

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

MOTION OFFENSE, LLC * May 18, 2023
 *
VS. * CIVIL ACTION NO.
 *
DROPBOX, INC. * 6:20-CV-251

BEFORE THE HONORABLE ALAN D ALBRIGHT
JURY TRIAL PROCEEDINGS
Volume 4 of 5

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DROPBOX 1033
DROPBOX v. MOTION OFFENSE
IPR2024-00286

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08:49

08:49 1 (Hearing begins.)

08:49 2 THE BAILIFF: All rise.

08:49 3 THE COURT: Please remain standing for

08:49 4 the jury.

08:49 5 (Jury entered the courtroom.)

08:50 6 THE COURT: Thank you. You may be

08:50 7 seated.

08:50 8 Counsel, we can resume with your witness,

08:50 9 please.

10 MR. LANTIER: Thank you, Your Honor.

11 Professor Shamos, if you could retake the

12 stand.

13 THE COURT: Good morning, Dr. Shamos.

08:50 14 THE WITNESS: Good morning.

08:50 15 DIRECT EXAMINATION CONTINUED

08:50 16 BY MR. LANTIER:

08:50 17 Q. Good morning, Professor Shamos.

08:50 18 A. Good morning.

08:50 19 Q. Now, when we left off yesterday afternoon, we

08:50 20 were just about to start through the limitations of

08:50 21 Claim 12 of the '052 patent.

08:50 22 Do you remember that?

08:50 23 A. Yes.

08:50 24 Q. All right.

08:51 25 MR. LANTIER: If we could begin on Slide

08:51 1 53.

2 BY MR. LANTIER:

08:51 3 Q. Could you tell us what we're seeing here?

08:51 4 A. Yes. This is a listing of the first half of
08:51 5 Claim 12. But as before, the limitations clump
08:51 6 themselves into certain functional areas.

08:51 7 So, for example, the first thing that -- we're
08:51 8 talking about file request now. So the first thing
08:51 9 that happens is the first user has to initiate a file
08:51 10 request, that is, has to ask Dropbox, please do what
08:51 11 you need to do so I can share my file.

08:51 12 Then the next set of limitations has to do
08:51 13 with what Dropbox does then, which is it generates and
08:51 14 sends a first message with a file request to the second
08:51 15 user from whom the files are being requested.

08:51 16 Then on the next page, we have more
08:51 17 limitations. This talks about what happens -- what the
08:51 18 second user is allowed to do using Dropbox. He's
08:51 19 allowed to upload a file in response to the file
20 request.

21 And then an acknowledgement is sent to the
08:52 22 first user saying, your second user actually has
08:52 23 accepted your invitation to open -- to add things to
08:52 24 the folder.

08:52 25 Q. Dr. -- Professor Shamos, did you compare the

08:52 1 Dropbox 2011 AirDropper product to the asserted claims
08:52 2 of the '052 patent?

08:52 3 A. Yes.

08:52 4 MR. LANTIER: If we could start with the
08:52 5 preamble.

6 BY MR. LANTIER:

08:52 7 Q. What are you showing here on Slide 55?

08:52 8 A. Yeah. So this preamble is just like the
08:52 9 preambles of the other claims. It recites an
08:52 10 apparatus, and there's memory, and there are
08:52 11 instructions that get executed. There's no dispute
08:52 12 Dropbox 2011 had this.

08:52 13 Q. Can we check that off?

08:52 14 A. Yes.

08:52 15 MR. LANTIER: Now, turning to the next
08:52 16 slide.

17 BY MR. LANTIER:

08:52 18 Q. Could you tell us what you're showing here?

08:52 19 A. Yes. So I think I mentioned yesterday that
08:52 20 all of the steps of this claim are performed by
08:53 21 AirDropper except the last step.

08:53 22 So for quite a while, we're going to be
08:53 23 talking about what AirDropper does.

08:53 24 This says: Cause, at a first node, display of
08:53 25 at least one first interface with a first user

08:53 1 interface element and a second user interface element,
08:53 2 utilizing first hypertext markup language-equipped code
08:53 3 that is sent via at least one network, the at least one
08:53 4 first interface for use in creating a file request
08:53 5 requesting at least one file.

08:53 6 Now, everything in this claim, except the
08:53 7 hypertext markup language-equipped code, is visible on
08:53 8 this interface, so the interface that's in the purple
08:53 9 box.

08:53 10 We can see there's a file request. We can see
08:53 11 that -- whom it's from, and we see there's an e-mail
08:53 12 address that's been added.

08:53 13 And there's -- down at the bottom, it says:
08:53 14 What files are you requesting?

08:53 15 And then there's a list of which files the
08:53 16 user is requesting.

08:53 17 With respect to the hypertext markup
08:54 18 language-equipped code, that's visible in the file
08:54 19 whose file path name I've provided over here.

08:54 20 At Lines 53 to 64, those are the HTML that
08:54 21 actually, when processed by the browser, renders this
08:54 22 particular interface that we're looking at.

08:54 23 Q. And the evidence that we're looking at here is
08:54 24 DTX-105 and DTX-797; is that right?

08:54 25 A. Yes.

08:54 1 Q. All right. Did Dropbox 2011 AirDropper have
08:54 2 Limitation 12[a]?

08:54 3 A. Yes.

08:54 4 MR. LANTIER: Let's turn to the next
08:54 5 limitation, please.

08:54 6 BY MR. LANTIER:

08:54 7 Q. And what is that?

08:54 8 A. Okay. This is: Receive, from the first node,
08:54 9 via the at least one network a file description via the
08:54 10 first user interface element that includes a text box,
08:54 11 utilizing the at least one first interface, the file
08:54 12 description describing the at least one file in
08:54 13 connection with the file request.

08:54 14 So if we follow the red arrow, that's the file
08:55 15 description.

08:55 16 So it says: What files are you requesting?

08:55 17 And then there's a text box there that's in
08:55 18 light blue, which includes what's in the red. That's
08:55 19 the text box in which the user gives a file
08:55 20 description.

08:55 21 Q. So did Dropbox 2011 AirDropper have Element
08:55 22 12[b]?

08:55 23 A. Yes.

08:55 24 Q. What's the next limitation?

08:55 25 A. This is: Receive, from the first node via the

08:55 1 at least one network, an indication of at least one of
08:55 2 a date or a time via the second user interface element,
08:55 3 utilizing the at least one first interface, the file
08:55 4 request being based on the at least one of the date or
08:55 5 the time.

08:55 6 Now, I think it's clear, if you look in the
08:55 7 purple box, there isn't a date or time in there. I
08:55 8 wasn't able to find a photograph that actually showed
08:55 9 the request for a date or a time.

08:55 10 However, there is code provided by AirDropper
08:55 11 that actually shows the presentation of radio buttons
08:56 12 that the user can select in order to pick an expiration
08:56 13 time.

08:56 14 MR. LANTIER: Your Honor, I think at this
08:56 15 point we'll need to close the courtroom just for about
08:56 16 three minutes.

08:56 17 THE COURT: Okay. If everyone would step
08:56 18 outside just for a couple minutes if you're not under
08:56 19 the protective order, please.

08:56 20 (Sealed proceedings.)

08:56 21 BY MR. LANTIER:

08:56 22 Q. Professor Shamos, could you please turn to Tab
08:56 23 B in your source code exhibit binder?

08:56 24 A. I'm there.

08:56 25 Q. And is that DTX-797?

08:56 1 A. Yes.

08:56 2 Q. Have you reviewed this file as part of -- or
08:56 3 this code as part of your analysis?

4 A. Yes.

08:56 5 Q. What is it?

08:56 6 [REDACTED]

08:57 7 [REDACTED]

08:57 8 MR. LANTIER: Your Honor, we move to
08:57 9 admit DTX-797.

08:57 10 MR. DEVLIN: No objection.

08:57 11 THE COURT: It'll be admitted.

08:57 12 MR. LANTIER: Now, if we could go back to
08:57 13 the slides and advance to Slide 59.

14 BY MR. LANTIER:

08:57 15 Q. Here we have displayed on the slide a portion
08:57 16 of the code.

08:57 17 Could you explain to the jury what we're
08:57 18 seeing here?

08:57 19 [REDACTED]

08:57 20 [REDACTED]

08:57 21 [REDACTED]

08:57 22 [REDACTED]

08:57 23 [REDACTED]

08:57 24 [REDACTED]

08:57 25 [REDACTED]

08:57 1 [REDACTED]

08:57 2 [REDACTED]

08:58 3 [REDACTED]

08:58 4 [REDACTED]

08:58 5 [REDACTED]

08:58 6 [REDACTED] [REDACTED]

08:58 7 [REDACTED]

08:58 8 [REDACTED]

08:58 9 [REDACTED]

08:58 10 [REDACTED]

08:58 11 [REDACTED]

08:58 12 [REDACTED]

08:58 13 [REDACTED]

08:58 14 [REDACTED]

08:58 15 [REDACTED]

08:58 16 [REDACTED]

08:58 17 [REDACTED]

08:58 18 [REDACTED] [REDACTED]

08:58 19 [REDACTED]

08:58 20 MR. LANTIER: Your Honor, we could unseal

08:59 21 the courtroom right now. In two limitations we're

08:59 22 going to have to seal it again.

08:59 23 THE COURT: Let's just keep going then.

08:59 24 MR. LANTIER: Okay.

08:59 25 BY MR. LANTIER:

08:59 1 Q. So, Professor Shamos, what was your conclusion
08:59 2 as to whether Dropbox 2011 AirDropper discloses or
08:59 3 taught Claim Element 12[c]?

08:59 4 A. It does. I just didn't have a photograph that
08:59 5 showed that.

08:59 6 Q. Okay. What's the next limitation of Claim 12?
08:59 7 Oh, pardon me. I missed -- could you tell us
08:59 8 what we're seeing here on Slide 60?

08:59 9 [REDACTED]
08:59 10 [REDACTED]
08:59 11 [REDACTED]
08:59 12 [REDACTED]
08:59 13 [REDACTED]
08:59 14 [REDACTED]
08:59 15 [REDACTED]
08:59 16 [REDACTED]
08:59 17 [REDACTED]
08:59 18 [REDACTED]
09:00 19 [REDACTED]
09:00 20 [REDACTED]

09:00 21 Q. And those are at DTX-799 and DTX-800; is that
09:00 22 right?

09:00 23 A. Yes.

09:00 24 Q. Okay.

09:00 25 MR. LANTIER: Now, could we move on to

09:00 1 the next limitation of Claim 12, please?

09:00 2 A. Yes.

09:00 3 BY MR. LANTIER:

09:00 4 Q. And what limitation is that?

09:00 5 A. Cause, at the first node, display of at least
09:00 6 one second interface with a third user interface
09:00 7 element and a fourth user interface element, utilizing
09:00 8 second hypertext markup language-equipped code that is
09:00 9 sent via the at least one network, the at least one
09:00 10 second interface for use in causing the file request to
09:00 11 be sent.

09:00 12 Now, you'll notice that the word "second
09:00 13 interface" is in green, but I don't have any arrow
09:00 14 pointing down to a second interface. Dropbox 2011
09:00 15 AirDropper itself did not have a second interface.

09:01 16 On the other hand, it's my opinion that
09:01 17 whether to use one interface or two interfaces or three
09:01 18 interfaces is a matter of design choice for the
09:01 19 designer. And I'm sure you've all been to web pages
09:01 20 that present one pop-up box. Some of them present two
09:01 21 pop-up boxes. The choice of one or two is within the
09:01 22 ken of an interface developer.

09:01 23 Q. So is Limitation 12[d] of the '052 patent
09:01 24 obvious in light of Dropbox 2011 AirDropper?

09:01 25 A. Yes.

09:01 1 Q. Can we check the box?

09:01 2 A. Yes.

09:01 3 Q. What's the next element?

09:01 4 A. Receive, from the first node via the at least
09:01 5 one network, indicia associated with at least one
09:01 6 e-mail address via the third user interface element,
09:01 7 utilizing the at least one second interface, the at
09:01 8 least one e-mail address for being used to send the
09:01 9 file request.

09:01 10 Again, you can see the e-mail address is in
09:01 11 the purple box. The third user interface element is in
09:02 12 black. And, again, I don't show anything on the screen
09:02 13 corresponding to the green second interface because
09:02 14 AirDropper 2011 didn't have that. But, again, it would
09:02 15 be obvious.

09:02 16 Q. And, again, it's just the difference between
09:02 17 putting two things on one pop-up box or on two pop-up
09:02 18 boxes? That's the only difference?

09:02 19 A. That's right.

09:02 20 Q. So did Dropbox 2011 AirDropper have Limitation
09:02 21 12[e]?

09:02 22 A. It would render it obvious.

09:02 23 Q. What is the next limitation of Claim 12 of the
09:02 24 '052 patent?

09:02 25 A. Receive, from the first node via the at least

09:02 1 one network, an indication of a selection of the fourth
09:02 2 user interface element, utilizing the at least one
09:02 3 second interface, where the receipt of the indication
09:02 4 of the selection of the fourth user interface element
09:02 5 indicates that the file request is to be caused to be
09:02 6 sent.

09:02 7 Well, that's in yellow. That's the send
09:02 8 button. So the send button is going to cause the
09:03 9 request to be sent. And, again, there's a second
09:03 10 interface in green, which I haven't shown on the screen
09:03 11 because it would only have been obvious.

09:03 12 Q. Can we check off Limitation 12[f]?

09:03 13 A. Yes.

09:03 14 MR. LANTIER: And let's move on to the
09:03 15 next limitation of Claim 12 of the '052 patent.

16 BY MR. LANTIER:

09:03 17 Q. What is that?

09:03 18 A. In response to the receipt of the indication
09:03 19 of the selection of the fourth user element.

09:03 20 Well, what's going on here is what's going to
09:03 21 happen up at AirDropper when the person hits send.

09:03 22 And based on the file description, the
09:03 23 indication of the at least one of the date or the time,
09:03 24 and the indicia associated with the at least one e-mail
09:03 25 address.

09:03 1 Well, there's no action specified in 12[g].
09:03 2 This is the setup. It's after you -- AirDropper has
09:03 3 received all this stuff, then in the next limitation,
09:03 4 it's going to do something.

09:03 5 But what this is showing is that there is a
09:03 6 fourth user interface element; that's the send button.
09:03 7 There's a file description. [REDACTED]

09:04 8 [REDACTED]

09:04 9 [REDACTED] And then the indicia associated
09:04 10 with the at least one e-mail address, there's the
09:04 11 e-mail address in purple. So that's the setup for the
09:04 12 next limitation.

09:04 13 Q. So does Dropbox 2011 AirDropper include
09:04 14 Element 12[g]?

09:04 15 A. Yes.

09:04 16 Q. What's the next element of Claim 12?

09:04 17 A. This is what it does after it receives the
09:04 18 send indication.

09:04 19 It says: Generate a first message addressed
09:04 20 to the at least one e-mail address and including the
09:04 21 file request, the first message indicating the at least
09:04 22 one of the date or the time on which the file request
09:04 23 is based, and further including a fifth user interface
09:04 24 element and at least one sentence including the file
09:04 25 description describing at least one file in connection

09:04 1 with the file request.

09:04 2 Okay. So there's the first message. That's
09:04 3 the thing that the recipient gets, the guy who's being
09:04 4 asked to share files.

09:04 5 And the fifth user interface element is the --
09:05 6 in purple, it's the click here button or the click here
09:05 7 hyperlink.

09:05 8 And then the file description, describing the
09:05 9 at least one file in connection with the file request,
09:05 10 you can see that in the red rectangle. And it's
09:05 11 actually a full sentence.

09:05 12 It says: Could you send me: - Our
09:05 13 Presentation file - The MP3 soundtrack for opening the
09:05 14 music -- for opening music - The PDF e-book we're
09:05 15 giving out?

09:05 16 So that's a sentence, and it's in a text box,
09:05 17 and it's in the file description.

09:05 18 Q. Is this limitation present in Dropbox 2011
09:05 19 AirDropper?

09:05 20 A. By obviousness because of the date or the
09:05 21 time. There's no date or time that's shown on the
09:05 22 screen.

09:05 23 Q. But you had shown that earlier, right?

09:05 24 A. Yes.

09:05 25 Q. Can we check this one off?

09:05 1 A. Yes.

09:05 2 Q. What's the next limitation of Claim 12?

09:05 3 (Clarification by Reporter.)

09:05 4 MR. LANTIER: No. We can be back on the
09:05 5 public record. I apologize.

09:05 6 THE COURT: No problem.

09:42 7 (Sealed proceedings end.)

09:05 8 A. The next limitation is: Send, to a second
09:06 9 node via the at least one network, the first message.

09:06 10 So it generates the first message, but then it
09:06 11 has to send it so that Matthew can receive it. So
09:06 12 there's the message in the rectangle.

09:06 13 BY MR. LANTIER:

09:06 14 Q. Did Dropbox 2011 AirDropper have Limitation
09:06 15 12[i] of Claim 12?

09:06 16 A. Yes.

09:06 17 Q. What's the next limitation of Claim 12?

09:06 18 A. Receive, from the second node via the at least
09:06 19 one network, an indication of a selection of the fifth
09:06 20 user interface element.

09:06 21 So this is where Matthew is going to decide
09:06 22 he'd like to actually look at those files, or he'd
09:06 23 actually like to upload his files.

09:06 24 Of the first message, where the receipt of the
09:06 25 indication of the selection of the fifth user interface

09:06 1 element indicates that the at least one file is to be
09:06 2 uploaded in response to the file request.

09:06 3 So it says to upload the files, visit this
09:06 4 secure link, click here. When he clicks on that link,
09:06 5 he's going to then have the opportunity to upload the
09:07 6 files that were requested.

09:07 7 Q. Did Dropbox 2011 AirDropper include Limitation
09:07 8 12[j]?

09:07 9 A. Yes.

09:07 10 Q. What's the next limitation?

09:07 11 A. So this is the process that takes place after
09:07 12 the recipient clicks "click here."

09:07 13 It says: In response to the receipt of the
09:07 14 indication of the selection of the fifth user interface
09:07 15 element, cause, at the second node, display of at least
09:07 16 one third interface with a sixth user interface element
09:07 17 and a seventh user interface element, utilizing third
09:07 18 hypertext markup language-equipped code that is sent
09:07 19 via at least one network, the at least one third
09:07 20 interface for use in uploading the at least one file in
09:07 21 response to the file request.

09:07 22 So in the brown rectangle, this is what's
09:07 23 shown on the user's screen. This gives him the
09:08 24 opportunity to add files in response to the file
09:08 25 request.

09:08 1 Q. Did Dropbox 2011 AirDropper have this claim
09:08 2 limitation?

09:08 3 A. Yes.

09:08 4 Q. Would you please move to the next claim
09:08 5 limitation?

09:08 6 A. This is: Receive, from the second node via
09:08 7 the at least one network, an indication of a selection
09:08 8 of the at least one file, utilizing the sixth user
09:08 9 interface element, utilizing the at least one third
09:08 10 interface.

09:08 11 So you can see that there are four files
09:08 12 listed here, and there's even an indication of whether
09:08 13 they're small, medium or large. And so the user has
09:08 14 the opportunity to select those. And then when he hits
09:08 15 send, it can say add files, and then say send. And
09:08 16 those files will be then available to the person who
09:08 17 requested them.

09:08 18 Q. Did Dropbox 2011 AirDropper have Limitation
09:08 19 12[1]?

09:08 20 A. Yes.

09:08 21 MR. LANTIER: If we move to Limitation
09:08 22 12[m].

09:08 23 BY MR. LANTIER:

09:08 24 Q. And could you describe what that is, please?

09:09 25 A. Yes. So this is what happens at AirDropper

09:09 1 when the user hits send.

09:09 2 It's: Receive, from the second node via the
09:09 3 at least one network, an indication of a selection of
09:09 4 the seventh user interface element, utilizing the at
09:09 5 least one third interface, where the receipt of the
09:09 6 indication of selection of the seventh user interface
09:09 7 element indicates that the at least one file is to be
09:09 8 caused to be uploaded.

09:09 9 So it's -- basically, AirDropper's receiving
09:09 10 the request to upload the files.

09:09 11 Q. Now, could you turn in your binder to -- oh,
09:09 12 before I move to that, did Dropbox 2011 AirDropper have
09:09 13 Limitation 12[m]?

09:09 14 A. Yeah. I anticipated you. I checked it off.

09:09 15 Q. Thank you.

09:09 16 Could you please turn in your binder to Tab 5?

09:09 17 And this is DTX-742.

09:10 18 A. I'm there.

09:10 19 Q. What is DTX-742?

09:10 20 A. It's a message from AirDropper to somebody
09:10 21 called jesselamb@gmail.com -- I think he was a
09:10 22 developer of AirDropper -- that is announcing that a
09:10 23 file has arrived in a new package.

09:10 24 Q. And what is the date on the e-mail?

09:10 25 A. It's June 29th, 2011.

09:10 1 Q. Did you say 2011?

09:10 2 A. Yes.

09:10 3 Q. Have you reviewed this e-mail as part of your
09:10 4 analysis?

09:10 5 A. Yes.

09:10 6 MR. LANTIER: Your Honor, we move to
09:10 7 admit DTX-742.

09:10 8 MR. DEVLIN: No objection.

09:10 9 THE COURT: Admitted.

09:10 10 BY MR. LANTIER:

09:10 11 Q. Now, what's the next limitation of Claim 12?

09:10 12 A. In response to the receipt of the indication
09:10 13 of the selection of the seventh user interface element,
09:10 14 generate a second message that includes an eighth user
09:10 15 interface element and does not include a file
09:10 16 attachment with the second message, the second message
09:10 17 indicating that the file request has been responded to.

09:10 18 So the message is over on the left in the red
09:11 19 rectangle. You can see that it's an e-mail from
09:11 20 AirDropper. It's to Jesse Lamb. And it doesn't have
09:11 21 any attachment, but it does have a hyperlink that
09:11 22 allows him to go to the new package.

09:11 23 Q. And this is the limitation that requires
09:11 24 generating a second message that includes the eighth
09:11 25 user interface element.

09:11 1 Do we have that right?

09:11 2 A. Yes. Generate a second message. So this is
09:11 3 being done at AirDropper.

09:11 4 Q. Does -- did Dropbox 2011 AirDropper have
09:11 5 Limitation 12[n]?

09:11 6 A. Yes.

09:11 7 Q. Could you please move to the next limitation
09:11 8 of the claim and describe this for us?

09:11 9 A. Yes. This is sending the message that was
09:11 10 just generated in a previous limitation. Send to the
09:11 11 first node, via the at least one network, the second
09:11 12 message.

09:11 13 So AirDropper sends it.

09:11 14 Q. Dropbox 2011 AirDropper had that limitation;
09:12 15 is that right?

09:12 16 A. Yes.

09:12 17 Q. Could you please tell us about the next claim
09:12 18 limitation in Claim 12?

09:12 19 A. This is 12[p]. Receive, from the first node
09:12 20 via the at least one network, an indication of a
09:12 21 selection of the eighth user interface element of the
09:12 22 second message.

09:12 23 So this is going to talk about what happens
09:12 24 when the recipient, Jesse Lamb, clicks on that
09:12 25 hyperlink down at the bottom. The HTTP in blue

09:12 1 indicates that he'd like to see those files that he
09:12 2 just requested.

09:12 3 Q. Did Dropbox 2011 AirDropper have Limitation
09:12 4 12[p]?

09:12 5 A. Yes.

09:12 6 Q. What's the next limitation of the claim?

09:12 7 A. So the next limitation is the last one. This
09:12 8 is how Jesse is actually going to be able to see the
09:12 9 files, and the answer is that they were in Matthew's
09:12 10 Dropbox account. And so this particular step is
09:13 11 performed by Dropbox.

09:13 12 In response to the receipt of the indication
09:13 13 of the selection of the eighth user interface element
09:13 14 of the second message, cause, at the first node,
09:13 15 display of at least one fourth interface with a
09:13 16 reference to the at least one file for allowing access
09:13 17 to the at least one file at the first node.

09:13 18 So now what happens, you can see on the right,
09:13 19 that this is a browser window. And if you look at the
09:13 20 address line, it's right above the purple -- or the
09:13 21 pink -- the top of the pink rectangle that says:
09:13 22 <https://www.dropbox.com>.

09:13 23 So this is a page that was created by Dropbox
09:13 24 and sent to the recipient, and it shows that there's a
09:13 25 representation there of this file

09:13 1 "child-at-school.jpg." If he clicks on that, he'll be
09:13 2 able to see -- that image will be downloaded, and he'll
09:13 3 be able to see it. But at this moment, it hasn't been
09:14 4 downloaded yet.

09:14 5 Q. And this evidence is at Exhibits DTX-742 and
09:14 6 DTX-86; is that right?

09:14 7 A. Yes.

09:14 8 Q. Did Dropbox 2011 AirDropper have Limitation
09:14 9 12[q]?

09:14 10 A. Yes.

09:14 11 Q. Okay.

09:14 12 MR. LANTIER: If we turn to Slide 75.

13 BY MR. LANTIER:

09:14 14 Q. Have we made it through all the elements of
09:14 15 Claim 12 of the '052 patent?

09:14 16 A. Yes.

09:14 17 Q. And does Dropbox 2011 AirDropper have or
09:14 18 render obvious all those limitations?

09:14 19 A. Yes.

09:14 20 Q. What does that mean?

09:14 21 A. It means it's invalid over Dropbox 2011
09:14 22 AirDropper.

09:14 23 Q. Now, does Dr. Akl agree with you on that?

09:14 24 A. No.

09:14 25 MR. LANTIER: If we could turn to Slide

09:14 1 76.

2 BY MR. LANTIER:

09:14 3 Q. Could you explain to the jury what you

09:14 4 understand Dr. Akl's disagreements to be?

09:14 5 A. Well, in his rebuttal report, he said that

09:14 6 there was no deadline feature, but I clearly showed

09:14 7 there was a deadline feature.

09:14 8 He says there's no deadline specified in the

09:15 9 e-mail. So the recipient gets an e-mail that says,

09:15 10 please upload some files. The window that I showed you

09:15 11 did not say you have to do it by a certain date.

09:15 12 But obviously if you have to do it by a

09:15 13 certain date, it certainly makes sense to tell the

09:15 14 person that he only has a certain amount of time to

09:15 15 upload the thing. And so including the message -- the

09:15 16 expiration date or time in the e-mail would have been

09:15 17 obvious.

09:15 18 Then yes. He disagrees, he says there was

09:15 19 only one interface in AirDropper. And I talked about

09:15 20 that before, whether you present one window or if we

09:15 21 present two windows or three windows is a matter of

09:15 22 graphic design choice by the creator of the system.

09:15 23 So it would have been obvious to use two

09:15 24 instead of one.

09:15 25 Q. And this, again, is the issue of whether you

09:15 1 use one pop-up box or two pop-up boxes to display the
09:15 2 information?

09:15 3 A. Right.

09:15 4 Q. Okay. Now, could we move to Claim 20 of the
09:16 5 '052 patent?

09:16 6 A. Yes.

09:16 7 Q. And could you tell us what the limitation of
09:16 8 Claim 20 is?

09:16 9 A. Yes. Basically Claim 20 is about enforcement
09:16 10 of the deadline. The apparatus of Claim 12, wherein
09:16 11 the apparatus is configured such that the at least one
09:16 12 of the date or the time of the indication of the at
09:16 13 least one of the date or the time is a criterion, and
09:16 14 the indication of the at least one file is received
09:16 15 based on whether the criterion is met.

09:16 16 And so I have citations here to DTXs that
09:16 17 contain the AirDropper code that actually enforces the
09:16 18 deadline.

09:16 19 Q. And that's DTX-797, DTX-799 and DTX-800.

09:16 20 Do I have that right?

09:16 21 A. Yes.

09:16 22 Q. Did Dropbox 2011 AirDropper disclose the
09:16 23 additional limitation of Claim 20?

09:16 24 A. Disclosed or rendered obvious. Yes. And this
09:17 25 one -- for this additional limitation, it actually

09:17 1 disclosed it.

09:17 2 Q. And what does that mean about Claim 20?

09:17 3 A. Claim 20 is invalid for obviousness over
09:17 4 Dropbox 2011 AirDropper.

09:17 5 Q. Let's turn to -- we'll need to get to Claim
09:17 6 27, because that's the other asserted claim. But as
09:17 7 the jury now knows to get there, we need to go through
09:17 8 Claim 26.

09:17 9 So could we -- could we move on to Claim
09:17 10 26?

09:17 11 A. Yes.

09:17 12 Q. And what is that limitation?

09:17 13 A. It's the apparatus of Claim 12, which means we
09:17 14 have to bring in everything that we just did on Claim
09:17 15 12. Wherein the apparatus is configured such that, in
09:17 16 response to the receipt of the indication of the
09:17 17 selection of the seventh user interface element, a
09:17 18 creation of a representation of the at least one file
09:17 19 is caused, at the first node, in a location among one
09:17 20 or more folders on a file explorer interface that is
09:17 21 not a web page and is displayed utilizing a
09:18 22 client-based file explorer application, such that the
09:18 23 at least one file is accessible via both the second
09:18 24 message and the file explorer interface.

09:18 25 So there's a lot there. So the seventh user

09:18 1 interface element was the send button. So when the
09:18 2 send button is activated, a representation of the at
09:18 3 least one file is caused at the first node.

09:18 4 This is the guy who had requested the files.
09:18 5 He now wants to see them. And so you can see, in the
09:18 6 brown rectangle in the middle, there's a representation
09:18 7 of this file called "PDF-Dropbox.PDF."

09:18 8 And that's displayed in a file explorer
09:18 9 interface -- and that file explorer interface is not a
09:18 10 web page, it's the native Dropbox application -- such
09:18 11 that the at least one file is accessible via both the
09:18 12 second message. You get to it from -- by clicking on
09:18 13 the second message. And through the file explorer
09:18 14 interface, you can also click it.

09:19 15 Q. And the evidence of that is at -- that you're
09:19 16 showing here is DTX-105, DTX-116 and DTX-742; is that
09:19 17 right?

09:19 18 A. Yes.

09:19 19 Q. Did Dropbox 2011 AirDropper disclose the
09:19 20 additional limitation of Claim 26?

09:19 21 A. Yes.

09:19 22 MR. LANTIER: Let's go then to Slide 79.

23 BY MR. LANTIER:

09:19 24 Q. And what do we see here?

09:19 25 A. This is what's going to happen when he selects

09:19 1 PDF-Dropbox.PDF. Presuming he wants to see it.

09:19 2 So it says: The apparatus of Claim 26,
09:19 3 wherein the apparatus is configured such that the
09:19 4 second message is sent without including the at least
09:19 5 one file as an attachment of the second message.

09:19 6 So let's look at that. You can see there's an
09:19 7 e-mail there. It has a hyperlink in it, but it has no
09:19 8 attachments.

09:19 9 And then continuing on: And a storage at the
09:19 10 first node does not store the at least one file when
09:19 11 the creation of the representation of the at least one
09:20 12 file is caused, both for avoiding the at least one file
09:20 13 from having to be communicated to and stored at the
09:20 14 first node until the at least one file is requested by
09:20 15 a user at the first node using the representation or
09:20 16 the reference.

09:20 17 So there you can see Pete on the left, the
09:20 18 left yellow -- sorry, the left purple rectangle, it
09:20 19 says: PDF-Dropbox.PDF.

09:20 20 If you click on that, then you can see in the
09:20 21 next rectangle over that a download begins of
09:20 22 PDF-Dropbox.PDF. And you can see there's a little blue
09:20 23 progress bar that shows it's being downloaded, which
09:20 24 means it hadn't been there yet.

09:20 25 Q. So did Dropbox 2011 AirDropper disclose the

09:20 1 additional limitation of Claim 27?

09:20 2 A. Yes.

09:20 3 Q. And what does that mean?

09:20 4 A. It means that Claim 27 is invalid for
09:20 5 obviousness over Dropbox 2011 AirDropper.

09:20 6 MR. LANTIER: Okay. Could we turn to the
09:21 7 '548 patent?

09:21 8 A. Yes.

09:21 9 BY MR. LANTIER:

09:21 10 Q. And the only asserted claim of the '548 patent
09:21 11 is Claim 46; is that right?

09:21 12 A. Yes.

09:21 13 Q. Is that an independent or a dependent claim?

09:21 14 A. It's dependent on -- it depends from 45, which
09:21 15 itself depends from 44.

09:21 16 Q. All right. If we turn to Slide 81, what are
09:21 17 you showing us here?

09:21 18 A. This is the good news.

09:21 19 The good news is that there's a correspondence
09:21 20 between the elements of Claim 44 and of '052, Claim 12,
09:21 21 which we already went through. And so it's not
09:21 22 necessary to go through it again for these three
09:21 23 elements, the preamble, 44[a] and 44[b].

09:21 24 Q. And if we turn to Slide 82, what do we see
09:21 25 here?

09:21 1 A. More good news.

09:21 2 So Limitations 44[c], 44[d] and 44[e] are
09:21 3 parallel respectively to Limitations 12[e], 12[f] and
09:21 4 12[g] to [h] of '052, Claim 12.

09:22 5 Q. So you've already pointed to the evidence that
09:22 6 those limitations are taught by Dropbox 2011
09:22 7 AirDropper?

09:22 8 A. Yes.

09:22 9 Q. Okay.

09:22 10 MR. LANTIER: Could we move to Slide 83?

09:22 11 A. More good news.

09:22 12 Limitations 44[f], 44[g] and 44[h] have very
09:22 13 close correspondences in '052, Claim 12. And so my
09:22 14 proof for those limitations would be the same as for
09:22 15 Claim 12.

09:22 16 BY MR. LANTIER:

09:22 17 Q. And if we turn to Slide 84, what do we see
09:22 18 there?

09:22 19 A. The good news just keeps coming.

09:22 20 Limitations 44[i] through [j], 44[k] and 44[l]
09:22 21 correspond respectively to Limitations 12[l] through
09:22 22 [m], 12[n] and 12[o] of '052, Claim 12.

09:22 23 Q. And so you've already identified for the jury
09:22 24 the evidence that those limitations are met by Dropbox
09:23 25 2011 AirDropper, right?

09:23 1 A. Yes.

09:23 2 Q. Okay.

09:23 3 MR. LANTIER: If we could turn to Slide
4 85.

09:23 5 BY MR. LANTIER:

09:23 6 Q. What do we see here?

09:23 7 A. These are the last two elements, 44[m] and
09:23 8 44[n], which correspond respectively to Limitations
09:23 9 12[p] and 12[q] of '052, Claim 12, which brings us to
09:23 10 the end of Claim 44.

09:23 11 Q. Okay. So we've been through all the
09:23 12 limitations of Independent Claim 44.

09:23 13 What's your conclusion about whether Dropbox
09:23 14 2011 AirDropper discloses all those limitations based
09:23 15 on the evidence you've reviewed?

09:23 16 A. It discloses or renders obvious. Yes.

09:23 17 Q. And that's the same analysis that we talked
09:23 18 through with Claim 12 of the '052 patent; is that
09:23 19 right?

09:23 20 A. Yes.

09:23 21 Q. Now, let's go to Claim 45.

09:23 22 MR. LANTIER: And if we turn to Slide
09:23 23 87 -- excuse me. 86.

09:23 24 A. Yes.

09:23 25 BY MR. LANTIER:

09:23 1 Q. What are you showing here?

09:23 2 A. So these are the limitations of Claim 40 --
09:24 3 '548, Claim 45, matched up against limitations of '052,
09:24 4 Claim 12. And so there's correspondence between the
09:24 5 preamble, 45[a], 45[b] and 45[c] in Claim 12. So I
09:24 6 would use the same evidence for those.

09:24 7 MR. LANTIER: If we turn to Slide 87.

09:24 8 A. Yes. So there's a "... " at the bottom of 86,
09:24 9 which indicates that there's not a total correspondence
09:24 10 between 45 and 12. So we have to -- there's a
09:24 11 limitation -- a new limitation we have to deal with.

09:24 12 This one is: The second message is at least
09:24 13 partially prewritten and is caused to be automatically
09:24 14 generated without user involvement after the receipt of
09:24 15 the message associated with the selection of the fifth
09:24 16 user interface element.

09:24 17 So when you say send, certain things happen.
09:24 18 And they happen automatically. You don't have to do
09:24 19 anything else in addition to cause the -- an e-mail to
09:24 20 be sent.

09:24 21 And you can see in this -- in this message, it
09:25 22 looks as though everything is actually prewritten.
09:25 23 Certainly the "from," "sent," "to," "subject," "one
09:25 24 file arrived in New Package," that's generated by the
09:25 25 system. It wasn't typed in by any user.

09:25 1 BY MR. LANTIER:

09:25 2 Q. So could you just explain a little bit more
09:25 3 what it means for something to be prewritten in this
09:25 4 context?

09:25 5 A. Well, so an e-mail contains text, and there
09:25 6 are only two places the text can come from. It's
09:25 7 either generated by the server or was manually typed in
09:25 8 by the user.

09:25 9 Q. And so if we're talking about it being
09:25 10 partially prewritten here, that's partially prewritten
09:25 11 by which of those two things?

09:25 12 A. By the server. The system that's running this
09:25 13 is generating -- in this case, it generated the entire
09:25 14 e-mail. But the user could have added a message,
09:25 15 presumably, if he wanted to. But the rest of it is
09:25 16 prewritten.

09:25 17 Q. And someone receiving this e-mail, is it a
09:25 18 secret to them that the system has partially
09:25 19 prewritten -- at least partially prewritten the e-mail?

09:25 20 A. No. The headers are never -- the only header
09:25 21 that would be typed in in an e-mail is usually the
09:26 22 subject line. Something like that.

09:26 23 Q. And so the --

09:26 24 A. The "from."

09:26 25 Q. -- person receiving this would understand that

09:26 1 a server had generated part of the e-mail; is that
09:26 2 right?

09:26 3 A. Yes. I don't think the user would ever write
09:26 4 "one file arrived in New Package." Because the sender
09:26 5 doesn't know whether it's going to arrive or not.

09:26 6 Q. Now, if we -- before moving on, what was your
09:26 7 conclusion as to whether Element 45[d] is met?

09:26 8 A. Yes. It's met by Dropbox 2011 AirDropper.

09:26 9 Q. And the evidence of that's in DTX-742; is that
09:26 10 right?

09:26 11 A. Yes.

09:26 12 Q. Now, is this the final limitation of Claim 45?

09:26 13 A. Yes. The period is there.

09:26 14 Q. And so what's your conclusion as to whether
09:26 15 Dropbox 2011 AirDropper included or rendered obvious
09:26 16 all the limitations of Claim 45 of the '548 patent?

09:27 17 A. It did.

09:27 18 MR. LANTIER: Could we please turn to
09:27 19 Slide 88?

20 BY MR. LANTIER:

09:27 21 Q. And could you tell us what we're seeing here?

09:27 22 A. Yes. On the left is the entire text of Claim
09:27 23 46. On the right are two corresponding limitations in
09:27 24 the '052 patent, Claims 26 and 27, which we went
09:27 25 through.

09:27 1 And so my proof for Claim 46 would be the same
09:27 2 as the proof that I illustrated for Claims 26 and 27 of
09:27 3 the '052 patent.

09:27 4 Q. So based on all we've talked about here, does
09:27 5 Dropbox 2011 AirDropper have or render obvious all the
09:27 6 limitations of Claim 46 of the '548 patent?

09:27 7 A. Yes.

09:27 8 Q. And what does that mean?

09:27 9 A. It means that all the file requests are
09:27 10 invalid for obviousness over Dropbox 2011 AirDropper.

09:27 11 Q. Okay. Now, we've made it through all the
09:27 12 asserted limitations of all of the asserted claims of
09:27 13 all of the asserted patents and compared them against
09:28 14 either Dropbox 2011 for the first two or Dropbox 2011
09:28 15 AirDropper for the second two.

09:28 16 Are we done with your testimony here?

09:28 17 A. No.

09:28 18 Q. And could you please explain to the ladies and
09:28 19 gentlemen of the jury why that is not the case, why
09:28 20 we're not quite done yet?

09:28 21 A. Yes. The reason that we're not quite done is
09:28 22 it's conceivable the jury may not agree with me and may
09:28 23 not find that all of these limitations were rendered
09:28 24 obvious by Dropbox 2011 and AirDropper.

09:28 25 And so the issue then becomes whether or not

09:28 1 there's some other prior art that would categorically
09:28 2 render all of these claims invalid. And so --

09:28 3 Q. And so, Dr. Shamos, just to be clear, you have
09:28 4 demonstrated and put forth the evidence, including the
09:28 5 source code, that each limitation of the asserted
09:28 6 claims is present or obvious based on the prior art in
09:29 7 2011, correct?

09:29 8 A. Yes.

09:29 9 Q. All right. So yes, if we could move on then
09:29 10 to explain why we'll also talk about a different issue,
09:29 11 that would be helpful.

09:29 12 A. Okay. So you can see that on this -- it's a
09:29 13 very simple flowchart. There's a question in the blue
09:29 14 box, which is: Does Dropbox 2011 or Dropbox 2011
09:29 15 AirDropper meet all claim elements?

09:29 16 And I believe the answer is yes. And I showed
09:29 17 that, which would imply that all the claims are
09:29 18 invalid. But it is a question, and so, therefore,
09:29 19 there has to be a "no" exit from that box.

09:29 20 Q. And Dr. -- or Professor Shamos, you mentioned
09:29 21 to the jury that Dr. Akl had raised some disputes about
09:29 22 limitations of some of those claims, right?

09:29 23 A. Yes.

09:29 24 Q. Okay. So could we then move on to the next
09:29 25 slide here, and could you tell us what we're going to

09:29 1 talk about now?

09:29 2 A. Yes. So we're going to talk about something
09:29 3 called "priority date," which is what is the date on
09:30 4 which these asserted claims were first -- the invention
09:30 5 that's claimed in the asserted claims, when was that
09:30 6 first disclosed to the Patent Office?

09:30 7 And Motion Offense says that it was in 2012,
09:30 8 and I'm going to show that it was really in 2017.

09:30 9 Q. And in particular, we see this tree-type
09:30 10 structure here on Slide 91.

09:30 11 Could you explain why the jury needs to know
09:30 12 about this?

09:30 13 A. Yes. So the issue is going to be, if you look
09:30 14 at the red box, those are the asserted patents that
09:30 15 contain all of the asserted claims in this case. They
09:30 16 were all filed beginning October 2017 or after.

09:30 17 So on the right-hand side of the screen is
09:30 18 2017. On the left-hand side of the screen are earlier
09:30 19 events.

