

Beamer, Norman

From: Trials
Sent: Thursday, March 20, 2025 10:07 AM
To: ddahlgren@devlinlawfirm.com; Trishan; Gregory; Liv; Andrew Gordon; Andrew Sherman; DLF- Lit Paras
Cc: Trials
Subject: RE: Dropbox v. Motion Offense IPR2024-00286, 00287 - PO request to correct exhibit and submit sur-reply evidence
Attachments: IPR2024-00286

Counsel,

Leave to file a corrected Exhibit 2026 in IPR2024-00286 is denied as untimely. In a May 31, 2024 email (attached), Patent Owner was requested to correct this exhibit, but failed to do so.

Patent Owner's request for authorization to submit new evidence and for a one week extension to submit its Sur-Replies (the February 21, 2025 due date of which has been extended three times) are also denied as untimely.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
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(571) 272-5366

From: Derek Dahlgren <ddahlgren@devlinlawfirm.com>
Sent: Wednesday, March 19, 2025 6:06 PM
To: Trials <Trials@USPTO.GOV>
Cc: Efram, Trishan <trishan.esram@wilmerhale.com>; Lantier, Gregory <gregory.lantier@wilmerhale.com>; Herriot, Liv <liv.herriot@wilmerhale.com>; Andrew Gordon <andrew@zilkakotab.com>; Andrew Sherman <asherman@devlinlawfirm.com>; DLF- Lit Paras <dlflitparas@devlinlawfirm.com>
Subject: Dropbox v. Motion Offense IPR2024-00286, 00287 - PO request to correct exhibit and submit sur-reply evidence

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Dear Honorable Board:

Patent Owner is contacting the Board regarding two issues. First, it requests leave to file a corrected Exhibit 2026 in IPR2024-00286. The wrong provisional application was filed and served as reflected by the provisional application identified in the Table of Exhibits in the POR. Second, Patent Owner requests authorization to submit evidence that it has identified indicating that Petitioner has not complied with 37 CFR 42.51(b)(1)(iii), including with respect to new arguments raised in Reply. Patent Owner requests a one week extension to submit its Sur-Replies with such evidence or

alternatively that it be authorized to submit a supplemental filing identifying the evidence with a concise statement concerning relevance so that it may be addressed at the hearing. Patent Owner's Sur-Replies are currently due tomorrow, March 20.

Patent Owner and Petitioner have conferred on these issues.

Petitioner's Statement

Petitioner opposes Patent Owner's requests. First, in its Reply in IPR2024-00286, Petitioner responded to the Exhibit 2026 that was filed by the Patent Owner. Petitioner would be prejudiced if Patent Owner submits a new exhibit in support of its arguments because Patent Owner never filed the provisional application that Patent Owner now wants to introduce and because Petitioner's and Dr. Mowry's arguments were directed to the provision application that Patent Owner filed as Exhibit 2026. Second, Petitioner has not violated 37 CFR 42.51(b)(1)(iii) because none of Dr. Mowry's testimony in this proceeding is inconsistent with anything he testified to before. Motion Offense is belatedly raising this now, after having decided not to depose Dr. Mowry regarding his original declaration, thus giving Dropbox no opportunity to respond in its Reply. It would be unfair to allow Patent Owner in its Sur-Reply to accuse Petitioner of not having complied with 37 CFR 42.51(b)(1)(iii) without giving Petitioner an opportunity to respond in a brief. Patent Owner also had a chance to question Petitioner's expert Dr. Mowry on any alleged inconsistent evidence in a deposition after the Board's institution decision but declined to conduct any deposition at that stage of the trial. Further, the PTAB Trial Practice Guide indicates that Patent Owner's Sur-Reply "may not be accompanied by new evidence other than deposition transcripts." 2019 PTAB Trial Practice Guide at 73.

The parties are available should a call be necessary.

Best regards,
Derek

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