

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.
Petitioner

v.

MOTION OFFENSE, LLC
Patent Owner

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

PETITIONER'S MOTION TO EXCLUDE

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Pursuant to 37 C.F.R. § 42.64(c), Dropbox, Inc. ("Petitioner") moves to exclude evidence included and statements made by Motion Offense, LLC ("PO") in its Sur-Reply. EX1036 is a copy of the Sur-Reply highlighting the portions that should be excluded. Petitioner timely objected on grounds discussed herein (Paper No. 38) and now files this motion to preserve the objections. *See* 37 C.F.R. §42.64.

I. BACKGROUND

On April 2, 2025, the Board issued an order reciting the relevant background and denying PO's request to file a corrected version of EX2026 and to file a motion to submit supplemental evidence. Paper No. 39 ("Order") at 2-3, 7. The Order acknowledges that Petitioner contends that PO's Sur-Reply includes improper new arguments and evidence, but noted that the Board would not address those issues because "Petitioner indicated that it intends to file motions to exclude the allegedly improper evidence and arguments." *Id.* at 4 n.3. This is that motion for this IPR proceeding.

II. LEGAL STANDARD

A party may move to exclude evidence "under the Trial Practice Guide's advice, or on other grounds." *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081 (Fed. Cir. 2015) (citing 37 C.F.R. § 42.64(c)). Other grounds include the Federal Rules of Evidence (FRE), which generally apply to IPR proceedings. 37 C.F.R. § 42.62. Under FRE 402, irrelevant evidence is inadmissible. *See also* FRE 401

(defining relevance). And even relevant evidence may be excluded “if its probative value is substantially outweighed by the danger of ... unfair prejudice.” FRE 403.

III. ARGUMENT

A. The Board Should Exclude PO's Unfounded Allegations Of A 37 C.F.R. § 42.51(b)(1)(iii) Violation

The Board should exclude the unfounded allegations of a 37 C.F.R. § 42.51(b)(1)(iii) violation in PO's Sur-Reply because (1) they are untimely and prejudicial, as the Board already found, and (2) because they lack probative value and pose an undue risk of prejudice under FRE 401, 402, and 403.

1. Despite the Board's March 20 denial of PO's belated request to raise its unfounded allegations, PO's Sur-Reply attempts to smear Petitioner with false allegations of a 37 C.F.R. § 42.51(b)(1)(iii) violation. The Board should not take the bait; it should exclude all of PO's baseless allegations from the Sur-Reply for the same reasons the Board (twice) denied PO's request to file a motion to submit supplemental information regarding Petitioner's compliance with 37 C.F.R. § 42.51(b)(1)(iii): The evidence and arguments are “untimely”; “Petitioner would be prejudiced as the hearings in these proceedings are less than a month away”; and it is not credible that PO was unable to obtain the evidence earlier because PO “admits that most of the evidence was publicly available.” Order at 6-7. *See* highlights in EX1036.

2. The Board should further exclude PO's false assertions under FRE 401, 402, and 403 because they lack any probative value and risk undue prejudice. These statements all lack probative value because there is nothing "inconsistent" between Petitioner's positions in this IPR and its positions in any prior proceedings or any of Dr. Mowry's or any other Dropbox expert's prior testimony. To the extent they have any probative value (they do not), that is clearly outweighed by the risk of prejudice because Petitioner does not have a full and fair opportunity to respond to these late-made assertions.

First, PO alleges a damages report served in an unrelated litigation and authored by non-technical witness, not Dr. Mowry, demonstrate Mr. Houston's overarching focus on having locally stored versions available." *See* highlight in EX1036 at 12 n.10. That assertion lacks probative value because PO fails to analyze the substance of the cited paragraphs or compare them to the challenged claim. That is likely because these irrelevant background paragraphs about Dropbox's early history and success do not mention the Houston reference nor interpret or help interpret the Houston reference—or any reference in this IPR for that matter. But there is also nothing inconsistent with having locally available folders and modifying Houston so that the recipient first needs to click on a newly shared folder before its content is downloaded. *See, e.g.*, Pet. Reply at 7, 9-11.

Second, PO asserts that a 2009 Dropbox guide is inconsistent with positions taken by Petitioner in the current proceeding. *See* highlight in EX1036 at 12-13. But there is no contradiction at all. The 2009 Dropbox guide does not exclude using green check mark overlays to indicate that folders and their files are synchronized with a host system and are stored locally. EX1034, ¶31, ¶31 n.7; *see also* Pet. Reply at 15 n.9. That evidence is therefore not probative of any disputed issue in this proceeding.

Third, PO asserts that Petitioner's statements during prosecution of continuation applications claiming priority to Garcia are inconsistent with positions taken by Petitioner in the current proceeding. *See* highlight in EX1036 at 15 n.12. That too is facially false, and Petitioner's statements in those continuation applications thus lack any probative value in this IPR. Petitioner's reliance on Garcia's specification disclosure of "[w]hen the contact clicks on the link to folder 1115, the contents of the folder are shared with the contact" during prosecution of the continuation applications to support pending claims, which relate to providing content to a client device, is no way inconsistent with Petitioner's position in the instant IPR. Providing content after the contact clicks on the link in the email does not imply that the content is downloaded or delivered immediately. *See, e.g.*, Pet. Reply at 15-17.

Finally, PO's statements in footnotes 1, 7, and 11 of its Sur-Reply are nothing more than naked (and false) assertions lacking any probative value. *See* highlights in EX1036 at 1 n1., 6 n.7, 13 n.11. These statements should therefore be excluded under FRE 401, 402 and 403, in addition to the reasons for exclusion that the Board already found in its April 2 Order (Paper 39).