09:30 20 So the two initial applications in 2012 are
09:31 21 shown in the two extreme left boxes, the '635
09:31 22 application on September 25th and the '906 application
09:31 23 on September 22nd of 2012.

09:31 24 Those were ultimately abandoned, but a
09:31 25 continuation-in-part application was filed in May of

09:31 1 2014. That was ultimately abandoned. And all of the
09:31 2 asserted patents are continuations-in-part following
09:31 3 from the '623 application.

09:31 4 Q. And, Professor Shamos, you then have a text
09:31 5 that says "all assert priority to 2012" with a dotted
09:31 6 line and arrow pointing back to that September 2012
09:31 7 date.

09:31 8 Could you explain what that refers to?

09:31 9 A. Yes. So it's permissible for a patent that's
09:31 10 filed in October 2017 to claim priority to an earlier
09:31 11 patent application -- it's possible, and it's often
09:31 12 done -- provided that the earlier patent application
09:31 13 actually describes the invention that's being claimed.

09:32 14 And so Motion Offense is asserting that it's
09:32 15 entitled to a priority date in 2012.

09:32 16 Q. And who is going to need to look at the 2012
09:32 17 applications to determine whether the limitations of
09:32 18 the claims that are asserted here were taught in those
09:32 19 applications?

09:32 20 A. We are.

09:32 21 Q. And are you going to help walk us through that
09:32 22 now?

09:32 23 A. Yes. And so what I'm going to show, though,
09:32 24 is that the prior applications do not disclose the
09:32 25 claimed inventions. And, therefore, the asserted

09:32 1 patents are not entitled to their asserted priority
09:32 2 date in 2012, but at best are entitled to October 2017.

09:32 3 Q. Now, if we take a step back and start with
09:32 4 some of the words we're using here --

09:32 5 A. Yes.

09:32 6 Q. -- the jury has heard a bit about continuation
09:32 7 applications and continuation-in-part applications.

09:33 8 Could you please explain what those are?

09:33 9 A. Yes. It's a simple idea actually. So what
09:33 10 goes on in obtaining a patent is that there's a
09:33 11 dialogue that goes on between the inventor and his
09:33 12 attorney on the one hand and the Patent Office on the
09:33 13 other hand.

09:33 14 And the job of the patent attorney is to get a
09:33 15 claim allowed, because once a claim is allowed, then
09:33 16 his client has a patent.

09:33 17 And so all kind of issues and difficulties
09:33 18 arise during this process. And the examiner may
09:33 19 indicate the Claims 1, 3 and 5 are allowable.

09:33 20 And so they want to take their winnings, they
09:33 21 want to get that -- get those claims allowed and get a
09:33 22 printed patent that they can start enforcing, but
09:33 23 Claims 2, 4 and 6 are still -- they're still debating.

09:33 24 So what you do then is you file a continuation
09:33 25 application so you can continue the prosecution of the

09:33 1 original application essentially.

09:33 2 And the continuation application has exactly
09:33 3 the same specification as the original. That's what a
09:34 4 continuation is.

09:34 5 Q. And when you say that a continuation
09:34 6 application has the same specification as the original,
09:34 7 could you just explain what that means, the
09:34 8 specification?

09:34 9 A. Yes. So the specification is the part of the
09:34 10 patent that explains what the invention is and
09:34 11 explaining how to make and use the invention.

09:34 12 And the claims part is a verbal description of
09:34 13 exactly what the invention is. And so what you can do
09:34 14 in a continuation application is you can add different
09:34 15 claims, you can change claims, you can add new ones,
09:34 16 provided that they are supported by what you've
09:34 17 described in your specification.

09:34 18 And so you can add small amounts of material
09:34 19 to a continuation application, but you can't add what
09:34 20 the Patent Office refers to as new matter. That is, a
09:34 21 new invention cannot be described in a continuation
09:34 22 application.

09:34 23 Q. And if someone would like to include new
09:34 24 matter in a patent application, so something new, some
09:35 25 new invention, what's the mechanism that's used to do

09:35 1 that?

09:35 2 A. Well, that's a continuation-in-part. And
09:35 3 that's defined by the Patent Office as: An application
09:35 4 filed during the lifetime of an earlier non-provisional
09:35 5 application repeating some substantial portion or all
09:35 6 of the earlier non-provisional application and adding
09:35 7 matter not disclosed in the said earlier
09:35 8 non-provisional application.

09:35 9 So perfectly permissible to add new matter if
09:35 10 you designate your application as a
09:35 11 continuation-in-part. And it may be that the new
09:35 12 matter is needed to support some new claims. It may
09:35 13 not be that it's necessary to support other claims. It
09:35 14 depends.

09:35 15 Q. And if the new matter that's been added is
09:35 16 supporting material that's in the claims that are added
09:35 17 as of that date, what's the consequence?

09:35 18 A. Well, if the new matter is the only support
09:35 19 for the new claims, then the applicant is not entitled
09:36 20 to refer back to the original application of which this
09:36 21 is a continuation-in-part. He's stuck with his filing
09:36 22 date of the continuation-in-part application.

09:36 23 Q. So this concept that if you add something to
09:36 24 your patent applications later, you're not able to say
09:36 25 that you had the -- you're entitled to the earlier date

09:36 1 when we're looking at the validity of those claims; is
09:36 2 that right?

09:36 3 A. It depends on what you add, and it depends on
09:36 4 what you claim.

09:36 5 Q. Yes. So there's one other term I think we
09:36 6 should discuss, and that is the "priority date" --

09:36 7 A. Yes.

09:36 8 Q. -- term.

09:36 9 Could you explain what that is?

09:36 10 A. Yes. So the priority date, it's a simple
09:36 11 idea. It's the date the invention was first disclosed
09:36 12 to the Patent Office, because then the Patent Office
09:36 13 knows that you really invented it if you described it.

09:36 14 A claim whose invention was not disclosed to
09:36 15 the Patent Office is not entitled to a filing date.

09:36 16 MR. LANTIER: Now, if we could turn to
09:36 17 the next slide.

09:36 18 BY MR. LANTIER:

09:37 19 Q. Could you explain what Motion Offense --
09:37 20 Motion Offense is trying to do here in this trial?

09:37 21 A. Yes. So we saw that the -- there was some
09:37 22 original applications that were filed in 2012. I'm
09:37 23 going to show that those applications do not describe
09:37 24 the invention of one of the claimed -- well, any of the
09:37 25 claims that are asserted, but in particular, let's say

09:37 1 a Claim 3 from the 2017 applications.

09:37 2 And on the right-hand side, there's a
09:37 3 continuation-in-part filed in 2017. That's the first
09:37 4 application that actually described the invention of
09:37 5 Claim 3.

09:37 6 If that is the case, then the assertion of
09:37 7 priority back to 2012 is invalid, and it's not entitled
09:37 8 to 2012 but would be entitled to October 2017.

09:37 9 Q. Okay. So if the -- if the applications filed
09:37 10 in September of 2012 don't include parts of what is in
09:37 11 the claims, then what's the proper priority date for
09:38 12 the patents?

09:38 13 A. It would be only -- again, the priority date
09:38 14 is the date on which the invention was first disclosed
09:38 15 to the Patent Office. So that would be 2017 in your
09:38 16 hypothetical.

09:38 17 Q. October 3rd, 2017; is that right?

09:38 18 A. I forget the day, but it's October 2017. Yes.

09:38 19 Q. Okay. Yes.

09:38 20 MR. LANTIER: Now, if we turn to the next
09:38 21 slide.

22 BY MR. LANTIER:

09:38 23 Q. Does that show your conclusion?

09:38 24 A. Yes. I will show in the next few minutes that
09:38 25 Motion Offense's alleged priority date for all the

09:38 1 claims is September 25th, 2012, but they're really only
09:38 2 entitled to October 3rd, 2017.

09:38 3 Q. All right.

09:38 4 MR. LANTIER: So let's start through that
09:38 5 analysis.

6 BY MR. LANTIER:

09:38 7 Q. What are you showing us here on Slide 97?

09:38 8 A. Well, this a reminder. I think we've seen
09:38 9 this Paragraph 5 from the '635 application several
09:39 10 times. This is the inventor's statement that his
09:39 11 invention is different from Dropbox.

09:39 12 Q. And just to make one point clear before we go
09:39 13 to the next slide, is -- the issue here that we're
09:39 14 talking about with the priority date, is it only
09:39 15 relevant to one of the asserted patents, or does it
09:39 16 apply to the specifications of all of the asserted
09:39 17 patents?

09:39 18 A. It applies to all of the asserted claims. I
09:39 19 haven't done an investigation for the claims that are
09:39 20 not asserted.

09:39 21 Q. That's a very fair clarification.

09:39 22 So what do we -- do we need to look at the
09:39 23 claims that aren't asserted? Is that relevant here?

09:39 24 A. No. No. It's not.

09:39 25 Q. The question is whether the claims that are

09:39 1 asserted have support back in the September 2012 patent
09:39 2 application, right?

09:39 3 A. Yes. I think I explained that each claim
09:39 4 separately could have a different priority date. Some
09:39 5 of them might be entitled to 2012, some of them might
09:39 6 not be entitled to 2012. So it's done on a
09:40 7 claim-by-claim basis.

09:40 8 Q. But for the eight asserted claims here, does
09:40 9 this analysis apply?

09:40 10 A. Yes.

09:40 11 Q. All right.

09:40 12 MR. LANTIER: If we could turn to the
09:40 13 next slide.

14 BY MR. LANTIER:

09:40 15 Q. What are you showing us here?

09:40 16 A. Well, I'm showing the material from the '906
09:40 17 application in 2012, and I'm including two parts of it,
09:40 18 the two rectangles on the left.

09:40 19 The top one is from the specification part.
09:40 20 That's the description of the invention. The bottom,
09:40 21 which has been numbered Claim 1, is a claim
09:40 22 corresponding to the disclosure in the specification.

09:40 23 So what was talked about in the '906
09:40 24 application were methods and systems, and there was a
09:40 25 claim to a method.

09:40 1 Over on the right, we have the '158 patent
09:40 2 that we've looked at this week. And I have on the top
09:40 3 the abstract of that patent, and I have on the bottom
09:40 4 Claim 3 or the beginning of Claim 3 of that patent.

09:40 5 And all of a sudden apparatuses have appeared.
09:41 6 On the left is methods and systems, but then on the
09:41 7 right is methods, apparatuses and systems.

09:41 8 And on the left, there's a claim to a method,
09:41 9 and on the right, there's a claim to an apparatus. So
09:41 10 this is -- this is a hint that something new is going
09:41 11 on.

09:41 12 Q. And we see that the '906 application is at
09:41 13 DTX-354, right? And PTX-1 is that '158 patent?

09:41 14 A. Yes.

09:41 15 Q. Now, is there a picture we can use to
09:41 16 illustrate the difference between what was described in
09:41 17 2012 and what was described first in October of 2017?

09:41 18 MR. LANTIER: If we go to the next slide.

09:41 19 A. Yeah. Before we go, so if you remember --
09:41 20 well, the 2012 applications refer to a first node and a
09:41 21 second node.

09:41 22 All of the asserted patents in this case add a
09:41 23 third node. And that third node, they're saying, is
09:42 24 Dropbox. But there was no such third node in the 2012
09:42 25 applications.

09:42 1 So here's what's going on. This is Figure 7
09:42 2 from both 2012 applications. You can see there's a
09:42 3 first node, 502, at the top of the drawing, and there's
09:42 4 a second node, 504, at the top of the drawing.

09:42 5 The first node and the second node are the
09:42 6 first user and the second user. And the specification
09:42 7 discloses a first node that shares a file with a second
09:42 8 node. And it does that by means of various messages.

09:42 9 And so these messages, you can see in purple,
09:42 10 there's a first message, a second message, a third
09:42 11 message and a fourth message. And those messages are
09:42 12 all between the first node and the second node.
09:42 13 There's no third node lurking around in there.

09:42 14 MR. LANTIER: And if we turn to the next
09:42 15 slide.

16 BY MR. LANTIER:

09:42 17 Q. Why are you showing us this?

09:42 18 A. Well, this is legitimately the disclosure in
09:43 19 the '906 application.

09:43 20 So you can see in the drawing that there's a
09:43 21 first node, and there's a second node, 504, in green.
09:43 22 And the communication takes place through the network,
09:43 23 506, represented as the cloud, but there is this thing
09:43 24 in there called the "path node." So it looks like it
09:43 25 could be some kind of third node.

09:43 1 So let's take a look at the description of
09:43 2 what a path node is.

09:43 3 It says: Exemplary path nodes include mail
09:43 4 relay nodes, phone switch nodes and proxy nodes, such
09:43 5 as instant messaging proxies for communicating through
09:43 6 firewalls.

09:43 7 It's my opinion that phone switch nodes and
09:43 8 proxy nodes don't have any role in the allegations
09:43 9 against Dropbox. At best, there could be a mail relay
09:43 10 node.

09:43 11 So that's the one I'm going to talk about.

09:43 12 MR. LANTIER: And before we do, if you
09:43 13 turn to Slide 101.

09:43 14 BY MR. LANTIER:

09:43 15 Q. What are you showing here?

09:43 16 A. This is the other application from 2012, and
09:44 17 it shows, again, a first node, a second node and
09:44 18 there's a proxy node in the cloud.

09:44 19 And it has the same disclosure about what that
09:44 20 path node is, mail relay nodes, phone switch nodes and
09:44 21 proxy nodes, such as instant messaging proxies for
09:44 22 communicating through firewalls.

09:44 23 I mean, the reason I say instant messaging
09:44 24 proxies are not relevant here is there's no allegation
09:44 25 that there was any instant messaging going on in

09:44 1 Dropbox.

09:44 2 Q. Now, do you remember earlier this week when
09:44 3 Mr. Morris testified, he said that the only changes
09:44 4 that were made in 2017 were some changes to the
09:44 5 abstract of the patents?

09:44 6 A. I heard that.

09:44 7 Q. Yeah. Was that accurate?

09:44 8 A. Well, clearly not. Looking at this slide.

09:44 9 Q. Okay. What are we seeing here?

09:44 10 A. Okay. So this is a -- these are images of the
09:44 11 first four pages of the '158 patent, which was filed in
09:44 12 2017.

09:44 13 And I've highlighted in yellow the newly added
09:45 14 language. And so it's going to turn out, if we
09:45 15 actually were to look at the text that was added, it
09:45 16 really is almost a literal repetition of what the
09:45 17 claims say of the '158 patent. It just says them in
09:45 18 non-claim form in the specification.

09:45 19 And the way continuations-in-part work is you
09:45 20 don't file a continuation-in-part unless you really
09:45 21 need to add new matter. Otherwise you could just file
09:45 22 a continuation, and you keep your original filing date.

09:45 23 And so this new matter was added to support
09:45 24 the new claims.

09:45 25 Q. And were the claims -- are the claims that are

09:45 1 asserted in this case supported by the applications if
09:45 2 they don't have that new language in them?

09:45 3 A. No. That's presumably why the new language
09:45 4 was added.

09:45 5 MR. LANTIER: Could we take a look at
09:45 6 that on the next slide?

09:45 7 A. Yes.

09:45 8 BY MR. LANTIER:

09:45 9 Q. What are you showing here?

09:46 10 A. Okay. So in -- on the left, I have material
09:46 11 from the '158 patent filed in 2017. And on the left is
09:46 12 the parts of the specification that I had highlighted
09:46 13 in yellow earlier on the previous slide, but I've
09:46 14 highlighted specific terms in yellow here even though
09:46 15 all of this should really be yellow because it
09:46 16 corresponds to what was on this -- on this previous
09:46 17 slide.

09:46 18 So what I've taken is this -- some of this
09:46 19 yellow material, and I've only re-yellowed the things
09:46 20 that are really relevant.

09:46 21 And so here on the left is the specification,
09:46 22 and on the right is exemplary Claim 3, one of the
09:46 23 asserted claims of the '158 patent. And you can see
09:46 24 that the language in the specification basically
09:46 25 follows directly what the claim language says. So

09:46 1 everything in yellow on the left has a corresponding
09:46 2 yellow text in the claim.

09:46 3 Q. And what's the significance of that?

09:46 4 A. That this new matter needed to be added in
09:47 5 order to support those claims.

09:47 6 MR. LANTIER: Could we turn to the next
09:47 7 slide, please?

8 BY MR. LANTIER:

09:47 9 Q. And could you explain what you're showing us
09:47 10 here?

09:47 11 A. Yes. This is the '052 patent showing its
09:47 12 newly added language.

09:47 13 Now, what's really interesting here is, if you
09:47 14 look at the top of Column 2, there's a heading there
09:47 15 called "Summary." That's an explanation of a summary
09:47 16 of the invention. And that extends all the way to the
09:47 17 middle of Column 5 before it says "Brief Description of
09:47 18 the Drawings."

09:47 19 You can see that the only material from the
09:47 20 original application that survived in the summary of
09:47 21 the invention is the first paragraph. And the first
09:47 22 paragraph doesn't really say anything. I mean, it
09:47 23 doesn't say anything about the invention. It's just a
09:47 24 statement of -- that I'm going to disclose a system
09:47 25 that has these components to it.

09:47 1 So the -- nothing survived in the summary of
09:47 2 the invention from the original application.

09:47 3 Q. And, again, all of the text that you've
09:47 4 highlighted here in yellow, that never appeared -- this
09:48 5 text here was not in the 2012 patent applications. It
09:48 6 was included for the first time here on October 3rd,
09:48 7 2017?

09:48 8 A. That's right. So this material was only added
09:48 9 in 2017. And yet they're trying to claim a 2012 date.

09:48 10 MR. LANTIER: Now, if we could turn to
09:48 11 the next slide.

12 BY MR. LANTIER:

09:48 13 Q. Could you explain to us why that new material
09:48 14 matters to the claims?

09:48 15 A. Yes. So, again, the material on the left is
09:48 16 from the summary of the invention that was all in
09:48 17 yellow on the previous slide. Now I've just
09:48 18 highlighted certain words in yellow that correspond
09:48 19 directly to limitations in the Claim 12.

09:48 20 And we just went through Claim 12 earlier
09:48 21 today showing that this new matter was required to
09:48 22 support those -- to support those claims. And in
09:48 23 particular it added that the apparatus is going to
09:48 24 generate messages. In the original 2012 applications,
09:49 25 there was no apparatus that generated messages.

09:49 1 Q. And, again, when you say that there's an
09:49 2 apparatus that generates messages, what types of
09:49 3 messages are we talking about here?

09:49 4 A. Principally e-mails but also HTTP gets
09:49 5 requests for files, things like that.

09:49 6 Q. And if the apparatus isn't going to generate a
09:49 7 message, who could generate a message?

09:49 8 A. A first node or a second node. The user's
09:49 9 computer could do it.

09:49 10 Q. So a human being sitting at a computer, for
09:49 11 example?

09:49 12 A. Either the human being himself doing it or
09:49 13 software running on his computer doing it.

09:49 14 Q. Okay. So let's take a step back then and try
09:49 15 to explain that in some context.

09:49 16 A. Okay.

09:49 17 MR. LANTIER: And could we look at Slide
09:49 18 106?

19 BY MR. LANTIER:

09:49 20 Q. And could you explain what you're showing us
09:49 21 here?

09:49 22 A. Yes. I'm going to show you how e-mail works.

09:49 23 And I've been teaching about e-mail and the
09:49 24 protocols for decades. And the analogy that I like to
09:50 25 use, because it's almost exact, is that the Internet is

09:50 1 really just like the post office, the U.S. Post Office.
2 And I'll show that here.

09:50 3 So suppose we have somebody who's not in Waco,
09:50 4 a sender, who wants to write a letter to somebody in
09:50 5 Waco. Let's suppose it's somebody in Pittsburgh, like
09:50 6 me. And I'm in ZIP Code 15213. But I write a letter,
09:50 7 and I write an address on the outside that has 76701,
09:50 8 which I think is the ZIP Code we're in now.

09:50 9 This is a physical letter. It's written on
09:50 10 paper. You put a stamp on it. And what do you do?
09:50 11 You go to a post office box. You go to a mailbox on
09:50 12 the corner. And what happens? At some time during the
09:50 13 day, a postman shows up, empties the box and brings it
09:50 14 to the post office of the ZIP Code where you live.

09:50 15 And they do things with it there. They look
09:50 16 at it. They sort it. It might actually be addressed
09:50 17 to the same post office, in which case it never leaves
09:50 18 the post office. Just gets put in a sack and tomorrow
09:50 19 a mail carrier will bring you the letter.

09:51 20 But if it's addressed to some other ZIP Code,
09:51 21 it has to be transported out of the post office to
09:51 22 somewhere. And it's possible that it may go through
09:51 23 many post offices on the way, but eventually it ends up
09:51 24 in the post office corresponding to the receiver's ZIP
25 Code.

09:51 1 So the sender ultimately sends the letter to
09:51 2 his post office. The post office in 15213, their job
09:51 3 is to make sure that it gets to 76701. Then when it
09:51 4 gets to 76701, the postman shows up, and he brings the
09:51 5 letter to the recipient, who then opens it.

09:51 6 That's how e-mail works also. This is how
09:51 7 mail works. It's exactly how e-mail works too. And
09:51 8 I'll show that.

09:51 9 So in this case, an e-mail, the sender is not
09:51 10 physically licking a stamp and putting it on an
09:51 11 envelope. They're sitting at an e-mail client, and
09:51 12 they're drafting the e-mail. And then when they say
09:51 13 send, what happens to it?

09:52 14 Well, it goes essentially to a post office.
09:52 15 It goes to something called an outgoing e-mail server.
09:52 16 And the job of the outgoing e-mail server is to make
09:52 17 sure that it's properly sent to the incoming e-mail
09:52 18 server of the recipient. That's what the e-mail
09:52 19 address is all about.

09:52 20 Like my address is shamos@cs.cmu.edu,
09:52 21 cs.cmu.edu is the mailbox that I want -- that the
09:52 22 sender wanted that mail to go.

09:52 23 So the outgoing e-mail server passes it
09:52 24 through the cloud, through the Internet, to an incoming
09:52 25 e-mail server, which is the one that the recipient is

09:52 1 going to go to with his e-mail client in order to check
09:52 2 his mail. And so the recipient then gets it.

09:52 3 Well, if you look at this diagram, it's
09:52 4 exactly like the post office. It's just done
09:52 5 electronically instead of physically.

09:52 6 Q. And, Professor Shamos, how does this all
09:52 7 relate to what was in the 2012 patent application?

09:52 8 A. Yes. So I had to go through all of this to
09:53 9 explain what a mail proxy node is.

09:53 10 And so I think I said that in the case of the
09:53 11 postal service, the post office in Pittsburgh is not
09:53 12 going to directly send a letter to Waco. They're not
09:53 13 going to put it in the truck and have that truck drive
09:53 14 all the way here. They're going to send it to some
09:53 15 larger intermediate post office, which is going to send
09:53 16 it on to some other intermediate post office, and
09:53 17 eventually it will get to Waco.

09:53 18 E-mail works the same way. The incoming --
09:53 19 the outgoing e-mail server can't directly send it to
09:53 20 the incoming one. It goes through what are called
09:53 21 "mail relay nodes" on the way. And that's what's shown
09:53 22 here on the diagram. In the middle of the cloud,
09:53 23 there's a mail relay node that takes the e-mail and
09:53 24 passes it on to another server.

09:53 25 But the important point is that just like the

09:53 1 post office, the mail relay node doesn't open your
09:53 2 mail. It doesn't add things. It doesn't generate any
09:53 3 mails. All -- its job is to take your letter and pass
09:53 4 it unchanged to the next post office. That's exactly
09:54 5 the same thing with the mail relay node. It doesn't
09:54 6 generate anything.

09:54 7 Q. So just to make sure we've -- we're clear on
09:54 8 what we've been discussing, what you're discussing here
09:54 9 is the path node or the mail relay node that was
09:54 10 described in the September 2012 patent applications?

09:54 11 A. Yes. Because I have a belief that Dr. Akl is
09:54 12 going to point to mail relay node as a third node.

09:54 13 MR. LANTIER: And if we turn to the next
09:54 14 slide.

15 BY MR. LANTIER:

09:54 16 Q. Could you explain that here?

09:54 17 A. Yes. This is just a reminder of what it said
09:54 18 in the original 2012 application, that "exemplary path
09:54 19 nodes include mail relay nodes." And I already said
09:54 20 that the phone switch nodes and proxy nodes don't have
09:54 21 relevance here.

09:54 22 Q. Okay. Now, let's get to the important point
09:54 23 here in terms of how the 2017 applications were
09:54 24 different.

09:54 25 Could you go to the next slide and explain

09:54 1 that to us?

09:54 2 A. Yes. So if you recall, in the original 2012
09:55 3 applications I showed Figure 7. It has a first node
09:55 4 and a second node. And there were four messages that
09:55 5 went between the first and second node. Those messages
09:55 6 were generated by the first node, sent to the second
09:55 7 node. Okay? For example, the e-mails went from the
09:55 8 first node to the second node.

09:55 9 In the 2017 patents, the e-mails are not
09:55 10 generated by the first node, by the user. The e-mails
09:55 11 are generated, according to their theory, by Dropbox,
09:55 12 which is the apparatus or the third node.

09:55 13 So you don't send an e-mail. When you're
09:55 14 sharing a file, you do not create an e-mail. What you
09:55 15 do is you tell Dropbox: Would you please generate an
09:55 16 e-mail and send it to the recipient to request a file?

09:55 17 And so what goes on here is the sender, even
09:55 18 though he's at his computer, he's not sending an
09:55 19 e-mail. What he's doing is he's sending a message to
09:55 20 create a shared folder. And then he indicates the
09:55 21 e-mail addresses of the people that he wants to share
09:56 22 it with. That message goes to the third node which is
09:56 23 Dropbox.

09:56 24 Dropbox then has to generate an e-mail and
09:56 25 then has to send it to its outgoing e-mail server. And

09:56 1 then, of course, it's the regular e-mail process from
09:56 2 then on. It goes from outgoing e-mail server to the
09:56 3 incoming e-mail server to the recipient, who's the one
09:56 4 who's being asked to share files.

09:56 5 Q. So just in a nutshell, what is it that's not
09:56 6 disclosed in the 2012 Morris applications that will be
09:56 7 focused on here?

09:56 8 A. Right. Well, one thing is there's no third
09:56 9 node that generates an e-mail.

09:56 10 Q. Let's go through that for each of the asserted
09:56 11 claims here.

09:56 12 A. Okay.

09:56 13 MR. LANTIER: If we turn to Slide 111.
09:56 14 BY MR. LANTIER:

09:56 15 Q. What are we seeing here?

09:56 16 A. On the right is the -- a part of the language
09:56 17 of '158, Claim 3. So there's the preamble and then one
09:56 18 of the limitations, one of the steps.

09:57 19 And so it says: An apparatus, et cetera,
09:57 20 et cetera, to generate -- with instructions to generate
09:57 21 at least one e-mail message.

09:57 22 And in the 2012 application, the figure which
09:57 23 I have on the left, there's no apparatus that generates
09:57 24 at least one e-mail message. It's generated at the
09:57 25 first node and sent to the second node.

09:57 1 Q. And that's -- we can see the only thing that
09:57 2 we see sitting between the first node and the second
09:57 3 node is the proxy node that you described as the path
09:57 4 node; is that right?

09:57 5 A. Yes. And the proxy node does not generate
09:57 6 e-mails. It's forbidden. It would involve tampering
09:57 7 with somebody's mail. You don't do that.

09:57 8 MR. LANTIER: Now, if we turn to the next
09:57 9 slide.

10 BY MR. LANTIER:

09:57 11 Q. What are you showing us here?

09:57 12 A. This is from the '158 patent, Claim 3. This
09:57 13 is claiming an apparatus that has instructions that do
09:57 14 things. And one is to cause at a first node something
09:57 15 to happen and cause at a second node something to
09:57 16 happen.

09:57 17 And that was not disclosed in the 2012
09:58 18 applications. There's a first node and a second node,
09:58 19 and they pass messages between each other. There's no
09:58 20 apparatus that's causing these things to happen.

09:58 21 MR. LANTIER: And if we turn to the next
09:58 22 slide.

23 BY MR. LANTIER:

09:58 24 Q. What are you showing us here with respect to
09:58 25 the '052 patent?

09:58 1 A. This is a portion of Claim 12, which says: An
09:58 2 apparatus that executes instructions to generate a
09:58 3 first message addressed to the at least one e-mail
09:58 4 address.

09:58 5 There, on the left, you can see one of the
09:58 6 2012 applications. There's no third node that's
09:58 7 generating an e-mail message. It's generated by the
09:58 8 first node.

09:58 9 MR. LANTIER: And if we turn to the next
09:58 10 slide.

11 BY MR. LANTIER:

09:58 12 Q. Can you tell us about how your analysis
09:58 13 applies to the asserted claim of the '548 patent?

09:58 14 A. Yes. On the right is the '548 patent, pieces
09:58 15 of Claims 44 and 46, which is proper because 46 depends
09:59 16 from Claim 44.

09:59 17 So they're instructions, which when executed
09:59 18 by an apparatus cause the apparatus to cause generation
09:59 19 of a first message and to cause the sending to the
09:59 20 first node via the network of the message.

09:59 21 And you can look on the left, there's no
09:59 22 apparatus in there that does that.

09:59 23 MR. LANTIER: And then, finally, if we
09:59 24 turn to Slide 115.

25 BY MR. LANTIER:

09:59 1 Q. Can you explain how your analysis applies to
09:59 2 the asserted claim of the '215 patent?

09:59 3 A. Yes. This is -- in '215, the only asserted
09:59 4 claim is 18, but it depends from 1. So on the right, I
09:59 5 have pieces of 1 and 18. It's a method comprising
09:59 6 causing something at a first node and causing something
09:59 7 at a second node.

09:59 8 You can see on the left, there's no third node
09:59 9 that does that. Those are all done by the first node
09:59 10 and second node themselves.

09:59 11 Q. And so just to summarize, have you now shown
09:59 12 us, for each of the asserted claims, that there are
09:59 13 limitations in those claims that are -- that do not
10:00 14 have support in the September 2012 patent applications
10:00 15 that Mr. Morris filed?

10:00 16 A. That's right.

10:00 17 Q. Now, are you aware that Dr. Akl's offered an
10:00 18 opinion on this topic?

10:00 19 A. Yes.

10:00 20 Q. And does he agree with you?

10:00 21 A. No.

10:00 22 Q. Have you studied the entirety of the 2012
10:00 23 applications?

10:00 24 A. Yes. Not only the applications but their
10:00 25 prosecution histories also.

10:00 1 Q. And when you studied every word of those
10:00 2 applications, did you see any support for the claim
10:00 3 limitations that you've just walked us through?

10:00 4 A. No. For a really simple reason, there is
10:00 5 none. And that's why that material was added in 2017.

10:00 6 MR. LANTIER: Now, turning to Slide 116.

10:00 7 BY MR. LANTIER:

10:00 8 Q. Can you just tell us again what your
10:00 9 conclusion is here?

10:00 10 A. Yes. My conclusion is that the applications
10:00 11 that were filed in 2017 are not entitled to claim
10:01 12 priority to 2012.

10:01 13 Q. Now, if the applications are not entitled to
10:01 14 the 2012 priority date, does that change the prior art
10:01 15 that is relevant to evaluating the validity of the
10:01 16 patent claims?

10:01 17 A. Well, it has no effect on the Dropbox 2011 and
10:01 18 Dropbox 2011 AirDropper because those were before the
10:01 19 2012 applications anyway.

10:01 20 But what it means is that other prior art that
10:01 21 may be after 2012 can be used to invalidate these
10:01 22 claims because they're really only 2017 claims.

10:01 23 Q. And so what did you look at in particular with
10:01 24 respect to an additional reason that the claims would
10:01 25 be invalid if the priority date is not 2012?

10:01 1 A. I looked at Dropbox 2017.

10:01 2 Q. And could you tell us what Dropbox 2017 is?

10:01 3 A. Yes. So Dropbox 2017 is the version of
10:02 4 Dropbox that was available in 2017 before these
10:02 5 applications were filed. And I had the source code
10:02 6 snapshot from before October 3rd of 2017 of exactly
10:02 7 what the source code of Dropbox was.

10:02 8 Q. Okay. So this a little bit -- I want to make
10:02 9 sure everybody understands sort of what the steps of
10:02 10 your analysis are here.

10:02 11 Using Slide 117, could you walk us through
10:02 12 what you're saying?

10:02 13 A. Yes. So I think Dr. Gibbons showed that
10:02 14 Dropbox 2021 does not infringe. Dropbox 2017 had, for
10:02 15 purposes of these claims, the same behaviors as Dropbox
10:02 16 2021. So Dropbox 2017 wouldn't infringe either, even
10:02 17 assuming that Motion Offense were entitled to a 2012
10:02 18 date.

10:02 19 However, Motion Offense has asserted that
10:02 20 Dropbox 2021 and Dropbox 2017 infringe the asserted
10:03 21 claims. He must interpret the claims the same way for
10:03 22 infringement as you do for invalidity. It's not -- you
10:03 23 can't change horses in midstream.

10:03 24 So I'm using Motion Offense's infringement
10:03 25 theory and seeing if it applies to Dropbox 2017. If it

10:03 1 does, then those claims must be invalid because Dropbox
10:03 2 2017 came before the 2017 applications in Motion
10:03 3 Offense.

10:03 4 Q. All right. And was Dropbox 2017 in public use
10:03 5 before October of 2017?

10:03 6 A. Yes. Dropbox has hundreds of millions of
10:03 7 users. I'm sure most of them are members of the
10:03 8 public.

10:03 9 Q. And are you saying that all of the accused
10:03 10 features of Dropbox in this case for infringement were
10:03 11 already in Dropbox before October 3rd of 2017?

10:04 12 A. If Motion Offense's infringement theory is
10:04 13 correct, then yes.

10:04 14 MR. LANTIER: If we could turn to Slide
10:04 15 118.

10:04 16 A. Well, okay. I guess I should have been
10:04 17 clicking along with you here.

10:04 18 Okay. There we go.

10:04 19 BY MR. LANTIER:

10:04 20 Q. All right. If we could -- we'll try to move
10:04 21 as efficiently as we can, but we do need to walk
10:04 22 through the claim elements of each of the claims.

10:04 23 And could you start us here with the preamble
10:04 24 of '158 patent, Claim 3?

10:04 25 A. Yes. I'm going to abbreviate this by sparing

10:04 1 everybody a reading of the entire text of every claim
10:04 2 limitation.

10:04 3 But the -- what I'm basically showing is that
10:04 4 I'm trying to apply Motion Offense's infringement
10:04 5 theory that they've raised in this case to Dropbox
10:04 6 2017. Because Dropbox 2017 behaved, for purposes of
10:04 7 these claims, identically to that of Dropbox 2021,
10:05 8 which is what Dr. Akl used for his infringement case.

10:05 9 So this is Dr. Akl's argument for the
10:05 10 preamble, and it applies equally well to 2017 because
10:05 11 it was the same then.

10:05 12 Q. And so just before we move on from this slide,
10:05 13 you're -- you are showing here in the body of this
10:05 14 slide what Dr. Akl relied on when he said that the
10:05 15 claims were infringed; is that right?

10:05 16 A. Yes. Everything that he said about Dropbox
10:05 17 2021 applies equally well to Dropbox 2017 --

10:05 18 Q. Okay. Under --

10:05 19 A. -- under his theory.

10:05 20 Q. Under his theory, is the preamble of
10:05 21 Claim 1 -- excuse me -- Claim 3 of the '158 patent
10:05 22 satisfied?

10:05 23 A. Yes.

10:05 24 Q. Okay. And just to make sure it's clear,
10:05 25 you've got MOT up at the top.

10:05 1 What does that refer to again?

10:05 2 A. Motion Offense's Theory.

10:05 3 Q. Very good.

10:05 4 All right.

10:05 5 MR. LANTIER: If we could move to the
10:05 6 next slide, please.

7 BY MR. LANTIER:

10:05 8 Q. Did Dropbox 2017 have Limitation 3[a]?

10:06 9 A. Yes. I'm going to abbreviate this a lot.

10:06 10 So on the slides that are -- that have purple
10:06 11 titles, the purple -- the reason I use purple there is
10:06 12 to distinguish from 2011. This is 2017 we're talking
10:06 13 about. Make it real simple.

10:06 14 On the left is the evidence that Dr. Akl
10:06 15 showed you for that particular limitation and Dropbox
10:06 16 2021. On the right, I'm showing source code citations
10:06 17 that show that the same function exactly was performed
10:06 18 by Dropbox 2017.

10:06 19 Q. And those are DTX, here, 877, 878 and 879; is
10:06 20 that right?

10:06 21 A. Yes.

10:06 22 Q. And based on your review of the source code,
10:06 23 did Dropbox 2017 have Limitation 3[a] under the Motion
10:06 24 Offense theory?

10:06 25 A. Yes.

10:06 1 MR. LANTIER: Please turn to Slide 120.

10:06 2 A. We --

10:06 3 BY MR. LANTIER:

10:06 4 Q. Does Dropbox 2017 have Limitation 3[b] based
10:06 5 on your analysis?

10:07 6 A. Yes. We can make this really speedy. It's
10:07 7 the same thing. On the left, Dr. Akl did not actually
10:07 8 exhibit this particular interface, but he did show
10:07 9 allegedly some code that produced this. So this is not
10:07 10 from -- this is not from his demonstration.

10:07 11 On the other hand, I found source code that
10:07 12 would create this interface in Dropbox 2017, and that's
10:07 13 what's shown on the left -- on the right, I mean.

10:07 14 Q. So under the Motion Offense theory, is Claim
10:07 15 3[b] met by Dropbox 2017?

10:07 16 A. Yes.

10:07 17 MR. LANTIER: Let's move on to the next
10:07 18 claim element.

10:07 19 A. This is the same idea. On the left is the
10:07 20 evidence that Dr. Akl actually displayed on the screen
10:07 21 during his testimony. And on the right are the source
10:07 22 code files in Dropbox 2017 that would create that
10:08 23 interface.

10:08 24 MR. LANTIER: If we move on to the next
10:08 25 limitation.

10:08 1 A. Oh, let's just read DTX-877, DTX-878 and
10:08 2 DTX-879 into the record.

10:08 3 BY MR. LANTIER:

10:08 4 Q. Thank you. I was abbreviating because I think
10:08 5 those are already in.

10:08 6 A. Yes -- no. I meant in corresponding to the
10:08 7 Limitation 3[c].

10:08 8 Q. Very good.

10:08 9 So do those source code files evidence that
10:08 10 under the Motion Offense theory, Claim Element 3[c] is
10:08 11 met in Dropbox 2017?

10:08 12 A. Yes.

10:08 13 MR. LANTIER: Let's move on to the next
10:08 14 limitation, please.

10:08 15 A. It's the same thing for Limitation 3[d]. On
10:08 16 the left is an interface for which Dr. Akl showed
10:08 17 developer tools code that produced that. And on the
10:08 18 right is the corresponding code, which are the same
10:08 19 DTXs as for Limitation 3[c].

10:08 20 MR. LANTIER: And let's move on to
10:08 21 Limitation 3[e].

10:08 22 A. Same thing. On the left is an interface; on
10:09 23 the right is the same DTXs that create that interface.

10:09 24 MR. LANTIER: And let's move on to Claim
10:09 25 Element 3[f].

10:09 1 A. 3[f], here on the left, this was the actual
10:09 2 exhibit that Dr. Akl showed you. And on the right is
10:09 3 the code. This time it's different files, DTX-880,
10:09 4 DTX-881 and DTX-882, that produced that interface.

10:09 5 BY MR. LANTIER:

10:09 6 Q. And so have you reviewed each of those source
10:09 7 code files, Dr. Akl -- excuse me -- Professor Shamos?

10:09 8 A. Yes. I have.

10:09 9 Q. And have you reviewed all the source code that
10:09 10 we're talking about here with respect to Dropbox
10:09 11 2011 -- excuse me. 2017?

10:09 12 A. Yes. That's the basis on which I'm saying
10:09 13 this.

10:09 14 Q. Okay. Thank you very much, Professor Shamos.

10:09 15 MR. LANTIER: Could we please move on
10:09 16 then to the next limitation?

10:09 17 A. Same thing. Same code.

10:09 18 BY MR. LANTIER:

10:09 19 Q. So Limitation 3[g] is present in Dropbox 2017
10:10 20 under Motion Offense's infringement theory; is that
10:10 21 right?

10:10 22 A. Yes.

10:10 23 MR. LANTIER: Let's move to the next
10:10 24 limitation.

25 BY MR. LANTIER:

10:10 1 Q. What do we see here?

10:10 2 A. Same thing but different code.

10:10 3 So Dr. Akl showed this window that had various
10:10 4 folders, some of which have a cloud, and some of which
10:10 5 have green checkmarks. You want to read the DTXs, or
10:10 6 should I?

10:10 7 Q. You can.

10:10 8 A. Oh, okay. The corresponding source code is
10:10 9 DTX-907, 909, 911, 912, 913, 914, 915, 916, 917, 918.

10:10 10 Q. Thank you.

10:10 11 And this corresponds to Limitations 3[h]
10:10 12 through [j] of Claim 3 of the '158 patent; is that
10:10 13 right?

10:10 14 A. Yes.

10:10 15 MR. LANTIER: Could we move on to the
10:10 16 next limitation, please, 3[k]?

10:11 17 A. Yes. Same thing. Dr. Akl at Slide 100 showed
10:11 18 the drawing on the left. And the same functions
10:11 19 existed in Dropbox 2017 that existed in Dropbox 2021 to
10:11 20 perform this function.

10:11 21 BY MR. LANTIER:

10:11 22 Q. And that's based on the same source code files
10:11 23 that we talked about with the prior limitations; is
10:11 24 that right?

10:11 25 A. Yes.

10:11 1 MR. LANTIER: Could we move on to the
10:11 2 next limitation, please?

10:11 3 A. Yes. Same thing. On the left is Dr. Akl's
10:11 4 Slide 107. On the right are the same source code
10:11 5 functions.

10:11 6 BY MR. LANTIER:

10:11 7 Q. And so under Motion Offense's infringement
10:11 8 theory, is this claim element met by Dropbox 2017?

10:11 9 A. Yes.

10:11 10 MR. LANTIER: Let's move on to the next
10:11 11 limitation, please.

10:11 12 A. Same thing. It's Dr. Akl's Slide 112. And
10:11 13 the Dropbox 2017 functions are listed on the right.
10:12 14 They're the same as for the previous limitation.

