interface.” Pet., 61. A POSITA

would have understood that clicking on an HTTP link will take a user to a web page such as, for example, the web interface depicted in Garcia's Figure 13. Thus, as Petitioner explained, "the user would be able to access the shared folder from the web page or the file explorer interface"—multiple different interfaces as the claim requires. Pet., 60-61. EX1034, ¶¶44-45.

PO also cites a document outside of Garcia (EX2011 "SugarSync User Guide"), but that document is not mentioned by Garcia, and nothing in that document supports PO's argument that the folder recipient could access a shared folder only "via the virtual drive, not via a web page." POR, 50. PO made a similar argument in its POPR, and the Board properly rejected it: "[t]he fact that arguably related SugarSync documents indicate use of an interface other than a web page does not alter the disclosures in Garcia of using a web page." DI, 46. EX1034, ¶46.

PO points to the highlighted language below from the SugarSync User Guide, indicating that "[w]hen you send an invitation to a shared folder, your recipients receive an email with a link button"—which is entirely consistent with Petitioner's explanation that "clicking the HTTP link would have opened a web page in a web browser."

Receiving a Shared Folder Invitation

If someone shares a SugarSync folder with you, you can access and download the files from the SugarSync Website, or you can [sync the folder to your computer](#). After syncing to your computer, you can locate the shared folder in **Documents > SugarSync Shared Folders**.



If you change the location of the SugarSync Shared Folders directory, or move any of its subfolders, SugarSync will not be able to update your shared files. To access your shared folders from a different location on your computer, you can create a shortcut (or an Alias for Mac) to the folder or any of the subfolders in any location. For more information, see [Creating Shortcuts to Shared Folders](#).

When you send an invitation to a shared folder, your recipients receive an email with a link button.

If they don't have a SugarSync account, they can [sign up for a free account](#).

After creating an account, SugarSync walks them through the SugarSync Manager installation. As soon as the installation completes, the folder syncs to the recipient's computer in a new folder created automatically by SugarSync: **Documents > SugarSync Shared Folders**.

After the folder is synced to the recipient's computer, SugarSync keeps the shared files up-to-date in everyone's shared folder no matter who makes changes to the files.

POR, 50 (citing EX2011, 75-76), (annotations in original). EX1034, ¶47.

PO also cites language explaining that if the recipient does not have a SugarSync account, the recipient can create an account, which will trigger an installation process followed by “the folder sync[ing] to the recipient’s computer in a new folder created automatically by Sugar Sync.” POR, 50. But this procedure for recipients who do *not* have an account does not indicate that users with an account cannot access the folder via a webpage. Indeed, in language at the start of this excerpt—which PO conspicuously fails to mention—the User Guide states recipients *can* access the files either “from the SugarSync Website” or by “sync[ing] the folder to your computer.” EX2011, 75. The User Guide thus supports Petitioner’s position, not PO’s. Dr. Mowry’s declaration further elaborates regarding how portions of another User Guide cited by PO (EX2010) are contrary to PO’s arguments. EX1034, ¶¶48-49.

C. Claims 17-21 Are Obvious over Houston, Garcia, and Manzano (Ground 2)

The Petition relied on Manzano for the element 17[g] “to the extent PO further contends that a representation of a folder in a file explorer interface implies that at least one file in the folder is not downloaded when the representation of the folder is caused.” Pet., 65; *see also id.* 68 (“Manzano discloses that a storage at a second node does not store a shared file until the user at the second node expressly requests that the file be downloaded.”). As the Board found, under a proper interpretation, the claims do *not* require that a file in a folder not be downloaded when the representation of the folder is caused, rendering this alternative ground unnecessary. DI, 48. EX1034, ¶¶51-52.

Even under PO's proposed claim interpretation, PO's arguments fail. PO argues Manzano does not disclose a representation “displayable via the file explorer interface” (POR, 51-52) but Petitioner did not rely on Manzano for that feature of 17[g]. The Petition relied on Manzano for teaching that the second node does not store a shared file until the user initiates the communication—a feature that PO acknowledges Manzano discloses. *See* POR, 52 (“Manzano's system teaches a system that, among other things, does not download local files to folder automatically but instead allows a user to selectively download files stored remotely”). EX1034, ¶52.

PO also argues that “for the same reasons that a POSITA would not have combined Houston with Garcia..., a POSITA would not have combined Houston with Manzano” because Houston allegedly teaches away from a system like Manzano that does not download files to a folder recipient automatically. POR, 52. But, as explained above, *supra* § III.A, Houston does not teach away from such systems, and a POSITA therefore *would have* been motivated to combine Houston with both Garcia and Manzano. *See* Pet., 26-32, 68-73. EX1034, ¶53.

Finally, PO argues Manzano is not “from the same field of endeavor” as the ’520 patent or Garcia because they are directed to “sharing folders with another user” while Manzano is directed to “allowing a user to transfer their own files from a first computer to a second computer.” POR, 52-53. PO defines the field of endeavor too narrowly. The “field of endeavor is not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field.” *Netflix, Inc. v. DIVX, LLC*, 80 F.4th 1352, 1359 (Fed. Cir. 2023) (quotation marks omitted). Manzano and Garcia are each directed to “sharing electronic content among electronic devices over a network” (Pet., 69), which is the same field of endeavor as the ’520 patent. Moreover, Manzano is analogous art under the independent “reasonably pertinent” test. *See In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007) (“reference is reasonably pertinent” if it “logically would have commended itself to an inventor’s

attention in considering his problem.”) (quotation marks omitted). EX1034, ¶54.