B. Material From Provisional Application No. 61/233,787 Constitutes New Evidence Prohibited for Sur-Reply

Though the Board has twice denied PO's request to replace the current EX2026 with a new document, "Houston II," PO improperly reproduced a substantial portion of Houston II in the Sur-Reply. *See* highlight in EX1036 at 9-12, 9 n.9. This reproduced portion of Houston II, as highlighted in EX1036, should be excluded.

The Board's Order correctly denied PO's request to supplement the record with this new evidence. Order at 5. The Board explained that a "lack of diligence on Patent Owner's part does not constitute good cause for allowing Patent Owner to file a corrected version of a document when Patent Owner failed to do so for almost a year, and the hearing in the proceeding is less than a month away." *Id.* The Board further explained that "[f]iling a corrected exhibit at this late date and under these circumstances would be prejudicial to Petitioner and not in the interests of justice." *Id.* PO's reproduction of the above-noted portions of Houston II is an

attempt to belatedly introduce that evidence into the proceeding. Because 37 CFR § 42.63 requires that evidence in an IPR proceeding be filed as an exhibit, and Houston II was not and cannot be filed as such, the reproduced paragraphs should be excluded from the Sur-Reply.

During a conference call with the Board on March 28, 2025, PO alleged that the following cases support its position that “patents that are incorporated by reference are effectively part of the host patent as if they were explicitly contained therein”: *Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022) (citing *X2Y Attenuators, LLC v. Int’l Trade Comm’n*, 757 F.3d 1358, 1362-1363). EX2054, 23:9-13. Those cases and the legal proposition for which they stand are inapposite. Both *X2Y Attenuators* and *Finjan* address whether the content of patents incorporated by reference in other patents are relevant to ***claim construction*** and state that patents incorporated by reference are “effectively part of the host [patents] as if [they] were explicitly contained therein.” *Finjan*, 51 F.4th at 1382 (alterations in original); *X2Y Attenuators*, 757 F.3d at 1362-1363 (alterations in original). Neither case address provisional patent applications or arose in the context of an IPR at all, much less found (as PO now asks the Board to find) that a party can rely upon a provisional patent application as evidence in an IPR even where that provisional patent application was nowhere timely included as an exhibit. The Board was right to prohibit PO from introducing Houston II as evidence at this very late point in this

IPR and it should not permit PO to evade that ruling by copying the contents of that untimely evidence and pasting it in to the Sur-Reply.

Further, in addition to being untimely, any alleged probative value of this new evidence is substantially outweighed by a danger of unfair prejudice, confusing the issues, and misleading the factfinder and should be excluded under FRE 403.

IV. CONCLUSION

Petitioner requests the Board exclude statements highlighted in EX1036.

Respectfully submitted,

/Trishan Eram/

Trishan Eram

Registration No. 74,075

UPDATED TABLE OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 11,611,520
1002	Declaration of Dr. Todd Mowry
1003	U.S. Patent No. 8,825,597 (“Houston”)
1004	U.S. Patent No. 9,633,125 (“Garcia”)
1005	U.S. Patent Application Publication No. 2010/0005138 (“Manzano”)
1006	U.S. Patent Application Publication No. 2007/0011246 (“Wu”)
1007	[Reserved]
1008	U.S. Patent Application Publication No. 2012/0278404 (“Meisels”)
1009	U.S. Patent Application Publication No. 2013/0067303 (“Kantor”)
1010	[Reserved]
1011	“SugarSync now allows you to work directly in Windows Explorer,” D. Mihovilovic, May 6, 2009
1012	Internet Archive Declaration of Nathaniel E Frank-White
1013	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:20-cv-00251, Jury Verdict Form, May 19, 2023, Dkt. 382
1014	’520 Patent File History
1015	U.S. Patent No. 6,351,776 (“O’Brien”)

Petitioner's Motion to Exclude
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Exhibit	Description
1016	U.S. Patent Application Publication No. 2008/0320397 (“Do”)
1017	“Supporting File Sharing Through Improved Awareness,” T. Whalen, August 2008
1018	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:23-cv-00303, First Amended Complaint for Patent Infringement, July 26, 2023, Dkt. 22
1019	[Reserved]
1020	[Reserved]
1021	[Reserved]
1022	[Reserved]
1023	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:23-cv-00303, Plaintiff's Disclosure of Preliminary Infringement Contentions, September 20, 2023
1024	Declaration of Gregory H. Lantier
1025	Declaration of Liv L. Herriot
1026	Declaration of Todd C. Zubler
1027	[Reserved]
1028	Deposition Transcript of Michael Smith
1029	[Reserved]
1030	[Reserved]

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Exhibit	Description
1031	[Reserved]
1032	[Reserved]
1033	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:23-cv-00303, Jury Trial Proceedings Volume 4 of 5, May 18, 2023, Dkt. 409
1034	Second Declaration of Dr. Todd Mowry
1035	<i>Motion Offense, LLC v. Dropbox, Inc.</i> , WDTX-6:23-cv-00303, Drobox, Inc.'s Renewed Pre-Verdict Motion for Judgment As A Matter of Law, May 18, 2023, Dkt. 393
1036	Highlighted Version of Patent Owner's Sur-Reply
1037	[Reserved]

CERTIFICATE OF SERVICE

I hereby certify that, on April 4, 2025, I caused a true and correct copy of the foregoing materials:

- Petitioner's Motion to Exclude
- Exhibit 1036
- Updated Table of Exhibits

to be served via electronic mail by consent on counsel of record at:

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Respectfully Submitted

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