10:12 15 BY MR. LANTIER:

10:12 16 Q. And so under Motion Offense's infringement
10:12 17 theory, Claim Element 3[m] is met by Dropbox 2017; is
10:12 18 that right?

10:12 19 A. Yes.

10:12 20 MR. LANTIER: Let's move on to the next
10:12 21 slide.

22 BY MR. LANTIER:

10:12 23 Q. What do we have here?

10:12 24 A. This is Claim 6. Same thing.

10:12 25 So Dr. Akl showed this on two slides, 125 and

10:12 1 126. On the right-hand side, I have DTX-877, 878 and
10:12 2 879 are the source code that would create that
10:12 3 interface and populate it.

10:12 4 Q. And so with respect to Claim 6 of the '158
10:12 5 patent under the Motion Offense infringement theory, is
10:12 6 it all in Dropbox 2017?

10:12 7 A. Yes.

10:12 8 MR. LANTIER: Let's move on, please, to
10:12 9 Claim 14.

10 10 BY MR. LANTIER:

10:12 11 Q. What do we see here?

10:12 12 A. On the left are Dr. Akl's Slides 133 to 135.
10:12 13 And on the right are the Dropbox 2017 source code files
10:12 14 that produced those interfaces. I think this list of
10:13 15 functions is the same as one of the -- one of the
10:13 16 previous limitations.

10:13 17 Q. And I'll do it this time. That's DTX-907,
10:13 18 909, 911, 912, 913, 914, 915, 916, 917 and 918.

10:13 19 Did I read those right?

10:13 20 A. Yes.

10:13 21 Q. And so under the Motion Offense theory, is
10:13 22 Claim 14 of the '158 patent present in Dropbox 2017?

10:13 23 A. Yes.

10:13 24 Q. And so for the claims of the '158 patent that
10:13 25 have been asserted, what does that mean under the

10:13 1 Motion Offense theory?

10:13 2 A. If Motion Offense's theory of infringement is
10:13 3 correct, then all of -- well, all the claims we've
10:13 4 talked about are invalid because of Dropbox 2017.

10:13 5 Q. All right.

10:14 6 MR. LANTIER: Let's move on to the '215
7 patent.

8 BY MR. LANTIER:

10:14 9 Q. And what do we see here on Slide 133?

10:14 10 A. So this is easier because earlier I showed the
10:14 11 correspondence between the claims of '215 and '158.
10:14 12 And so all these limitations I would give the same
10:14 13 proof for Limitations 1[a], 1[b], 1[c] and 1[d].

10:14 14 MR. LANTIER: If we turn to Slide 134.

10:14 15 A. I would give all the same proof for
10:14 16 Limitations 1[e], 1[f] and 1[g], but the "..."
10:14 17 indicates that there's another limitation we have to
10:14 18 deal with.

10:14 19 BY MR. LANTIER:

10:14 20 Q. And could we turn to Slide 135 and talk about
10:14 21 one of those?

10:14 22 A. Yes.

10:14 23 This is the limitation where the at least one
10:14 24 e-mail is at least partially prewritten.

10:14 25 Dr. Akl showed, indeed, that there was a

10:14 1 prewritten e-mail. But there was also a prewritten
10:14 2 e-mail in Dropbox 2017 as shown by DTX-881, 882 and
10:14 3 883.

10:14 4 Q. And so this is the -- one of those limitations
10:14 5 where it says that the e-mail is at least partially
10:14 6 prewritten; is that right?

10:15 7 A. Yes.

10:15 8 Q. And we can see what Dr. Akl is pointing to for
10:15 9 that on the left side of the screen?

10:15 10 A. Yes. It is prewritten.

10:15 11 Q. Was it any secret to a Dropbox user that
10:15 12 Dropbox servers rewrote part of that e-mail?

10:15 13 A. No. You can tell when you receive an e-mail
10:15 14 what part of it was written by the sender and what part
10:15 15 was generated by the system.

10:15 16 Q. Okay. And the source code that you've
10:15 17 identified shows that that functionality was already
10:15 18 present in Dropbox 2017 before the October 3rd, 2017
10:15 19 filing date, right?

10:15 20 A. Yes.

10:15 21 Q. Okay.

10:15 22 MR. LANTIER: If we could move on then to
10:15 23 Slide 136.

24 BY MR. LANTIER:

10:15 25 Q. What are you showing us here?

10:15 1 A. This is Limitation 1[i], which didn't have a
10:15 2 correspondence in the earlier claim.

10:15 3 Again, on the left are an interface for which
10:15 4 Dr. Akl referred to various developer tools for proof.
10:16 5 Those interfaces would be created in Dropbox 2017 by
10:16 6 DTX-881, 882 and 883.

10:16 7 Q. So under the Motion Offense theory, was that
10:16 8 limitation present in Dropbox 2017?

10:16 9 A. Yes.

10:16 10 MR. LANTIER: Let's move on to the next
10:16 11 limitation.

12 BY MR. LANTIER:

10:16 13 Q. What do we see here?

10:16 14 A. This has to do with the creation of a file
10:16 15 representation. The evidence that Dr. Akl gave
10:16 16 corresponded to this particular screen that's shown on
10:16 17 the left. And that interface would have been produced
10:16 18 in Dropbox 2017 by DTX-882 and 907.

10:16 19 MR. LANTIER: And if we turn to the next
10:16 20 slide.

21 BY MR. LANTIER:

10:16 22 Q. Did the evidence that you reviewed show that
10:16 23 Limitation 1[k] of the '215 patent was present in
10:16 24 Dropbox 2017 under Motion Offense's infringement
10:16 25 theory?

10:16 1 A. Yes. On the left is Dr. Akl's Slide 172, and
10:17 2 on the right is the name of -- the path name of the
10:17 3 file -- it's in DTX-907 -- that performs that function.

10:17 4 MR. LANTIER: Now let's turn to Element
10:17 5 1[l] and 1[m] of the '215 patent.

6 BY MR. LANTIER:

10:17 7 Q. Can you explain what we're seeing here?

10:17 8 A. Yes. Those both have correspondence in --
10:17 9 some corresponding limitations in '158, Claim 3. I
10:17 10 would use the same proof for that.

10:17 11 Q. And so if one were to accept Motion Offense's
10:17 12 infringement theory, would Dropbox 2017 have those
10:17 13 limitations?

10:17 14 A. Yes.

10:17 15 MR. LANTIER: Now let's turn to Slide
10:17 16 140.

17 BY MR. LANTIER:

10:17 18 Q. Can you tell us whether your review of the
10:17 19 source code showed that under Motion Offense's
10:17 20 infringement theory, the additional element of Claim 18
10:17 21 of the '215 patent was present in Dropbox 2017?

10:17 22 A. Yes. For this claim -- '215, Claim 18, on the
10:17 23 left, I've shown Dr. Akl's exhibits that he used in his
10:18 24 infringement argument. And on the right is a list of
10:18 25 source code modules that perform the functions that are

10:18 1 illustrated in those -- in that drawing.

10:18 2 And I should note that many of the source code
10:18 3 files between 2017 and 2021 were literally identical.
10:18 4 I mean, there was no change made to basic
10:18 5 functionality.

10:18 6 Q. And just for the record, what we're looking at
10:18 7 here came -- you saw in DTX-882, DTX-907, DTX-909, 911,
10:18 8 912, 913, 914, 915, 916, 917 and 918?

10:18 9 A. Yes.

10:18 10 Q. Under the Motion Offense infringement theory,
10:18 11 did Claim 18 of the -- were all elements of Claim 18 of
10:18 12 the '215 patent present in Dropbox 2017?

10:19 13 A. Yes.

10:19 14 Q. And what does that mean for that claim under
10:19 15 Motion Offense's infringement theory?

10:19 16 A. That Dropbox 2017 would invalidate that claim
10:19 17 under their theory.

10:19 18 Q. All right.

10:19 19 MR. LANTIER: Let's move on then to the
10:19 20 '052 patent, Claim 12.

21 BY MR. LANTIER:

10:19 22 Q. And we'll start again with the preamble.

10:19 23 Can you explain the correspondence between
10:19 24 what's accused and Dropbox 2017?

10:19 25 A. Yes. There's no argument about this, that

10:19 1 Dropbox has always had an apparatus that had memory and
10:19 2 instructions and processors.

10:19 3 Q. So let's move to the next claim limitation.

10:19 4 Did Dropbox 2017 have Limitation 12[a] under
10:19 5 the Motion Offense theory?

10:19 6 A. Yes. On the left is Dr. Akl's Slide 200, on
10:19 7 the right is the corresponding code from DTX-884, 893
10:19 8 and 894 that would create that interface.

10:19 9 Q. Let's go to the next limitation.

10:19 10 Did Dropbox 2017 have Limitation 12[b] under
10:20 11 the Motion Offense theory?

10:20 12 A. Yes. On the left is Dr. Akl's Slide 208, on
10:20 13 the right is DTX -- the reference to DTX-886, which
10:20 14 performs the same function.

10:20 15 Q. Turning to the next slide, did Dropbox 2017
10:20 16 have Element 12[c] under the Motion Offense theory?

10:20 17 A. Yes. On the left is Dr. Akl's Slide 214, on
10:20 18 the right are DTX-885, 886 and 888, which contain the
10:20 19 code that would generate the text that's sent to the
10:20 20 user's browser or the user's application in order to
10:20 21 create that interface.

10:20 22 Q. Let's turn to Element 12[d].

10:20 23 Under the Motion Offense theory, did Dropbox
10:20 24 2017 already have the accused functionality?

10:20 25 A. Yes. On the left is Dr. Akl's Slide 221. On

10:20 1 the right are references to DTX-884, 893 and 894 that
10:21 2 perform that function.

10:21 3 Q. Did Dropbox 2017 already have the accused
10:21 4 functionality of Claim Element 12[e]?

10:21 5 A. Yes. Dr. Akl's Slide 226 corresponds to the
10:21 6 same source code files that I used for the previous
10:21 7 limitations.

10:21 8 MR. LANTIER: And turning to Claim
10:21 9 Element 12[f].

10:21 10 BY MR. LANTIER:

10:21 11 Q. Did Dropbox 2017 include the -- this claim
10:21 12 element under the Motion Offense infringement theory?

10:21 13 A. Same thing. This is his Slide 230. And on
10:21 14 the right are the same source code files referenced in
10:21 15 the previous limitation.

10:21 16 MR. LANTIER: Now, if we move on to Claim
10:21 17 Element 12[g].

10:21 18 A. Yes. These are [g] and [h] together. And
10:21 19 Dr. Akl used Slide 235 for that, and I have source code
10:21 20 in DTX-881 and 882 that performs that function.

10:22 21 BY MR. LANTIER:

10:22 22 Q. And again, just to remind everyone, you've
10:22 23 looked at the source code and compared it against what
10:22 24 Dr. Akl said infringes these claims; is that right?

10:22 25 A. Yes.

10:22 1 Q. And you're illustrating here the
10:22 2 correspondence between those two things?

10:22 3 A. Yes. If what he said is correct in 2021
10:22 4 Dropbox, it also applies to 2017 Dropbox.

10:22 5 MR. LANTIER: Now, if we could, please,
10:22 6 move on to Limitation 12[i].

7 BY MR. LANTIER:

10:22 8 Q. Could you explain what you saw in the evidence
10:22 9 here?

10:22 10 A. Yes. He used slide -- his Slide 240, and I've
10:22 11 shown in DTX-881 and 882 code that performs the same
10:22 12 function.

10:22 13 MR. LANTIER: And if we move on to
10:22 14 Element 12[j].

15 BY MR. LANTIER:

10:22 16 Q. What did you see in the evidence?

10:22 17 A. Same thing. His Slide 245 and then against
10:22 18 DTX-893.

10:22 19 MR. LANTIER: If we move on to Element
20 12[k].

21 BY MR. LANTIER:

10:23 22 Q. What did you see in the evidence?

10:23 23 A. His Slides 249 to 250 and corresponding code
10:23 24 in DTX-893.

10:23 25 Q. And the code in 893, again, that's from 2017;

10:23 1 is that right?

10:23 2 A. Yes.

10:23 3 MR. LANTIER: Let's move on then to

10:23 4 Limitation 12[l].

5 BY MR. LANTIER:

10:23 6 Q. What did you see in the evidence with respect
10:23 7 to whether that limitation is satisfied by Dropbox 2017
10:23 8 under the Motion Offense theory?

10:23 9 A. His Slide 255 corresponds to Dropbox 2017 code
10:23 10 in DTX-894.

10:23 11 MR. LANTIER: And now, finally, moving on
10:23 12 to Limitation 12[m].

10:23 13 A. His slides 259 to 260, corresponding 2017 code
10:23 14 in DTX-894.

10:23 15 BY MR. LANTIER:

10:23 16 Q. Thank you.

10:23 17 And so to the extent that what's shown in --
10:23 18 on the left is relevant to infringement, it would also
10:23 19 be present in Dropbox prior to the filing date of the
10:24 20 2017 applications; is that right?

10:24 21 A. Yes.

10:24 22 MR. LANTIER: If we turn to the next
10:24 23 limitation.

24 BY MR. LANTIER:

10:24 25 Q. Could you tell us about Claim 12[n]?

10:24 1 A. His Slide 264 against Dropbox 2017 code in
10:24 2 DTX-893 and 489.

10:24 3 Q. And those match up?

10:24 4 A. Yes.

10:24 5 MR. LANTIER: Let's move on to the next
10:24 6 limitation, Limitation 12[o].

10:24 7 A. Yes. His Slide 268 matching up with Dropbox
10:24 8 2017 code in DTX-893 and 894.

10:24 9 MR. LANTIER: And if we move on to
10:24 10 Limitation 12[p].

11 BY MR. LANTIER:

10:24 12 Q. Could you tell us what you found there?

10:24 13 A. Dr. Akl's Slide 272 matching up with Dropbox
10:24 14 2017 code in DTX-893 and 894.

10:24 15 MR. LANTIER: And I think I said finally
10:24 16 once before, and I apologize for that. Getting
10:24 17 everyone's hopes up.

10:24 18 But here we are, Limitation 12[q] of
10:25 19 Claim 12 of the '052 patent.

20 BY MR. LANTIER:

10:25 21 Q. When you compare the evidence of Dropbox 2017
10:25 22 against what Dr. Akl has said meets the claim language,
10:25 23 what did you find there?

10:25 24 A. Yes. His Slides 277 and 278 match up with
10:25 25 code in Dropbox 2017, DTX-893 and 894.

10:25 1 Q. Okay. And so to summarize --

10:25 2 MR. LANTIER: If we turn to the next
10:25 3 slide.

10:25 4 BY MR. LANTIER:

10:25 5 Q. -- if we apply the Motion Offense infringement
10:25 6 theory here, which of the claim limitations were
10:25 7 already in Dropbox prior to October 3rd, 2017, based on
10:25 8 your review of all this evidence?

10:25 9 A. All of them. Essentially, Dropbox 2017, for
10:25 10 purposes of the asserted claims, perform the same way
10:25 11 as Dropbox 2021.

10:25 12 Q. Okay.

10:25 13 MR. LANTIER: Let's turn to the dependent
10:25 14 claims of the '052 patent and start with Claim 20.

10:25 15 A. Yes. On the left, Dr. Akl's Slides 281 and
10:26 16 283. On the right, Dropbox 2017 code at DTX-888, 889,
10:26 17 890, 891 and 893.

10:26 18 BY MR. LANTIER:

10:26 19 Q. And so this is the requirement you talked
10:26 20 about with the deadline; is that right?

10:26 21 A. Yes. Dropbox 2021 allowed you to set a
10:26 22 deadline, but so did Dropbox 2017.

10:26 23 MR. LANTIER: Let's move on then to Claim
10:26 24 26 under the Motion Offense theory.

10:26 25 THE COURT: Counsel, would this be a

10:26 1 place for a break?

10:26 2 MR. LANTIER: Of course, Your Honor.

10:26 3 THE COURT: Let's take our recess for the
10:26 4 morning.

10:26 5 Please remember my instructions. We'll
10:26 6 come back in 10 or 15 minutes.

10:26 7 THE BAILIFF: All rise.

10:26 8 (Jury exited the courtroom.)

10:26 9 THE COURT: You may be seated.

10:27 10 Doctor, you may step down.

10:27 11 Is there anything we need to take up?

10:27 12 MR. DEVLIN: Not from the plaintiff, Your
10:27 13 Honor.

10:27 14 MR. LANTIER: I don't believe for
10:27 15 Dropbox, Your Honor.

10:27 16 THE COURT: Okay.

10:27 17 (Recess taken.)

10:44 18 THE BAILIFF: All rise.

10:44 19 THE COURT: Please remain standing for
10:44 20 the jury.

10:44 21 (Jury entered the courtroom.)

10:45 22 THE COURT: Thank you. You may be
10:45 23 seated.

10:45 24 Counsel?

10:45 25 BY MR. LANTIER:

10:45 1 Q. Professor Shamos, if we could resume here with
10:45 2 Claim 26 of the '052 patent, what did your comparison
10:45 3 of the evidence with respect to Dropbox 2017 against
10:45 4 the evidence identified by Dr. Akl show?

10:45 5 A. Yes. On the left are Dr. Akl's Slides 290,
10:45 6 294 and 295. And on the right are the Dropbox 2017
10:45 7 functions that perform the same functions, DTX-907,
10:45 8 909, 911, 912, 913, 914, 915, 916, 917 and 918.

10:46 9 Q. Thank you, Professor.

10:46 10 MR. LANTIER: And now if we could turn to
10:46 11 the next slide.

12 BY MR. LANTIER:

10:46 13 Q. Could you tell us what you found when you
10:46 14 compared the evidence with respect to Claim 27 of the
10:46 15 '052 patent?

10:46 16 A. Yes. On the left is from Dr. Akl's Slide 302,
10:46 17 and on the right are the Dropbox 2017 functions, which
10:46 18 happen to be the same functions recited -- that I used
10:46 19 for Claim 26.

10:46 20 Q. The same source code evidence?

10:46 21 A. Yes.

10:46 22 Q. Thank you, Professor Shamos.

10:46 23 And so under the Motion Offense infringement
10:46 24 theory, what does this comparison of the evidence mean
10:46 25 for the asserted claims of the '052 patent?

10:46 1 A. Under their infringement theory, if they are
10:46 2 not entitled to a 2012 date, then Dropbox 2017
10:46 3 invalidates all the claims.

10:46 4 Q. Okay.

10:47 5 MR. LANTIER: Let's move on then to the
10:47 6 '548 patent.

7 BY MR. LANTIER:

10:47 8 Q. Could you tell us what you're showing here on
10:47 9 Slide 162?

10:47 10 A. Yes. This is the correspondence I showed
10:47 11 before between limitations of the -- of Claim 44 of the
10:47 12 '548 patent as against limitations of the Claim 12 of
10:47 13 the '052 patent. And there are correspondences between
10:47 14 the preamble, 44[a] and 44[b].

10:47 15 Q. And so the same evidence applies there?

10:47 16 A. Yes.

10:47 17 MR. LANTIER: If we turn to Slide 163.

18 BY MR. LANTIER:

10:47 19 Q. What are you showing here?

10:47 20 A. The same thing for Limitations 44[c], 44[d]
10:47 21 and 44[e]. I would use the same evidence for those.

10:47 22 MR. LANTIER: If we turn to Slide 164.

23 BY MR. LANTIER:

10:47 24 Q. What are we seeing here?

10:47 25 A. Limitations 44[f], 44[g] and 44[h] correspond

10:47 1 to limitations in Claim 12, so I would use the same
10:47 2 evidence for those.

10:47 3 MR. LANTIER: And turning to Slide 165.

4 BY MR. LANTIER:

10:47 5 Q. Which limitations are you showing here?

10:47 6 A. 44[i] through [j], 44[k] and 44[l] have
10:48 7 correspondences in '052, Claim 12. I've used the same
10:48 8 evidence.

10:48 9 MR. LANTIER: And if we turn to the next
10:48 10 slide, 166.

11 BY MR. LANTIER:

10:48 12 Q. What are the limitations here?

10:48 13 A. 44[m] and 44[n] correspond respectively to
10:48 14 '052, Claim 12[p] and 12[q].

10:48 15 Q. And same evidence therefore applies?

10:48 16 A. Yes. That's right.

10:48 17 Q. All right. So under the Motion Offense
10:48 18 infringement theory, does Dropbox 2011 meet all the
10:48 19 limitations of Claim 44 of the '548 patent?

10:48 20 A. 2017. Dropbox 2017.

10:48 21 Q. Excuse me. I misspoke. Dropbox 2017?

10:48 22 A. Yes. It does.

10:48 23 MR. LANTIER: Now, if we turn to Claim 45
10:48 24 of the '548 patent.

25 BY MR. LANTIER:

10:48 1 Q. Can you tell us what you're illustrating on
10:48 2 Slide 167?

10:48 3 A. Yes. This is a mapping between limitations --
10:48 4 some limitations of Claim 45 and those of '052, Claim
10:49 5 12. The preamble, 45[a], 45[b] and 45[c] have
10:49 6 correspondences, so I used the same evidence for those.

10:49 7 Q. And what does the "... " mean?

10:49 8 A. Means that there are elements that don't have
10:49 9 a correspondence in Claim 12.

10:49 10 MR. LANTIER: So could we please turn to
10:49 11 the next slide?

12 BY MR. LANTIER:

10:49 13 Q. Can you tell us what your review of the
10:49 14 evidence showed?

10:49 15 A. Yes. This is the partially prewritten
10:49 16 limitation. Dr. Akl used his Slide 336 to show that
10:49 17 there was prewritten text. But there was prewritten
10:49 18 text in Dropbox 2011 as evidenced by DTX-881, 882 and
10:49 19 883.

10:49 20 Q. And Professor Shamos, I think now it's my
10:49 21 turn.

10:49 22 You said "Dropbox 2011." Did you mean Dropbox
10:49 23 2017?

10:49 24 A. I did. I just can't read. It's right there
10:49 25 on the screen. 2017.

10:49 1 Q. Okay. Thank you.

10:49 2 MR. LANTIER: And if we turn to the next
10:49 3 slide.

4 BY MR. LANTIER:

10:49 5 Q. What does your -- what did your -- what are
10:49 6 you showing us here with respect to the correspondence
10:50 7 of claim limitations for Claim 46 to the '052 patent,
10:50 8 Claims 26 and 27?

10:50 9 A. Yes. Claim 46 maps to the '052, Claims 26 and
10:50 10 27. So I would use the same evidence for Claim 46 that
10:50 11 I did for those.

10:50 12 Q. And then if we turn to Slide 170, can you
10:50 13 explain -- well, before we get to Slide 170, in light
10:50 14 of that, what's your conclusion with respect to under
10:50 15 Motion Offense's infringement theory, whether all of
10:50 16 the elements of the asserted claim of the '548 patent
10:50 17 are found in Dropbox 2017?

10:50 18 A. Yes. Under Motion Offense's infringement
10:50 19 theory, if they are not entitled to a 2012 date, then
10:50 20 this -- the claims of the '548 patent are invalidated
10:50 21 by Dropbox 2017.

10:50 22 Q. All right. Now, I want to make one thing
10:51 23 clear. So first we walked through Dropbox 2011 and the
10:51 24 Dropbox 2011 AirDropper prior art, right?

10:51 25 A. Yes.

10:51 1 Q. And you compared the elements of every
10:51 2 asserted claim to that prior art, right?

10:51 3 A. Yes.

10:51 4 Q. And does it matter whose application of the
10:51 5 claims we use for purposes of whether the evidence you
10:51 6 showed us of Dropbox 2011 and Dropbox 2011 AirDropper
10:51 7 invalidate all of the asserted claims in the case?

10:51 8 A. No. I think that Motion Offense's
10:51 9 infringement theory is, let's say, more generous,
10:51 10 includes more things than I think it should. So it
10:51 11 certainly would include Dropbox 2011.

10:51 12 Q. So Dropbox 2011 and Dropbox 2011 AirDropper
10:51 13 invalidate all of the Motion Offense asserted claims,
10:51 14 right?

10:51 15 A. Yes. Regardless of the priority date of the
10:52 16 claims.

10:52 17 Q. And so then when we're talking about Dropbox
10:52 18 2017, what did you do when you analyzed whether there
10:52 19 would be invalidity of the claims?

10:52 20 A. I had to use their infringement theory to do
10:52 21 that.

10:52 22 Q. And you applied their infringement theory when
10:52 23 you were analyzing Dropbox 2017 against the claims; is
10:52 24 that right?

10:52 25 A. Yes.

10:52 1 Q. We talked about Dropbox 2017. You analyzed
10:52 2 the source code and identified the Dropbox source code
10:52 3 files that evidenced the presence of everything Dr. Akl
10:52 4 pointed to for infringement in Dropbox prior to
10:52 5 October 3rd, 2017; is that right?

10:52 6 A. Yes.

10:52 7 Q. And do you remember Dr. Akl saying a couple of
10:52 8 days ago that Dropbox's source code isn't publicly
10:52 9 available?

10:52 10 A. Yes.

10:52 11 Q. Do you agree with him on that?

10:52 12 A. Some of it. So we've been using the term
10:53 13 "source code" kind of loosely during this trial.

10:53 14 So there's source code that's actually written
10:53 15 by programmers. It runs on -- some of it runs on
10:53 16 Dropbox servers. That code is secret.

10:53 17 There's other source code that we've been
10:53 18 using that term to apply to the material like
10:53 19 JavaScript that's sent down to a user's computer.
10:53 20 That, of course, is not secret because anything that's
10:53 21 sent to your computer, you can look at. And so there
10:53 22 is some source code that is secret.

10:53 23 What's going on here with 2017 is we don't
10:53 24 have photographs of the actual interfaces from 2017.
10:53 25 So in order to prove the 2017 behaved the same way as

10:53 1 2021, I had to look at the source code to do that.

10:53 2 Q. Does the fact that the Dropbox source code on
10:53 3 the Dropbox servers isn't available to the public mean
10:53 4 that Dropbox 2011 or Dropbox 2011 AirDropper or Dropbox
10:54 5 2017 is not available to the public?

10:54 6 A. No. So if you look at the claims, the claims
10:54 7 recite various behaviors. For example, sending an
10:54 8 e-mail message and responding to a click in an e-mail
10:54 9 message. All of that behavior can be observed by
10:54 10 somebody who's a user of Dropbox. You don't have to
10:54 11 look at the secret code in the server to determine that
10:54 12 those things are happening.

10:54 13 MR. LANTIER: If we could turn to the
10:54 14 next slide, Slide 170.

15 BY MR. LANTIER:

10:54 16 Q. This is really just to reorient us.

10:54 17 Can you explain what you're showing here in
10:54 18 this invalidity flowchart?

10:54 19 A. Yes. So there are two questions to be
10:54 20 answered. The first one is in the top left blue box.
10:54 21 Does Dropbox 2011 or Dropbox 2011 AirDropper meet all
10:54 22 the claim elements?

10:54 23 I think so, and I think I showed that. And if
10:54 24 the answer is yes, then all the claims are invalid over
10:54 25 those two references.

10:54 1 If the jury doesn't agree and doesn't think
10:54 2 that Dropbox 2011 or Dropbox 2011 AirDropper meet all
10:55 3 the claim elements, then we follow the "no exit" from
10:55 4 that box. And then we have to ask the question,
10:55 5 whether the priority date should be backdated to 2012.

10:55 6 If the answer to that is no, that means
10:55 7 they're only entitled to 2017, and then Dropbox 2017
10:55 8 invalidates everything.

10:55 9 And there's another output which I haven't
10:55 10 shown on the bottom here, which is if the priority date
10:55 11 shouldn't be backdated, then the jury can find that
10:55 12 Motion Offense wins. It's a possibility.

10:55 13 Q. Could we turn to one more topic just for a
10:55 14 couple of minutes?

10:55 15 Are you familiar with a term that is used in
10:55 16 the patent field that is "commercial success"?

10:55 17 A. Yes.

10:55 18 Q. And what does "commercial success" refer to?
10:55 19 What's it relevant to?

10:55 20 A. It's relevant to whether an invention was
10:55 21 obvious or not. The general concept is that if you
10:55 22 achieve great commercial success with an invention,
10:56 23 then other people, if they had thought of your
10:56 24 invention, they could have obtained commercial success
10:56 25 also.

10:56 1 And the fact that they didn't means it wasn't
10:56 2 obvious to them to do it. So commercial success is
10:56 3 evidence of nonobviousness.

10:56 4 Q. And has Dr. Akl identified or set forth some
10:56 5 opinions that commercial success is relevant to
10:56 6 obviousness in this case?

10:56 7 A. Yes. He did.

10:56 8 Q. Now, Mr. Belanger talked about commercial
10:56 9 success a little bit yesterday.

10:56 10 Do you remember that?

10:56 11 A. Yes.

10:56 12 Q. And he sort of showed how Dropbox was very
10:56 13 successful prior to even 2012.

10:56 14 Do you remember that?

10:56 15 A. Yes.

10:56 16 Q. Can you explain how that fact is relevant to
10:56 17 how the jury ought to consider any arguments about
10:56 18 commercial success here?

10:56 19 A. Okay. So it's clear -- and there was some
10:56 20 discussion of the Crunchies and the Webby awards --
10:56 21 that Dropbox was lauded even prior to 2012. It had
10:57 22 achieved, you know, tens of millions of users by that
10:57 23 time and was commercially successful.

10:57 24 What I think Motion Offense is trying to argue
10:57 25 that the commercial success of Dropbox somehow applies

10:57 1 to Motion Offense and indicates that Motion Offense's
10:57 2 inventions weren't obvious. I don't really get the
10:57 3 argument.

10:57 4 Q. Well, do you agree with that?

10:57 5 A. No. Of course not, because this all happened
10:57 6 before any of Motion Offense's patents were filed.

10:57 7 Q. So in other words, the success of Dropbox
10:57 8 can't be tied to anything that we've heard from the
10:57 9 Motion Offense witnesses this week.

10:57 10 Is that what you're saying?

10:57 11 A. Well, it can't be tied to anything about the
10:57 12 patents that weren't even filed until after the
10:57 13 commercial success occurred.

10:57 14 Q. And, again, we see here a set of awards that
10:57 15 Dropbox had earned prior to 2012; is that right?

10:58 16 A. Yes.

10:58 17 Q. Now, finally, Professor Shamos --

10:58 18 A. One exception. So on the bottom right, it is
10:58 19 2012. But it's prior to the filing of the patent
10:58 20 applications.

10:58 21 Q. Thank you. Thank you for being accurate
10:58 22 there.

10:58 23 The one on the bottom is not prior to 2012. I
10:58 24 misspoke. It's in 2012, but it's February 1st, 2012,
10:58 25 which is before September 25th, 2012, right?

10:58 1 A. Yes.

10:58 2 Q. Okay. Now, if we could just turn to the very
10:58 3 last slide here.

10:58 4 Could you summarize for the ladies and
10:58 5 gentlemen of the jury the conclusions that you reached
10:58 6 based on all of the evidence that you have reviewed?

10:58 7 A. Okay. Motion Offense, in my opinion, is not
10:58 8 entitled to a 2012 priority date for the reasons that I
10:58 9 explained this morning.

10:58 10 Dropbox 2011 invalidates all the folder
10:58 11 sharing claims for reasons I gave yesterday.

10:58 12 Under Motion Offense's infringement theory, if
10:59 13 you believe that, then Dropbox 2017 invalidates all the
10:59 14 folder sharing claims if they're not entitled to a 2012
10:59 15 date.

10:59 16 Dropbox 2011 AirDropper invalidates all the
10:59 17 file request claims.

10:59 18 And under Motion Offense's infringement
10:59 19 theory, if they are not entitled to a 2012 date, then
10:59 20 Dropbox 2017 also invalidates all the file request
10:59 21 claims.

10:59 22 Q. One last question. And this is specific to
10:59 23 Dropbox 2017.

10:59 24 Did Dr. Akl identify any claim limitations of
10:59 25 any of the asserted claims that he said are not present

10:59 1 in Dropbox 2017?

10:59 2 A. No.

10:59 3 Q. Okay. Thank you.

10:59 4 MR. LANTIER: I pass the witness.

5 MR. DEVLIN: Few minutes to get set up,
6 Your Honor?

7 THE COURT: Sure.

8 MR. DEVLIN: Thank you.

9 May it please the Court.

10 THE COURT: Yes, sir.

10:59 11 CROSS-EXAMINATION

10:59 12 BY MR. DEVLIN:

11:01 13 Q. Dr. Shamos, I don't know if we've met before
11:01 14 but not during this case, right?

11:01 15 A. Certainly not during this case. I don't think
11:01 16 we met before.

11:01 17 Q. Probably not. But thank you for being here.

11:01 18 A. One of us would remember the other.

11:01 19 Q. Probably. Pleasure to meet you. Thanks for
11:01 20 being here.

11:01 21 Now, you're a lawyer?

11:02 22 A. I am.

11:02 23 Q. You've been -- you actually practiced law full
11:02 24 time for eight years or so?

11:02 25 A. Yes.

11:02 1 Q. And you've practiced part time for decades?

11:02 2 A. Yes.

11:02 3 Q. Okay. So you know a lot about the legal
11:02 4 standards and Patent Office procedures and so forth
11:02 5 that'll help us along the way during this examination,
11:02 6 right?

11:02 7 A. Yes.

11:02 8 Q. Okay. Great.

11:02 9 And one of the things we know is that, at
11:02 10 least with respect to one of the patents here, really
11:02 11 kind of all of them, but the Patent Office had a
11:02 12 boatload of information about Dropbox when they were
11:02 13 reviewing these applications that led to these patents,
11:02 14 right?

11:02 15 A. No. I think they may have had a boatload for
11:02 16 the '215 patent.

11:02 17 Q. Great. Let's talk about that.

11:02 18 They had a boatload of information about
11:02 19 Dropbox, and particularly Dropbox 2011 and so -- and
11:02 20 earlier when they were examining and allowing the
11:02 21 claims of the '215 patent, right?

11:02 22 A. Yes.

11:02 23 Q. Okay. Let's talk about how that happened,
11:02 24 because it's kind of an odd occurrence.

11:02 25 What happened was there were -- there was a

11:03 1 case filed. And of the patents that were originally
11:03 2 filed, only three of the four patents that are here in
11:03 3 this trial were in that first case, right?

11:03 4 A. Yes.

11:03 5 Q. Okay. And while that was going on, the
11:03 6 application that became the '215 patent was still
11:03 7 pending in the Patent Office, right?

11:03 8 A. Yes.

11:03 9 Q. Okay. And then at some point as part of the
11:03 10 procedures in the case, Dropbox and its lawyers prepare
11:03 11 a big set of materials that lay out why they think the
11:03 12 patent claims that are asserted are invalid, right?

11:03 13 A. Yes.

11:03 14 Q. And that's called the "invalidity
11:03 15 contentions," correct?

11:03 16 A. Yes.

11:03 17 Q. Okay. And at that time, the '215 patent was
11:03 18 still pending as an application in the Patent Office,
11:03 19 right?

11:03 20 A. Yes.

11:03 21 Q. Okay. And now, it took some time for these
11:03 22 contentions to get to the prosecuting attorneys. It's
11:03 23 two different sets of attorneys.

11:03 24 But eventually, the prosecuting lawyers who
11:03 25 were working on the application of the '215 submitted

11:04 1 all this stuff, everything that was public, to the
11:04 2 Patent Office, right?

11:04 3 A. Yes.

11:04 4 Q. Okay. And, in fact, at that time, what was
11:04 5 about to become the '215 patent had been granted and
11:04 6 the only thing that remained was paying an issue fee,
11:04 7 and then it's going to issue as a patent.

11:04 8 This was right before this submission takes
11:04 9 place, right?

11:04 10 A. Yes.

11:04 11 Q. And Motion Offense and its lawyers said, wait.
11:04 12 Stop. Do not issue this patent yet. We have a lot
11:04 13 more information for you to review.

11:04 14 And they submitted all of it, right?

11:04 15 A. I don't think they said, stop. I think they
11:04 16 submitted an information disclosure statement revealing
11:04 17 this prior art.

11:04 18 Q. Well, you know that they pulled the patent
11:04 19 from granting an issuance. There's a special procedure
11:04 20 that happens when you submit that information
11:04 21 disclosure statement with all the materials when a
11:04 22 patent's already been -- or when the application's
11:04 23 already been granted, right?

11:04 24 A. Yes.

11:04 25 Q. Okay. So in that sense, that's what I mean.

11:04 1 They followed that procedure.

11:04 2 They halted the issuance and had the examiner
11:04 3 go back and look at all this stuff, right?

11:04 4 A. Yes.

11:04 5 Q. Okay. And you know that it wasn't just -- so
11:04 6 there were a lot of documents that were cited in these
11:05 7 infringement contentions that had been provided from
11:05 8 Dropbox and its lawyers to Motion Offense.

11:05 9 There were a lot of different documents and
11:05 10 materials cited, right?

11:05 11 A. Yes.

11:05 12 Q. Okay. And one of the things we hear sometimes
11:05 13 is that, you know what? You've just flooded the
11:05 14 examiner with a bunch of information. It's just a pile
11:05 15 and pile of documents. There's no way they can
11:05 16 reasonably go through that and ascertain what's in
11:05 17 there and how it applies to the claims.

11:05 18 You've heard that argument before, right?

11:05 19 A. Yeah. I think it applies in this case.

11:05 20 Q. Except one thing happened. Motion Offense
11:05 21 also submitted the actual charts themselves, the
11:05 22 roadmap that the defendants provided that supposedly
11:05 23 makes the claims invalid based on all this pile of
11:05 24 information.

11:05 25 A. Yes. They --

11:05 1 Q. You know that?

11:05 2 A. Yes. They did. And they were tens of
11:05 3 thousands of pages long.

11:05 4 Q. These are the contentions. Look about right?

11:05 5 A. Can't tell.

11:06 6 Q. Well, okay. I'm going to tell you they are.

11:06 7 I spared some trees here, so we only have one copy of
11:06 8 this. So if you want to look it, we can.

11:06 9 I'm not going to go through it in detail with
11:06 10 you --

11:06 11 A. Fine.

11:06 12 Q. -- except maybe one of these tabs or
11:06 13 something. But if you ever want to see it, fire away.

11:06 14 But this is the contentions that were
11:06 15 submitted.

11:06 16 And the contentions, what they are is in the
11:06 17 form of charts, claim charts we call them, right?

11:06 18 A. Yes.

11:06 19 Q. Okay. And what a claim chart is is it lines
11:06 20 up the words and phrases and elements of the claim with
11:06 21 the evidence that is asserted to invalidate the claim
11:06 22 line-by-line, element-by-element, right?

11:06 23 A. Yes.

11:06 24 Q. Just like we've been doing here. Just like
11:06 25 Dr. Akl said, here's a claim element; here's the

11:06 1 evidence that relates to that and so forth.

11:06 2 And you did the same thing, here's the claim
11:06 3 element, evidence, element, evidence, right?

11:06 4 A. Yes.

11:06 5 Q. That's how claim charts are set up?

11:06 6 A. Yes.

11:06 7 Q. Okay. And that's what was submitted to the
11:06 8 Patent Office, this roadmap of how this massive pile of
11:06 9 information and documents supposedly renders the claims
11:07 10 invalid based on Dropbox and some other things going
11:07 11 on, right?

11:07 12 A. Yes.

11:07 13 Q. Okay. Thank you.

11:07 14 Now, you knew all this when you rendered your
11:07 15 report, right?

11:07 16 A. Yes.

11:07 17 Q. Okay. We didn't hear about it here yet until
11:07 18 now?

11:07 19 A. We didn't hear about what?

11:07 20 Q. All of this submission to the Patent Office
11:07 21 and the roadmap going to them?

11:07 22 A. That's right.

11:07 23 Q. Okay. Thank you.

11:07 24 And we can tell some of the things that the
11:07 25 Patent Office looked at by looking at the face of the

11:07 1 patent itself, right?

11:07 2 A. Yes.

11:07 3 Q. Okay. And so just to actually finish our
11:07 4 story, the examiner looked at all this information and
11:07 5 you know -- you read the prosecution history, right?

11:07 6 A. Yes. I'm not agreeing with your statement
11:07 7 that he looked at all the information.

11:07 8 Q. Well, that's where I'm getting at.

11:07 9 A. Yeah.

11:07 10 Q. You read the prosecution history?

11:07 11 A. Yes.

11:07 12 Q. And that weird word "prosecution history" is
11:07 13 the written record of the back and forth between the
11:07 14 applicant and the patent examiner, right?

11:07 15 A. Yes.

11:07 16 Q. Okay. And you saw the IDS, the Information
11:08 17 Disclosure Statement, that was submitted by Motion
11:08 18 Offense to the examiner with all this stuff, right?

11:08 19 A. Yes.

11:08 20 Q. And you know the examiner wrote at the bottom:
11:08 21 The examiner has reviewed all this unless I've struck
11:08 22 it out, right?

11:08 23 A. He did say that.

11:08 24 Q. Okay. And he didn't strike out anything, did
11:08 25 he?

11:08 1 A. No.

11:08 2 Q. In particular, he didn't strike out the
11:08 3 contentions. It's written in there.

11:08 4 And right in that page, it says: The examiner
11:08 5 reviewed this unless I struck it, right?

11:08 6 A. Yes.

11:08 7 Q. Okay. Thank you.

11:08 8 Now, let's look at the patent real quick. And
11:08 9 we can look at the '215 patent, which then did issue
11:08 10 after this submission.

11:08 11 It was regranted and issued obviously as the
11:08 12 '215, right?

11:08 13 A. Yes.

11:08 14 Q. And by the way, I'm going a little fast today
11:08 15 because we have some time limitations. I will keep an
11:08 16 eye out in case someone flags me that I'm talking too
11:08 17 fast. And I'm going to try to move a little more
11:08 18 quickly, so I appreciate you bearing with me on that.

11:09 19 So if we look on the '215 patent, and it's on
11:09 20 the screen now.

11:09 21 MR. DEVLIN: And, Mr. Gooden, if we could
11:09 22 pull up the right-hand column, there's a -- the
11:09 23 right-hand column near the top, it says "References
11:09 24 Cited," and then it says "U.S. Patent Documents."

11:09 25 Yeah. Pull that up. And go down a

11:09 1 little further.

11:09 2 If you can stretch down and get the
11:09 3 foreign patent documents and other publications. I'm
11:09 4 sorry. Leave it there.

11:09 5 Perfect. Awesome. Thank you.

11:09 6 BY MR. DEVLIN:

11:09 7 Q. So what happens is once the patent issues on
11:09 8 the -- in the patent itself, starting on the cover
11:09 9 page, it identifies the references cited.