D. Claims 19-21 (Ground 1) and Claims 17-21 (Grounds 3-4)

PO does not raise substantive arguments for claims 19-21 of Ground 1 and claims 17-21 of Grounds 3 and 4. POR, 51, 53-54. EX1034, ¶¶50, 55.

IV. Secondary Considerations

Secondary considerations—for which PO relies on *Dropbox's* own product—do not support a finding of non-obviousness. POR, 54-63.

First, PO does not, and cannot, meet its burden of showing a nexus exists between Dropbox's Smart Sync feature and claims of the '520 patent. *See, e.g., Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019). PO has not shown, and will be unable to show, either in district court or in this proceeding that Dropbox practices the challenged claims. The district court litigation is in its earliest stages—PO served insufficient preliminary infringement contentions; no discovery has occurred; and Dropbox has not yet served non-infringement interrogatory responses or expert reports.

Second, contrary to PO's arguments, the verdict of non-infringement in the related case, *Motion Offense, LLC v. Dropbox, Inc.*, 6:20-cv-251 (W.D. Tex.), does not support a finding of nexus. POR, 59; *see also id.*, 14-17. PO incorrectly argues the jury's non-infringement finding was based only on one claim element—“HTML-equipped code”—that is not recited in any of the claims challenged here.

POR, 59. Not so. Dropbox also presented evidence that Dropbox does not make, use, offer to sell, or sell hardware and/or software required by the asserted apparatus claims and that some of the steps required by the asserted method claims were performed by third-parties. EX1035, 2-5.

Finally, PO misstates the record and argues “Dropbox admitted that at least as of 2017, its system included all the elements of the then-asserted claims.” POR, 59. In fact, Dropbox’s expert “us[ed] Motion Offense’s infringement theory [to see] if it applies to Dropbox 2017” because Dropbox 2017 came before the asserted patents’ priority date. EX1033 [Dkt 409], 1110:8-1111:3. Dropbox always asserted it did not infringe and argued only that, if PO were correct that its claims cover Dropbox, the asserted claims would be anticipated by Dropbox prior art.

V. Conclusion

Based on the foregoing and as set forth by the evidence presented in the Petition, claims 17-21 of the ’520 patent are unpatentable and should be canceled.

Respectfully submitted,

/Trishan Eram/

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Petitioner's Reply to Patent Owner's Response
of U.S. Patent No. 11,611,520

UPDATED TABLE OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 11,611,520
1002	Declaration of Dr. Todd Mowry
1003	U.S. Patent No. 8,825,597 ("Houston")
1004	U.S. Patent No. 9,633,125 ("Garcia")
1005	U.S. Patent Application Publication No. 2010/0005138 ("Manzano")
1006	U.S. Patent Application Publication No. 2007/0011246 ("Wu")
1007	[Reserved]
1008	U.S. Patent Application Publication No. 2012/0278404 ("Meisels")
1009	U.S. Patent Application Publication No. 2013/0067303 ("Kantor")
1010	[Reserved]
1011	"SugarSync now allows you to work directly in Windows Explorer," D. Mihovilovic, May 6, 2009
1012	Internet Archive Declaration of Nathaniel E Frank-White
1013	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:20-cv-00251, Jury Verdict Form, May 19, 2023, Dkt. 382

Petitioner's Reply to Patent Owner's Response
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Exhibit	Description
1014	'520 Patent File History
1015	U.S. Patent No. 6,351,776 ("O'Brien")
1016	U.S. Patent Application Publication No. 2008/0320397 ("Do")
1017	"Supporting File Sharing Through Improved Awareness," T. Whalen, August 2008
1018	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:23-cv-00303, First Amended Complaint for Patent Infringement, July 26, 2023, Dkt. 22
1019	[Reserved]
1020	[Reserved]
1021	[Reserved]
1022	[Reserved]
1023	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:23-cv-00303, Plaintiff's Disclosure of Preliminary Infringement Contentions, September 20, 2023
1024	Declaration of Gregory H. Lantier
1025	Declaration of Liv L. Herriot
1026	Declaration of Todd C. Zubler
1027	[Reserved]
1028	Deposition Transcript of Michael Smith
1029	[Reserved]

Petitioner's Reply to Patent Owner's Response
of U.S. Patent No. 11,611,520

Exhibit	Description
1030	[Reserved]
1031	[Reserved]
1032	[Reserved]
1033	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:23-cv-00303, Jury Trial Proceedings Volume 4 of 5, May 18, 2023, Dkt. 409
1034	Second Declaration of Dr. Todd Mowry
1035	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:23-cv-00303, Drobox, Inc.'s Renewed Pre-Verdict Motion for Judgment As A Matter of Law, May 18, 2023, Dkt. 393

WORD COUNT CERTIFICATE OF COMPLIANCE

I certify that the foregoing Petitioner's Reply to Patent Owner's Response contains 5,577 words as measured by the word processing software used to prepare the document, in compliance with 37 C.F.R. § 42.24 (d).

Respectfully submitted,

Dated: January 24, 2025

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CERTIFICATE OF SERVICE

I hereby certify that, on January 24, 2025, I caused a true and correct copy of the foregoing materials:

- Petitioner's Reply to Patent Owner's Response
- Exhibits 1028 and 1033-1035
- Updated Table of Exhibits
- Word Count Certificate of Compliance

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