11:09 10 And that's all the information the examiner
11:09 11 looked at during the application process, right?

11:09 12 A. Correct.

11:09 13 Q. Okay. And it has U.S. Patent Documents, it
11:09 14 has foreign patent documents and it has other
11:09 15 publications.

11:09 16 Do you see that?

11:09 17 A. Yes.

11:09 18 Q. And here we see a couple of things that the
11:09 19 Patent Office, the examiner, reviewed.

11:09 20 Do you see that?

11:09 21 A. Yes.

11:09 22 Q. Of course, each one says "continued."

11:09 23 So we're going to look at the next page and so
11:09 24 forth, right?

11:10 25 A. Yes.

11:10 1 Q. Okay.

11:10 2 MR. DEVLIN: So if we go to the next
11:10 3 page, Mr. Gooden.

11:10 4 BY MR. DEVLIN:

11:10 5 Q. Now, we're continuing with this list of stuff.
11:10 6 And after a little bit of verbiage, you see on the
11:10 7 left-hand side, about halfway down, it says "U.S.
11:10 8 Patent Documents."

11:10 9 Do you see that?

11:10 10 A. Yes.

11:10 11 Q. And that's going to be the listing of all the
11:10 12 patents and published patent applications that the
11:10 13 examiner reviewed as part of the process, right?

14 A. Right.

11:10 15 Q. Okay. Great.

11:10 16 And if you look -- boy. Okay.

11:10 17 MR. DEVLIN: It is -- if you go to the
11:10 18 right of where you're highlighted, Mr. Gooden.

11:10 19 Yeah. And then grab -- starting in that
11:10 20 column, I want to take about 10 or 12 documents up from
11:10 21 where you are.

11:10 22 Yeah. Perfect. Yep. Pull that up.

11:10 23 Excellent. Thank you.

11:10 24 BY MR. DEVLIN:

11:10 25 Q. Okay. So now about seven or six items down,

11:10 1 there's a 8,825,597 patent.

2 Do you see that?

3 A. Yes.

11:10 4 Q. And that's to Houston, et al.?

11:10 5 Do you see that?

11:10 6 A. Yes.

11:10 7 Q. That's the Houston patent, that's Mr. Houston,
11:11 8 who's the founder of Dropbox, right?

11:11 9 A. Yes.

11:11 10 Q. And that's the patent that you pointed out in
11:11 11 your examination that said this shows how Dropbox
11:11 12 works, right?

11:11 13 A. Part of how Dropbox works. Yes.

11:11 14 Q. Great.

11:11 15 As of that time, 2011, part of how it works,
11:11 16 right?

11:11 17 A. Yes.

11:11 18 Q. Okay. Great.

11:11 19 And so the examiner had that, right?

11:11 20 A. Yes.

11:11 21 Q. Okay. Thanks.

11:11 22 MR. DEVLIN: You can take that down,
11:11 23 Mr. Gooden.

11:11 24 If you go to the next page.

25 BY MR. DEVLIN:

11:11 1 Q. Okay. And here on the right-hand column -- so
11:11 2 we're still in U.S. Patent Documents. We got pages --
11:11 3 two pages now, four columns, of just U.S. Patent
11:11 4 Documents, right?

11:11 5 A. Yes.

11:11 6 Q. Okay.

11:11 7 MR. DEVLIN: And now on the right-hand
11:11 8 column, after that second gap, Mr. Gooden, take about
11:11 9 12 items down from there.

11:11 10 Perfect. Excellent.

11:11 11 BY MR. DEVLIN:

11:11 12 Q. Okay. So if you look about midway through --
11:11 13 if you look on the right-hand side, you see Kirigin,
11:11 14 et al.?

11:11 15 A. Yes.

11:11 16 Q. And that's -- first name, inventor, Kirigin,
11:11 17 and other inventors, right? And that's the '929
11:11 18 application from this person -- I'm not sure if it's a
11:12 19 woman or gentleman, Kirigin, who's the first named
11:12 20 inventor on this patent application.

11:12 21 But do you remember talking about that one?

11:12 22 A. Yes. I think it's a man.

11:12 23 Q. Okay. Thank you.

11:12 24 And so that's one of the things you pointed to
11:12 25 in your direct testimony saying this shows how the

11:12 1 Dropbox system works as of 2010, 2011 because that's
11:12 2 when it was filed, right?

11:12 3 A. In part.

11:12 4 Q. In part. Thank you.

11:12 5 Okay. Great.

11:12 6 But the examiner had that, right?

11:12 7 A. Yes.

11:12 8 Q. And if we look down here, we'll see other
11:12 9 things. There's Kirigin right above it. There's
11:12 10 another application from Mr. Kirigin. And there's
11:12 11 other stuff in and out here of Houston and Kirigin and
11:12 12 so forth, right?

11:12 13 A. Yes.

11:12 14 Q. Thank you.

11:12 15 MR. DEVLIN: Go to the next page.

16 BY MR. DEVLIN:

11:12 17 Q. Okay. Now we're starting to get into -- we
11:12 18 got some foreign patent documents, just a few, and then
11:12 19 we have other publications, right?

11:12 20 A. Yes.

11:12 21 Q. Okay. "Other publications" means things like
11:12 22 articles, videos, anything that's out there, public
11:12 23 basically, that's, you know, in some written or
11:13 24 tangible form that's not a patent, that the Patent
11:13 25 Office just separates them out, right?

11:13 1 A. Yes.

11:13 2 Q. Okay. Great. Thank you.

11:13 3 And one of the items -- so you had talked
11:13 4 about a couple things like -- other things like
11:13 5 something called Egnyte or something and Box.

11:13 6 Remember talking about those as part of the
11:13 7 background?

11:13 8 A. Yes.

11:13 9 Q. Okay.

11:13 10 MR. DEVLIN: And if we pull up just the
11:13 11 second -- the bottom half of the right-hand column,
11:13 12 Mr. Gooden. Just real quick.

11:13 13 Thank you.

11:13 14 BY MR. DEVLIN:

11:13 15 Q. We see a bunch of things that say Egnyte,
11:13 16 Egnyte, Egnyte, Egnyte, Egnyte. See that?

11:13 17 A. Yes.

11:13 18 Q. Okay. So the Patent Office had a lot of
11:13 19 information about this Egnyte thing you mentioned.
11:13 20 Fair?

11:13 21 A. Yes.

11:13 22 Q. Fair?

11:13 23 A. Yes.

11:13 24 Q. Great. Thank you.

11:13 25 MR. DEVLIN: Go to the next page. Pull

11:13 1 up the top half of that. Actually go about top two

11:13 2 thirds, please. Left-hand column. Thank you.

11:13 3 Left-hand column, two thirds of it.

11:13 4 Perfect. Good enough.

11:13 5 BY MR. DEVLIN:

11:13 6 Q. See more Egnyte stuff there, right?

7 A. Yes.

11:13 8 Q. And then we see Flickr, Flickr, Flickr,
11:13 9 Flickr, Flickr. See that, right?

11:13 10 A. Yes.

11:13 11 Q. Flickr was like a photo sharing app?

11:14 12 A. Yes. I used it.

11:14 13 Q. Great. So Patent Office had a lot of
11:14 14 information about that, right?

11:14 15 A. Yes.

11:14 16 Q. Great.

11:14 17 MR. DEVLIN: If you could punch back out,
11:14 18 Mr. Gooden, and then take the bottom third of that
11:14 19 left-hand column.

11:14 20 BY MR. DEVLIN:

11:14 21 Q. And now we start to see things -- see where it
11:14 22 says "House4Sale"?

11:14 23 A. Yes.

11:14 24 Q. That's something -- actually that's about a
11:14 25 Dropbox tip.

1 Do you see that right next to it, Dropbox?

11:14 2 A. Yes.

11:14 3 Q. And then just below that, couple lines down,
11:14 4 we see "Dropbox channel."

11:14 5 Do you see that?

11:14 6 A. Yes.

11:14 7 Q. Uh-huh. And then another one, it says "New
11:14 8 file in your Public folder." We got "New file in your
11:14 9 Public folder" on a Dropbox channel.

11:14 10 See that?

11:14 11 A. Yes.

11:14 12 Q. Okay. So -- and then there's like Kindle
11:14 13 Vision, the way -- the last one at the bottom, "How to
11:14 14 use Dropbox to share a file without installing it."

11:14 15 You see that?

11:14 16 A. Yes.

11:14 17 Q. Okay. So the Patent Office had some
11:14 18 information about Dropbox, right?

11:14 19 A. Yes.

11:14 20 Q. Okay.

11:14 21 MR. DEVLIN: Let's go to the next page.

11:14 22 Thank you, Mr. Gooden.

11:15 23 And if we take the last -- go to the left
11:15 24 column. I'm going to skip a bunch of other stuff on
11:15 25 the top part of that left-hand column. Just take the

11:15 1 last third of that left-hand column, please,
11:15 2 Mr. Gooden.

11:15 3 Excellent. Thank you.

11:15 4 BY MR. DEVLIN:

11:15 5 Q. And now we see more Dropbox stuff. So if we
11:15 6 look at the second -- the last two items here. One's
11:15 7 "About Dropbox - Simplify your life."

11:15 8 See that?

11:15 9 A. Yes.

11:15 10 Q. Dropbox, next one down, "Can I share files
11:15 11 with non-Dropbox users?"

11:15 12 MR. DEVLIN: Mr. Gooden, if you could
11:15 13 punch that out and go to the right-hand column and pull
11:15 14 up the whole first half of that, please.

11:15 15 Great.

11:15 16 BY MR. DEVLIN:

11:15 17 Q. "Dropbox - Features - Simplify your life."

11:15 18 See that?

11:15 19 A. Yes.

11:15 20 Q. "How do I invite team members to my Teams
11:15 21 account?"

11:15 22 Do you see that?

11:15 23 A. Yes.

11:15 24 Q. And Teams is one of those business things
11:15 25 where a lot of people can share a folder and stuff,

11:15 1 right?

11:15 2 A. Yes.

11:15 3 Q. Thanks.

11:15 4 Next one down, "How do I link to files in my
11:15 5 Dropbox?"

11:15 6 See that?

11:15 7 A. Yes.

11:15 8 Q. Next one down, "How do I share folders with
11:15 9 other people?"

11:15 10 That's what this is about, folder sharing,
11:15 11 right?

11:16 12 A. Well, it's about the details of folder
11:16 13 sharing, not just the fact that it exists.

11:16 14 Q. Great. Thank you.

11:16 15 Do you think that that article might have some
11:16 16 details about those few words in its title?

11:16 17 A. It may have some.

11:16 18 Q. Yeah. I would think so. Thank you.

11:16 19 Next one, "Dropbox - Tour - Simple Sharing."
11:16 20 Sharing. See that?

11:16 21 A. Yes.

11:16 22 Q. Okay. Another tour, "What is Dropbox,"
11:16 23 et cetera. Right? And it goes on for a few more. I
11:16 24 won't belabor it.

11:16 25 MR. DEVLIN: Thank you, Mr. Gooden. You

11:16 1 can take that down.

2 BY MR. DEVLIN:

11:16 3 Q. So the Patent Office had all this information?

11:16 4 A. Yes.

11:16 5 Q. And it allowed the '215 patent, which includes

11:16 6 one of the claims that you say is invalid based on

11:16 7 information on Dropbox 2011?

11:16 8 A. Yes.

11:16 9 Q. Fair summary?

11:16 10 Thank you.

11:16 11 A. Yes.

11:16 12 Q. Okay. Let's talk a little bit --

11:16 13 MR. DEVLIN: Thank you, Mr. Gooden.

11:16 14 BY MR. DEVLIN:

11:16 15 Q. Let's talk a little bit about just one or two

11:16 16 of the -- of the components of your actual analysis.

11:17 17 Okay?

11:17 18 For a time, we'll just hit -- we'll do one on,

11:17 19 say, the folder share claims or maybe one on the -- on

11:17 20 the file request deadline stuff. But -- anyway, here

11:17 21 we go.

11:17 22 So let's talk about representations. I want

11:17 23 to understand your opinion. Now, I think I heard

11:17 24 something yesterday, and I do want to clean it up.

11:17 25 Tell me if I didn't hear this or if I'm

11:17 1 mischaracterizing you. But I think I heard you say at
11:17 2 one point that even when a file is downloaded in
11:17 3 Dropbox, it's still just a representation?

11:17 4 A. No.

11:17 5 Q. Did you say that?

11:17 6 A. No. I didn't.

11:17 7 Q. Okay. Great.

11:17 8 Can we agree that when -- the representation
11:17 9 that we're talking about here is when the user can see
11:17 10 the file, but it hasn't been downloaded, fair?

11:17 11 A. No. That's not what it means.

11:17 12 Q. Okay. So tell me -- I don't want to go too
11:17 13 broad into left field, but let me try it -- so let me
11:18 14 try another question.

11:18 15 We can agree that the desktop app of
11:18 16 Dropbox -- so not the mobile, the desktop app as of
11:18 17 2011, that did not have representations.

11:18 18 Would you agree with that?

11:18 19 A. No.

11:18 20 Q. Okay. So you're saying that even the desktop
11:18 21 app in 2011 has representations?

11:18 22 A. Yes. I showed them.

11:18 23 Q. Okay. And are those representations
11:18 24 downloaded only when the user interacts with a file?

11:18 25 A. No.

11:18 1 Q. So -- hold on, hold on, hold on.

11:18 2 What was the answer?

11:18 3 A. The answer is no.

11:18 4 Q. Thank you.

11:18 5 Okay. And that's --

11:18 6 A. Maybe I didn't hear the question. What was
11:18 7 the question?

11:18 8 Q. Yeah. That in 2011 Dropbox, the desktop app,
11:18 9 the system doesn't wait for the user to interact with
11:18 10 something and select it before it downloads it, right?

11:18 11 A. That's true. But that does not relate to the
11:18 12 representation.

11:18 13 Q. Okay.

11:18 14 MR. DEVLIN: Motion to -- as
11:18 15 nonresponsive on everything after the "that's true,"
11:19 16 Your Honor.

11:19 17 THE COURT: I'll sustain it.

11:19 18 MR. DEVLIN: Thank you.

11:19 19 BY MR. DEVLIN:

11:19 20 Q. So -- okay. And I just want to clear this up.

11:19 21 We can agree that the way that 2011 worked on
11:19 22 the desktop was that when you shared a folder with
11:19 23 someone that contained files and the user accepted that
11:19 24 folder, those files came down automatically, right?

11:19 25 A. Yes.

11:19 1 Q. Okay. And are you saying that meets the
11:19 2 elements of the claims of the representation in these
11:19 3 patents?

11:19 4 A. It's the representation -- no.

11:19 5 Q. I'm sorry. Yes or no --

11:19 6 A. No.

11:19 7 Q. -- are you saying --

11:19 8 THE COURT: Counsel. Counsel. Counsel.

11:19 9 MR. DEVLIN: Thank you.

11:19 10 THE COURT: You don't get to tell him yes
11:19 11 or no. Just ask your question.

11:19 12 MR. DEVLIN: Thank you, Your Honor.

11:19 13 BY MR. DEVLIN:

11:19 14 Q. So are you saying that that process of
11:19 15 automatic downloading with the desktop app of Dropbox
11:19 16 in 2011 meets all the requirements of the claims here
11:19 17 with respect to the representation and how it works and
11:19 18 the selective downloading?

11:19 19 A. The desktop app didn't synchronize. The
11:20 20 desktop app --

11:20 21 THE COURT: Now, here's the trade-off,
11:20 22 Doctor. He asked you a question that's entitled to a
11:20 23 direct answer, and you need to give him a direct
11:20 24 answer.

11:20 25 THE WITNESS: Oh. So --

11:20 1 BY MR. DEVLIN:

11:20 2 Q. I'll try it again.

11:20 3 A. Give me the question again.

11:20 4 Q. Sure. Sure. I'll try again.

11:20 5 Are you saying that the desktop version of
11:20 6 Dropbox in 2011 had the features of the patents related
11:20 7 to representation and the selective download of
11:20 8 documents with user interaction?

11:20 9 A. It had the representations. It didn't have
11:20 10 the selective download.

11:20 11 Q. Okay. Thank you. Okay. We'll leave it at
11:20 12 that.

11:20 13 Let's -- so -- thank you.

11:20 14 So let's talk about mobile stuff in 2011.

11:20 15 Now, I think we can agree that when you -- in
11:21 16 the mobile app for 2011, when you open that app up and
11:21 17 you looked at folder and files, what you're seeing is
11:21 18 what's in the user's Dropbox account, right?

11:21 19 A. Yes.

11:21 20 Q. Okay. Great. Thank you.

11:21 21 Let's look at the claim language of the '215
11:21 22 patent as an example, and we can go to Claim 1.

11:21 23 MR. DEVLIN: I think that's Exhibit 6,
11:21 24 Mr. Gooden, and I believe it's at Page 40.

11:21 25 Little further in. I wasn't even close.

11:21 1 There we go. Thank you.

11:21 2 BY MR. DEVLIN:

11:21 3 Q. All right. Now, just to center ourselves, the
11:21 4 asserted claim of the '215 patent is Claim 18.

11:21 5 Do you remember?

11:21 6 A. Yes.

11:21 7 Q. And that depends on this Claim 1, so we're
11:21 8 looking at the Claim 1, right?

11:21 9 A. Yes.

11:21 10 Q. Okay. And one of the elements is near --

11:21 11 MR. DEVLIN: Yeah. If you can pull that
11:21 12 up, Mr. Gooden.

11:22 13 Sorry. Just where you were, down -- down
11:22 14 one element with your cursor. And then pull up
11:22 15 everything to the bottom.

11:22 16 Perfect. Thank you.

11:22 17 BY MR. DEVLIN:

11:22 18 Q. So we have a causing, and then I'm going to
11:22 19 actually go where it says "cause creation."

11:22 20 Do you see that?

11:22 21 A. Yes.

11:22 22 Q. Okay. And you need to cause a second
11:22 23 representation.

11:22 24 Do you see that?

11:22 25 A. Yes.

11:22 1 Q. And it's a folder among more folders, right?

11:22 2 A. Yes.

11:22 3 Q. Stored at the second node.

11:22 4 That's the recipient user, right?

11:22 5 A. Yes.

11:22 6 Q. Okay. And then here it is: That is

7 displayable --

11:22 8 MR. DEVLIN: Little to the left. Thank
11:22 9 you, Mr. Gooden.

10 BY MR. DEVLIN:

11:22 11 Q. That is displayable via the file explorer
11:22 12 interface of the client-based file explorer
11:22 13 application.

11:22 14 Do you see that?

11:22 15 A. Yes.

11:22 16 Q. Okay. Now, both of those -- there's two terms
11:22 17 here that are introduced by the word "the."

11:22 18 See those?

11:22 19 A. Yes.

11:22 20 Q. And so that's two different features.

11:23 21 They have "the" in front of them, right?

11:23 22 A. Yes.

11:23 23 Q. Okay. And we know that because of that
11:23 24 antecedent basis issue we've been talking about, right?

11:23 25 A. Yes.

11:23 1 Q. Okay. And so what you're saying here is that
11:23 2 the interface in the app, the Dropbox app for mobile
11:23 3 back in 2011, that satisfies both of these two elements
11:23 4 here.

11:23 5 That's what you're saying?

11:23 6 A. Yes.

11:23 7 Q. Okay. Great.

11:23 8 So you're saying not only that there's a file
11:23 9 explorer interface, but there's a client-based file
11:23 10 explorer application, right?

11:23 11 A. Yes.

11:23 12 Q. Okay. Great.

11:23 13 So you know what we're going to -- I'm glad --
11:23 14 I wanted to line that up so we got all that clear, and
11:23 15 then we'll have someone else talk about that in a
11:23 16 little bit, okay?

11:23 17 Thank you.

11:23 18 Let's move on to the -- actually, you know
11:23 19 what, let me do one other thing.

11:23 20 MR. DEVLIN: Could we see -- Mr. Gooden,
11:23 21 do you have the demonstrative exhibits?

11:23 22 Thank you, sir.

11:23 23 Could you pull those up?

11:23 24 And I'd like to go to Demonstrative
11:23 25 Exhibit 58, 5-8, please.

11:24 1 BY MR. DEVLIN:

11:24 2 Q. So, Dr. Shamos, we're putting up your --

11:24 3 MR. DEVLIN: Oh, I think I got that

11:24 4 wrong, Mr. Gooden.

11:24 5 Could we go back and forward a second.

11:24 6 My apologies. Thank you.

11:24 7 One more from there. One more from

11:24 8 there, Mr. Gooden. I'm not sure how I got that wrong.

11:24 9 I'm sorry. Thank you. 47.

11:24 10 There we go. Excellent. Okay.

11:24 11 Go back one slide from here, Mr. Gooden,
11:24 12 please.

11:24 13 Thank you.

14 BY MR. DEVLIN:

11:24 15 Q. Okay. So this is where you're walking through
11:24 16 the evidence -- I'm sorry for that delay.

11:25 17 This is where you're walking through the
11:25 18 evidence of Dropbox 2011, and you're comparing it to
11:25 19 the '215 patent, Claim 1, right?

11:25 20 A. Yes.

11:25 21 Q. Okay. And some of the elements, you had
11:25 22 already done with respect to an earlier claim, right?
11:25 23 Some of the features and elements?

11:25 24 A. Yes.

11:25 25 Q. Okay. And as we're -- as we're looking here,

11:25 1 what you would do is you'd have the element, and you
11:25 2 got the evidence underneath it there, right?

11:25 3 A. Yes.

11:25 4 Q. Okay.

11:25 5 MR. DEVLIN: Let's go to the next slide.

6 BY MR. DEVLIN:

11:25 7 Q. So this is the claim language we were just
11:25 8 looking at in the patent.

11:25 9 And now, I -- this is what we received of a
11:25 10 copy of this. I'm pretty sure that when you first
11:25 11 looked at this slide, you didn't have this evidence
11:25 12 here.

11:25 13 You were looking at the claim language, right?

11:25 14 A. This is an animation. And so when you PDF it,
11:25 15 everything that's animated gets overlaid with
11:25 16 everything.

11:25 17 Q. That's what I'm saying. There's nothing -- I
11:25 18 want to make that very clear. Nothing nefarious is
11:25 19 going on here.

11:25 20 This is -- we just got a static slide, and you
11:25 21 had an active slide, right? Something that could
11:26 22 change and move, right?

11:26 23 A. Yes. I actually don't know what you got.

11:26 24 Q. We got this. So tell --

11:26 25 A. I believe you.

11:26 1 Q. Okay. Great.

11:26 2 And -- but the point is, so you did some work.
11:26 3 You looked at the Claim 1 of the '215, and you were
11:26 4 looking at the Claim 3 of the '158 patent, and you were
11:26 5 comparing those a little bit, right?

11:26 6 A. Yes.

11:26 7 Q. Okay. But when you -- it just so happened
11:26 8 that when you put the actual evidence up for the '215,
11:26 9 Claim 1, it blocked out the actual claim language.

11:26 10 A. Yeah. But you know what the claim language
11:26 11 is. You have the patent.

11:26 12 Q. Okay. But the -- I hear you.

11:26 13 But when it's on the screen and you're looking
11:26 14 at both, it happened to get blocked out, fair?

11:26 15 A. On that screen, they're blocked out, sure.

11:26 16 Q. Thank you. Okay.

11:26 17 MR. DEVLIN: Take that down, Mr. Gooden.

11:26 18 BY MR. DEVLIN:

11:26 19 Q. Let's talk about this deadline thing.

11:27 20 Now, we heard a couple things about the
11:27 21 deadline. I think some of the fact witnesses that we
11:27 22 heard talked about a deadline feature that was in
11:27 23 Dropbox itself, where you had a text box you can -- you
11:27 24 can write some stuff into. And when you were sharing a
11:27 25 folder, tell people, hey. I'd like some stuff. Give

11:27 1 me some files.

11:27 2 Remember that?

11:27 3 A. Yes. In 2011. Yes.

11:27 4 Q. In 2011. Right.

11:27 5 Now, that -- writing that in there doesn't
11:27 6 enforce any controls in the system, right?

11:27 7 It doesn't lock the system down after some
11:27 8 date that someone happened to put in to their -- that
11:27 9 little text box, right?

11:27 10 A. That's true.

11:27 11 Q. Okay. Great.

11:27 12 And so what you're looking at when it comes to
11:27 13 the deadline issue is this AirDropper thing, right?

11:27 14 A. Yes.

11:27 15 Q. Okay. Great.

11:27 16 MR. DEVLIN: And so if we could pull up
11:27 17 Demonstrative Slide 59, and I really hope that's the
11:27 18 right number.

11:28 19 Good.

20 BY MR. DEVLIN:

11:28 21 Q. This is a slide you put up?

11:28 22 A. Yes.

11:28 23 Q. Great.

11:28 24

11:28 25

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MR. LANTIER: Your Honor, I apologize for

11:28

4

the interruption. I think, because this is the

11:28

5

AirDropper source code, we probably should seal the

11:28

6

courtroom.

11:28

7

THE COURT: Very good.

11:28

8

(Sealed proceedings.)

9

MR. DEVLIN: I think this will be five

10

minutes or less, Your Honor.

11:28

11

Let's put that back up, Mr. Gooden.

11:28

12

Thanks so much.

13

BY MR. DEVLIN:

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11:30	19	[REDACTED]	
11:30	20	[REDACTED]	
11:30	21	[REDACTED]	[REDACTED]
11:31	22	[REDACTED]	[REDACTED]
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11:31 6

Q. Thank you.

11:31 7

11:31 8

11:31 9

11:31 10

We'll talk about a few quick issues just so we're on the same page on some points that might be floating out there that I think you can help us with based on your particular expertise.

11:31 11

A. If I can.

11:31 12

Q. We'll do our best.

11:31 13

11:31 14

So one of the things we were looking at is Dropbox patents, right?

11:31 15

A. Yes.

11:31 16

11:31 17

11:31 18

Q. And your contention -- we're not quibbling with it -- is that those patents demonstrate features of the Dropbox service at some point in time, right?

11:32 19

11:32 20

11:32 21

MR. LANTIER: I again apologize for interrupting, Your Honor. I believe we can now reopen the courtroom.

11:32 22

11:32 23

MR. DEVLIN: I gave them a five-minute -- I thought they'd wander back in, but...

09:42 24

(Sealed proceedings end.)

11:32 25

BY MR. DEVLIN:

11:32 1 Q. Okay. So let's talk about these patents.

11:32 2 So what I'm getting at is this notion -- I
11:32 3 want to make it very clear for everybody. The fact
11:32 4 that Dropbox has its own patents that cover aspects and
11:32 5 features of its service doesn't negate infringement if
11:32 6 they're actually using Mr. Morris' patented inventions,
11:32 7 right?

11:32 8 A. Right.

11:32 9 Q. Okay. So to be clear, what I'm saying is,
11:32 10 just because they have their own patents, the question
11:32 11 of whether they're infringing Mr. Morris' patents is
11:32 12 independent of that, right?

11:32 13 A. Yes.

11:32 14 Q. All that matters for infringement is that the
11:32 15 Dropbox service meets every element of these asserted
11:32 16 patent claims, correct?

11:32 17 A. If they're valid. Yes.

11:32 18 Q. If they're valid. Good point.

11:32 19 And if it does that for valid patent claims,
11:33 20 that's infringement, and it doesn't matter how many
11:33 21 patents Dropbox has that also might cover various
11:33 22 features and components of its system, fair?

11:33 23 A. That's right.

11:33 24 Q. Thank you. Glad we cleared that up.

11:33 25 Another thing that's been hovering around in

11:33 1 this case is this issue of abandonment of those
11:33 2 original 2012 applications.

11:33 3 You've heard that, right?

11:33 4 A. Yes.

11:33 5 Q. And let's just ask you. That happens
11:33 6 regularly in prosecution of patent applications, people
11:33 7 file continuing applications, and they let the earlier
11:33 8 application go abandoned because they got the new one
11:33 9 on file, right?

11:33 10 A. Yes.

11:33 11 Q. Okay. Nothing wrong with that, right?

11:33 12 A. Right.

11:33 13 Q. Exactly. Happens all the time.

11:33 14 And importantly, it doesn't mean that the
11:33 15 inventor has abandoned the invention or the ideas.
11:33 16 They've just carried on the prosecution of those in a
11:33 17 new application or applications, right?

11:33 18 A. Not really.

11:33 19 Q. Okay. It doesn't mean that the idea is not
11:33 20 worthy of a patent. They're carrying on these ideas in
11:34 21 new applications, right?

11:34 22 A. With different claims.

11:34 23 Q. With different claims. Sometimes. Sometimes
11:34 24 you can actually have a continuation that has the same
11:34 25 claims, right?

11:34 1 A. Yes.

11:34 2 Q. Okay. So you're -- just because you have a
11:34 3 continuation doesn't mean you're abandoning the earlier
11:34 4 original application, right?

11:34 5 A. Right.

11:34 6 Q. Thank you.

11:34 7 Okay. Let's talk about this issue of
11:34 8 priority, right? You with me? This is --

11:34 9 A. I'm right there.

11:34 10 Q. Okay. You're right there.

11:34 11 So -- but for everyone else's lingo, this
11:34 12 issue of priority is whether do these patent claims
11:34 13 that are at issue here, do they obtain the benefit, the
11:34 14 priority of those 2012 applications, right?

11:34 15 A. Yes.

11:34 16 Q. Okay. And your view is they don't. Because
11:34 17 there was new matter added, and the only matter in the
11:34 18 application, the only subject matter, the only text in
11:34 19 the new applications that supports the claims in this
11:35 20 lawsuit comes from those October -- whatever the 2018
11:35 21 applications were.

11:35 22 Do I have you right?

11:35 23 A. I think it was -- yes.

11:35 24 Q. Yeah. Something like that?

11:35 25 A. Right.

11:35 1 Q. Let me -- so when we say something like that,
11:35 2 we're talking about is just that date? We're not sure
11:35 3 of it?

11:35 4 A. Right.

11:35 5 Q. The concept is the same?

11:35 6 Your point is the only text in the
11:35 7 applications that supports the claims in this lawsuit
11:35 8 comes from those 2018 applications that were filed.

11:35 9 That's your opinion?

11:35 10 A. Yes.

11:35 11 Q. Thank you. Okay. Just want to get that out
11:35 12 there so we're clear.

11:35 13 You mentioned with respect to CIP, so there's
11:35 14 continuations, which is where you basically keep the
11:35 15 subject matter the exact same, right?

11:35 16 A. Yes.

11:35 17 Q. And then there's continuations-in-part where
11:35 18 you're adding some new text subject matter in the body
11:35 19 of the application, right?

11:35 20 A. Yes.

11:35 21 Q. Okay. Great.

11:35 22 But part of the thing -- also part of the
11:35 23 requirement for the continuation-in-part is that you're
11:35 24 keeping all or substantially all of the original text
11:36 25 in that same continuing application, right?

11:36 1 A. Yes.

11:36 2 Q. Okay. Thank you.

11:36 3 And that's what happened here, correct?

11:36 4 A. Yes.

11:36 5 Q. Okay. And these patent applicants were very
11:36 6 clear when they were filing a CIP. They didn't try to
11:36 7 hide it. They made it clear that it was a CIP,
11:36 8 continuation-in-part, old subject matter plus new
11:36 9 stuff, right?

11:36 10 A. Yes.

11:36 11 Q. Great. Thank you.

11:36 12 All right. Now, to evaluate the question of
11:36 13 whether the subject matter of these claims today should
11:36 14 obtain the benefit of the 2012 applications, the
11:36 15 analysis that we conduct is a comparison of the claims
11:36 16 today to the text and figures of the 2012 applications,
11:36 17 right?

11:36 18 A. Yes. As I did.

11:36 19 Q. Okay. A lot of the comparison you did was the
11:36 20 text of the claims to the text in the new applications,
11:37 21 right?

11:37 22 A. Not to show that it wasn't invalid.

11:37 23 Q. Sorry. A lot of the comparison that we saw on
11:37 24 the screen --

11:37 25 A. Yeah.

11:37 1 Q. -- was the claims now to the summary of the
11:37 2 invention text in the new applications, right?

11:37 3 A. Yeah. I did that before we went to the
11:37 4 specific claim limitations.

11:37 5 Q. Great. Thank you.

11:37 6 And then we looked a little bit at some of the
11:37 7 text of those early 2012 applications and the figures,
11:37 8 right?

11:37 9 A. Yes.

11:37 10 Q. Okay. But you didn't show, obviously, all of
11:37 11 the text of the 2012 application and figures, right?

11:37 12 A. That's right.

11:37 13 Q. Of course not.

11:37 14 But you know this issue's been addressed
11:37 15 before in a prior proceeding, this issue of priority?
11:37 16 It came up before, right?

11:37 17 A. I've heard that.

11:37 18 Q. Okay. And you know as part of that
11:37 19 proceeding, Motion Offense, in response to someone
11:37 20 else's opinions about it, pointed to specific parts of
11:37 21 the specification that provided -- supports the early
11:38 22 2012 application's specification. Pointed to specific
11:38 23 parts of that --

11:38 24 MR. LANTIER: Your Honor, I object. And
11:38 25 may we approach just so I can understand the parameters

11:38 1 of what's permissible and what's not permissible?

11:38 2 THE COURT: Sure.

11:38 3 (Bench conference.)

11:38 4 MR. LANTIER: Your Honor, he seems to be
11:38 5 going into your early summary judgment decision here
11:38 6 and I just want to make sure that, if he does, we can
11:38 7 make clear that Your Honor said the jury would need to
11:38 8 decide that issue as to whether there's actually
11:38 9 written description support.

11:38 10 MR. DEVLIN: I can shortchange it. So
11:38 11 I'm not going to say anything about the decision or
11:38 12 anything at all.

11:38 13 My only point I'm going to make is that
11:38 14 Motion Offense pointed to specific stuff, and that when
11:38 15 he rendered his opinions here and then he gave his
11:38 16 testimony today, he didn't talk about it. That's all.

11:38 17 THE COURT: I'm not sure why it's
11:38 18 relevant what he didn't talk about that the jury hasn't
11:39 19 seen.

11:39 20 MR. DEVLIN: He -- I mean -- well, the
11:39 21 jury's going to see it. I'm going to show it. But he
11:39 22 ignored it.

11:39 23 THE COURT: If you want to lay the
11:39 24 groundwork, I think what you need to do to make it make
11:39 25 sense is that they're going to see it and that he

11:39 1 didn't look at it. Otherwise you're -- they don't know
11:39 2 what it is you're talking about.

11:39 3 MR. DEVLIN: Oh, I'm going to go right
11:39 4 into it. That's the next step.

11:39 5 MR. LANTIER: I guess the windup here is
11:39 6 kind of a half truth, and so I don't know why we'd say
11:39 7 there was a prior proceeding and identify --

8 (Simultaneous conversation.)

11:39 9 MR. LANTIER: It's a half truth.

11:39 10 MR. DEVLIN: I am not going into it at
11:39 11 all. In fact, I was already past it. My only point
11:39 12 was that Motion Offense made everyone aware that there
11:39 13 were certain things that were important to this issue
11:39 14 and he hasn't talked about them at all. That's it.
11:39 15 That's the next two questions. And then I'm going to
11:39 16 put them on the screen.

11:39 17 THE COURT: I don't think it matters that
11:39 18 you've made them -- I think what -- because they don't
11:39 19 know what you're talking about.

11:39 20 I think what you -- because they're not
11:39 21 going to hear about the prior proceedings.

11:39 22 I think what you have to talk about is
11:39 23 what you anticipate your expert's going to say and
11:40 24 point out that he didn't address them.

11:40 25 MR. DEVLIN: I'm going to put it right on

11:40 1 the screen right now.

11:40 2 THE COURT: If you do it that way, I'm
11:40 3 fine with that.

11:40 4 MR. DEVLIN: Okay. Can I at least say
11:40 5 that he knew about it before I -- I'll do -- I'll put
11:40 6 it on the screen first. I can do that.

11:40 7 MR. LANTIER: I don't think so. I mean,
11:40 8 if we're going to tell the jury he knew about it, we
11:40 9 should explain how he knew about it and that you said
11:40 10 it was a fact issue.

11:40 11 THE COURT: I don't understand what it is
11:40 12 that -- I understand ultimately what you're trying to
11:40 13 accomplish, but I don't understand the way that you're
11:40 14 going about it.

11:40 15 MR. DEVLIN: So I'm going to put this up
11:40 16 on the screen. The only point I was making right now
11:40 17 as a predicate point is that he was aware of this and
11:40 18 ignored it. And that's meaningful to his credibility.

11:40 19 THE COURT: It's only meaningful if
11:40 20 they're going to hear someone else talk about it.
11:40 21 That's what I'm trying to say.

11:40 22 If you'll lay the foundation -- he's read
11:40 23 your expert's report, right?

11:40 24 MR. DEVLIN: He spoke about it. Yes.
11:40 25 He's read the expert report.

11:40 1 THE COURT: And so he knows what's in it.
11:40 2 He knows -- if you want to tether it to what your
11:41 3 expert might say, then I'll allow you to talk about it.

11:41 4 MR. DEVLIN: I'm going to tether it to
11:41 5 what I'm going to cross him on and then the third
11:41 6 question coming out of my mouth. It's going on the
11:41 7 screen, and I'm going to cross him on it. It's going
11:41 8 to be tethered right here.

11:41 9 THE COURT: As long as it's tethered to
11:41 10 what your expert's going to --

11:41 11 MR. DEVLIN: I will say that too. Yes.
11:41 12 Thank you.

11:41 13 MR. LANTIER: Can you just ask the jury
11:41 14 to disregard the question and answer about the prior
11:41 15 proceeding, just because it seems confusing to suggest
11:41 16 that there's some --

11:41 17 THE COURT: They have no idea --
18 (Simultaneous speakers.)

11:41 19 THE COURT: I've been through this.

11:41 20 MR. LANTIER: Okay, Your Honor.

11:41 21 THE COURT: I dismissed a witness because
11:41 22 they said something that really dramatically violated a
11:41 23 MIL. I talked to the jury afterwards, and they had no
11:41 24 idea what it said.

11:41 25 I promise you, you're fine.

11:41 1 MR. LANTIER: Thank you, Your Honor.

11:41 2 MR. DEVLIN: Thank you.

11:41 3 (Bench conference concludes.)

11:41 4 BY MR. DEVLIN:

11:41 5 Q. Okay. So I guess all I'm trying to get at,
11:42 6 sir, is that you were aware that Motion Offense had
11:42 7 pointed to certain disclosures in the patent that
11:42 8 supported -- in the 2012 applications that had
11:42 9 supported these claims, right?

11:42 10 A. You mean in actions with the Court that
11:42 11 occurred --

11:42 12 Q. Just that you're aware of it. That's all I'm
11:42 13 asking.

11:42 14 A. Well, I need to know the time frame.

11:42 15 Q. During this case.

11:42 16 A. And to whom?

11:42 17 Q. So let me shortchange this so we don't brush
11:42 18 up against something we don't want to brush up against.

11:42 19 Let's look at some other disclosures of the
11:42 20 2012 patent application.

11:42 21 MR. DEVLIN: And if we could look at
11:42 22 PTX-1333, please.

11:42 23 1333, Mr. Gooden.

11:43 24 Great. Okay.

25 BY MR. DEVLIN:

11:43 1 Q. So we see this is the declaration cover page,
11:43 2 but this is one of the applications from 2012.

11:43 3 Do you recognize that, sir?

11:43 4 A. Yes.

11:43 5 Q. Yes. Thank you.

11:43 6 Okay. If we could go to -- so how this works
11:43 7 is the application has a lot of text in it. It's got
11:43 8 figures. It's got claims at the time, right?

11:43 9 A. Yes.

11:43 10 Q. All right. So we're going to look at some of
11:43 11 the text here.

11:43 12 By the way, you had looked at some figures and
11:43 13 talked about it, and the issue is that there's this --
11:43 14 as you're saying, the claims, although they don't say
11:43 15 the word "third node," the various functionality within
11:43 16 the claims as it's being applied here basically
11:44 17 requires some functioning third node, right?

18 A. Yes.

11:44 19 Q. Do I have that right?

11:44 20 A. That's right.

11:44 21 Q. Thank you.

11:44 22 And that these patents don't disclose that
11:44 23 concept.

11:44 24 Is that what you're saying?

11:44 25 A. They don't disclose the third node that does

11:44 1 those things.

11:44 2 Q. Got it. Okay. Thank you.

11:44 3 And so you pointed to examples of when there
11:44 4 is some third node, but it kind of just passes things
11:44 5 back and forth, right?

11:44 6 A. Right.

11:44 7 Q. Okay. Thanks.

11:44 8 MR. DEVLIN: So let's look at Paragraph
11:44 9 48, Mr. Gooden. I apologize. I don't have a page
11:44 10 cite, but it's Paragraph 48. I would say go about six,
11:44 11 seven lines in.

12 BY MR. DEVLIN:

11:44 13 Q. Okay. So here -- so we've used the term
11:44 14 "node" and "network node." In the application, it's
11:44 15 giving some information about what that means.

11:45 16 Now, let me get something else clear.

11:45 17 These applications, when we're talking about
11:45 18 this issue of priority and what someone would
11:45 19 understand from that 2012 text, that's done from the
11:45 20 perspective of a person of ordinary skill in the art,
11:45 21 right?

11:45 22 A. Yes.

11:45 23 Q. Okay. And that person has a degree in
11:45 24 computer science or electrical engineering, has a
11:45 25 couple years' experience, right?

11:45 1 A. Yes.

11:45 2 Q. The definition's very little here, but they
11:45 3 all involve somebody who's got some skill in this area
11:45 4 right?

11:45 5 A. Yes.

11:45 6 Q. And so we all know and patent applications are
11:45 7 written in ways where they often lay out various
11:45 8 different options.

11:45 9 Once you talk through an idea some big main
11:45 10 way, you then might have some discussion of other ways
11:45 11 and options that someone could implement those ideas,
11:45 12 right?

11:45 13 A. Yes.

11:45 14 Q. Okay. Great.

11:45 15 So here what the applicant is saying, and this
11:45 16 is Mr. Morris: The terms "network node" and "node" in
11:45 17 this document both refer to a device having -- both of
11:45 18 those refer to a device having a network interface
11:46 19 component for operatively coupling to a network.

11:46 20 So far so good?

11:46 21 A. Sure.

11:46 22 Q. Then it says: Further, the terms "device" and
11:46 23 "node" used herein may refer to one or more devices and
11:46 24 nodes, respectively.

11:46 25 Right?

11:46 1 A. Yes.

11:46 2 Q. Good so far?

11:46 3 A. Yes. And often would.

11:46 4 Q. And then those node or nodes or devices
11:46 5 provide and/or otherwise include an execution
11:46 6 environment.

11:46 7 Do you see that?

11:46 8 A. Yes.

11:46 9 Q. And an execution environment in this patent is
11:46 10 where stuff happens, right?

11:46 11 A. Yes.

11:46 12 Q. There's a processor, there's memory, there's
11:46 13 instructions.

11:46 14 Things happen at an execution environment,
11:46 15 right?

11:46 16 A. Yes.

11:46 17 Q. Okay. Great. Thank you.

11:46 18 MR. DEVLIN: Let's go to Paragraph 73,
11:46 19 Mr. Gooden. It's probably two or three pages in.

11:46 20 And my apologies not having the page
11:46 21 cite.

11:46 22 Great. 73. Pull that up.

11:46 23 Thanks.

11:46 24 BY MR. DEVLIN:

11:46 25 Q. And without going -- the first sentence is

11:47 1 talking about various adaptations and analogs.

11:47 2 Do you see that?

11:47 3 A. Yes.

11:47 4 Q. And that's the lingo in patents for, hey. I'm
11:47 5 going to talk about maybe another way that you can
11:47 6 implement what I've just taught you, person of skill in
11:47 7 the art, right?

11:47 8 A. Yes.

11:47 9 Q. Okay. Great.

11:47 10 MR. DEVLIN: And so if we go to the
11:47 11 second sentence, begins with "for example" on Line 3.

12 BY MR. DEVLIN:

11:47 13 Q. So it says: For example, those skilled in the
11:47 14 art will see, based on the description herein, that
11:47 15 arrangements of components for performing the method
11:47 16 illustrated in Figure 2A and the method illustrated in
11:47 17 Figure 2B may each be distributed across more than one
11:47 18 node and/or execution environment.

11:47 19 Do you see that?

11:47 20 A. Yes.

11:47 21 Q. And to be clear, the method of Figures 2A and
11:47 22 2B, that's the main flowchart in the figures that talks
11:47 23 about the whole folder sharing process, right?

11:47 24 A. Yes.

11:47 25 Q. Okay. Great.

11:47 1 And then it goes on to say: For example, such
11:48 2 arrangements may operate at least partially in a
11:48 3 browser in one execution environment and at least
11:48 4 partially in a server in another execution environment
11:48 5 interoperating via a network.

11:48 6 Did I read that right, sir?

11:48 7 A. Totally.

11:48 8 Q. Okay. And the network, one example of it is
11:48 9 the Internet, right?

11:48 10 A. Yes.

11:48 11 Q. Thank you.

11:48 12 There's other -- without going into them,
11:48 13 there's other words like this in the application that
11:48 14 talk about other embodiments, other examples,
11:48 15 et cetera, right?

11:48 16 A. Yes.

11:48 17 Q. Thank you.

11:48 18 Now, you know also because you're a patent
11:48 19 lawyer -- actually, you're not -- this is a weird
11:48 20 phrase.

11:48 21 You're not only a lawyer, but you're a patent
11:48 22 lawyer?

11:48 23 A. Yes.

11:48 24 Q. You're registered to practice before the
11:48 25 United States Patent Office, right?

11:48 1 A. Yes.

11:48 2 Q. Great. Okay.

11:49 3 So you know about some of the procedures that
11:49 4 go on in the Patent Office as applications are
11:49 5 examined, right?

11:49 6 A. Yes.

11:49 7 Q. Okay. And one of the things that the Patent
11:49 8 Office has to look at these days is this question of
11:49 9 priority, particularly for applications that claim
11:49 10 priority earlier than 2013.

11:49 11 You know that, right?

11:49 12 A. My understanding is that's not right.

11:49 13 Q. Okay. Let's talk about that.

11:49 14 In 2013, there was a new law passed -- or
11:49 15 maybe it was 2012 passed. It became effective in 2013.
11:49 16 And when I say "new law," I mean the patent statute of
11:49 17 our country was amended, right?

11:49 18 A. Yes.

11:49 19 Q. Okay. The law changed. And that was called
11:49 20 the "America Invents Act," right?

11:49 21 A. Yes.

11:49 22 Q. Reflecting the importance of inventions and
11:49 23 patents to our economy, fair?

11:49 24 A. Yes.

11:49 25 Q. Thank you.

11:49 1 And in short it's called the "AIA," right?

11:49 2 A. Yes.

11:49 3 Q. And one of the changes that happened with the
11:50 4 AIA was that the method by which we evaluated what's in
11:50 5 the prior art changed, right?

11:50 6 A. Yes.

11:50 7 Q. And so whenever a patent application gets
11:50 8 evaluated, before there was one set of rules, and then
11:50 9 after there's a new set of rules, right?

11:50 10 A. Yes.

11:50 11 Q. Okay. And one of the keys is that if you have
11:50 12 one of these continuing applications that gets filed
11:50 13 after 2013 but it has a prior application that's
11:50 14 related to before 2013, the Patent Office has to figure
11:50 15 out which set of rules am I to apply, the pre-AIA
11:50 16 rules, which would be the 2012 application here, or the
11:50 17 post-AIA rules, which would be the 2018 applications
11:50 18 here, right?

11:50 19 A. Yes.

11:50 20 Q. Okay. Thank you.

11:50 21 And you know in this case, the examination of
11:51 22 every one of these applications that was filed in 2018,
11:51 23 CIPs claiming priority to the 2012 applications, the
11:51 24 Patent Office decided to examine them under the 2012
11:51 25 rules, not the later rules, right?

11:51 1 A. Right.

11:51 2 Q. Okay. So the Patent Office had to make that
11:51 3 determination to do that. And they did that, didn't
11:51 4 they?

11:51 5 A. For examination purposes. Yes.

11:51 6 Q. They did it for examination purposes, but they
11:51 7 had to decide it, right?

11:51 8 A. It's not dispositive. But yes.

11:51 9 Q. Thank you.

11:51 10 In fact, when there's questions about it,
11:51 11 there's like a special branch in the PTO that examiners
11:51 12 can go to if they have any question about it that have
11:51 13 experts on this very issue. You know that, right?

11:51 14 A. Yes.

11:51 15 Q. Okay. So if the jury agrees with the Patent
11:52 16 Office's determination that these claims do get the
11:52 17 benefit of the 2012 application, all this stuff we
11:52 18 heard about the 2017 version of Dropbox is irrelevant
11:52 19 to your validity analysis, fair?

11:52 20 A. Yes. As I explained.

11:52 21 Q. That was your flowchart. If it's a no, then
11:52 22 don't worry about 2017, right?

11:52 23 A. Yes.

11:52 24 Q. Okay. Great.

11:52 25 Now, during that analysis, what you were doing

11:52 1 was showing the correspondence between 2017 and
11:52 2 Dr. Akl's analysis, right?

11:52 3 A. Yes.

11:52 4 Q. And you called that Motion Offense's theory
11:52 5 but really what you were looking at is Dr. Akl's
11:52 6 analysis of infringement, right?

11:52 7 A. That is Motion Offense's theory. Yes.

11:52 8 Q. Great. That's what I mean. They were
11:52 9 basically the same thing. What you're calling Motion
11:52 10 Offense theory is Dr. Akl's analysis, right?

11:52 11 A. Yes.

11:52 12 Q. Okay. Thank you.

11:52 13 And so what we found there is that all of
11:53 14 those boxes at the end of your determination, they got
11:53 15 checked off, right?

11:53 16 A. Yes.

11:53 17 Q. Okay. Because the evidence -- if Dr. Akl's
11:53 18 analysis is correct -- in other words, if Motion
11:53 19 Offense's theory, Dr. Akl's analysis is correct, the
11:53 20 evidence hits all those claim elements?

11:53 21 A. Yes. That's what it would mean for him to be
11:53 22 correct.

11:53 23 Q. Okay. Thank you very much.

11:53 24 Sorry. One more question.

11:53 25 Which is to say, if a system meets all the

11:53 1 claim elements, that's infringement, right?

11:53 2 A. Yes.

11:53 3 Q. Great. Thank you.

11:53 4 MR. DEVLIN: Pass the witness.

11:53 5 MR. LANTIER: Your Honor, may we
11:53 6 approach?

11:53 7 THE COURT: Sure.

11:53 8 (Bench conference.)

11:53 9 MR. LANTIER: Your Honor, I'm going to
11:53 10 introduce the decision on institution in the '215 IPR
11:54 11 proceeding. That was one of the most aggressive
11:54 12 crosses I've ever seen suggesting that the Patent
11:54 13 Office has already decided this issue.

11:54 14 And the IPR was instituted on the '215
11:54 15 patent, which was the subject of the cross-examination,
11:54 16 based on the Houston '597 patent that Mr. Devlin
11:54 17 pointed to and said the Patent Office had this, and
11:54 18 they still issued the patent, the door has been opened.

11:54 19 MR. DEVLIN: Here's the problem. This
11:54 20 claim, Claim 18, it's at issue here, there's no IPR on
11:54 21 it. There's no claim in this lawsuit right now that
11:54 22 there's been any IPR on it, period. We've been very
11:54 23 careful not to -- and every claim is independent.
11:54 24 Every claim was changed.

11:54 25 The fact that the Patent Office has

11:54 1 instituted an IPR on other claims in the same patent is
11:54 2 irrelevant to what's going on here and extremely
11:54 3 prejudicial. We've been very careful.

11:54 4 MR. LANTIER: Your Honor, the Patent
11:54 5 Office instituted IPR on Claim 19, which depends from
11:55 6 Claim 1 just like Claim 18. There's no dispute about
11:55 7 the last one, about the Claim 18 limitation.

11:55 8 So to the extent that they did institute
11:55 9 IPR in Claim 19, it's showing that they -- in Claim 1
11:55 10 is satisfied by Houston.

11:55 11 MR. DEVLIN: Claim 19 is different than
11:55 12 Claim 18. The question is whether Claim 18 has a
11:55 13 collection of elements, just independent and isolated
11:55 14 from Claim 1, the collection of elements, the invention
11:55 15 as a whole is patentable. That's what we have in this
11:55 16 trial here. Whatever's going on in Claim 19 is
11:55 17 irrelevant to that determination and extremely
11:55 18 prejudicial. We've been very careful.

11:55 19 MR. LANTIER: I've never seen such an
11:55 20 aggressive cross to say you shouldn't independently
11:55 21 evaluate invalidity because the Patent Office already
11:55 22 decided this.

11:55 23 And now the jury is being left with a
11:55 24 half truth, that the Patent Office doesn't think the
11:55 25 '597 patent is relevant to these claims. That's false.

11:55 1 That's just not true.

11:55 2 MR. DEVLIN: So the problem with that
11:55 3 argument is the word "these claims."

11:55 4 THE COURT: I'm going to exclude it.

11:55 5 MR. DEVLIN: Thank you.

11:56 6 MR. LANTIER: Your Honor, we'll submit a
11:56 7 proffer later today.

11:56 8 THE COURT: Sure.

11:56 9 MR. LANTIER: Thank you.

11:56 10 (Bench conference concludes.)

11:56 11 REDIRECT EXAMINATION

11:56 12 BY MR. LANTIER:

11:56 13 Q. Professor Shamos, just a few questions for you
11:56 14 here.

11:56 15 Do you remember that you were questioned about
11:56 16 the prior art that had been submitted to the Patent
11:56 17 Office in connection with the '215 patent application?

11:56 18 A. Yes.

11:56 19 MR. LANTIER: And if we could call up the
11:56 20 '215 patent. That's PTX-6.

21 BY MR. LANTIER:

11:56 22 Q. Now, Professor Shamos, you have prosecuted a
11:56 23 number of patent applications over the course of your
11:56 24 career; is that right?

11:56 25 A. Hundreds.

11:56 1 Q. And if we look at PTX-6 and call up the full
11:57 2 first page, I'd like to go first to Page 2. And this
11:57 3 is where the References Cited list begins, right?

11:57 4 A. Yes.

11:57 5 Q. And now, each of the entries after that
11:57 6 References Cited is a document that either the examiner
11:57 7 found but more likely that the attorneys for Motion
11:57 8 Offense submitted to the Patent Office, right?

11:57 9 A. Yeah. The ones with the asterisks are the
11:57 10 ones the examiner found.

11:57 11 Q. Right. And if it doesn't have an asterisk,
11:57 12 then it came in the piles that the Motion Offense
11:57 13 attorneys sent to the patent examiner, right?

11:57 14 A. Yes.

11:57 15 Q. And so if we look at -- we see that on Page 2,
11:57 16 does that continue on Page 3?

11:57 17 A. Yes.

11:57 18 Q. And does that continue then again on Page 4?

11:57 19 A. Yes. A little.

11:58 20 Q. And does it continue again on Page 5?

11:58 21 A. Well, the other publications. Those were --
11:58 22 the first were patents.

11:58 23 Q. Oh, I'm sorry, yes, but --

11:58 24 A. We're done with the patents. We're on to the
11:58 25 other publications.

11:58 1 Q. Right. But it's all materials that the
11:58 2 attorneys for Motion Offense submitted to the patent
11:58 3 examiner, right?

11:58 4 A. Yes.

11:58 5 Q. And then we see that on Page 5, it continues?

11:58 6 A. Yes.

11:58 7 Q. And Page 6, it continues?

11:58 8 A. Yes.

11:58 9 Q. And Page 7, it continues?

11:58 10 A. Yes.

11:58 11 Q. And Page 8, it continues?

11:58 12 A. Yes.

11:58 13 Q. Now, in your years of experience, have you
11:58 14 ever seen a dump like this on a patent examiner?

11:58 15 A. I've seen it in similar situations where
11:58 16 there's been litigation and certain prior art has
11:58 17 become known to the patent applicant, and the law
11:58 18 obliges them to disclose that to the Patent Office.

11:58 19 Q. And in your experience, does the patent
11:58 20 examiner actually -- is the patent examiner actually
11:59 21 able to read that amount of information?

11:59 22 A. No. It's called "swamping." I mean, you
11:59 23 throw so much at the examiner that there's no realistic
11:59 24 possibility he would ever look at it all.

11:59 25 I mean, there's a whole box of printout there

11:59 1 of contention charts. There's no chance that the
11:59 2 examiner is going to go through that in detail.

11:59 3 Q. And so in your experience, having done this
11:59 4 type of work but also being a lawyer who's been
11:59 5 involved in patent prosecution, do you think
11:59 6 realistically the examiner was able to look at any
11:59 7 particular one of these materials?

11:59 8 A. I don't know, but I doubt it.

11:59 9 Q. And is there any way -- based on what we can
11:59 10 see here, is there any particular evidence that the
11:59 11 examiner looked at any one of the particular pieces of
11:59 12 prior art that was flooded in to him?

11:59 13 A. The evidence is that the examiner checked --
11:59 14 made checkmarks on the information disclosure statement
12:00 15 asserting that he did.

12:00 16 Q. And does that happen in every prosecution?

12:00 17 A. Yes. He's obliged to look.

12:00 18 Q. Now, about how many hours, just very
12:00 19 approximately, are examiners supposed to take to review
12:00 20 patent applications?

12:00 21 A. It's -- well, up to tens.

12:00 22 Q. So tens of hours?

12:00 23 A. Yes.

12:00 24 Q. Now, we have thousands of pieces of prior art
12:00 25 that were flooded in to the examiner here; is that

12:00 1 right?

12:00 2 A. Yes.

12:00 3 Q. And so realistically could the examiner have
12:00 4 looked at this stuff?

12:00 5 A. Well, not realistically. I mean, technically,
12:00 6 he could have, could have spent a year at it.

12:00 7 Q. But in reality, given the amount of time that
12:00 8 examiners are given to examine patent applications, is
12:00 9 it realistic that any examiner could have done that for
12:00 10 all of this prior art here?

12:00 11 A. No.

12:00 12 Q. Now, if the examiner had reviewed a piece of
12:01 13 prior art describing Dropbox and issued the patent
12:01 14 anyway, that would mean that the examiner had
12:01 15 determined that Dropbox is different from these claims,
12:01 16 right?

12:01 17 A. Yes.

12:01 18 Q. So that would mean Dropbox doesn't infringe,
12:01 19 and the examiner concluded that, correct?

12:01 20 A. That's right.

12:01 21 Q. Now, I noticed that you weren't cross-examined
12:01 22 at all as to your testimony about obviousness.

12:01 23 Does that seem right to you?

12:01 24 A. That's my recollection.

12:01 25 Q. No questions at all asked of you of that

12:01 1 analysis, right?

12:01 2 A. Right.

12:01 3 Q. And I don't remember hearing any questions
12:01 4 either about your analysis -- your technical analysis
12:01 5 with respect to Dropbox 2017, right?

12:02 6 A. That's right.

12:02 7 Q. You were questioned aggressively on Claim 20
12:02 8 of the '052 patent.

12:02 9 That's the one -- Mr. Devlin said that's the
12:02 10 claim that has "deadline" in it?

12:02 11 A. Yes.

12:02 12 MR. LANTIER: Do -- if we could go to the
12:02 13 '052 patent. Should be PTX-2. We'll go to Claim 20.
12:02 14 BY MR. LANTIER:

12:02 15 Q. Do you see the word "deadline" in that claim?

12:02 16 A. Not the word. No.

12:02 17 Q. All right. Now, you were also cross-examined
12:02 18 on the testimony you gave about the priority date that
12:03 19 should be accorded to the claims in this case.

12:03 20 Do you remember that?

12:03 21 A. Yes.

12:03 22 Q. And there was one paragraph, a single
12:03 23 paragraph, of the 2012 patent applications that
12:03 24 Mr. Devlin pointed you to as I recall.

12:03 25 Does that seem right to you?

12:03 1 A. Oh, I remember it. Yes.

12:03 2 MR. LANTIER: Could we call up PTX-1333
12:03 3 at Page 23 and go to Paragraph 73?

12:03 4 BY MR. LANTIER:

12:03 5 Q. Is this the paragraph that was shown to you
12:03 6 during your cross-examination?

12:03 7 A. Yes.

12:03 8 Q. Can you explain what this paragraph is saying?

12:03 9 A. Yes. What it fundamentally says is that a
12:03 10 node itself is not necessarily a single machine, but
12:03 11 the node can include multiple machines.

12:03 12 Some of those machines can be servers, some
12:03 13 presumably could be ordinary computers, but they're all
12:03 14 part of the same node.

12:03 15 Q. And so can you explain to the ladies and
12:04 16 gentlemen of the jury how that's different from what
12:04 17 you talked about being in the claims of the patents
12:04 18 asserted in this case?

12:04 19 A. Yes. It's true that one node can have
12:04 20 multiple computers in it, but it's still one node.

12:04 21 The -- if you recall in the 2012 applications,
12:04 22 there's a first node and a second node, and then
12:04 23 there's some stuff in between that was the mail relay
12:04 24 node that doesn't really mean anything.

12:04 25 There's still a first node and a second node.

12:04 1 Each of those could have multiple computers, but
12:04 2 there's still no third node. And it's the third node
12:04 3 that is performing the functions that are recited in
12:04 4 the claims.

12:04 5 Q. And does anything in Paragraph 73 describe a
12:04 6 third node that generates e-mails?

12:04 7 A. No.

12:04 8 Q. And what is accused of meeting the third node
12:04 9 requirements of the claims in this case?

12:04 10 A. Dropbox servers.

12:04 11 Q. Now, let me ask you one -- about one other
12:05 12 thing. You remember that the suggestion was made that
12:05 13 the examiner had reviewed the Dropbox prior art that
12:05 14 was submitted to him.

12:05 15 Do you remember that?

12:05 16 A. Yes.

12:05 17 Q. And we talked about -- we just talked about
12:05 18 how, practically speaking, that that's highly unlikely,
12:05 19 right?

12:05 20 A. Yes.

12:05 21 Q. You remember throughout the trial this week
12:05 22 we've seen the very first paragraph of what Mr. Morris
12:05 23 included in the patent applications originally, right?

12:05 24 A. The very first paragraph?

12:05 25 Q. In the background section.

12:05 1 A. You mean Paragraph 5?

12:05 2 Q. Yes. Paragraph 5. Sorry.

12:05 3 A. That's why I was confused, because I didn't
12:05 4 think Paragraph 5 was the first paragraph.

12:05 5 Q. That's fair.

12:05 6 It's the first paragraph of the background
12:05 7 section, right?

12:05 8 A. Yes.

12:05 9 Q. And that paragraph says that the invention is
12:05 10 different from Dropbox, right?

12:05 11 A. Yes.

12:05 12 Q. And so if the examiner had read that paragraph
12:05 13 and was evaluating the prior art, how would that impact
12:06 14 how the examiner approached review of the prior art
12:06 15 that had been submitted to him or her?

12:06 16 A. I don't know. But it would be an indication
12:06 17 that he really need not bother with the Dropbox prior
12:06 18 art because it's different.

12:06 19 Q. Thank you.

12:06 20 MR. LANTIER: I pass the witness.

12:06 21 RECROSS-EXAMINATION

12:06 22 BY MR. DEVLIN:

12:06 23 Q. Do you remember what slide number had that
12:06 24 quote on it from the application?

12:06 25 Let me try to find it right now. Talking

12:06 1 about the one you were just talking about, about how
12:06 2 it's different.

12:06 3 Remember that by any chance?

12:06 4 A. Unfortunately, I don't remember the slide
12:06 5 number. Maybe Mr. Lantier can help you.

12:06 6 Q. While my team is trying to figure that out,
12:06 7 helpfully, let me talk about a few more things.

12:06 8 So you had said -- I think the word was a
12:06 9 "dump" of information to the Patent Office, right?

12:07 10 A. You used that. I used the word "swamping."

12:07 11 Q. Okay. Fair enough.

12:07 12 And that that happened, but in this case --

12:07 13 MR. DEVLIN: Thank you very much.

14 BY MR. DEVLIN:

12:07 15 Q. In this case, the examiner had the roadmap,
12:07 16 which itself is big. This is the roadmap for claim
12:07 17 charts, element-by-element analysis, claim language
12:07 18 versus prior art evidence, that Dropbox had put
12:07 19 together and that was submitted to the examiner as
12:07 20 well, right?

12:07 21 A. Yes.

12:07 22 Q. Thank you.

12:07 23 And the examiner indicated through the
12:07 24 mechanisms you talked about that he had reviewed this,
12:07 25 right?

12:07 1 A. He said that because he had to.

12:07 2 Q. Are you suggesting the examiner didn't review
12:07 3 it, that he lied when he wrote that he had?

12:07 4 A. Depends what you mean by "review." I'm sure
12:07 5 he looked at something in there because that would
12:07 6 entitle him to say he had reviewed it. I don't think
12:07 7 he reviewed every page in there.

12:08 8 Q. I see.

12:08 9 Just shirked it a little bit?

12:08 10 A. He might have shirked it a lot.

12:08 11 Q. Okay. There was a concept that got thrown
12:08 12 out, that if the examiner thought that Dropbox was
12:08 13 different, that shows there's no infringement.

12:08 14 Do you remember that little bit of testimony?

12:08 15 A. Yes.

12:08 16 Q. That's totally wrong.

12:08 17 You know that, right?

12:08 18 A. No. I don't know that.

12:08 19 Q. Because the examiner is looking at Dropbox in
12:08 20 2011, that's what's different?

12:08 21 A. Yes.

12:08 22 Q. What's accused here is Dropbox now?

12:08 23 A. Yeah. But in 2015, he was looking at much
12:08 24 later submissions for Dropbox.

12:08 25 Q. In 2015, he's looking at 2011 Dropbox in that

12:08 1 chart, right?

12:08 2 A. That's true.

12:08 3 Q. Because the examiner is using the 2012 date as
12:08 4 the right priority date, so he's looking at prior art
12:08 5 before then, right?

12:08 6 A. Yes.

12:08 7 Q. Okay. So it has nothing to do with whether
12:08 8 the current Dropbox service infringes, right?

12:08 9 A. I don't say it has nothing to do with it.
12:09 10 It's not dispositive of that issue.

12:09 11 Q. Thank you. I'll leave it at that.

12:09 12 I think it was Slide 97, we've heard.

12:09 13 MR. DEVLIN: And I appreciate my
12:09 14 colleague for that. Slide 97.

12:09 15 Great.

16 BY MR. DEVLIN:

12:09 17 Q. Let's look at this language. Let's look at
12:09 18 what Mr. Morris is saying here.

12:09 19 And by the way, you heard in opening that
12:09 20 this -- that this argument was made -- you were here
12:09 21 for openings?

12:09 22 A. Yes.

12:09 23 Q. And the argument was made that Mr. Morris was
12:09 24 distinguishing Dropbox in this application, right?

12:09 25 A. That's what it looks like to me.

12:09 1 Q. Okay. If that's true, what he's
12:09 2 distinguishing is the Dropbox of 2011, right?

12:09 3 A. That is true.

12:09 4 Q. Great.

12:09 5 He's not distinguishing the Dropbox of today
12:09 6 because he has no idea in 2012 what it's going to look
12:09 7 like, right?

12:09 8 A. That's right.

12:09 9 Q. Thank you.

12:09 10 And what he actually says -- it's the second
12:09 11 line -- begins with the words "for example."

12:09 12 For example, sharing a file in a Samba file
12:10 13 system is different than sharing a cloud -- sharing a
12:10 14 via cloud-based storage system, such as Dropbox.

12:10 15 Do you see that?

12:10 16 A. Yes.

12:10 17 Q. Okay. And he says sharing via e-mail is still
12:10 18 different, right?

12:10 19 A. Yes.

12:10 20 Q. So what he's comparing and drawing differences
12:10 21 to are just the variety of different ways that people
12:10 22 did it back then, right?

12:10 23 A. Yeah. But his disclosure is sharing via
12:10 24 e-mail, which is different from a cloud-based system.

12:10 25 Q. His disclosure is distinguishing from all of

12:10 1 these, the Samba file system, the cloud-based system of
12:10 2 that time and e-mails of that time, right?

12:10 3 A. To an extent.

12:10 4 Q. Thank you.

12:10 5 MR. DEVLIN: Nothing further. Pass the
12:10 6 witness.

12:10 7 MR. LANTIER: If we could just keep that
12:10 8 slide up for a moment.

9 FURTHER REDIRECT EXAMINATION
10 BY MR. LANTIER:

12:10 11 Q. Professor Shamos, in the first sentence here,
12:11 12 Mr. Morris represented to the Patent Office in 2012
12:11 13 that a variety of means exist for sharing files,
12:11 14 folders and other data via network; is that right?

12:11 15 A. Yes.

12:11 16 Q. And there's some typos in here, but we're not
12:11 17 going to focus on those.

12:11 18 It says "filed," but he meant files, right?

12:11 19 A. We all understood what it meant.

12:11 20 Q. Yeah. And he says: For each, a user must
12:11 21 know how to configure and/or set up the sharing.

12:11 22 Do you see that?

12:11 23 A. Yes.

12:11 24 Q. So he says: There are a variety of means that
12:11 25 exist, but for each, a user must know how to configure

12:11 1 and/or set up the sharing.

12:11 2 That's what he said, right?

12:11 3 A. Yes.

12:11 4 Q. And he says next, for example -- so he's
12:11 5 giving for example that's -- those are examples of
12:11 6 means that exist for sharing files, folders and other
12:11 7 data via network for which a user must know how to
12:12 8 configure and/or set up the sharing, right?

12:12 9 A. That's what he says.

12:12 10 Q. And he gives two examples, right?

12:12 11 A. Yes.

12:12 12 Q. One is the Samba file system, right?

12:12 13 A. Yes.

12:12 14 Q. And a Samba file system, that's not -- you
12:12 15 don't use e-mails to share files in a Samba file
12:12 16 system, right?

12:12 17 A. Right.

12:12 18 Q. And the second one he gives is sharing via a
12:12 19 cloud-based storage system such as Dropbox.

12:12 20 Do you see that?

12:12 21 A. Yes.

12:12 22 Q. And when you share via a cloud-based storage
12:12 23 system such as Dropbox, you don't share -- you don't
12:12 24 e-mail to share a file, right? A person doesn't e-mail
12:12 25 to share the file?

12:12 1 A. It's not shared via an attachment. No.

12:12 2 Q. Yes.

12:12 3 And, in fact, when -- you know, if I'm on
12:12 4 Dropbox, I'm not generating an e-mail and sending it to
12:12 5 somebody. I'm generating a request or sending a
12:12 6 request or a message to Dropbox, and then Dropbox will
12:12 7 generate any necessary e-mails, right?

12:13 8 A. Yes. That's what I showed when I was
12:13 9 explaining how e-mail works.

12:13 10 Q. And then the next sentence is: Sharing via
12:13 11 e-mail is still different, right?

12 12 A. Yes.

12:13 13 Q. And so sharing via e-mail is still different
12:13 14 from sharing via a Samba file system or sharing via
12:13 15 Dropbox, right?

12:13 16 A. Yes.

12:13 17 Q. And what he says is that: It would be useful
12:13 18 if sharing files, folders, directory data and other
12:13 19 network accessible data were as easy as sending an
12:13 20 attachment in an e-mail.

12:13 21 Isn't that what he said?

12:13 22 A. Yes.

12:13 23 Q. And then what the 2012 applications describe
12:13 24 is sending an e-mail without an attachment to share
12:13 25 files, right?

12:13 1 A. Yes.

12:13 2 Q. Okay.

12:13 3 MR. LANTIER: Nothing further. I pass
12:13 4 the witness.

12:13 5 MR. DEVLIN: Nothing further, Your Honor.

12:13 6 THE COURT: May he be excused?

12:13 7 MR. DEVLIN: Certainly for us. Thank
12:13 8 you.

12:13 9 THE COURT: You may step down, sir.

12:13 10 Could I have a counsel from each side up
12:13 11 here?

12:13 12 (Bench conference.)

12:14 13 THE COURT: Okay. We'll break for lunch.
12:14 14 You can put whatever you want on.

12:14 15 Number two, I don't remember you
12:14 16 qualifying him saying anything about the Patent Office.

12:14 17 MR. DEVLIN: I didn't.

12:14 18 MR. LANTIER: He went after him on cross
12:14 19 on it and said he was an expert.

12:14 20 MR. DEVLIN: I'm okay.

12:14 21 THE COURT: Okay.

12:14 22 MR. DEVLIN: I feel --

12:14 23 THE COURT: Okay.

12:14 24 MR. LANTIER: I didn't think it would be
12:14 25 appropriate to qualify him as an expert, and then he

12:14 1 did it on cross.

12:14 2 THE COURT: I was surprised you didn't
12:14 3 object. I was shocked by it, so...

12:14 4 And third, you have 30 minutes left.

12:14 5 MR. DEVLIN: I understand. Yep. And --
12:14 6 not including closings, right?

12:14 7 THE COURT: That's right.

12:14 8 MR. DEVLIN: Okay. Thank you.

12:14 9 THE COURT: No, no, no.

12:15 10 MR. DEVLIN: You almost panicked me.

12:15 11 THE COURT: Closings are separate.

12:15 12 MR. DEVLIN: That's perfect.

12:15 13 THE COURT: So what we've got to get done
12:15 14 is -- or we actually got finished much earlier today
12:15 15 than I thought we would, but that's okay, because I
12:15 16 don't like doing closing arguments too late in the
12:15 17 afternoon.

12:15 18 And y'all seem to be okay with it, right?

19 MR. DEVLIN: Yes.

20 THE COURT: Coming in tomorrow morning at
12:15 21 9:00.

12:15 22 MR. DEVLIN: Perfect. Thank you.

12:15 23 THE COURT: So why don't I give the jury
12:15 24 until 1:30 to come back? Why don't I give them until
12:15 25 2:00 to come back? That way we can come back at 1:30

12:15 1 or so and make sure that the charge is in the right
12:15 2 order, and anything -- whatever we need to get done,
12:15 3 get done. Then we'll put on your guy. You're done?

12:15 4 MR. LANTIER: We'll rest.

12:15 5 THE COURT: And for the record, by you I
12:15 6 meant the defendant.

12:15 7 And then you have your expert, which
12:16 8 we'll finish whenever we finish this afternoon, but it
12:16 9 won't be long.

12:16 10 MR. DEVLIN: Can't be long.

12:16 11 THE COURT: Can't be long.

12:16 12 And then we'll -- and then -- and the
12:16 13 reason I want to make sure the charge is right because
12:16 14 when you finish the evidence, then I'll read the charge
12:16 15 today. And all we'll do tomorrow is your closing
12:16 16 arguments. Does that work?

12:16 17 MR. DEVLIN: Works great. Thank you,
12:16 18 Your Honor.

12:16 19 MR. LANTIER: We'll want to preserve --
12:16 20 put on the record our 50(a) motion after the close of
12:16 21 our case. We can do it either when we come back after
12:16 22 lunch or do it after.

12:16 23 THE COURT: You can do it as soon as we
12:16 24 excuse the jury.

12:16 25 MR. DEVLIN: Once they rest, Your Honor,

12:16 1 we'll need to do ours. But we can do that whenever
12:16 2 it's convenient later in the day when the jury --

12:16 3 THE COURT: At the end of the day.

12:16 4 MR. DEVLIN: Yeah, thank you.

12:16 5 MR. LANTIER: I mean, I think that's
12:16 6 completely fine. I can do the same if it's better for
12:16 7 Your Honor.

12:16 8 THE COURT: Let's do it at the end
12:16 9 because I'm going to deny everything.

12:16 10 MR. LANTIER: Yes. I understand. We
12:16 11 just want to make sure we fully preserve.

12:16 12 THE COURT: No. It's all preserved. And
12:16 13 so we'll just do it.

12:17 14 Mr. Devlin agrees that you can reserve
12:17 15 your motion until he's put on his witness, and we'll do
12:17 16 it all at once.

12:17 17 MR. LANTIER: Thank you, Your Honor.

12:17 18 (Bench conference concludes.)

12:17 19 THE COURT: Okay, ladies and gentlemen.
12:17 20 Here's what we're going to do. I hate having you all
12:17 21 wait here when we're doing things. So to avoid that,
12:17 22 I'm going to -- we're going to break until 2:00.

12:17 23 So there are a couple things we need to
12:17 24 do, but you all won't be sitting in the jury room
12:17 25 waiting for us to finish. We'll be ready to go at

12:17 1 2:00.

12:17 2 We have one witness left, I believe. And
12:17 3 after that witness finishes, then I will do my least
12:17 4 favorite part of the trial, which is I will have to
12:17 5 read to you for about an hour the law on the case.

12:17 6 And then we'll be done for the day.

12:17 7 The good news is, is that then tomorrow
12:18 8 we'll have probably my favorite part of the trial,
12:18 9 which is you'll get the closing arguments at 9:00, and
12:18 10 then you'll begin your deliberations.

12:18 11 So let me remind you at this time that
12:18 12 the closing arguments are just arguments. They're not
12:18 13 evidence. We'll finish the evidence today. But the
12:18 14 closing arguments are certainly very important to help
12:18 15 guide you as to what the lawyers think is the
12:18 16 appropriate verdict for you to reach.

12:18 17 So we will stand in recess until 2:00
12:18 18 o'clock. We'll finish the evidence and the charge
12:18 19 today, and you will begin deliberating tomorrow.

12:18 20 THE BAILIFF: All rise.

12:18 21 (Jury exited the courtroom.)

12:18 22 THE COURT: Thank you. You may be
12:18 23 seated.

12:18 24 If you would like to recall the expert
12:18 25 and put on the witness that -- with the evidence that I

12:19 1 excluded, you're welcome -- you can do that now, if you
12:19 2 care to.

12:19 3 MR. LANTIER: Thank you, Your Honor.

12:19 4 Professor Shamos, if you could return to
12:19 5 the stand for a moment.

6 THE COURT: Yes, sir.

12:19 7 MR. LANTIER: Thank you, Your Honor.

12:19 8 DIRECT EXAMINATION

12:19 9 BY MR. LANTIER:

12:19 10 Q. Professor Shamos, during your
12:19 11 cross-examination, do you remember that you were asked
12:19 12 a series of questions about the Patent Office's
12:19 13 examination of the '215 patent?

12:19 14 A. Yes.

12:19 15 Q. And do you recall that Mr. Devlin had pointed
12:20 16 you specifically to the '597 Houston patent that
12:20 17 appears on the face of the '215 patent?

12:20 18 A. Yes.

12:20 19 MR. LANTIER: If we could call up the
12:20 20 decision granting institution of inter partes review in
12:20 21 IPR 2022-1313.

22 BY MR. LANTIER:

12:20 23 Q. Professor Shamos, could you tell us first what
12:20 24 an inter partes review is?

12:20 25 THE COURT: I don't think you need to --

12:20 1 I don't think -- I think you can just put on the
12:20 2 evidence.

12:20 3 MR. LANTIER: Okay. Very good, Your
12:20 4 Honor.

12:20 5 BY MR. LANTIER:

12:20 6 Q. Professor Shamos, do you see that this is a
12:20 7 decision on institution and an IPR?

12:20 8 A. Yes.

12:20 9 Q. And this is an IPR that was filed by Google
12:20 10 against Motion Offense?

12:20 11 A. Yes.

12:20 12 Q. And it has to do with the '215 patent, right?

12:20 13 A. Yes.

12:20 14 MR. LANTIER: If we could just go ahead
12:20 15 to Page 8 of that decision.

12:20 16 BY MR. LANTIER:

12:21 17 Q. Do you see that -- the heading "Asserted
12:21 18 Ground"?

12:21 19 A. Yes.

12:21 20 Q. And that the challenged claims were 19, 20 and
12:21 21 51?

12:21 22 A. Yes.

12:21 23 Q. And that the first reference, the lead
12:21 24 reference was "Houston"?

12:21 25 A. Yes. I'd have to see which Houston patent

12:21 1 that is, but...

12:21 2 Q. And that's coming next.

12:21 3 If we go to the footnote at the bottom of the
12:21 4 page, Footnote 4.

12:21 5 A. Yes.

12:21 6 Q. The Houston reference is the reference that
12:21 7 you were asked about during your cross-examination, the
12:21 8 '597 patent, right?

12:21 9 A. Yes.

12:21 10 MR. LANTIER: Okay. Now, if we just go
12:21 11 to the end of the document at Page 55.

12 12 BY MR. LANTIER:

12:21 13 Q. Can you see the conclusion?

12:21 14 A. It's getting smaller.

12:22 15 Q. Do you see that the conclusion says: Based on
12:22 16 the arguments presented in the petition, we conclude
12:22 17 that petitioner has demonstrated a reasonable
12:22 18 likelihood of prevailing with respect to at least one
12:22 19 claim of the '215 patent challenged in the petition?

12:22 20 A. Yes.

12:22 21 Q. And the Patent Office instituted a trial on
12:22 22 all claims and all grounds asserted in the Google
12:22 23 petition?

12:22 24 A. Yes. As they were obliged to do if they found
12:22 25 at least one claim.

12:22 1 Q. Yes. So here the Patent Office is finding
12:22 2 that at least one claim of the three challenged claims
12:22 3 is reasonably likely to be canceled as a result of this
12:22 4 IPR proceeding, right?

12:22 5 A. Yes.

12:22 6 Q. Okay. Thank you, Professor Shamos.

12:22 7 MR. LANTIER: No further questions.

12:22 8 THE COURT: Mr. Devlin, anything?

12:22 9 MR. DEVLIN: Nothing. Nothing, Your
12:23 10 Honor. Thank you.

12:23 11 THE COURT: Okay.

12:23 12 Is there anything we need to take up now?

12:23 13 MR. LANTIER: Not for Dropbox, Your
12:23 14 Honor.

12:23 15 MR. DEVLIN: Not for Motion Offense.

12:23 16 THE COURT: Why don't we come back
12:23 17 about -- well, let me ask you this: Do you all have --
12:23 18 and the only folks that need to stay for this are the
12:23 19 ones who were involved in the jury charge.

12:23 20 My understanding is that at least one of
12:23 21 you wanted to add something to the jury charge from
12:23 22 what we did yesterday.

12:23 23 MR. LANTIER: That was Motion Offense, I
12:23 24 believe, Your Honor.

12:23 25 MR. DEVLIN: And, Your Honor, Mr. Puckett

12:23 1 just was whispering to me, and I reported to him that
12:23 2 we'd be back at 1:30. So he went out to, I think,
12:23 3 start to take a look at something. So my apologies if
12:23 4 I've got us wound down.

12:23 5 THE COURT: Okay. So we'll be -- I'll be
12:23 6 back about 1:30, and we'll go from there.

12:23 7 THE BAILIFF: All rise.
12:23 8 (Recess taken.)

01:42 9 THE BAILIFF: All rise.

01:42 10 THE COURT: Thank you. You may be
01:42 11 seated.

01:42 12 Happy to take up -- why don't we just go
13 ahead and do this on the record since Kristie's here.

01:43 14 I'm happy to take up the issue of the
01:43 15 additional charge.

01:43 16 MR. PUCKETT: Thank you, Your Honor.

01:43 17 And before I get into this, I'll let the
01:43 18 Court know we've been working over the lunch break to
01:43 19 resolve all the issues with the jury charge.

01:43 20 I'm very confident that we can announce
01:43 21 that, with the exception of this one issue that's been
01:43 22 presented to you by motion, I think that we have --
01:43 23 everything else that will either be resolved -- or will
01:43 24 be resolved within the next few minutes after we finish
01:43 25 this, Your Honor.

01:43 1 THE COURT: Okay.

01:43 2 MR. PUCKETT: With respect to the motion
01:43 3 that was filed, we asked for an additional instruction
01:43 4 to distinguish -- or to inform the jury about what is
01:43 5 the legal implication of an abandonment of a patent
01:43 6 application for which there is a co-pending
01:43 7 continuation application.

01:43 8 We think that the law gives patent
01:43 9 applicants the clear right to engage in continuation
01:43 10 practice, 35 U.S.C. Section 120, and that there are
01:43 11 rules under the Patent Office's own internal rules of
01:44 12 procedure that give the patent applicant the right to
01:44 13 use continuation practice and to claim a priority back
01:44 14 to earlier applications, of course, if there's written
01:44 15 description support, even if the earlier application
01:44 16 has been abandoned, and that the suggestion has been
01:44 17 made in this case otherwise.

01:44 18 And, in fact, in the filing that
01:44 19 Mr. Lantier made this morning, we thought it would --
01:44 20 made it very explicit that at the closing, he intends
01:44 21 to tell the jury that the abandonment of the 2012
01:44 22 applications has some impact on validity in this case,
01:44 23 in particular whether or not that that fact somehow is
01:44 24 relevant to whether or not the 2012 applications
01:44 25 provide written description support for the claims that

01:44 1 are issued here.

01:44 2 We think that statement is wrong as a
01:44 3 matter of law. We think that patent prosecutors all
01:44 4 around America would be shocked to find out that
01:44 5 Mr. Lantier intends to take the position in this trial.
01:44 6 We don't think that it's consistent with the law, and
01:44 7 that's why we've asked for the instruction, Your Honor.

01:44 8 THE COURT: It would help if I had the
01:44 9 instruction.

01:44 10 MR. PUCKETT: Oh, would you like me to
01:45 11 hand up the instruction to you, Your Honor?

01:45 12 THE COURT: That'd be good. Yeah.

01:45 13 MR. PUCKETT: Your Honor, I only have it
01:45 14 electronic at the moment. It was filed with the Court,
01:45 15 but I'll get Your Honor a paper copy in just a matter
01:45 16 of a minute.

01:45 17 MS. AMADI: Good afternoon, Your Honor.
01:45 18 Brittany Amadi on behalf of Dropbox.

01:45 19 Your Honor, we submitted a written filing
01:45 20 this morning responding to their request for an
01:45 21 instruction with respect to the abandonment issue.

01:45 22 All of the evidence that's been submitted
01:45 23 in this case is factual evidence, evidence that appears
01:45 24 on the face of the patent itself, that there is a -- it
01:45 25 is a continuation-in-part of applications that were

01:45 1 filed that were then subsequently abandoned.

01:45 2 And that's the evidence that has come in
01:45 3 through trial. We think it's improper through an
01:45 4 instruction for Motion Offense to be able to
01:45 5 essentially insert advocacy into the jury instructions.
01:45 6 And they've asked for instructions that it's not
01:46 7 relevant.

01:46 8 And we, of course, disagree that it -- it
01:46 9 is very much relevant, as we just heard from Professor
01:46 10 Shamos, that prior 2012 applications do not support --
01:46 11 our position is that they do not support the -- provide
01:46 12 written description to support for the later-filed
01:46 13 applications.

01:46 14 And the fact that the applicant filed
01:46 15 those applications in 2012 without written -- without
01:46 16 describing what is now claimed in 2017 and then
01:46 17 abandoned those applications is relevant information.
01:46 18 And it's factual information that the jury has heard in
01:46 19 this trial.

01:46 20 And so we just don't believe there's any
01:46 21 basis for an instruction of this nature. There's never
01:46 22 been any suggestion in this trial that abandonment is
01:46 23 some sort of legally improper -- or any sort of
01:46 24 argument along those lines.

01:46 25 It's really just the factual evidence

01:46 1 that it was filed, it didn't include certain material,
01:46 2 and those applications were abandoned.

01:47 3 THE COURT: I'm reading here.

01:47 4 MS. AMADI: Sure.

01:47 5 THE COURT: Has -- let me ask the
01:47 6 plaintiffs who are submitting this.

01:47 7 I don't get the sense from the citations
01:47 8 you've offered that these -- that this came from a jury
01:48 9 charge.

01:48 10 And do you have any case where an
01:48 11 instruction on abandonment like this was given?

01:48 12 MR. PUCKETT: I cannot point to a case
01:48 13 where an instruction like this was given to a jury. We
01:48 14 have cited cases where courts have found it important
01:48 15 to draw this distinction between the abandonment of a
01:48 16 patent application versus the legal defense of
01:48 17 invalidity based upon abandonment under the old pre-AIA
01:48 18 statute. It was 102(c), I believe was the statute that
01:48 19 you are not entitled to a patent if you have abandoned,
01:48 20 suppressed or concealed the invention.

01:48 21 And so there's clearly in the case --
01:48 22 there's very clear case law support that we have cited
01:48 23 in the footnotes here for a distinction between
01:48 24 abandonment of a patent application, according to the
01:48 25 internal procedures of the Patent Office, versus the

01:48 1 statutory defense of abandonment that was available
01:48 2 under the 103(c) of the pre-AIA version of the statute.

01:49 3 But to answer Your Honor's question, this
01:49 4 does not come from like a pattern jury charge. It's
01:49 5 not at issue, I think, that's presented in very many
01:49 6 cases. And so that's sort of how pattern instructions
01:49 7 get created, is there -- sometimes there's a need for a
01:49 8 new one.

01:49 9 (Off-the-record bench conference.)

01:53 10 THE COURT: The Court is not going to
01:53 11 give this instruction in part but not exclusively -- I
01:53 12 will put it on the record.

01:53 13 With respect to the second paragraph, I
01:53 14 think both sentences are incorrect the way they're
01:53 15 phrased with respect to the facts as they've come into
01:53 16 evidence in this trial.

01:53 17 With regard to the third paragraph, it
01:53 18 may or may not be correct what's in -- the third full
01:53 19 paragraph may or may not be correct but again is
01:53 20 impacted by the facts -- the way the jury were to find
01:53 21 the unique facts in this case.

01:53 22 And so to make the third paragraph
01:53 23 correct, I think I'd have to add language about the
01:54 24 timing of when the abandonment happened, and I'm not
01:54 25 going to get into all that.

01:54 1 So I'm not going to give this jury
01:54 2 instruction.

01:54 3 Other than that, are there any issues
01:54 4 with regard to the jury charge?

01:54 5 MS. AMADI: Thank you, Your Honor. Just
01:54 6 a couple of issues that we wanted to raise with Your
01:54 7 Honor.

01:54 8 The first, it relates actually to the
01:54 9 verdict form.

01:54 10 THE COURT: Okay.

01:54 11 MS. AMADI: Your Honor had indicated
01:54 12 yesterday that, you know, typically in -- where there's
01:54 13 a finding of noninfringement and there's no
01:54 14 counterclaim of invalidity, that that typically moots
01:54 15 the jury's obligation to find invalidity going forward.

01:54 16 And I believe in this case, there are two
01:54 17 patents in which Dropbox has asserted a counterclaim of
01:54 18 invalidity and two patents in which there is a defense
01:54 19 of invalidity.

01:54 20 Your Honor had indicated that the --
01:54 21 two -- the verdict form would have to be essentially
01:54 22 split to allow the jury to go forward with addressing
01:55 23 the two on which there are counterclaims and not
01:55 24 addressing the two on which there are not counterclaims
01:55 25 in the event that the jury finds noninfringement.

01:55 1 We would ask that Your Honor submit the
01:55 2 issue of invalidity on all four asserted patents to the
01:55 3 jury --

01:55 4 THE COURT: I'm not going to do that.
01:55 5 Anything else?

01:55 6 MS. AMADI: May I be heard on --

01:55 7 THE COURT: No.

01:55 8 MS. AMADI: Okay.

01:55 9 THE COURT: You all discussed this
01:55 10 yesterday. I heard it yesterday. Nothing's changed.
01:55 11 And so I'm -- that's the -- you know, I'm good.

01:55 12 MS. AMADI: The only other issue, Your
01:55 13 Honor, is we wanted to raise with respect to the
01:55 14 cross-examination of Professor Shamos this morning.

01:55 15 There was a jury instruction that Dropbox
01:55 16 had proposed that we didn't explicitly discuss
01:55 17 yesterday related to Patent Office procedure.

01:55 18 And so we would request that in view of
01:55 19 the cross-examination related to the Patent Office's
01:55 20 review of certain materials on the face of the patent,
01:55 21 that Your Honor issue an instruction which was set
01:55 22 forth in our proposal on Page 67.

01:56 23 I'm happy to hand it up, if Your Honor
01:56 24 would like.

01:56 25 THE COURT: Please.

01:56 1 Okay. I have two -- on Pages 67 and 68,
01:57 2 I have two proposals. One is yours; one is the
01:57 3 plaintiff's.

01:57 4 Am I taking up both of these? They're
01:57 5 different.

01:57 6 MS. AMADI: No, Your Honor. That's just
01:57 7 how the instructions were presented. It would just be
01:57 8 the Dropbox proposal there.

01:57 9 THE COURT: So let me hear from the
01:57 10 plaintiff why I would not give the instruction Dropbox
01:57 11 is proposing?

01:57 12 MR. PUCKETT: Your Honor, I'm going to
01:57 13 apologize. I must have misunderstood the beginning of
01:57 14 counsel's arguments. I was focused on a different
01:57 15 instruction. I wasn't looking at the right place.

01:57 16 So if Your Honor could direct me to the
01:57 17 specific instruction that you're --

01:57 18 THE COURT: If I have the one that I
01:57 19 should have, it's on Page 67 and begins: However, the
01:58 20 fact that the PTO grants a patent does not necessarily
01:58 21 mean that any invention claimed in the patent, in fact,
01:58 22 deserves the protection of a patent...

01:58 23 And goes on from there.

01:58 24 MR. PUCKETT: So, Your Honor -- and so
01:58 25 I'm looking at the -- so you're looking at the version

01:58 1 that was submitted in the pretrial order, Your Honor?

01:58 2 THE COURT: I don't know that, but I am
01:58 3 looking at the version I was just handed.

01:58 4 MR. PUCKETT: So, Your Honor -- and I'm
01:58 5 speaking a little bit off memory, but that's okay.

01:58 6 Our objection to that was just simply
01:58 7 that it was -- it seemed to be inconsistent with the
01:58 8 presumption of validity.

01:58 9 I mean, there are other instructions, as
01:58 10 I understand it, in the set that says that the jury can
01:58 11 consider whether or not the Patent Office considered
01:58 12 certain art and those sorts of things, yes.

01:58 13 THE COURT: That was yesterday. And
01:58 14 today we had testimony -- Mr. Devlin raised questions
01:58 15 about this. Dropbox questioned their expert about it.
01:58 16 It wasn't in front of -- this issue wasn't in front of
01:59 17 me yesterday when I took this up.

01:59 18 So my question -- my -- the only sentence
01:59 19 I have a problem with, a little bit, because it sounds
01:59 20 to me like I'm putting my thumb on the scale, is the
01:59 21 one that's three lines up from the bottom.

01:59 22 Even though it's correct -- this is a
01:59 23 correct statement, but it says: For example, here
01:59 24 Dropbox was not allowed to participate in the
01:59 25 prosecution process or present any prior art to the

01:59 1 patent examiner.

01:59 2 Now, I know that's a true statement. I
01:59 3 got that. But it sounds to me like, in the context of
01:59 4 everything else, I'm saying that I'm weighing in on it
01:59 5 in favor of Dropbox.

01:59 6 So what I would propose -- and by the
01:59 7 way, again, so it's clear, during closing arguments,
01:59 8 counsel for defendant would be free to say, for
01:59 9 example, here, Dropbox was not allowed to participate.
02:00 10 And I'm not -- that's a correct statement of the law.
02:00 11 But I'm concerned me saying it and then having counsel
02:00 12 for defendant be able to say, as the Judge told you,
02:00 13 and I don't want to do that.

02:00 14 So I'm going to give the Dropbox proposal
02:00 15 with the exception of that sentence. And, again, for
02:00 16 the record, the sentence I am taking out is, for
02:00 17 example, here Dropbox was not allowed to participate in
02:00 18 the prosecution process or present any prior art to the
02:00 19 patent examiner. Other than that, I would give the
02:00 20 Dropbox proposal.

02:00 21 So whoever's the scrivener on this needs
02:00 22 to add that.

02:00 23 And is there anything else we need to
02:00 24 take up?

02:00 25 MS. AMADI: Not from Dropbox at this

02:00 1 time.

02:00 2 MR. PUCKETT: Substantively not from us,
3 Your Honor.

02:00 4 The only thing I'll say is we're
02:00 5 responsible for the printing, and so I just wanted to
02:00 6 get some idea of like -- and I know the answer is as
02:00 7 soon as possible. But what did we need to have?

02:00 8 THE COURT: I'd like to have it -- so
02:01 9 here's what I see happening. I don't know how long you
02:01 10 all are going to take on this next witness.

02:01 11 I know y'all aren't going to take more
02:01 12 than 30 minutes. And I know the other side's not going
02:01 13 to take more than an hour and 30 minutes-ish.

02:01 14 And so -- and then when we finish with
02:01 15 your rebuttal witness, we'll have a little bit of --
02:01 16 we'll have to do a little of motion stuff, but I'd like
02:01 17 to get started as soon after that as we can reading it.

02:01 18 But I can't read it until I have it. So
02:01 19 whenever y'all get it here is when you get it, but I'd
02:01 20 like to have it as soon as -- in time so that -- that
02:01 21 will be mas o menos 3:30, 4:00 -- so that I can read it
02:01 22 because it takes me an hour to read it.

02:01 23 And so I'd like to be reading it no later
02:01 24 than 4:00.

02:01 25 MR. PUCKETT: Okay. We'll set that as a

02:01 1 drop-dead deadline and certainly endeavor to get it
02:01 2 here much sooner, Your Honor.

02:01 3 Thank you.

02:01 4 THE COURT: Anything else?

02:02 5 MS. AMADI: Just one clarifying question.
02:02 6 Will we have an opportunity to place our objections on
02:02 7 the record?

02:02 8 THE COURT: Yes. Of course. And that's
02:02 9 something else -- that's why I was building in -- yes.
02:02 10 Objections to the charge and motions for directed
02:02 11 verdict I'll take up when that last expert's done.
02:02 12 That's why I'm saying I'm building in a little time for
02:02 13 that as well.

02:02 14 But absolutely you'll have time to do
02:02 15 that.

02:02 16 MS. AMADI: Thank you, Your Honor.

02:02 17 THE COURT: Anything else?

02:02 18 MR. PUCKETT: Not from us, Your Honor.

02:02 19 THE COURT: Okay. We'll be back in just
02:02 20 a minute or two.

02:02 21 THE BAILIFF: All rise.

02:02 22 (Recess taken.)

02:07 23 THE BAILIFF: All rise.

02:07 24 THE COURT: Please remain standing for
02:07 25 the jury.

02:08 1 (Jury entered the courtroom.)

02:08 2 THE COURT: Thank you. You may be

02:08 3 seated.

02:08 4 Does the defendant have any other

02:08 5 witnesses?

02:08 6 MR. LANTIER: Your Honor, Dropbox rests.

02:08 7 THE COURT: Thank you, sir.

02:08 8 Does the plaintiff have any witnesses?

02:08 9 MR. DEVLIN: Your Honor, plaintiff would

02:08 10 like to call Dr. Robert Akl again for a brief rebuttal,

02:08 11 but I think he's just returned. No. He just stepped

02:08 12 out of the courtroom, Your Honor. He was just here,

02:08 13 and I had asked him to come in. We'll grab him very

02:08 14 quickly. My apologies.

02:08 15 Now we'll call Dr. Akl --

02:08 16 THE COURT: Very good.

02:08 17 MR. DEVLIN: -- for a brief rebuttal.

02:09 18 Thank you, Your Honor.

02:09 19 DIRECT EXAMINATION

02:09 20 BY MR. DAHLGREN:

02:09 21 Q. Good afternoon, Dr. Akl.

02:09 22 A. Good afternoon.

02:09 23 Q. I'd like to talk about two items briefly,

02:10 24 hopefully very briefly.

02:10 25 MR. DAHLGREN: First, Mr. Gooden, will

02:10 1 you please pull up PTX-6? It's Column 49, Lines 59
02:10 2 through 63, please.

02:10 3 BY MR. DAHLGREN:

02:10 4 Q. Dr. Akl, in this claim language, and this is
02:10 5 Claim 1 of the '215 patent, you see the reference to
02:10 6 the file explorer interface?

02:10 7 A. Yes.

02:10 8 Q. And do you see also the reference to the
02:10 9 client-based file explorer application?

02:10 10 A. Yes.

02:10 11 Q. Are those two different claim elements?

02:10 12 A. Yes.

02:10 13 Q. Did Dr. Shamos show where those two different
02:10 14 claim elements were present?

02:10 15 A. No.

02:10 16 Q. The second thing I'd like to talk about is --
02:11 17 actually before we get there -- I apologize.

02:11 18 With respect to the latter, the client-based
02:11 19 file explorer application, could you explain what
02:11 20 that -- what that is?

02:11 21 A. Sure. So what Dr. Shamos pointed to was a --
02:11 22 the Android -- sorry, the Dropbox app running on an
02:11 23 iPhone. And back in 2011, there was not a file
02:11 24 explorer application that can -- that actually existed
02:11 25 on the iPhone or on the iPad. Those didn't come in

02:11 1 till I think 2016.

02:11 2 And so there wasn't anything that he could
02:11 3 point to. He mainly pointed to a Dropbox app. And
02:11 4 apps then can see their own files, but that does not
02:12 5 make them a file explorer application. Just the way
02:12 6 any other app, like iTunes or anything else, can see
02:12 7 its own apps, Dropbox can see the apps -- can see the
02:12 8 folders and files of its own. But not anything else.

02:12 9 MR. DAHLGREN: Mr. Gooden, will you
02:12 10 please pull up -- it's PTX-1333 at 23? And Paragraph
02:12 11 73 specifically.

02:12 12 BY MR. DAHLGREN:

02:12 13 Q. So I'd like to talk now about the priority
02:12 14 issue briefly. And just two different disclosures in
02:12 15 the '635 application.

02:12 16 So we have Paragraph 73 here. Looking at this
02:12 17 paragraph and particularly the latter half of it, can
02:12 18 you please describe what's being discussed?

02:13 19 A. Sure. So the -- so this is from the
02:13 20 application Paragraph 73, and it's saying -- it's
02:13 21 describing Figures 2A and 2B, and specifically it's
02:13 22 saying that you can have one node or one or more
02:13 23 execution environments.

02:13 24 And execution environments are basically --
02:13 25 they're described in the first figure. They are

02:13 1 basically what do things. Like they have processors
02:13 2 and memory and instructions, and they allow the
02:13 3 execution of whatever functionality the invention wants
02:13 4 to do.

02:13 5 MR. DAHLGREN: Mr. Gooden, if you could
02:13 6 go to -- it's Paragraph 51, and it's bridging Pages 15
02:13 7 and 16.

02:13 8 BY MR. DAHLGREN:

02:14 9 Q. So -- so, Dr. Akl, in this paragraph, there's
02:14 10 a reference to remote application, HTML, script
02:14 11 languages. I think we've heard some of those terms
02:14 12 throughout this week.

02:14 13 Could you please explain what this paragraph
02:14 14 is disclosing?

02:14 15 A. Yes. So this is Paragraph 51, and it is --

02:14 16 MR. LANTIER: Your Honor, respectfully I
02:14 17 object to this. It's not in the report.

02:14 18 MR. DAHLGREN: This paragraph is cited in
02:14 19 his expert report.

02:14 20 THE COURT: Where?

02:14 21 MR. DAHLGREN: It's in his -- there's
02:15 22 a -- it's Appendix C, which is Exhibit -- okay. So --
02:15 23 get my glasses. Sorry, Your Honor.

02:15 24 So on Page 3, and it is Appendix C to his
02:15 25 expert report, Paragraph 51 is reproduced in full. And

02:15 1 this is a claim chart that's attached to his expert
02:15 2 report about -- and where he's offering support for his
02:15 3 opinion on priority.

02:15 4 MR. LANTIER: Your Honor, certainly no
02:15 5 problem with him reading the paragraph. I was
02:15 6 objecting to him providing a new characterization of
02:15 7 the paragraph at this point in the trial.

02:15 8 THE COURT: Okay. You may proceed.

02:15 9 MR. DAHLGREN: Okay.

02:15 10 THE COURT: Thank you.

02:15 11 BY MR. DAHLGREN:

02:16 12 Q. So, Dr. Akl, with respect to Paragraph 51, I
02:16 13 believe I'd asked if you could please explain what this
02:16 14 paragraph is describing.

02:16 15 A. Yes. So one of the things it is describing,
02:16 16 it says: For example, a web page received by a user
02:16 17 agent from a remote application provider may include
02:16 18 HTML, ECMAScript, and/or byte code for presenting one
02:16 19 or more UI elements included in a user interface of the
02:16 20 remote application.

02:16 21 Q. And could you kind of put that in lay terms,
02:16 22 to the best of your ability?

02:16 23 A. Yes. So the context is -- it is providing
02:16 24 support for the application -- for the patents that are
02:16 25 being asserted.

02:16 1 This is from the 2012 application, and it is
02:17 2 describing exactly a remote application that can
02:17 3 include HTML and scripting languages, just like
02:17 4 JavaScript, that's what ECMA is, that would exist in
02:17 5 the nodes that are described in this application.

02:17 6 So this is showing that the patents should be
02:17 7 entitled to the 2012 priority date.

02:17 8 Q. And, Dr. Akl, just to confirm, is it your
02:17 9 opinion that the patents being asserted in this lawsuit
02:17 10 are entitled to the September 25, 2012 priority date?

02:17 11 A. Yes. And that's part of the support for that
02:17 12 that was -- that Dr. Shamos said wasn't there.

02:17 13 MR. DAHLGREN: Pass the witness, Your
02:17 14 Honor.

15 CROSS-EXAMINATION

16 BY MR. LANTIER:

02:17 17 Q. Good afternoon, Dr. Akl.

02:18 18 A. Good afternoon.

02:18 19 Q. Just to remind everyone, you're not an expert
02:18 20 in patent law, correct?

02:18 21 A. Correct.

02:18 22 Q. And you yourself have no patents, correct?

02:18 23 A. Yes.

02:18 24 Q. You've not filed any applications for any
02:18 25 patents, correct?

02:18 1 A. Correct.

02:18 2 Q. And you've never filed a continuation-in-part
02:18 3 application, right?

02:18 4 A. Correct.

02:18 5 Q. Now, at this trial, the jury has heard from a
02:18 6 number of witnesses, right?

02:18 7 A. Yes.

02:18 8 Q. And with the exception of Mr. Dell, whose
02:18 9 testimony is irrelevant if the claims are not infringed
02:18 10 or they're invalid, right?

02:18 11 A. I don't understand the question, sorry.

02:18 12 Q. Oh, Mr. Dell testified about damages.

02:18 13 Do you remember that?

02:18 14 A. Yes.

02:18 15 Q. And that testimony, we don't get to that --
02:18 16 it's irrelevant if the claims are not infringed and/or
02:18 17 they're invalid, correct?

02:18 18 A. I believe so.

02:19 19 Q. So other than Mr. Dell, we'll put him to the
02:19 20 side, you're actually the only witness that the ladies
02:19 21 and gentlemen of the jury have heard from this week who
02:19 22 doesn't have any patents, right?

02:19 23 A. I don't know.

02:19 24 Q. And Motion Offense has asked you to be the one
02:19 25 to offer the opinion that the patent applications filed

02:19 1 here in October of 2017 are entitled to the
02:19 2 September 2012 priority date, correct?

02:19 3 A. Yes.

02:19 4 Q. All right.

02:19 5 MR. LANTIER: If we could pull up the
02:19 6 demonstrative slide with Mr. Zilka on it.

7 BY MR. LANTIER:

02:19 8 Q. Do you remember yesterday there was some video
02:19 9 deposition testimony played?

02:19 10 A. Yes.

02:19 11 Q. And one of the videos that was played was this
02:19 12 Mr. Zilka from Mirai Ventures, right?

02:19 13 A. Yes.

02:19 14 Q. And you know he's a lawyer, right?

02:19 15 A. I don't know.

02:19 16 Q. Okay. You're not sure one way or the other?

02:19 17 A. Correct.

02:20 18 Q. Okay. In any event, do you recall that he
02:20 19 testified about what a continuation-in-part application
02:20 20 is?

02:20 21 A. Yes.

02:20 22 Q. And what he said is that: A
02:20 23 continuation-in-part application is an application that
02:20 24 shares at least one common inventor with a previous
02:20 25 application and introduces in one form or another new

02:20 1 matter.

02:20 2 Right?

02:20 3 A. That's what he said.

02:20 4 Q. And then he was asked: Well, what's the
02:20 5 difference between a continuation application and a
02:20 6 continuation-in-part application?

02:20 7 And he says: The latter requires that there
02:20 8 be in one form or another new matter.

02:20 9 Correct?

02:20 10 A. That is what he said.

02:20 11 Q. Sure. And the use of the word "the latter"
02:20 12 there means it's the second term.

02:20 13 So he's referring to the continuation-in-part
02:20 14 application, right?

02:20 15 A. I believe so.

02:20 16 Q. So we know that when a continuation-in-part
02:20 17 application is filed, it means that there is in one
02:20 18 form or another new matter in that application,
02:20 19 correct?

02:21 20 A. I think so.

02:21 21 Q. And we haven't heard any Motion Offense
02:21 22 witness take the stand and explain what that new matter
02:21 23 is, correct?

02:21 24 A. I don't know.

02:21 25 Q. You're not sure -- you've been here all week,

02:21 1 right?

02:21 2 A. Yes.

02:21 3 Q. Have you heard anyone from Motion Offense take
02:21 4 the stand and say, hey. Look. Here's what we added to
02:21 5 these patent applications. It's not what is in the
02:21 6 claims here? Have you heard that?

02:21 7 A. I don't know.

02:21 8 Q. You were here when Professor Shamos testified
02:21 9 this morning, correct?

02:21 10 A. Yes.

02:21 11 Q. And you heard him explain exactly what the new
02:21 12 matter is that's in the claims that are asserted here
02:21 13 at the trial, correct?

02:21 14 A. I heard his answers to the questions asked.
02:21 15 Yes.

02:21 16 Q. And during your testimony, you pointed to
02:21 17 exactly two paragraphs of the 2012 filings to refute
02:22 18 what Professor Shamos said, correct?

02:22 19 A. Yes.

02:22 20 Q. And that's going to be at PTX-1333.
02:22 21 That was the document you were looking at,
02:22 22 correct?

02:22 23 A. Yes.

02:22 24 Q. And it was Paragraph 73, and it was Paragraph
02:22 25 51.

02:22 1 Did I get that right?

02:22 2 A. I think so. Yes.

02:22 3 Q. And so later in the trial, if the ladies and
02:22 4 gentlemen of the jury would like to take a look at what
02:22 5 you identified to say that that -- that the claims
02:22 6 asserted in this case are supported in the 2012 patent
02:22 7 applications, they just need to read those two
02:22 8 paragraphs to see what you identified, correct?

02:22 9 A. No. That's wrong.

02:22 10 Q. Sir, are you saying you identified a paragraph
02:22 11 today other than Paragraph 73 or 51?

02:22 12 A. No. That's right.

02:22 13 Q. Okay. Those are the two things you
02:22 14 identified, correct?

02:22 15 A. Today. Yes.

02:22 16 Q. And today was the day for your testimony on
02:23 17 the priority date issue, correct?

02:23 18 A. Yes. Rebutting Dr. Shamos.

02:23 19 Q. You didn't offer any testimony today rebutting
02:23 20 anything that Dr. Shamos said about the content of
02:23 21 Dropbox 2017, correct?

02:23 22 A. Correct.

02:23 23 Q. You did not testify that there's a single
02:23 24 limitation of any asserted claim that would be missing
02:23 25 from Dropbox 2017, correct?

02:23 1 A. Correct.

02:23 2 Q. And you understand that the claims must be
02:23 3 applied the same way for invalidity as they'll be
02:23 4 applied for purposes of infringement, correct?

02:24 5 A. That is my understanding of legal principles.

02:24 6 Q. And, sir, you're not denying that there was
02:24 7 new material added to both the '158 and the '052
02:24 8 applications on October 3rd, 2017, correct?

02:24 9 A. They're not relevant to the asserted claims,
02:24 10 so I don't have opinions on them.

02:24 11 Q. You don't have -- sir, just to be sure I
02:24 12 understand --

02:24 13 MR. LANTIER: And maybe we could call up
02:24 14 Dr. Shamos' Slide 102.

02:24 15 If we could go to the first one, before
02:24 16 he's got the conclusion there.

02:24 17 BY MR. LANTIER:

02:24 18 Q. You see his slide here, 102?

02:24 19 A. Yes.

02:24 20 MR. LANTIER: Put it back on the screen.

21 BY MR. LANTIER:

02:25 22 Q. The question is this: He highlighted all
02:25 23 those paragraphs in yellow.

02:25 24 Do you remember that?

02:25 25 A. Yes.

02:25 1 Q. You're not challenging that all those
02:25 2 paragraphs were added on October 3rd, 2017 to the
02:25 3 patent applications, correct?

02:25 4 A. Correct.

02:25 5 Q. And you understand that it's Motion Offense's
02:25 6 burden to prove to the ladies and gentlemen of the jury
02:25 7 that the claims in this case are entitled to be
02:25 8 backdated to the 2012 applications, correct?

02:25 9 A. I don't know.

02:25 10 Q. You just don't know?

02:25 11 A. Correct.

02:25 12 Q. You don't know whose burden it is to show
02:25 13 whether a claim is entitled to an earlier priority
02:25 14 date?

02:25 15 A. I'm not sure. I'm not a lawyer.

02:25 16 Q. You didn't look into that before you offered
02:25 17 that opinion at the end of your testimony, that the
02:25 18 claims are entitled to the earlier priority date?

02:26 19 A. I provided a technical opinion that they are
02:26 20 entitled.

02:26 21 Q. But you don't understand the law on it,
02:26 22 correct?

02:26 23 A. I was asked to do that research, and I did it.

02:26 24 Q. "That research" being not the legal research,
02:26 25 I guess, into the question of whose burden it is to

02:26 1 show that the claims are fully supported in the prior
02:26 2 application?

02:26 3 A. Correct. I did the technical research because
02:26 4 I was asked to.

02:26 5 Q. Okay. And you looked at those two paragraphs
02:26 6 we identified earlier, correct?

02:26 7 A. Yes.

02:26 8 Q. Now, the other thing you testified about --
02:26 9 the only other thing you testified about during your
02:26 10 brief rebuttal was that you said that the claims
02:26 11 wouldn't cover the iPhone or the Android mobile apps,
02:26 12 correct?

02:26 13 A. I don't think I said that.

02:27 14 Q. Okay. You don't remember that there was a
02:27 15 claim of the '215 patent that was pulled up by
02:27 16 Mr. Dahlgren.

02:27 17 You don't remember that?

02:27 18 A. I remember that. I don't remember -- I think
02:27 19 you're mischaracterizing what I said.

02:27 20 Q. All right. As I remember it, what you said
02:27 21 was -- well, strike that.

02:27 22 What I remember is he pulled up the claim, he
02:27 23 pointed you to some words in the claim -- I think it
02:27 24 was file explorer interface or file explorer
02:27 25 application -- and he asked you whether that would

02:27 1 encompass Dropbox mobile from the 2011 time period.

02:27 2 Do you remember that?

02:27 3 A. Yes.

02:27 4 Q. Okay. And I'm -- is that a fair
02:27 5 characterization of what you were talking about?

02:27 6 A. Yes.

02:27 7 Q. Sir, your testimony was that the ladies and
02:27 8 gentlemen of the jury should conclude that the mobile
02:27 9 application doesn't invalidate or can't contribute to
02:27 10 invalidating the claims of the patents because those
02:28 11 claims are not covered -- they don't cover the mobile
02:28 12 phone application, right?

02:28 13 A. The file explorer application is not there in
02:28 14 2011.

02:28 15 Q. In a mobile phone, right?

02:28 16 A. In what Dr. Shamos pointed to. Correct.

02:28 17 Q. So you said mobile phones, they didn't have
02:28 18 file explorer interfaces until 2016, correct?

02:28 19 A. I said an iPhone and an iPad did not have a
02:28 20 file application till 2016 and later.

02:28 21 Q. Okay. And the Android had it a little bit
02:28 22 earlier; is that right?

02:28 23 A. I didn't testify on Android.

02:28 24 Q. Do you know?

02:28 25 A. I don't remember. I don't know.

02:28 1 Q. So you don't know whether the Android had it
02:28 2 earlier or not; is that right?

02:28 3 A. There were no opinions provided for Android.

02:28 4 MR. LANTIER: Now, if we could call up
02:28 5 the '215 patent. So that's PTX-6, I believe.

02:29 6 And let's go into the written description
02:29 7 in these patents again for a moment. And if we could
02:29 8 call up Column 22 at Lines 48 to 54, and in particular,
02:29 9 I'll be looking at Line 49.

02:29 10 BY MR. LANTIER:

02:29 11 Q. You see it's talking about the execution
02:29 12 environment of the -- in the patents here?

02:29 13 MR. LANTIER: If we go up -- I apologize,
02:29 14 Mr. Lee. That was my fault.

15 BY MR. LANTIER:

02:29 16 Q. If we go up here to Line 48, 47, it's talking
02:29 17 about the execution environment?

02:29 18 A. Yes.

02:29 19 Q. And I don't know if the -- if the ladies and
02:29 20 gentlemen of the jury will remember this, but when you
02:29 21 were talking about Paragraph 73, you talked about this
02:29 22 language about an execution environment, correct?

02:29 23 A. Yes.

02:29 24 Q. And you said this is what shows that there's
02:30 25 support for the claims is that we're going to look at

02:30 1 this execution environment, correct?

02:30 2 A. In part. Correct.

02:30 3 Q. Yes. Have you read this portion of the patent
02:30 4 to see what the patent itself says are execution
02:30 5 environments for the invention?

02:30 6 A. Yes.

02:30 7 Q. And it says here, if we look to Line 49, that:
02:30 8 Exemplary communication agents include e-mail clients
02:30 9 and phone clients, correct?

02:30 10 A. Yes. I see those words.

02:30 11 Q. And if we turn to the written description at
02:30 12 Column 7, Lines 24 to 33.

02:30 13 MR. LANTIER: Just one line up. I think
02:30 14 I said the wrong one.

02:30 15 There you go. Thank you.

16 BY MR. LANTIER:

02:30 17 Q. So we have here part of the written
02:31 18 description of the patents. This is in all of the
02:31 19 asserted patents in this case. And it says: Exemplary
02:31 20 devices included in and/or otherwise providing suitable
02:31 21 execution environments for configuring according to the
02:31 22 subject matter include -- and we see it right there --
02:31 23 mobile devices.

02:31 24 Correct?

02:31 25 A. Yes.

02:31 1 Q. That's what the patent says are included in
02:31 2 the invention, correct?

02:31 3 A. Yes. In the list of examples.

02:31 4 MR. LANTIER: I pass the witness.

02:31 5 REDIRECT EXAMINATION

02:31 6 BY MR. DAHLGREN:

02:31 7 Q. I just have a few brief questions, Dr. Akl.

02:32 8 So the two paragraphs that you pointed to,
02:32 9 Paragraph 73 and Paragraph 51, are those just examples
02:32 10 of what Dr. Shamos said was missing?

02:32 11 A. Yes.

02:32 12 Q. And did you generally confirm that the things
02:32 13 Dr. Shamos contested -- excuse me.

02:32 14 Did you generally confirm the things that
02:32 15 Dr. Shamos contested were present?

02:32 16 A. Yes.

02:32 17 Q. And did you confirm that the claims generally
02:32 18 were entitled to a 2012 priority date?

02:32 19 A. Yes.

02:32 20 MR. DAHLGREN: Mr. Gooden, if you could
02:32 21 pull up Paragraph 73, please, of the '635 application.
02:32 22 It's PTX-1333.

23 BY MR. DAHLGREN:

02:32 24 Q. Mr. Lantier asked you about some examples of
02:33 25 execution environments. I'd like you to look at the

02:33 1 end of Paragraph 73 and tell me what example is being
02:33 2 disclosed here.

02:33 3 A. This says: For example, such arrangements may
02:33 4 operate at least partially in a browser in one
02:33 5 execution environment and at least partially in a
02:33 6 server in another execution environment interoperating
02:33 7 via a network.

02:33 8 MR. DAHLGREN: No further questions.
02:33 9 Pass the witness.

10 RECROSS-EXAMINATION

11 BY MR. LANTIER:

02:33 12 Q. Just one question. And this is on Paragraph
02:33 13 73 in the highlighted sentence. Were you here this
02:33 14 morning when Professor Shamos explained exactly what
02:33 15 that sentence of Paragraph 73 is about?

02:33 16 A. Yes.

02:33 17 MR. LANTIER: Thank you. No further
02:33 18 questions.

02:34 19 MR. DAHLGREN: No further questions.

02:34 20 THE COURT: May he be dismissed?

02:34 21 MR. DAHLGREN: Yes.

02:34 22 Thank you, Dr. Akl.

02:34 23 THE COURT: Do you have any other
02:34 24 witnesses?

02:34 25 MR. DEVLIN: Plaintiff rests, Your Honor.

02:34 1 Thank you.

02:34 2 THE COURT: Very good.

02:34 3 Ladies and gentlemen, we are -- and
02:34 4 anything else from the defendant?

02:34 5 MR. LANTIER: No, Your Honor. Thank you.

02:34 6 THE COURT: We are done with the evidence
02:34 7 in the case. We have a couple of bureaucratic things
02:34 8 to get done. I need to make sure that the jury charge
02:34 9 I'm going to read to you is in proper form.

02:34 10 Do we know when it will be here?

02:34 11 MR. DEVLIN: We have e-mailed it back,
02:34 12 and someone was already on their way to pick it up.

02:34 13 THE COURT: Okay. Very good.

02:34 14 MR. DEVLIN: Should be here within the
02:34 15 next five, ten minutes, Your Honor.

02:34 16 THE COURT: Perfect. So we will --
02:34 17 sometime before 3:00 o'clock, I'll begin reading to you
02:34 18 the charge. It takes me about an hour to read it to
02:34 19 you. And so if you all would be kind enough to go back
02:35 20 to the jury room. As soon as --

02:35 21 MR. DEVLIN: I've just been informed that
02:35 22 I was probably a little bit optimistic.

02:35 23 THE COURT: That's fine. We have things
02:35 24 to do.

02:35 25 MR. DEVLIN: It's a lot of printing.

02:35 1 THE COURT: Do you think it'll be here in
02:35 2 the next 25 minutes?

02:35 3 MR. DEVLIN: 25? Roughly. Hopefully.
02:35 4 We'll call and get an update, Your Honor. Thank you.

02:35 5 THE COURT: Okay. We'll get started with
02:35 6 that as soon as we have copies here.

02:35 7 THE BAILIFF: All rise.
02:35 8 (Jury exited the courtroom.)

02:35 9 THE COURT: You may be seated.
02:35 10 Okay. Let me take it in order. I'll
02:35 11 start with the defendant.

02:35 12 Do you have motions for directed verdict?
02:35 13 And then I'll hear from plaintiff.

02:35 14 MS. MAJOR: Good afternoon, Your Honor.
02:36 15 Dropbox has motions to present pursuant to Rule 50, and
02:36 16 we're prepared to do so now, Your Honor.

02:36 17 With Your Honor's permission, we'd also
02:36 18 like to follow up our oral motion with a supplemental
02:36 19 written submission tomorrow morning.

02:36 20 Is that acceptable?

02:36 21 THE COURT: Of course.

02:36 22 MS. MAJOR: Thank you.

02:36 23 So, Your Honor, Dropbox respectfully
02:36 24 moves for a judgment as a matter of law under Rule
02:36 25 50(a) on Motion Offense's claims against it and

02:36 1 Dropbox's defenses and counterclaims.

02:36 2 Specifically we move for a judgment as a
02:36 3 matter of law on Motion Offense's claims and ask the
02:36 4 Court to rule as a matter of law that Dropbox does not
02:36 5 infringe any asserted claim, that Motion Offense has
02:36 6 failed to prove entitlement to any damages, and Motion
02:36 7 Offense has failed to prove that the asserted claims
02:36 8 are entitled to any priority date earlier than
02:36 9 October 3rd, 2017.

02:36 10 Your Honor, Dropbox also moves for
02:36 11 judgment as a matter of law on Dropbox defenses and
02:36 12 counterclaims and asks the Court to rule as a matter of
02:37 13 law that the asserted claims are invalid over Dropbox
02:37 14 2011 alone or in combination with any other art or the
02:37 15 knowledge of a skilled artisan, and that they're
02:37 16 invalid over Dropbox 2011 in combination -- AirDropper
02:37 17 alone or in combination with other art or the knowledge
02:37 18 of a skilled artisan.

02:37 19 I could go on, Your Honor, but I
02:37 20 understand that we'll follow this up with a detailed
02:37 21 submission and that that may be, in your view,
02:37 22 sufficient.

02:37 23 Is that true?

02:37 24 THE COURT: Those will be overruled.

02:37 25 Anything from plaintiff?

02:37 1 MR. DEVLIN: This has been -- this is
02:37 2 right now becoming one of those days. The same lawyer
02:37 3 who ran back to grab the jury charge copies is the
02:37 4 lawyer who has the JMOLs.

02:37 5 I would -- if Your Honor is okay, I'd
02:37 6 rather have that lawyer come back so we do say the
02:37 7 right words rather than me trying to wing it right now,
02:37 8 if we can do that as soon as he's back, or at Your
02:38 9 Honor's convenience, of course, after that.

02:38 10 THE COURT: How about we do this with the
02:38 11 agreement of defendant? If -- when we get back, I'll
02:38 12 read the charge, and then they -- I'm going to deny
02:38 13 your motion.

02:38 14 But would it be okay with defendant if we
02:38 15 got the charge read to the jury as soon as it gets
02:38 16 here, and then I can allow the plaintiff to make their
02:38 17 motion?

02:38 18 MR. LANTIER: Yes, of course, Your Honor.

02:38 19 THE COURT: Okay. Very good.

02:38 20 MR. DEVLIN: Thank you, Your Honor.

02:38 21 THE COURT: And then I'll hear first from
02:38 22 plaintiff with respect to any objections you have to
02:38 23 the charge.

02:38 24 MR. PUCKETT: Your Honor, we discussed on
02:38 25 the record a little earlier a motion that we had filed

02:38 1 requesting an instruction on the issue of abandonment.

02:38 2 I think that one's preserved. So I'm not going to make

02:38 3 that objection now.

02:38 4 We just have two objections to the charge

02:38 5 as we understand that it will be presented or will be

02:38 6 finalized.

02:38 7 The first is that Motion Offense had made

02:38 8 a proposal for an instruction with respect to secret

02:39 9 prior art not counting as prior art.

02:39 10 And in particular, we had requested an

02:39 11 instruction that read: To qualify as prior art, the

02:39 12 alleged prior art must have been accessible to the

02:39 13 public at the relevant time. For example, when someone

02:39 14 other than the patentee uses a device or a system in

02:39 15 secret and the use of the system is concealed from the

02:39 16 public at large, that secret use of a system cannot

02:39 17 qualify as prior art under the law.

02:39 18 And we provided citations for that in our

02:39 19 submission with the joint pretrial order. So that's

02:39 20 our first objection, Your Honor.

02:39 21 And our second objection is with respect

02:39 22 to the inclusion of a jury instruction on the issue of

02:39 23 divided infringement.

02:39 24 And so we object to the Court's

02:39 25 instruction in that regard and it not being a fit with

02:39 1 the evidence that has been admitted in this trial. And
02:39 2 also that the instruction as submitted we view as not
02:39 3 being an accurate statement of the law.

02:39 4 And we provided citations in our
02:39 5 authority in that regard to the version that we
02:40 6 submitted with the pretrial order to the Court.

02:40 7 THE COURT: Okay.

02:40 8 MR. PUCKETT: Thank you, Your Honor.

02:40 9 MS. AMADI: Good afternoon, Your Honor.

02:40 10 Brittany Amadi on behalf of Dropbox.

02:40 11 Dropbox objects to Instruction 7.6,
02:40 12 burdens of proof and standards of proof.

02:40 13 Dropbox objects to this instruction on
02:40 14 the basis that the statement that "clear and convincing
02:40 15 evidence is evidence that produces in your mind a firm
02:40 16 belief or conviction as to the truth of the matter
02:40 17 sought to be established" is not an accurate statement
02:40 18 of Federal Circuit law.

02:40 19 Dropbox objects to Instruction No. 10.1,
02:40 20 direct infringement generally.

02:40 21 Dropbox objects to this instruction on
02:40 22 the basis that the statement "direct patent
02:40 23 infringement does not require proof that the infringing
02:41 24 party intended to infringe the patent. A party such as
02:41 25 Dropbox can directly infringe a patent without knowing

02:41 1 of the patent at all or without knowing that what the
02:41 2 party was doing or selling infringed the patent..." is
02:41 3 prejudicial and confusing to the extent that it imposes
02:41 4 a negative requirement of what is not required to prove
02:41 5 infringement.

02:41 6 Dropbox objects to the proposed
02:41 7 Instruction No. 11.1, presumption of validity, as
02:41 8 prejudicial and unnecessary in view of the Court's
02:41 9 instruction regarding clear and convincing evidence
02:41 10 standard for invalidity.

02:41 11 And this is with respect to the Chiron
02:41 12 Corp. v. Genentech case, 363 F.3d 1247, Federal Circuit
02:41 13 2004, which states that the presumption of validity and
02:41 14 heightened burden of proof for invalidity are static
02:41 15 and in reality different expressions of the same thing.

02:41 16 Dropbox objects to Instruction 11.2.3,
02:42 17 prior art corroboration of oral testimony.

02:42 18 Dropbox objects to the inclusion of an
02:42 19 instruction on corroboration. Dropbox has offered
02:42 20 documentary and physical evidence in support of the
02:42 21 prior art on which it relies. Accordingly, this
02:42 22 instruction is unnecessary and likely to confuse the
02:42 23 jury.

02:42 24 Dropbox further objects to the extent
02:42 25 this instruction fails to reference the rule of reason

02:42 1 under correct Federal Circuit law.

02:42 2 Dropbox also objects to Instruction 11.4
02:42 3 to the extent that there's no instruction on the nexus
02:42 4 requirement for secondary considerations.

02:42 5 Thank you, Your Honor.

02:42 6 THE COURT: Okay. I think that's all
02:42 7 that we have, but if I'm missing something, you all
02:42 8 need to let me know.

02:42 9 MR. LANTIER: Your Honor, I think there's
02:43 10 two issues. One, we could deal with now; one, I think
02:43 11 we can deal with later.

02:43 12 THE COURT: Sure.

02:43 13 MR. LANTIER: We do need to read in the
02:43 14 exhibits from Professor Shamos. It doesn't need to
02:43 15 happen --

02:43 16 THE COURT: Absolutely. Let's do it.
02:43 17 Sure.

02:43 18 MR. DEVLIN: There's an issue.

02:43 19 MR. LANTIER: Okay. I think there is an
02:43 20 issue that the parties are still working on.

02:43 21 Could we do that right before we bring
02:43 22 the jury back in?

02:43 23 THE COURT: Absolutely. We don't have
02:43 24 the charge here. We can do whatever you want.

02:43 25 MR. LANTIER: Thanks, Your Honor.

02:43 1 The other item is we talked at the outset
02:43 2 of the trial about the Section 101 issue and whether
02:43 3 there would need to be a bench trial.

02:43 4 I think the parties have reached -- or I
02:43 5 think the parties have a common understanding, I should
02:43 6 say, about the nature of the Court's prior rulings and,
02:43 7 specifically, that there was a finding made that none
02:43 8 of the asserted claims was directed to an abstract idea
02:43 9 at Alice Step 1.

02:43 10 And therefore, there really wouldn't be
02:43 11 an issue to move forward on in a bench trial because
02:43 12 you don't get to Alice Step 2 unless that legal issue
02:44 13 is decided the other way.

02:44 14 So I think we were working on a proposed
02:44 15 order that would memorialize what we both understand
02:44 16 the Court's ruling would be, and it would preserve
02:44 17 Dropbox's position for appellate purposes but would not
02:44 18 necessitate a bench trial.

02:44 19 But we did want to put -- want to put
02:44 20 that on Your Honor's radar and ensure that it was okay
02:44 21 with Your Honor.

02:44 22 THE COURT: Tell me this, because I think
02:44 23 it was Judge Gilliland who handled originally the 101.
02:44 24 And I should know this because I've dealt with 101 so
02:44 25 often, but I've dealt with it at the motion to dismiss

02:44 1 stage, the summary judgment stage, and I don't know
02:44 2 what's -- it was the pretrial conference stage, but I
02:44 3 don't know if it was --

02:44 4 MR. LANTIER: It was the summary
02:44 5 judgment.

02:44 6 THE COURT: Okay. So it seems to me that
02:44 7 if -- that's what I thought it was.

02:44 8 So it seems to me that if I have
02:44 9 granted -- affirmed the grant of a summary judgment,
02:44 10 then it's resolved because summary judgment is a
02:45 11 determination as a matter of law, and it's preserved.

02:45 12 Now, again, I'm not an appellate lawyer,
02:45 13 but it seems to me that there's nothing else you all
02:45 14 need to do to put bells and whistles on my
02:45 15 determination as a matter of law at the summary
02:45 16 judgment stage that none of the claims are -- meet the
02:45 17 first prong.

02:45 18 MR. LANTIER: I think the reason that the
02:45 19 parties think we do need to take one more step is that
02:45 20 there were not cross-motions for summary judgment. It
02:45 21 was only Dropbox that had moved for summary judgment of
02:45 22 invalidity.

02:45 23 And so we want to make it clear on the
02:45 24 record that judgment was affirmatively granted against
02:45 25 Dropbox at Alice Step 1 as opposed to a ruling just

02:45 1 that Dropbox didn't meet the standard to obtain summary
02:45 2 judgment of invalidity at that point in the case.

02:45 3 THE COURT: I think it's the same. I
02:45 4 mean, I know we're -- I actually -- unlike a lot of
02:45 5 judges, I actually enjoy these colloquies about these
02:46 6 issues. So I'm not -- I'm really -- I really do want
02:46 7 to have -- I find it intellectually fascinating.

02:46 8 But it seems to me that a denial of the
02:46 9 motion is -- there's no -- the counter-motion from the
02:46 10 plaintiff would have been the same.

02:46 11 And so, again, it seems to me that the
02:46 12 granting -- I'll do whatever you want, because I want
02:46 13 you to protect your record.

02:46 14 But it just seems to me that having made
02:46 15 that -- I don't know how well -- for example, it would
02:46 16 make no sense for the plaintiff to have filed anything
02:46 17 because they would essentially be doing the negative
02:46 18 and saying it doesn't -- a summary judgment, that it
02:46 19 doesn't. And I don't know that that makes sense
02:46 20 either.

02:46 21 MR. LANTIER: I agree with Your Honor. I
02:46 22 think if there had been a motion for judgment as a
02:46 23 matter of law of no invalidity, then I believe --

02:47 24 THE COURT: But not no invalidity -- I'm
02:47 25 sorry. But that it -- not just no invalidity, but that

02:47 1 it doesn't meet the first prong, which is what we care
02:47 2 about here.

02:47 3 MR. LANTIER: That's right. That's
02:47 4 right.

02:47 5 THE COURT: And so it seems to me that
02:47 6 unless there's something really weird about appellate
02:47 7 law that I don't understand, which may be all of it,
02:47 8 but -- is that it only makes sense for your side to
02:47 9 file a motion for summary judgment saying that it is
02:47 10 invalid under 101.

02:47 11 And if that's rejected, that's what
02:47 12 precludes the need to have the jury do anything. And I
02:47 13 don't know what else you can do -- I don't know why you
02:47 14 would have to do anything else to protect your record.

02:47 15 MR. LANTIER: And, Your Honor, I think my
02:47 16 hesitation is I've had prior cases where the patent
02:47 17 owner did affirmatively move for summary judgment at
02:47 18 Alice Step 1, and it was granted.

02:47 19 And so I think everybody here is in
02:47 20 agreement that the issue has been resolved against
02:47 21 Dropbox, the Court has concluded that the claims are
02:48 22 not directed to an abstract idea at Alice Step 1, and
02:48 23 it truly is just an issue, Your Honor, of us wanting to
02:48 24 make sure we've preserved that issue, and there's no
02:48 25 procedural defect in how that goes up.

02:48 1 THE COURT: I'm happy to do whatever you
02:48 2 want to protect it. I'm just saying, from my limited
02:48 3 understanding of patent law, what makes sense to me is
02:48 4 that you all have done -- only you all would file a
02:48 5 motion that would make any sense. Because I can't
02:48 6 imagine granting a plaintiff's motion for summary
02:48 7 judgment that there is no invalidity.

02:48 8 MR. LANTIER: I understand what Your
02:48 9 Honor's saying.

02:48 10 THE COURT: But let me make clear, I want
02:48 11 to do whatever I can to protect you all's record. So
02:48 12 I'm happy to do it.

02:48 13 MR. LANTIER: Very good. And we mainly
02:48 14 wanted to inform Your Honor that neither party is -- at
02:48 15 this point believes that there would be a reason to
02:48 16 have the bench trial given the Court's prior ruling.

02:48 17 THE COURT: Okay. Very good.
02:48 18 Anything else we need to take up?

02:48 19 MR. LANTIER: No, Your Honor.

02:48 20 THE COURT: If you all would let us know
02:49 21 when the charge is here and ready to be distributed, we
02:49 22 actually don't need the verdict form -- I guess it'll
02:49 23 be coming -- because they won't get it until tomorrow
02:49 24 after the closing arguments.

02:49 25 But as soon as the charge is here and if

02:49 1 you would put one on each chair for the jurors, then
02:49 2 I'll come out, and I'll read it.

02:49 3 MR. LANTIER: Thank you, Your Honor.

02:49 4 THE BAILIFF: All rise.

02:49 5 (Recess taken.)

03:14 6 THE BAILIFF: All rise.

03:14 7 THE COURT: Please remain standing for
03:14 8 the jury.

03:14 9 (Jury entered the courtroom.)

03:15 10 THE COURT: Thank you. You may be
03:15 11 seated.

03:15 12 Ladies and gentlemen, it is my duty and
03:15 13 responsibility to instruct you on the law that you are
03:15 14 to apply in this case. The law contained in these
03:15 15 instructions along with the preliminary instructions I
03:15 16 gave you at the beginning of the trial is the only law
03:15 17 that you may follow.

03:15 18 It is your duty to follow what I instruct
03:15 19 you the law is regardless of any opinion that you might
03:15 20 have as to what the law ought to be.

03:15 21 If I've given you the impression during
03:15 22 the trial that I have favored either party, you must
03:15 23 disregard that impression. If I've given you the
03:15 24 impression during the trial that I have any opinion
03:16 25 about the facts in this case, you must disregard that

03:16 1 too.

03:16 2 You are the sole judges of the facts in
03:16 3 this case. Other than these instructions I'm giving
03:16 4 you on the law, you must disregard anything that I've
03:16 5 said or done during the trial as you arrive at your
03:16 6 verdict.

03:16 7 You should consider all the instructions
03:16 8 about the law as a whole, regard each instruction in
03:16 9 light of the others without isolating a particular
03:16 10 statement or paragraph.

03:16 11 The testimony of the witnesses and other
03:16 12 exhibits introduced by the parties constitutes the
03:16 13 evidence. The statements of counsel, for example,
03:16 14 tomorrow when you hear the closing arguments, are not
03:16 15 evidence. They are only arguments.

03:16 16 It is important for you to distinguish
03:16 17 between the arguments of counsel and the evidence upon
03:16 18 which those arguments rest. What the lawyers say or do
03:16 19 is not evidence. You may, however, consider their
03:16 20 arguments in light of the evidence that has been
03:16 21 admitted and determine whether the evidence admitted in
03:16 22 this trial supports their arguments.

03:17 23 You must determine the facts from all the
03:17 24 testimony that you've heard and all the evidence that I
03:17 25 have admitted. You are the judges of the facts, but in

03:17 1 finding those facts, you must apply the law as I
03:17 2 instruct you.

03:17 3 You are required by law to decide the
03:17 4 case in a fair, impartial and unbiased manner based
03:17 5 entirely on the law and the evidence presented to you
03:17 6 here in the courtroom.

03:17 7 You may not be influenced by passion,
03:17 8 prejudice or sympathy that you might have for either
03:17 9 party in arriving at your verdict.

03:17 10 Tomorrow morning, you will hear closing
03:17 11 arguments from the attorneys. Statements and arguments
03:17 12 of the attorneys are not evidence. They are not
03:17 13 instructions on the law. They are intended to assist
03:17 14 you in understanding the evidence and their
03:17 15 contentions.

03:17 16 A verdict form has been prepared for you.
03:17 17 You will -- actually you will get the verdict form once
03:17 18 you go back tomorrow after the closing arguments. It
03:17 19 will be in the jury room.

03:17 20 After you have reached a unanimous
03:18 21 decision and agreement as to the verdict, your
03:18 22 foreperson will fill in the blank in the verdict form.
03:18 23 He or she will date it and sign it, hopefully in a
03:18 24 legible manner.

03:18 25 Answer -- which I've not always had.

03:18 1 Answer each question in the verdict form
03:18 2 from the facts as you may find them to be. Do not
03:18 3 decide who you think should win the case and answer the
03:18 4 questions to reach any result. Your answers and your
03:18 5 verdict must be unanimous.

03:18 6 The evidence that you are to consider
03:18 7 consists of the testimony of the witnesses, the
03:18 8 documents and other exhibits admitted into evidence,
03:18 9 any stipulations to which the lawyers agreed, and any
03:18 10 fair inferences and reasonable conclusions that you may
03:18 11 draw from the facts and circumstances that have been
03:18 12 proven. Nothing else is evidence.

03:18 13 Generally speaking, there are two types.
03:18 14 One is direct, such as the testimony of an eyewitness.
03:18 15 The other is indirect or circumstantial.
03:18 16 Circumstantial evidence is evidence that proves a fact
03:19 17 from which you can logically conclude another fact
03:19 18 exists.

03:19 19 Generally speaking, the law makes no
03:19 20 distinction between direct and circumstantial evidence
03:19 21 but simply requires that you determine the facts from
03:19 22 all of the evidence that you hear in this case, whether
03:19 23 it be direct or circumstantial or a combination.

03:19 24 As you were instructed before the trial
03:19 25 began, as you judge the facts, consider all of the

03:19 1 evidence, both direct and circumstantial. But that
03:19 2 does not mean that you have to believe all the
03:19 3 evidence, because it is entirely up to you to decide
03:19 4 which evidence that you received in the case gets
03:19 5 whatever weight that you individually believe it
03:19 6 deserves.

03:19 7 It will be exclusively up to you to
03:19 8 decide which witnesses you believed or didn't believe,
03:19 9 the weight you gave any testimony that you heard and
03:19 10 how much of any witness' testimony that you choose to
03:19 11 accept or reject.

03:19 12 You should never have been influenced by
03:20 13 any ruling I made on an objection. If I sustained an
03:20 14 objection, pretend the question was never asked. If
03:20 15 I -- if there was an answer given, disregard it. If I
03:20 16 overruled the objection, act like it was never made.
03:20 17 If I gave you instructions that some item of evidence
03:20 18 was received for a limited purpose, follow my
03:20 19 instructions.

03:20 20 If I gave you any limiting instructions
03:20 21 during trial, follow them. Any testimony I told you to
03:20 22 exclude or disregard is not evidence, and you may not
03:20 23 consider it.

03:20 24 You must not conduct any independent
03:20 25 research or investigation. You must make your decision

based only on the evidence admitted at trial and nothing else.

You alone are to determine the questions of credibility or truthfulness of the witnesses.

In weighing the testimony of the witnesses, you may consider their manner and demeanor on the stand, any feelings or interest they had in the case, any prejudice or bias about the case that he or she may have had, and the consistency or inconsistency of any testimony considered in the light of the circumstances.

Was the witness contradicted by other credible evidence? Had he or she made statements at other times and places contrary to those made on the witness stand?

You must give the testimony of each witness the credibility that you believe it deserves. In determining what weight to give to the testimony of a witness, consider whether there was evidence that at some time the witness said or did something or failed to say or do something that was different from the testimony given by a different witness or that witness at the trial.

A simple mistake by a witness does not necessarily mean the witness was not telling the truth

03:21 1 as he or she remembered it. We're people. People
03:21 2 forget things. They remember things inaccurately. If
03:21 3 someone made a misstatement, consider whether that
03:21 4 misstatement was an intentional falsehood or if you
03:21 5 believe it was just a mistake.

03:21 6 The significance of that may depend on
03:21 7 whether it had to do with something important or
03:21 8 unimportant. That being said, it is exclusively in
03:22 9 your province to believe every word that a witness said
03:22 10 or to disregard anything that they said. You are the
03:22 11 exclusive judges of the facts.

03:22 12 You are not to decide this case by
03:22 13 counting the number of witnesses who testified for
03:22 14 either side. Witness testimony is weighed. Witnesses
03:22 15 are not counted.

03:22 16 The test is not the relative number of
03:22 17 witnesses but the relative convincing force of the
03:22 18 evidence that you heard. The testimony of a single
03:22 19 witness is sufficient to prove any fact, even if a
03:22 20 greater number of witnesses testified to the contrary
03:22 21 if, after considering all the evidence, you believed
03:22 22 that one witness.

03:22 23 A "stipulation" is an agreement. When
03:22 24 there's no dispute about certain facts, the parties may
03:22 25 agree or "stipulate" to those facts, and you must

03:22 1 accept any stipulated fact introduced into evidence
03:22 2 during trial, and you must treat it as if it had been
03:22 3 proven here in court.

03:22 4 In some instances during the trial, I
03:22 5 admitted certain testimony or exhibits into evidence
03:23 6 for a limited purpose. At the time I gave you a
03:23 7 limiting instruction regarding the limiting purpose --
03:23 8 limited purpose for which you may consider that
03:23 9 evidence. For any testimony or other evidence admitted
03:23 10 for a limited purpose, you're required to follow my
03:23 11 limiting instructions and only consider the evidence
03:23 12 for any specific limited purpose for which the evidence
03:23 13 was admitted.

03:23 14 You should determine the facts in this
03:23 15 case solely from the properly admitted evidence.

03:23 16 Certain charts and summaries were shown
03:23 17 to you solely to help explain or summarize the facts
03:23 18 disclosed by other documents that are themselves in
03:23 19 evidence. These charts and summaries are not
03:23 20 themselves evidence or proof of any facts unless I
03:23 21 specifically admitted that chart or summary into
03:23 22 evidence as an exhibit.

03:23 23 Certain "demonstrative" exhibits were
03:23 24 shown to you, such as PowerPoint presentations,
03:23 25 posters, models, illustrations of the evidence, but

03:23 1 they are not themselves evidence. The demonstrative
03:24 2 exhibit is merely a party's description, picture or
03:24 3 model that is used to describe or demonstrate other
03:24 4 evidence that was properly admitted into evidence
03:24 5 during the trial.

03:24 6 If your recollection of the admitted
03:24 7 evidence differs from what a demonstrative exhibit
03:24 8 purported to show, rely on your recollection.

03:24 9 You should consider charts, summaries or
03:24 10 demonstrative evidence if they assist you in
03:24 11 understanding the evidence that was properly admitted
03:24 12 during trial. But the decision on the facts of the
03:24 13 case must rest solely on the properly admitted evidence
03:24 14 itself.

03:24 15 As I discussed in the preliminary
03:24 16 instructions, there are two standards of proof that you
03:24 17 will apply to the evidence depending on which issue you
03:24 18 are considering.

03:24 19 On some issues, you must decide whether
03:24 20 certain facts -- you must decide whether certain facts
03:24 21 have been proven by the standard of proof of a
03:24 22 preponderance of the evidence.

03:25 23 That means that the fact that is to be
03:25 24 proven is more likely true than not true, that the
03:25 25 evidence in favor of that fact being true is sufficient

to tip the scale, even if slightly, in its favor.

On other issues that I will identify for you, you must use a higher standard and decide whether a fact has been proven by clear and convincing evidence.

That is a standard of evidence that produces in your mind a firm belief or conviction as to the truth of the matter that is sought to be established. It is evidence so clear, direct, weighty and convincing as to enable you to come to a clear conviction without hesitancy.

The standards are different from what you may have heard in a criminal proceeding. In criminal cases, facts must be proven beyond a reasonable doubt, the highest standard of proof we have.

On a scale of these various standards of proof, as you move from, first, preponderance of the evidence, where the proof need only be sufficient to tip the scale in favor of a party proving a fact to the further end -- furthest end, which is to beyond a reasonable doubt, where the fact must be proven to a very high degree of certainty, you may think of the standard of proof of clear and convincing evidence as in between the two other standards.

The plaintiff, Motion Offense, has the

burden of proving the elements of its claim for patent infringement by a preponderance of the evidence. Motion Offense must prove by a preponderance of the evidence that Dropbox has infringed each asserted patent claim. They must also prove by the same standard, a preponderance of the evidence, the amount of damages, if any, to which the plaintiff is entitled as a result of the patent infringement by defendant.

Dropbox, the defendant, does not have any burden of proof on the issues of patent infringement or damages.

If Motion Offense argues that it is entitled to a priority date for any asserted claim of the asserted patents that is earlier than October 3rd, 2017, then the plaintiff has the burden of proving to you by a preponderance of the evidence that there is written description support for that earlier date.

If you find that plaintiff fails to meet that burden, then you must base your evaluation of invalidity on whether plaintiff's patent claims were anticipated and/or obvious as of October 3rd, 2017.

On the other hand, Dropbox, to prove its case of invalidity of any of the asserted patents, must do so by a standard of clear and convincing evidence.

Do not let bias, prejudice or sympathy

03:27 1 play any part in your deliberations. A corporation and
03:28 2 all persons -- all persons -- are equal before the law.
03:28 3 They must be treated as equals here in a court of
03:28 4 justice.

03:28 5 I will first give you a summary on each
03:28 6 side's contentions. I will then provide you with
03:28 7 detailed instructions as to what each side must prove
03:28 8 to win on their contentions.

03:28 9 The plaintiff is Motion Offense, LLC.
03:28 10 The defendant is Dropbox, Inc. Motion Offense asserts
03:28 11 that Dropbox infringes four different patents.

03:28 12 The plaintiff filed suit in this Court
03:28 13 seeking damages from Dropbox for allegedly infringing
03:28 14 each of these patents by making, using, selling and
03:28 15 offering for sale in the United States the patented
03:28 16 inventions in connection with defendant's use and sale
03:28 17 of certain products and services.

03:28 18 More specifically, plaintiff alleges that
03:28 19 defendant has infringed and continues to infringe each
03:29 20 of the following individual patent claims.

03:29 21 Collectively the set of patent claims will be referred
03:29 22 to as the "Asserted Claims":

03:29 23 The '158 patent, Claims 3, 6 and 14;

03:29 24 '052, Claims 12, 20 and 27;

03:29 25 The '548, Claim 46;

03:29 1 The '215, Claim 18.

03:29 2 Plaintiff alleges that defendant
03:29 3 infringes each asserted claim when Dropbox makes, uses
03:29 4 and/or sells the claimed inventions in connection with
03:29 5 the following Dropbox services or plans:

03:29 6 Dropbox Personal Plus;

03:29 7 Dropbox Personal Family;

03:29 8 Dropbox Business Professional;

03:29 9 Dropbox Business Standard;

03:29 10 Dropbox Business Advanced; and

03:29 11 Dropbox Business Enterprise.

03:29 12 Motion Offense alleges that Dropbox
03:29 13 infringes each of the asserted claims as a result of
03:29 14 using and/or incorporating one or more of the following
03:30 15 technical issues -- oh, gosh. I'm sorry -- the
03:30 16 following technical features in the aforementioned
03:30 17 Dropbox plans:

03:30 18 Folder sharing with Smart Sync; and/or

03:30 19 File request with Smart Sync.

03:30 20 Dropbox denies that it has infringed any
03:30 21 of the asserted claims of any of the asserted patents.

03:30 22 They also argue that the plaintiff cannot
03:30 23 prove by a preponderance of the evidence that it is
03:30 24 entitled to a priority date for any asserted claim of
03:30 25 any of the patents that is earlier than October 3rd,

2017.

Dropbox also alleges that each of the asserted patent claims is invalid. Dropbox alleges that each of the asserted claims is invalid for being anticipated or obvious in light of the prior art.

Your job will be to decide on a claim-by-claim basis whether or not the plaintiff has met its burden to prove that each asserted patent claim has been infringed by Dropbox, and whether or not Dropbox has met its burden of proof to show that each of the asserted patent claims is invalid.

If you decide that any one or more asserted claims of any of the asserted patents has been, one, infringed, and, two, not invalid, then you will need to decide the amount of damages that should be awarded to Motion Offense to compensate for the infringement and whatever infringement you have found.

I think I'm going to skip that. It's pretty obvious what I'm doing.

Next, several times in my instructions, I'll refer to a person of ordinary skill in the field of the invention. For example, the language of the claims must be read from the perspective of a person of ordinary skill in field of the invention.

When you are comparing the patent claims

1 to the prior art to determine whether the patent claims
2 are invalid as anticipated or obvious, you must make
3 the comparison from the perspective of a person of
4 ordinary skill in the field of the invention.

5 In this case, a person of ordinary skill
6 in the art of the asserted patents would have had, one,
7 a bachelor's degree in electrical engineering, computer
8 science or related field, and, two, two years of work
9 experience in the computer science field including, for
10 example, network systems, distributed systems, storage
11 systems, through -- though additional education might
12 substitute and can substitute for less work experience
13 and vice versa.

14 Under the patent laws, a person is
15 granted a patent only if the invention claimed in the
16 patent is new and not obvious in light of what came
17 before.

18 That which came before is referred to as
19 the "prior art." The prior art includes references,
20 such as systems, publications or patents, that Dropbox
21 contends disclose the claimed invention or elements of
22 the claimed inventions in this case.

23 Dropbox contends that each of the
24 following is a prior art system to the asserted
25 patents:

03:33 1 Dropbox 2017 system;
03:33 2 Dropbox 2011 system; and
03:33 3 Dropbox 2011 AirDropper system.

03:33 4 You must determine whether each of the
03:33 5 above is prior art that can be considered in
03:33 6 determining whether the asserted claims of the asserted
03:33 7 patents are invalid.

03:33 8 There are different types of prior art,
03:33 9 and I will instruct you on the relevant types that you
03:33 10 must consider.

03:33 11 Dropbox must prove by clear and
03:33 12 convincing evidence that the Dropbox 2017 system or
03:33 13 2011 system or 2011 AirDropper system are prior art.

03:33 14 I'll explain prior art in more detail
03:34 15 when I provide you with further instructions with
03:34 16 respect to invalidity.

03:34 17 Before you can decide many of the factual
03:34 18 disputes presented to you in this case, you will need
03:34 19 to understand the role of patent "claims."

03:34 20 The patent claims are the numbered
03:34 21 sentences at the end of each patent. The claims define
03:34 22 the patent owner's rights under the law. Like the
03:34 23 words used to describe the metes and bounds of land on
03:34 24 real property, the words of each patent claim define
03:34 25 the scope of the invention covered by the patent and

03:34 1 owned by the inventor or patent owner.

03:34 2 The claims are important, because it is
03:34 3 the words of the claims themselves that define what the
03:34 4 patent covers.

03:34 5 The figures and texts in the rest of the
03:34 6 patent may or may not provide a description and/or
03:34 7 examples of the invention and provide it -- a context
03:35 8 for the claims, but it is the claims that define the
03:35 9 breadth of the patent coverage. Therefore, what a
03:35 10 patent covers depends in turn on what each of the
03:35 11 claims covers.

03:35 12 To know what a claim covers, a claim sets
03:35 13 forth in words a set of requirements. There can be
03:35 14 several claims in a patent. A claim may be narrower or
03:35 15 broader than another claim in the same patent by
03:35 16 setting forth more or fewer requirements.

03:35 17 The requirements of a claim are often
03:35 18 referred to as "elements" or "limitations." The
03:35 19 coverage of a patent is assessed in a claim-by-claim
03:35 20 manner.

03:35 21 When a thing, such as a product or a
03:35 22 process, meets all of the requirements of a claim, the
03:35 23 claim is said to cover that thing, and that thing is
03:35 24 said to fall within the scope of that claim.

03:35 25 A claim covers a product or process where

03:36 1 each of the claim elements or limitations is present in
03:36 2 that product or process. If a product is missing even
03:36 3 one limitation or element of an asserted claim, the
03:36 4 product is not covered by that claim. The product does
03:36 5 not infringe the claim.

03:36 6 For any words or phrases in each patent
03:36 7 claim, you must apply the ordinary meaning of those
03:36 8 terms as they were understood by a person of ordinary
03:36 9 skill in the field of the patent.

03:36 10 You must use the same meaning for the
03:36 11 words of the patent when deciding both issues, on the
03:36 12 one hand, of invalidity and, on the other, of
03:36 13 infringement.

03:36 14 There are two types of patent claims in
03:36 15 this case, "independent" and "dependent." Let's start
03:36 16 with independent.

03:36 17 An independent claim sets forth all the
03:36 18 requirements that must be met in order to be covered by
03:36 19 the claim. It is not necessary to look at any other
03:36 20 claim to determine what the independent claim covers.

03:37 21 There are the following independent
03:37 22 claims:

03:37 23 In the '158 patent, Claim 3.

03:37 24 In the '052 patent, the Claim 12.

03:37 25 The remainder of the asserted claims in

03:37 1 this case are what we call dependent claims. A
03:37 2 dependent claim does not itself recite all of the
03:37 3 requirements it needs for the claim. Instead, a
03:37 4 dependent claim refers to a different and another claim
03:37 5 for some of its requirements. Those requirements from
03:37 6 the claim to which it refers are considered to be part
03:37 7 of the dependent claim.

03:37 8 In this way, the claim depends on another
03:37 9 claim, and a dependent claim incorporates all the
03:37 10 requirements of the claim or claims to which it refers.
03:37 11 The dependent claim then adds its own additional
03:38 12 requirements.

03:38 13 In this case, the following asserted
03:38 14 claims are dependent claims:

03:38 15 In the '158 patent, Claim 6 and 14.

03:38 16 In the '052, Claims 20 and 27.

03:38 17 In the '548, Claim 46.

03:38 18 In Patent '215 -- the '215 patent, Claim
03:38 19 18.

03:38 20 To determine what a dependent claim
03:38 21 covers, it requires you to look at both the dependent
03:38 22 claims and any other claim to which the dependent claim
03:38 23 refers. A product that meets all the requirements of
03:38 24 both, one, the dependent claim and, two, the claims to
03:38 25 which it refers is covered by the asserted dependent

03:38 1 claim.

03:38 2 If any requirement or dependent claim is
03:38 3 not -- of a dependent claim is not met, or if any
03:38 4 requirement of a claim from the dependent (sic) claim
03:38 5 depends on is not met, then the product is not covered
03:38 6 by the dependent claim.

03:38 7 An independent claim and any dependent
03:39 8 claim that refers back to the independent claim are
03:39 9 considered separate patent claims. If the requirement
03:39 10 of an independent claim -- if the requirements of a,
03:39 11 first, independent claim are met by an accused product
03:39 12 but a requirement of a dependent claim is not met, the
03:39 13 independent claim is still infringed. The requirements
03:39 14 of the dependent claim are not required to find
03:39 15 infringement of the independent claim.

03:39 16 You'll note they didn't put page numbers
03:39 17 here, so we're -- it'll be a mystery the whole time,
03:39 18 right up until we finish. I think I like it better
03:39 19 that way.

03:39 20 I will now instruct you on how to decide
03:39 21 whether or not the plaintiff has proven that Dropbox
03:40 22 has infringed each asserted patent claim.

03:40 23 You must determine infringement on a
03:40 24 claim-by-claim basis based on the evidence. You might
03:40 25 find that Dropbox has infringed one or more asserted

03:40 1 claims but not others.

03:40 2 Plaintiff must prove that the defendant
03:40 3 has infringed one or more of the asserted patent claims
03:40 4 by proving -- instead of must, it should be may -- they
03:40 5 may prove it by proving that Dropbox itself directly
03:40 6 infringed an asserted patent claim.

03:40 7 In order to prove infringement, plaintiff
03:40 8 must prove that the requirements for infringement are
03:40 9 met by a preponderance of the evidence, in other words,
03:40 10 that it is more likely than not that all the
03:40 11 requirements for direct infringement have been proved.

03:40 12 In reaching your decision on
03:40 13 infringement, keep in mind that it is only the claims
03:40 14 of a patent that can be infringed, not the other parts
03:40 15 of the patent.

03:40 16 In determining infringement, you must
03:40 17 only compare each asserted patent claim using the
03:40 18 definitions I have provided for you to the accused
03:40 19 product or method.

03:40 20 For purposes of infringement, you should
03:40 21 not be comparing the accused product or method to any
03:41 22 diagram or figure that is in the asserted patent or to
03:41 23 any particular embodiments described in the patent's
03:41 24 written description.

03:41 25 For infringement, the only correct

03:41 1 comparison is between, on the one hand, the accused
03:41 2 products and, on the other hand, the language of the
03:41 3 asserted claim itself.

03:41 4 You must reach your decision as to
03:41 5 whether each asserted claim is infringed based on my
03:41 6 instructions about the meaning and scope of the claims,
03:41 7 the legal requirements for infringement and the
03:41 8 evidence presented to you by the parties.

03:41 9 To prove direct infringement, plaintiff
03:41 10 must prove by a preponderance of the evidence that it
03:41 11 is more likely than not that Dropbox made, used, sold
03:41 12 or offered for sale within the United States a product
03:41 13 that meets all the requirements of an asserted patent
03:41 14 claim and that Dropbox did so without the permission of
03:41 15 plaintiff during the time the asserted patents were in
03:41 16 force.

03:41 17 You must compare the accused product or
03:42 18 method with each patent claim that Motion Offense
03:42 19 asserts it infringed to determine whether all of the
03:42 20 requirements of that claim are met.

03:42 21 Direct patent infringement does not
03:42 22 require proof that the infringing party intended to
03:42 23 infringe the patent. A party such as Dropbox can
03:42 24 directly infringe a patent without knowing of the
03:42 25 patent at all or without knowing that the party -- that

what the party is doing or selling infringes a patent.

A patent claim is infringed only if Dropbox's products or methods include each and every element or method step recited in each of the asserted patent claims.

If Dropbox's product or method does not contain one or more elements or method steps recited in each of those claims, then Dropbox does not directly infringe that claim. And you will decide these issues on a claim-by-claim basis.

The preamble to some of the asserted claims used the phrase "comprising." "Comprising" means "including but not limited to." If you find that Dropbox's accused products or methods include all the elements in the claim, even if the accused product or method includes additional components or method steps, you must still find that the accused product or method literally infringes the patent claim.

However, the product nonetheless must include each and every element of the claim. If any claim element is missing, the product does not infringe it.

You must determine whether or not there's infringement separately for each asserted patent claim. A dependent claim includes all the requirements of any

03:43 1 of the claims to which it refers plus the additional
03:43 2 requirement or requirements of its own.

03:43 3 Thus, for dependent claims, if you find
03:43 4 that an independent claim to which a dependent claim
03:43 5 refers is not infringed, there cannot be infringement
03:43 6 of the dependent claim.

03:43 7 On the other hand, if you find that an
03:43 8 independent claim has been infringed, you must still
03:43 9 act independently with regard to the dependent claim
03:44 10 and decide separately whether the product meets the
03:44 11 additional requirements of any claim that depends from
03:44 12 the independent claim to determine whether the
03:44 13 dependent claim may or may not have been infringed.

03:44 14 In this case Dropbox is accused of direct
03:44 15 infringement, which requires that all steps and/or
03:44 16 components of the claims are performed and are provided
03:44 17 by or are attributable to a single party. In other
03:44 18 words, to infringe, Dropbox must make or use the
03:44 19 complete invention.

03:44 20 For at least some of the asserted claims,
03:44 21 in addition to the elements of the claims that are
03:44 22 missing entirely, Dropbox contends that it has not
03:44 23 directly infringed because it does not make, sell,
03:44 24 offer for sell or import the complete invention.

03:44 25 Dropbox contends that it did not itself

03:44 1 perform each step of a claimed method or did not
03:44 2 perform all the steps necessary to make, sell, offer
03:44 3 for sale or import a claimed apparatus because a third
03:44 4 party performed one or more of the acts necessary to
03:45 5 infringe.

03:45 6 If you find that Dropbox has not
03:45 7 personally performed all acts necessary to infringe the
03:45 8 asserted claims against it, then Dropbox has not
03:45 9 directly infringed that claim.

03:45 10 That was infringement.

03:45 11 We're turning to invalidity.

03:45 12 These are the rules that you must follow
03:45 13 in deciding whether or not Dropbox has proven that each
03:45 14 asserted claim of the asserted patents is invalid.

03:45 15 To prove that any claim of a patent is
03:45 16 invalid, Dropbox must persuade you by clear and
03:45 17 convincing evidence, that is, you must be left with a
03:45 18 clear conviction that the asserted patent claim is
03:45 19 invalid.

03:45 20 In this case, Dropbox contends that each
03:45 21 of the asserted patent claims is invalid for one or
03:45 22 more of the following reasons:

03:45 23 One, anticipation;

03:46 24 Two, obviousness.

03:46 25 A patent is presumed to be valid. It is

presumed to have been properly granted by the PTO. But that presumption of validity can be overcome if clear and convincing evidence is presented in court that proves the patent is invalid. As with infringement, invalidity is assessed on a claim-by-claim basis.

However, the fact that the PTO grants a patent does not necessarily mean that any invention claimed in the patent, in fact, deserves the protection of a patent.

For example, the PTO may not have had available to it all other prior art that you got to see during trial.

In addition, there's a possibility that mistakes were made or that information was overlooked. Examiners have a lot of work to do. No process is perfect.

Unlike this Court proceeding, patent prosecution takes place without input from those who might later be accused of infringing a patent. Dropbox has the right to argue in front of you a claimed invention in the patent is invalid because it fails to meet the requirements for a patent.

It is your job to consider the evidence presented by the parties and determine independently whether or not Dropbox has proven that the patent is

03:47 1 invalid.

03:47 2 A granted patent is not entitled to a
03:47 3 presumption of -- a granted patent is not entitled to a
03:47 4 presumption of priority to an earlier-related
03:47 5 application. But granted patents are entitled to a
03:47 6 presumption of priority to the date that the patent
03:47 7 application was filed. Here, no earlier than
03:47 8 October 3rd, 2017.

03:47 9 Let's talk about prior art.

03:47 10 Dropbox alleges invalidity, and those
03:47 11 allegations rest on what is called "prior art."

03:47 12 Prior art is considered in determining
03:47 13 whether the asserted patent claims are either
03:47 14 anticipated or obvious. Prior art may include specific
03:48 15 items that were publicly known or that have been used
03:48 16 or offered for sale or reference, such as publications
03:48 17 or patents, that disclose the claimed invention or
03:48 18 elements of the claimed invention.

03:48 19 To make your decision regarding whether
03:48 20 any of the asserted claims are invalid as anticipated
03:48 21 or obvious, you must determine whether the alleged
03:48 22 prior art system qualifies as prior art.

03:48 23 To qualify as prior art, a prior art
03:48 24 system must predate the date of the invention or
03:48 25 priority date for each patent claim being challenged.

1 If Motion Offense claims a date of
2 invention or priority date for an asserted claim of the
3 asserted patents that is earlier than the date the
4 patent application for that patent was filed, as stated
5 on the first page of each patent, then plaintiff has
6 the burden of establishing by a preponderance of the
7 evidence that its claimed invention of the asserted
8 patents are entitled to the priority date that the
9 plaintiff asserts it has.

10 The priority date for each asserted
11 patent claim is then used to determine what qualifies
12 as prior art for evaluating the question of validity
13 for each individual and asserted claim.

14 Motion Offense claims that the asserted
15 claims -- Motion Offense contends that the asserted
16 claims are entitled to a priority date of
17 September 25th, 2012, because they are supported by the
18 '635 application, which was filed on September 25th,
19 2012, and the '906 application filed September 22nd,
20 2012, collectively the "2012 applications."

21 Dropbox contends that the claims asserted
22 in this case are not supported by that 2012
23 application. Dropbox contends that the asserted
24 patents are not therefore entitled to a priority date
25 any earlier than the date of the applications which

03:49 1 actually led to the '158 and '052 patents being issued,
03:49 2 namely, October 3rd, 2017.

03:50 3 Unless the plaintiff proves by a
03:50 4 preponderance of the evidence that a claim is
03:50 5 adequately described in the 2012 applications, you must
03:50 6 use October 3rd, 2017 as the priority date for purposes
03:50 7 of evaluating patent invalidity for that particular
03:50 8 patent claim.

03:50 9 I will explain what "date of invention"
03:50 10 or "priority date" mean under patent laws.

03:50 11 Patent law allows an applicant to file an
03:50 12 application that repeats all or some of an earlier
03:50 13 patent application. These later-filed applications are
03:50 14 called either a "continuation" or a
03:50 15 "continuation-in-part."

03:50 16 A continuation or continuation-in-part
03:50 17 application is considered to have the same filing date
03:50 18 as the earlier-filed patent application if the
03:50 19 disclosure of the earlier-filed patent application
03:50 20 provides support in it for the claims in that later
03:51 21 continuation or continuation-in-part application.

03:51 22 The disclosure of the earlier-filed
03:51 23 patent application provides support for the claims of
03:51 24 the later continuation or continuation-in-part
03:51 25 application if the written description of the

earlier-filed application discloses the full scope of the invention claimed in the later-filed application.

The written description requirement is designed to ensure that the inventor was in possession of the full scope of the invention he was claiming as of the patent's effective filing date.

In deciding whether an earlier-filed patent application satisfies this written description requirement, you must consider the description from the viewpoint of a person having ordinary skill in the art, as I explained it to you earlier.

And it had to be of the patent at the time the effective filing date of each of the asserted patents.

The earlier-filed application must describe the full scope of the claimed invention, including each element thereof either expressly or inherently.

A claimed element is disclosed inherently if a person having ordinary skill in the field that, as to the effective filing date, would have understood that the element is necessarily present in what the earlier-filed application discloses. It is not sufficient that the earlier-filed application discloses only enough to make the claimed invention obvious to a

1 person having ordinary skill.

2 The written description does not have to
3 be the exact words of the claim. The requirements may
4 be satisfied by any combination of the words,
5 structures, figures, diagrams, formulas contained in
6 the patent specification. Adequate written
7 descriptions do not require either examples or an
8 actual reduction to practice of a claimed invention.

9 A mere wish or plan for obtaining the
10 claimed invention is not adequate for a written
11 description. Rather, the level of disclosure required
12 depends on a variety of factors, such as existing
13 knowledge in a particular field, the extent and content
14 of prior art, the maturity of the science or
15 technology, and other considerations appropriate to the
16 subject matter.

17 A single prior art reference for purposes
18 of anticipation or obviousness can include a prior art
19 "system."

20 When considering the differences -- or
21 different prior art references, keep in mind that a
22 prior art system is considered a single piece of art
23 even if multiple documents are used to describe that
24 system as it is in the system that is -- that is prior
25 art.

03:53 1 Dropbox asserts each of the following is
03:54 2 a prior art system that either, one, anticipates the
03:54 3 asserted patent claims, or, two, would have made them
03:54 4 obvious:

03:54 5 Dropbox 2017 system;

03:54 6 Dropbox 2011 system;

7 Dropbox 2011-AirDropper system.

03:54 8 Dropbox, the defendant, contends that
03:54 9 Dropbox 2017, 2011 and 2011 AirDropper systems are
03:54 10 prior art because they were already in public use, on
03:54 11 sale or otherwise available for the public before the
03:54 12 date of the invention.

03:54 13 An invention is known when the
03:54 14 information about it was reasonably accessible to the
03:54 15 public as of that date. An invention was publicly used
03:54 16 when it was accessible to the public or commercially
03:54 17 exploited.

03:54 18 Here the parties dispute whether the date
03:54 19 of the invention is September 22nd, 2012, which is the
03:54 20 plaintiff's position, or October 3rd, 2017, which is
03:55 21 the defendant's position.

03:55 22 Let me instruct you on that in a second.

03:55 23 Let's talk just a little bit about the
03:55 24 USPTO or the Patent and Trademark Office.

03:55 25 Regardless of whether any particular

03:55 1 prior art reference was considered by the patent
03:55 2 examiner during the prosecution of the application that
03:55 3 matured into each of the asserted patents, the
03:55 4 defendant must still prove by clear and convincing
03:55 5 evidence that each challenged claim is invalid.

03:55 6 This burden of proof is only on Dropbox,
03:55 7 the defendant. It never changes regardless of whether
03:55 8 or not the patent examiner considered any particular
03:55 9 reference.

03:55 10 In deciding whether an alleged prior art
03:55 11 system qualifies as prior art, you must keep in mind
03:55 12 that the law does not permit a party to prove that
03:55 13 something is prior art using no more than the
03:55 14 uncorroborated oral testimony of a single person.

03:55 15 A party seeking to prove that a reference
03:56 16 qualifies as prior art must prove -- provide evidence
03:56 17 that corroborates oral testimony.

03:56 18 Documentary or physical evidence that is
03:56 19 made contemporaneously with the alleged prior art
03:56 20 provides the most reliable corroboration of the oral
03:56 21 testimony. For example, internal or public documents,
03:56 22 photographs or videos, source code, publications and
03:56 23 patents can all serve as corroboration.

03:56 24 Corroborating evidence may also consist
03:56 25 of testimony of other witnesses, or it may consist of

03:56 1 circumstantial evidence independent of the oral
03:56 2 testimony.

03:56 3 Corroborating evidence may take many
03:56 4 forms. It must be evaluated together and in context
03:56 5 using a rule of reason analysis, whereby all pertinent
03:56 6 evidence is considered to determine whether the
03:56 7 testimony at issue is credible.

03:56 8 If you find that Dropbox has not
03:56 9 corroborated oral testimony regarding prior art with
03:57 10 other evidence, you are not permitted to find that the
03:57 11 uncorroborated oral testimony alone establishes that a
03:57 12 reference qualifies as prior art.

03:57 13 Let's talk about anticipation.

03:57 14 For someone to be entitled to a patent,
03:57 15 it must actually be new. The defendant contends the
03:57 16 asserted patent claims are invalid because the claimed
03:57 17 inventions in them are anticipated.

03:57 18 Dropbox must convince you that they are
03:57 19 anticipated by clear and convincing evidence. It must
03:57 20 convince you that the evidence highly probably
03:57 21 demonstrates the claims that are asserted are invalid.

03:57 22 The following art -- Dropbox contends the
03:57 23 following prior art anticipates the patent claims that
03:57 24 have been asserted against it:

03:58 25 Dropbox 2017 system;

03:58 1 2011 system;

03:58 2 2011-AirDropper system.

03:58 3 Anticipation must be determined on a
03:58 4 claim-by-claim basis. Dropbox must prove by clear and
03:58 5 convincing evidence that all of the requirements of a
03:58 6 claim are present in a single prior art system.

03:58 7 To anticipate the invention, the prior
03:58 8 art does not have to use the same words in a claim but
03:58 9 all the requirements of the claim must have been
03:58 10 disclosed and arranged as in the asserted claim.

03:58 11 The claim requirements may either be
03:58 12 disclosed expressly or inherently -- that is,
03:58 13 necessarily implied -- such that a person having
03:58 14 ordinary skill in the art in the technology of the
03:58 15 invention looking at only that one reference could make
03:58 16 and use the claimed invention.

03:58 17 Where a defendant is relying on prior art
03:58 18 that was not considered by the Patent Office when the
03:58 19 patents were being examined, you may consider whether
03:59 20 that prior art is significantly different and more
03:59 21 relevant than the prior art that the Patent Office did
03:59 22 consider before allowing these patents.

03:59 23 If you decide it is different and more
03:59 24 relevant, you may weigh that prior art more heavily
03:59 25 when considering whether the challenger had carried its

03:59 1 clear and convincing burden of proving invalidity.

03:59 2 If a dependent claim is anticipated by
03:59 3 prior art, then the claim from which it depends is
03:59 4 necessarily anticipated as well.

03:59 5 Okay. That was anticipation. Let's talk
03:59 6 about obviousness.

03:59 7 Even though an invention may not have
03:59 8 been identically disclosed or described before it was
03:59 9 made by an inventor, in order to be patentable, the
03:59 10 invention must also not have been obvious to a person
03:59 11 of ordinary skill in the field of technology of the
03:59 12 patent before the filing date of the application.

03:59 13 Dropbox may establish a patent claim as
03:59 14 invalid by proving by clear and convincing evidence
03:59 15 that the claimed invention would have been obvious to
03:59 16 persons having ordinary skill in the art at the time
04:00 17 the patent application was filed in the field of the
04:00 18 invention.

04:00 19 In determining whether a claimed
04:00 20 invention is obvious, you must consider the level of
04:00 21 ordinary skill in the field of the invention that
04:00 22 someone would have had at the time the patent
04:00 23 application was filed, the scope and contents of the
04:00 24 prior art, any differences between the prior art and
04:00 25 the claimed invention, if present, so-called objective

04:00 1 testimony or evidence or secondary -- of secondary
04:00 2 considerations, which I will describe shortly.

04:00 3 But don't use hindsight. Consider only
04:00 4 what was known as of the date of the invention.

04:00 5 Keep in mind that the existence of each
04:00 6 and every element of the claimed invention in the prior
04:00 7 art does not necessarily prove obviousness. Most, if
04:00 8 not all, inventions rely on building blocks of prior
04:00 9 art.

04:00 10 In considering whether a claimed
04:00 11 invention is obvious, you should consider whether, at
04:00 12 the time of the claimed invention, there was a reason
04:00 13 that would have prompted a person having ordinary skill
04:00 14 in the field of the invention to combine the known
04:01 15 elements in the prior art in the way the claimed
04:01 16 invention does, taking it into account such factors as:

04:01 17 Whether the claimed invention was merely
04:01 18 the predictable result of using prior art elements
04:01 19 according to their known functions;

04:01 20 Whether the claimed invention provides an
04:01 21 obvious solution to a known problem in the relevant
04:01 22 field;

04:01 23 Whether the prior art teaches or suggests
04:01 24 the desirability of combining elements claimed in the
04:01 25 invention;

04:01 1 Whether the prior art teaches away from
04:01 2 combining elements in the claimed invention;

04:01 3 Whether it would have been obvious to try
04:01 4 the combination of elements, such as where there is a
04:01 5 design incentive or market pressure to solve a problem
04:01 6 and there are a finite number of identified,
04:01 7 predictable solutions.

04:01 8 To find it rendered the claimed invention
04:01 9 obvious, you must find that the prior art provided a
04:01 10 reasonable expectation of success. Obvious to try is
04:01 11 not sufficient in unpredictable technologies.

04:02 12 In determining whether the claimed
04:02 13 invention is obvious, you should take into account any
04:02 14 objective evidence, sometimes called "secondary
04:02 15 considerations," that might shed light on whether or
04:02 16 not the claimed invention is obvious, such as:

04:02 17 One, whether the claimed invention was
04:02 18 commercially successful as a result of the merits of
04:02 19 the claimed invention, rather than the result of design
04:02 20 needs or market-pressure advertising or similar
04:02 21 activities;

04:02 22 Whether the claimed invention satisfied a
04:02 23 long-felt need;

04:02 24 Whether others had tried and failed to
04:02 25 make the claimed invention;

04:02 1 Whether the other -- others who invented
04:02 2 the claimed invention at roughly the same time;

04:02 3 Whether others copied the claimed
04:02 4 invention;

04:02 5 Whether there were changes or related
04:02 6 technologies or market needs contemporaneous with the
04:02 7 claimed invention;

04:02 8 Whether the claimed invention achieved
04:02 9 unexpected results;

04:02 10 Whether others in the field praised the
04:02 11 claimed invention;

04:02 12 Whether persons having ordinary skill in
04:02 13 the art of the invention expressed surprise or
04:03 14 disbelief regarding the claimed invention;

04:03 15 Whether others sought or obtained rights
04:03 16 to the patent from the patentholder; and

04:03 17 Whether the inventor proceeded contrary
04:03 18 to accepted wisdom in the field.

04:03 19 These factors are relevant only if there
04:03 20 is a connection or a nexus between the factor and the
04:03 21 invention covered by the patent claim.

04:03 22 In determining whether the claimed
04:03 23 invention was obvious, consider each claim separately
04:03 24 but understand that if a dependent claim is obvious,
04:03 25 then the claim from which it depends are necessarily

04:03 1 obvious as well.

04:03 2 We're now about to turn to damages, but
04:03 3 let me say a little bit off script.

04:03 4 The fact that I have instructed you about
04:03 5 infringement doesn't mean I have any opinion about
04:03 6 infringement. The fact I have instructed you on
04:03 7 invalidity doesn't mean I have any opinion with regard
04:03 8 to invalidity. That's why y'all are here as judges.

04:03 9 The fact that I'm about to instruct you
04:03 10 on damages doesn't mean I have any opinion on damages.
04:03 11 I'm just reading you what the law is that you must
04:03 12 follow.

04:03 13 If you find that Dropbox infringed an
04:04 14 asserted claim of the asserted patents and that the
04:04 15 claim is not invalid, you must determine the amount of
04:04 16 damages to be awarded to the plaintiff for the
04:04 17 infringement that you have found.

04:04 18 By instructing you on damages, I'm not
04:04 19 suggesting which party should win the case on any
04:04 20 issue.

04:04 21 If you find that Dropbox has not
04:04 22 infringed any valid claim of the patent, Motion Offense
04:04 23 is not entitled to any damages. If you find that
04:04 24 Motion Offense is entitled to damages, then the amount
04:04 25 must be adequate to compensate them for the

04:04 1 infringement.

04:04 2 Damages are never meant to punish the
04:04 3 infringer. Your damages award, if you reach it, must
04:04 4 put Motion Offense in approximately the same financial
04:04 5 position it would have been had the infringement never
04:04 6 occurred.

04:04 7 The plaintiff has the burden to establish
04:04 8 the amount of damages by a preponderance of the
04:04 9 evidence. You should award only those damages that
04:04 10 Motion Offense establishes more likely than not it
04:04 11 suffered.

04:04 12 While Motion Offense is not required to
04:04 13 prove the amount of damages with mathematical
04:05 14 precision, it must prove them with reasonable
04:05 15 certainty. You may not award damages that are
04:05 16 speculative or only possible or that are based on
04:05 17 guesswork.

04:05 18 The plaintiff seeks a reasonable royalty
04:05 19 in the form of a running royalty through the date
04:05 20 June 30th, 2022.

04:05 21 A reasonable royalty is defined as the
04:05 22 amount -- money amount Dropbox and plaintiff would have
04:05 23 agreed upon as a fee for use of the invention at the
04:05 24 time just prior to when infringement began. In other
04:05 25 words, as you heard before, the negotiation would have

04:05 1 taken place immediately before the alleged infringement
04:05 2 began.

04:05 3 You must be careful to ensure that award
04:05 4 is no more and no less than the value of the patented
04:05 5 invention.

04:05 6 Reasonable royalty. The plaintiff seeks
04:05 7 "reasonable royalty" damages as compensation of the
04:05 8 alleged patent infringement.

04:05 9 If you find that one or all or some
04:06 10 combination of the asserted patent claims is infringed
04:06 11 and not invalid, then the plaintiff is entitled to at
04:06 12 least a reasonable royalty to compensate it for the
04:06 13 infringement.

04:06 14 A royalty is a payment made to the
04:06 15 patentholder in exchange for the right to make, use or
04:06 16 sell the claimed invention.

04:06 17 A reasonable royalty is the amount of
04:06 18 royalty payment that a patentholder and the alleged
04:06 19 infringer would have agreed to in a hypothetical
04:06 20 negotiation taking place at a time just prior to when
04:06 21 the infringement first began.

04:06 22 In considering this negotiation, this
04:06 23 hypothetical negotiation, focus on what the
04:06 24 expectations of the patentholder and the alleged
04:06 25 infringer would have been if they had entered into this

04:06 1 agreement at that time and if they both had acted
04:06 2 reasonably in their negotiations.

04:06 3 In determining the amount of reasonable
04:06 4 royalty as damages for the patent infringement, assume
04:06 5 both parties to the hypothetical negotiation knew and
04:06 6 acted under the belief that all of the asserted patent
04:06 7 claims were both, one, valid, and, two, infringed, and
04:07 8 that both parties to the hypothetical negotiation were
04:07 9 willing to enter into this agreement.

04:07 10 The reasonable royalty you determine must
04:07 11 be a royalty that would have resulted from a
04:07 12 hypothetical negotiation and not simply the royalty
04:07 13 that one party or the other party would have preferred.

04:07 14 You must consider the hypothetical
04:07 15 negotiation to have taken place at a time just before
04:07 16 the patent infringement began.

04:07 17 In your deliberations regarding the
04:07 18 amount of reasonable royalty, you may take into
04:07 19 consideration evidence of things that happened after
04:07 20 the infringement first began, i.e., after the time of
04:07 21 the hypothetical negotiation is assumed to take place,
04:07 22 but you may consider such evidence only to the extent
04:07 23 that it aids you in determining what the royalty would
04:07 24 have resulted from that hypothetical negotiation
04:07 25 between the two parties occurring just before

04:07 1 infringement.

04:07 2 The reasonable royalty award must be
04:07 3 based on the incremental value the patented invention
04:07 4 added to the end products of defendants.

04:07 5 When the infringing product or method
04:08 6 have both patented and unpatented features, then you
04:08 7 must measure the value requiring a determination of the
04:08 8 value added by the patented features.

04:08 9 The ultimate combination of royalty base
04:08 10 and royalty rate must reflect the value attributable to
04:08 11 the infringing features of the product or method and
04:08 12 not more.

04:08 13 The process of separating the value of
04:08 14 the allegedly infringing features from the value of all
04:08 15 other features is called "apportionment." When the
04:08 16 accused infringing products have both patented and
04:08 17 unpatented features, your award must be apportioned so
04:08 18 as based only on the value of the patented features and
04:08 19 no more.

04:08 20 In determining the reasonable royalty,
04:08 21 you should consider all the facts known and available
04:08 22 to the parties to the hypothetical negotiation at the
04:08 23 time the infringement began.

04:08 24 You'll recall these -- the damage expert
04:08 25 talked about these factors, and I'm going to read them

04:08 1 to you now:

04:08 2 The value that the claimed invention
04:08 3 contributes to the accused product;

04:08 4 The value that factors other than the
04:09 5 claimed invention contributed to the accused product;

04:09 6 Comparable license agreements or other
04:09 7 transactions, such as those covering the use of the
04:09 8 claimed invention or similar technology or involving
04:09 9 the asserted patents;

04:09 10 The royalties received by the patentee
04:09 11 for the licensing of the patents-in-suit, proving or
04:09 12 tending to prove an established royalty;

04:09 13 The rates paid by the licensee for the
04:09 14 use of other patents comparable to the patents-in-suit;

04:09 15 The nature and scope of the license as
04:09 16 exclusive or nonexclusive or as restricted or
04:09 17 non-restricted in terms of territory or with respect to
04:09 18 whom the manufactured product may be sold;

04:09 19 The licensor's established policy and
04:09 20 marketing program to maintain his or her patent
04:09 21 monopoly by not licensing others to use the invention
04:09 22 or by granting licenses under special conditions
04:09 23 designed to preserve the monopoly;

04:09 24 The commercial relationship between the
04:09 25 licensor and licensee, such as whether they are

04:09 1 competitors in the same territory and in the same line
04:09 2 of business or whether they are inventor and promoter;

04:09 3 The effect of selling the patented
04:09 4 specialty and promoting sales of other products of the
04:10 5 licensee, the existing value of the invention to the
04:10 6 licensor as a generator of sales of non-patentable
04:10 7 items -- or non-patented items, and the extent of such
04:10 8 derivative or convoyed sales;

04:09 9 The effect of selling the patented
04:09 10 specialty and promoting sales of other products of the
04:10 11 licensee, the existing value of the invention to the
04:10 12 licensor as a generator of sales of his non-patented
04:10 13 items, and the extent of such derivative or convoyed
04:10 14 sales;

04:10 15 The duration of the patent and the term
04:10 16 of the license;

04:10 17 The established profitability of the
04:10 18 product made under the patents, its commercial success
04:10 19 and current popularity;

04:10 20 The utility and advantages of the
04:10 21 patented property over the old modes or devices, if
04:10 22 any, that had been used for working out similar
04:10 23 results;

04:10 24 The nature of the patented invention, the
04:10 25 character of the commercial embodiment of it as owned

04:10 1 and produced by the licensor, the benefits to those who
04:10 2 have used the invention;

04:10 3 The extent to which the infringer has
04:10 4 made use of the invention and any evidence probative of
04:10 5 the value of that use;

04:10 6 The portion of the profits or the selling
04:10 7 price that may be customary in a particular business or
04:11 8 in comparable businesses to allow for use of the
04:11 9 invention or analogous invention;

04:11 10 The portion of the realizable profits
04:11 11 that should be credited to the invention as
04:11 12 distinguished from non-patented elements, the
04:11 13 manufacturing process, business risks or significant
04:11 14 features or improvements added by the infringer; and

04:11 15 The testimony and opinion of qualified
04:11 16 experts.

04:11 17 No one fact is dispositive. You can take
04:11 18 and consider the evidence that's been presented to you
04:11 19 and compare it to each of the factors or any of the
04:11 20 factors. It's entirely up to you. You are the judges.

04:11 21 But it must be taken from the evidence
04:11 22 that was admitted during the trial. The evidence which
04:11 23 in your mind would have increased or decreased a
04:11 24 royalty the alleged infringer would have been willing
04:11 25 to pay and the patentholder would have been willing to

04:11 1 accept, acting on both sides as normally prudent
04:11 2 business people.

04:11 3 Comparable license agreements and prior
04:11 4 transactions involving the asserted patents are one
04:11 5 factor that may inform your decision as to the proper
04:12 6 amount and form of the reasonable royalty award,
04:12 7 similar to the way in which the value of a house is
04:12 8 determined relative to comparable houses sold in the
04:12 9 same neighborhood.

04:12 10 Whether a license agreement is comparable
04:12 11 to a license under the hypothetical negotiation
04:12 12 scenario depends on many factors, such as do they
04:12 13 involve comparable technologies? Economic
04:12 14 circumstances? Structure? And scope?

04:12 15 If there are differences between a
04:12 16 license agreement and a hypothetical license, you must
04:12 17 take those into account when you make your reasonable
04:12 18 royalty determination.

04:12 19 However, an agreement may be comparable
04:12 20 even if the patented technology and economic
04:12 21 circumstance of the agreements are not identical to the
04:12 22 hypothetical negotiation. The question is whether the
04:12 23 agreement is sufficiently economically and
04:12 24 technologically comparable that it provides a
04:12 25 reasonable indication of how the parties to the

04:12 1 hypothetical negotiation would have negotiated a
04:12 2 license to the asserted patent.

04:12 3 The hypothetical license that would
04:12 4 result from the hypothetical negotiation is deemed to
04:12 5 be a voluntary agreement between two willing parties.

04:13 6 When determining if a particular license
04:13 7 agreement is comparable to the hypothetical license
04:13 8 that would result from the hypothetical negotiation,
04:13 9 consider whether the license agreement is between
04:13 10 parties to a lawsuit, whether the license agreement was
04:13 11 a settlement influenced by a desire to avoid further
04:13 12 litigation, and whether the parties to the license
04:13 13 agreement were willing parties who acted with the
04:13 14 knowledge and belief that the licensed patents were
04:13 15 valid and infringed at the time of the license
04:13 16 agreement.

04:13 17 I'm going to reserve the last couple of
04:13 18 pages until after you've heard the arguments. But I
04:13 19 will tell you on the final page -- because I've said
04:13 20 this before -- tonight and then especially through your
04:13 21 deliberations, you may not communicate with anyone or
04:13 22 provide any information about the case.

04:13 23 You'll be sequestered in the jury room.
04:13 24 You won't be able to call out. We want you to discuss
04:13 25 the case and not have any interference from outside.

04:13 1 So you won't have your cell phone or tablet or whatever
04:14 2 else you might have.

04:14 3 You may not use any social media once you
04:14 4 begin deliberating and you may not communicate with
04:14 5 anyone. The CSO will be outside the door if you need
04:14 6 something from me or you need to hand a note or
04:14 7 something. But you may not discuss with anyone
04:14 8 anything about the case.

04:14 9 Let me say something else. It may be on
04:14 10 the other page, but let me -- while I'm thinking about
04:14 11 it.

04:14 12 Throughout the period -- let me just go
04:14 13 ahead and give you a high level, and I'll read this
04:14 14 tomorrow to reinforce it.

04:14 15 What will happen tomorrow after the
04:14 16 lawyers do their closing arguments is you'll go back to
04:14 17 the jury room. You will select a jury foreperson.
04:14 18 You'll -- there's no paper back there. Whoever the
04:14 19 foreperson is needs to say we have selected a
04:14 20 foreperson. It is -- fill in the name. Again,
04:14 21 hopefully, so that I can read it. Date it and sign it.
04:14 22 And put the time on it.

04:14 23 Now, when you do that -- I'm telling you
04:15 24 this because it hasn't always happened -- we won't know
04:15 25 that you've done that unless you actually hand it to

04:15 1 the guard who's outside. In other words, it's not
04:15 2 enough for you all to finish that step, you actually
04:15 3 have to communicate to us that you have finished that
04:15 4 step.

04:15 5 So once that happens, and when you've
04:15 6 picked a foreperson, hand it to William or whoever's
04:15 7 sitting outside, and I'll let the lawyers know who the
04:15 8 foreperson is. And at that point, you may begin your
04:15 9 deliberations because the evidence, the exhibits will
04:15 10 be back there with you in electronic form.

04:15 11 During the course of your deliberations,
04:15 12 you may want to send me questions that you may have as
04:15 13 you deliberate. And that's perfectly fine. I will
04:15 14 get -- I'll get the notes, and I will write out a
04:15 15 response to you. Doing my best for it to be legible.

04:15 16 Very, very, very important. At no time
04:15 17 when you send me a note should you ever indicate to me
04:16 18 what the split might be at that moment. You know,
04:16 19 there are three of us who feel one way, everyone but
04:16 20 one person feels another.

04:16 21 Until I get a note saying we have a
04:16 22 verdict and that verdict will be unanimous, I never
04:16 23 want to know what -- the status of where you're at in
04:16 24 terms of your deliberation. That is exclusively for
04:16 25 you all to know until -- until you are unanimous.

04:16 1 So that was as fast as I could read it.
04:16 2 I'm sorry I couldn't do better.

04:16 3 You all have the rest of the day off. If
04:16 4 you would be here by 8:45 tomorrow, the only thing we
04:16 5 have left -- and it's my favorite part of the trial
04:16 6 really -- is to hear closing arguments from really good
04:16 7 lawyers.

04:16 8 You're lucky to have really good lawyers
04:16 9 in this case, and I'm looking forward to it. They will
04:16 10 each have about a half hour to do their closing
04:16 11 arguments. And then you'll begin your deliberations.

04:16 12 So remembering my instructions not to
04:16 13 discuss the case with anyone, we will see you tomorrow
04:17 14 morning.

04:17 15 THE BAILIFF: All rise.

04:17 16 (Jury exited the courtroom.)

04:17 17 THE COURT: Thank you. You may be
04:17 18 seated.

04:17 19 Is there anything we need to take up?

04:17 20 MR. DEVLIN: Sorry, Your Honor. We
04:17 21 had -- did not get a chance to -- we conferred. I need
04:17 22 to respond.

04:17 23 (Conference between counsel.)

04:17 24 MR. LANTIER: Your Honor, the -- I
04:17 25 believe the last thing we need to do is go through the

04:17 1 exhibits to be admitted --

04:17 2 THE COURT: Please.

04:17 3 MR. LANTIER: -- through Professor
04:17 4 Shamos.

04:17 5 I will say that there are some
04:17 6 objections, so we'll have to discuss those. But should
04:18 7 I read the list first, or should we talk about the
04:18 8 major objections?

04:18 9 THE COURT: When you say -- I don't
04:18 10 understand.

04:18 11 MR. DEVLIN: If I may, Your Honor.

04:18 12 There's one issue that Your Honor's going
04:18 13 to have to resolve. So as I understand it, some of the
04:18 14 exhibits that they're intending to offer are exhibits
04:18 15 that were listed -- so these are source code exhibits
04:18 16 that were listed by citation only on the slide for
04:18 17 Dr. Shamos' analysis. So if you remember, Dr. Akl
04:18 18 did --

04:18 19 THE COURT: The actual source code wasn't
04:18 20 shown?

04:18 21 MR. DEVLIN: The actual source code was
04:18 22 not shown.

04:18 23 THE COURT: Then the jury won't see it.

04:18 24 MR. DEVLIN: That was our objection, Your
04:18 25 Honor.

04:18 1 THE COURT: If that's the dispute.

04:18 2 MR. LANTIER: And, Your Honor, the reason
04:18 3 we did it that way was I had understood, based on past
04:18 4 experience, that normally Your Honor has witnesses
04:18 5 admit exhibits by turning to the document in their
04:18 6 binder, looking at the document.

04:18 7 We put a lot of evidence in -- or I
04:18 8 should say the plaintiff put a lot of evidence in for
04:19 9 Dr. Akl by just having it on slides.

04:19 10 THE COURT: Well, but if the jury didn't
04:19 11 see it, that's what I'm saying. They don't -- if all
04:19 12 you did was put in there by reference, it's there, and
04:19 13 they didn't see it, then I'm not -- is your position
04:19 14 that they ought to have it -- since you referenced it,
04:19 15 they ought to have it so if they want to look at it,
04:19 16 they can?

04:19 17 MR. LANTIER: Yes, Your Honor. I very
04:19 18 much doubt that they would.

04:19 19 THE COURT: Oh, no, no, no. I wish that
04:19 20 were true. I've learned that's -- no. They might.
04:19 21 And so --

04:19 22 So, Mr. Devlin.

04:19 23 MR. DEVLIN: I just want to note, Your
04:19 24 Honor, so the same process that we are requesting now,
04:19 25 which is that it only goes back if it was actually on

04:19 1 the screen and the witness talked about it. That's
04:19 2 what we followed with Dr. Akl. Dr. Akl had a lot of
04:19 3 similar --

04:19 4 THE COURT: And I thought that's --

04:19 5 MR. DEVLIN: -- citations, and we did not
04:19 6 put those in. Those are not back there.

04:19 7 THE COURT: And I thought I said
04:19 8 that pretty clearly, that the only source code that was
04:20 9 going back was something that was -- now, what I worry
04:20 10 about is I think I say things clearly, and Mr. Devlin
04:20 11 thinks that meant they had to actually show it, and
04:20 12 defendants thought as long as you identified that
04:20 13 section, that they would be able to see it in the back.

04:20 14 I'm not sure that I understand that. I
04:20 15 can understand how both of those could be.

04:20 16 Mr. Devlin, how are you prejudiced by
04:20 17 them having access to the source code that was
04:20 18 identified, albeit only by citation, and not shown?

04:20 19 MR. DEVLIN: So the basis of our
04:20 20 objection was -- I think -- I'm not sure if this is in
04:20 21 the pretrial order or if it was something that Your
04:20 22 Honor said, but we thought that Your Honor was clear
04:20 23 that only source code that was actually on the screen,
04:20 24 shown to the jury, discussed by a witness was going to
04:20 25 go back.

04:20 1 So, Your Honor, it's -- we're simply
04:21 2 trying to follow your rule. And we thought we followed
04:21 3 it. So if Your Honor wants to adjust, as long as we
04:21 4 can put the additional citations in that were on
04:21 5 Dr. Akl's slide, we would ask that.

04:21 6 THE COURT: Well, I'm definitely going to
04:21 7 do that.

04:21 8 MR. DEVLIN: Yes.

04:21 9 THE COURT: I mean, yes. You know,
04:21 10 occasionally one of y'all will say, well -- I order
04:21 11 something, and you say, well, is that for us too?

04:21 12 And yeah, pretty much I like things to be
04:21 13 even. So it will be the same for both sides.

04:21 14 If the defendant wants in -- if the
04:21 15 defendant said a citation number for a bit of source
04:21 16 code and you'd like that snippet of source code to go
04:21 17 back, I don't care. I'm fine with that, as long as --
04:21 18 but if Mr. Devlin and plaintiff do the same thing, then
04:21 19 they get to do that as well.

04:21 20 MR. LANTIER: Yes, Your Honor. And to be
04:21 21 honest, we thought they had done that because of the
04:21 22 way that they presented their case.

04:21 23 THE COURT: Okay. Well, it's for -- both
04:21 24 sides can do whatever they want then.

04:21 25 MR. DEVLIN: We're going to need to get

04:21 1 our list, Your Honor. It'll take us, you know, 30 to
04:22 2 60 minutes. We'll do that.

04:22 3 THE COURT: We'll just do it tomorrow
04:22 4 morning.

04:22 5 MR. DEVLIN: Okay. Thank you, Your
04:22 6 Honor.

04:22 7 (Off-the-record discussion.)

04:22 8 THE COURT: Then they'll need to do it
04:22 9 tonight, right?

04:22 10 So what we're saying is we don't have --
04:22 11 especially, we're the government and things don't
04:22 12 upload well. In fact, as we learned in another case,
04:22 13 if you try and upload everything at once, it doesn't
04:22 14 upload at all.

04:22 15 So -- by doing this, it'll be up to you
04:22 16 all to make sure you get it uploaded overnight, and
04:22 17 it's ready to go for the jury at -- when they go back
04:22 18 to the jury room. Because last time we had to keep
04:22 19 them from deliberating until we figured out how to get
04:23 20 them the evidence, and I'm not going to do that
04:23 21 tomorrow.

04:23 22 Y'all have tonight to -- whatever it is
04:23 23 you want and have someone cross check, you know, make
04:23 24 sure that plaintiff -- that y'all know what each other
04:23 25 are putting in and that it was -- but I'm going to take

04:23 1 it on faith that if y'all showed it and introduced
04:23 2 it -- if it was shown during trial and without
04:23 3 objection, then I'm going to -- then I'm going to
04:23 4 assume it was admitted as an exhibit.

04:23 5 But y'all will need to make sure to
04:23 6 upload it tonight. Again, you may be right. They may
04:23 7 not look at it. But in the event they want to, it
04:23 8 needs to be uploaded, because I'm going to let them
04:23 9 start deliberating tomorrow immediately after your
04:23 10 closing arguments.

04:23 11 Yes, sir.

04:23 12 MR. DEVLIN: Just total sanity check,
04:23 13 we're going to -- assuming we can agree with our
04:23 14 colleagues, we'll get the list and upload, and it'll be
04:23 15 uploaded before we've technically moved it in tomorrow
04:23 16 morning?

04:23 17 THE COURT: Correct. That's right.

04:23 18 MR. DEVLIN: Great. We're fine with
04:23 19 that, Your Honor.

04:23 20 Thank you. Okay.

04:24 21 MR. LANTIER: Thank you, Your Honor.
04:24 22 Nothing else.

04:24 23 THE COURT: Mr. Devlin?

04:24 24 MR. DEVLIN: We have our Rule 50 motion.

04:24 25 THE COURT: Oh, please. Yes.

04:24 1 And thank you to the defendant for
04:24 2 cooperating on letting this be done now.

04:24 3 MR. DEVLIN: One little -- we assume --
04:24 4 we'll work it out. We assume that the PDFs are what
04:24 5 the Court wants for uploading as opposed to something
04:24 6 native?

04:24 7 DEPUTY CLERK: Yes, sir. Thank you.

04:24 8 MR. DEVLIN: Thank you.

04:24 9 MR. PUCKETT: Your Honor, with respect to
04:24 10 the plaintiff Motion Offense's Rule 50 motions, I'll
04:24 11 read these into the record.

04:24 12 We want to move under Rule 50 on four
04:24 13 separate issues.

04:24 14 The first is going to be that on the
04:24 15 issue of infringement, there is no genuine dispute that
04:24 16 Dropbox infringes the asserted patents. Motion Offense
04:24 17 has established that Dropbox practices every element of
04:24 18 each asserted claim of the asserted patents.

04:24 19 Further, in pressing its invalidity case,
04:25 20 Dropbox has admitted that its current systems practice
04:25 21 every element of every claim as Dropbox argues that
04:25 22 both the 2011 and current Dropbox systems contain every
04:25 23 element of every claim.

04:25 24 Accordingly, Dropbox has conceded that it
04:25 25 infringes the asserted patents if they are valid.

04:25 1 The second issue, Your Honor, is going to
04:25 2 be on the issue of validity.

04:25 3 Motion Offense moves for judgment as a
04:25 4 matter of law against the affirmative defenses of both
04:25 5 anticipation and obviousness.

04:25 6 The grounds for this motion is with
04:25 7 respect to each of the systems that Dropbox alleges is
04:25 8 prior art in this case. Dropbox has not introduced
04:25 9 sufficient evidence from which the jury can find by
04:25 10 clear and convincing evidence that any of these systems
04:25 11 qualifies as prior art through prior public knowledge
04:25 12 by being publicly made, publicly used or sold or
04:25 13 offered for sale.

04:25 14 And this is true with respect to Dropbox
04:25 15 2017, Dropbox 2011 and Dropbox 2011 plus AirDropper.

04:25 16 More specifically, for publicly making or
04:26 17 public use or public knowledge of an alleged prior art
04:26 18 system, the legal standard requires proof that a person
04:26 19 of skill at the time would have been able to discern
04:26 20 that all elements of the asserted patent claim was
04:26 21 present within the alleged prior art system from the
04:26 22 person of skill's review of the publicly available
04:26 23 things.

04:26 24 And Dr. Shamos nor no other witness in
04:26 25 this case provided testimony under the required legal

04:26 1 standard that a person of ordinary skill would have
04:26 2 been able to discern the presence of all elements of
04:26 3 the patent claims in the prior art systems from
04:26 4 inspection of the publicly available material.

04:26 5 With respect to qualification of prior
04:26 6 art system by being sold or an offer for sale, the
04:26 7 legal standard requires proof that the thing that was
04:26 8 sold or offered for sale must contain all elements of
04:26 9 the asserted patent claim.

04:26 10 And again, neither Dr. Shamos nor any
04:26 11 other fact witness in this trial provided testimony
04:27 12 under the correct legal standard that the thing -- that
04:27 13 the system that is alleged to be prior art was ever
04:27 14 sold or offered for sale as it contained all elements
04:27 15 of the asserted patent claims.

04:27 16 For these reasons, there is insufficient
04:27 17 evidence on this record from which a jury could find by
04:27 18 clear and convincing evidence that any of the asserted
04:27 19 patent claims are either anticipated or invalid for
04:27 20 obviousness.

04:27 21 And as a result, Motion Offense moves for
04:27 22 judgment as a matter of law under Rule 50 against
04:27 23 Dropbox's affirmative defenses of both anticipation and
04:27 24 obviousness.

04:27 25 Additionally, on the issue of validity,

04:27 1 Dropbox has not offered any evidence tending to
04:27 2 establish that the required file explorer interface
04:27 3 element of Claims 3, 6 and 4 of the '158 patent; Claim
04:27 4 18 of the '215 patent; Claim 27 of the '052 patent; and
04:27 5 Claim 46 of the '548 patent or the "client-based file
04:27 6 explorer application" of Claim 18 of the '215 patent
04:28 7 was present in any prior art reference presented by
04:28 8 Dropbox.

04:28 9 Additionally, Dropbox has not offered any
04:28 10 evidence tending to establish the "time and date
04:28 11 elements" of Claims 12 and 20 of the '052 patent were
04:28 12 present in any prior art reference presented by
04:28 13 Dropbox.

04:28 14 Accordingly, Dropbox lacks sufficient
04:28 15 evidence to prove the asserted patents are invalid
04:28 16 under either 35 U.S.C. Section 102 and/or Section 103.

04:28 17 The third issue, Your Honor, is with
04:28 18 respect to the issue of priority date.

04:28 19 Dropbox (sic) moves for judgment as a
04:28 20 matter of law under the grounds that Dropbox has
04:28 21 insufficiently supported any challenge that it has that
04:28 22 the patents are entitled to a priority date other than
04:28 23 what has been established by Motion Offense, namely,
04:28 24 the priority date of September 25th, 2012.

04:28 25 And finally, Your Honor, on the issue of

04:28 1 damages, Motion Offense moves under Rule 50 that in
04:28 2 argument, that Dropbox has presented no evidence or
04:28 3 testimony regarding the measure of damages in this
04:29 4 case.

04:29 5 Accordingly, if the jury finds
04:29 6 infringement, Motion Offense should receive the full
04:29 7 amount of damages in the form of a running royalty for
04:29 8 the period of July 2018 through June 2022 in the amount
04:29 9 of \$35,711,653 as supported by the testimony of Motion
04:29 10 Offense's expert, Stephen Dell, and in the absence of
04:29 11 any contrary testimony on the issue of damages, Your
04:29 12 Honor.

04:29 13 THE COURT: I don't want to keep us here
04:29 14 any longer than I have to, but I have to say, good on
04:29 15 you for that last argument.

04:29 16 The idea that you would get a directed
04:29 17 verdict on the amount of damages because the other side
04:29 18 didn't put on an argument on which they have no burden,
04:29 19 I think that is aggressive but entertaining.

04:29 20 So yes, sir.

04:29 21 MR. DEVLIN: Your Honor, just one minor
04:29 22 correction. I think inadvertently we misspoke, and
04:30 23 once or twice said -- I think it was just once that
04:30 24 Dropbox moves.

04:30 25 Just to be clear, Motion Offense is

04:30 1 making all those motions just for the record.

04:30 2 Thank you, Your Honor.

04:30 3 THE COURT: I do that a lot.

04:30 4 And so -- but having said that, your --
04:30 5 all of your motions are respectfully overruled.

04:30 6 So anything else that we need to take a
04:30 7 up?

04:30 8 MR. LANTIER: Not for Dropbox, Your
04:30 9 Honor.

04:30 10 THE COURT: So tomorrow's one of my
04:30 11 favorite days for a couple of reasons. One, because
04:30 12 there will be nothing to take up because you all don't
04:30 13 need to exchange your PowerPoints.

04:30 14 And so I will get here when I get here,
04:30 15 but it will be before the jury does. But I'll be happy
04:30 16 knowing we don't have to do anything.

04:30 17 And, two, I want to thank you all for a
04:30 18 very easy trial. It was -- you know, I'll say again, I
04:30 19 know -- I've learned not to read the press. I'm much
04:31 20 happier. I've been much happier for three or four
04:31 21 years now.

04:31 22 But I'm aware that there is -- that there
04:31 23 are people who are inquisitive as to why I would want
04:31 24 patent cases, and this is yet another example where
04:31 25 they're just -- the trials are just better than any

04:31 1 other trial that I've had.

04:31 2 The standard of lawyers in these cases,
04:31 3 the median lawyers in these trials are usually in the
04:31 4 top 80 or 90 percent of trial lawyers, and y'all were
04:31 5 the same. And so if anyone is curious why I like
04:31 6 patent cases, this is why.

04:31 7 I think the trials are terrific. I
04:31 8 thought all of you did a terrific job. So I hope your
04:31 9 clients are happy. They should be. I certainly am.

04:31 10 And I look forward to the closing
04:31 11 arguments tomorrow.

04:31 12 THE BAILIFF: All rise.

04:31 13 (Hearing adjourned.)

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1 UNITED STATES DISTRICT COURT)
2 WESTERN DISTRICT OF TEXAS)
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5 I, Kristie M. Davis, Official Court
6 Reporter for the United States District Court, Western
7 District of Texas, do certify that the foregoing is a
8 correct transcript from the record of proceedings in
9 the above-entitled matter.

10 I certify that the transcript fees and
11 format comply with those prescribed by the Court and
12 Judicial Conference of the United States.

13 Certified to by me this 29th day of May
14 2023.

15
16 /s/ Kristie M. Davis
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