

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

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
EXCLUDE EVIDENCE**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
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Pursuant to 37 C.F.R. § 42.64(c) and the Board’s April 11, 2025 email, Patent Owner (“PO”) submits this opposition to Petitioner’s Motion to Exclude (“Motion”; Paper 40). Petitioner’s Motion is contrary to controlling precedent and public policy favoring adjudication on the merits. As set forth in more detail below, the Motion is contrary to controlling precedent and public policy favoring adjudication on the merits and should be denied.

I. PETITIONER’S MOTION LACKS MERIT

Petitioner’s Motion includes improper arguments regarding the merits and seeks to exclude, rather than strike, *argument* from PO’s sur-reply. (Paper 40 at 2-4; EX1036.) The arguments Petitioner seeks to exclude generally concern credibility and preserving PO’s arguments with respect to § 42.51(b)(1)(iii).¹ PO is “obligat[ed] to present its concern to the Board and seek relief” to preserve these issues.² Petitioner’s attacks against PO for doing just that are unfounded, as are its assertion that PO’s request was untimely. The timing was within the range that the Federal Circuit has indicated should normally be acceptable.³

¹ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272-74 (Fed. Cir. 2017).

² *Alivecor, Inc. v. Apple Inc.*, 130 F.4th 1006, ---, 2025 U.S. App. LEXIS 5311, at *26 (Fed. Cir. 2025).

³ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 n.4 (Fed. Cir. 2017) (stating that seeking supplementation within three weeks of hearing normally should be acceptable).

Petitioner’s Motion also attempts to exclude consideration of certain disclosures included in Houston—the primary reference in all grounds—as a matter of law through the incorporation by reference of the ’787 provisional application. Petitioner’s attempt to carve out one of the provisional applications that is incorporated by reference from the disclosure of Houston is contrary to Federal Circuit precedent: the incorporated provisional applications are “part and parcel” of Houston and all must be considered together as a whole.⁴ A party is not allowed to pick and choose portions of a reference while excluding others for purposes of obviousness.⁵ Excluding reliance on the Houston ’787 provisional would preclude reliance on the remainder of Houston under these circumstances.⁶

⁴ *Netflix, Inc. v. Avago Techs. Int’l*, Nos. 2024 U.S. App. LEXIS 17998, at *21 (Fed. Cir. July 23, 2024) (“By clearly identifying Appendix J, detailing the subject matter it addresses, and pointing to where it is found, Masters makes clear that Appendix J is part and parcel to Masters itself. We therefore conclude that the Board erred when it declined to consider Appendix J for purposes of its analysis.”); *see also Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022); *Trs. of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1365-66 (Fed. Cir. 2016).

⁵ *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-49 (Fed. Cir. 1986); *Recor Med. Inc. v. Medtronic Ireland Mfg. Unlimited Ltd.*, No. 23-2251 slip op. at 5 (Fed. Cir. Mar. 27, 2025) (“A reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect . . . We agree with Recor that the Board violated this principle here.”) (cleaned up).

⁶ That is consistent with 35 U.S.C. § 312, which requires Petitioners provide Patent Owners with copies of the patents and printed publications relied upon in a Petition as a threshold condition for filing. *See AMC Multi-Cinema, Inc. v. Fall Line Patents, LLC*, No. 2021-1051, 2021 U.S. App. LEXIS 29547, at *15 (Fed. Cir. Sep. 30, 2021).

Moreover, PO's Sur-Reply is the same or substantially similar in pertinent part to its POPR, dated April 30, 2024. Petitioner made no objection nor preserved any such objections and has waived any such objections.

Petitioner also accuses PO of making "baseless," "unfounded" or "false allegations," or "false assertions" throughout the Motion. (Paper 40 at 1-3.) But that is belied by Petitioner's conduct going back to the beginning of this proceeding. In the Institution Decision, the Board acknowledged that Houston teaches away from the combination with Garcia for at least disclaimed claims 1-8; however, the Board found that teaching away was not applicable to claims 17-21 under the construction it applied for purposes of the Institution Decision. (Paper 12 at 35-36.) However, at the time the Petition was filed, PO had not disclaimed claims and therefore under the same reasoning used by the Board the disclosure of the '787 provisional was inconsistent with the Petition's reasoning for combining Houston and Garcia with respect to claims 1-8. That inconsistency should have triggered Petitioner's duty to serve a copy of the provisional application with the filing of the Petition. But that never happened. Petitioner has not provided any such routine discovery so far despite its active prosecution and litigation dockets. PO submits that nothing is false or misleading or otherwise objectionable.

II. LEGAL STANDARD

“[A] motion to exclude [should not] address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply”; instead, it “must explain why the evidence is not admissible (e.g., relevance or hearsay) . . .” Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) at 79; *Sony Corp. v. Yissum Research Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00218, Paper 53, 53-54 (PTAB Sept. 22, 2014) (motion to exclude is not a mechanism to argue that a reply contains new arguments, but must state why the evidence is inadmissible, identify the corresponding objection in the record, and explain the objection). “If a party believes that a brief filed by the opposing party raises new issues, is accompanied by belatedly presented evidence, or otherwise exceeds the proper scope of reply or sur-reply, it may request authorization to file a motion to strike.” CTPG at 80.

III. ALL OF PETITIONER’S ALLEGED “VIOLATIONS” FAIL

A. The Alleged “Unfounded Allegations Of A 37 C.F.R. § 42.51(b)(1)(iii) Violation” Are not Evidence to be Excluded

Petitioner does not identify any *evidence* it seeks to exclude that contains allegedly “unfounded allegations” of 37 C.F.R. § 42.51(b)(1)(iii) violations in PO’s Sur-Reply. Instead, the Motion only cites portions of PO’s Sur-Reply itself along with attorney argument on why those portions should be excluded. (EX1036; Paper 40 at 2-5.) Petitioner has provided no basis for any relief. PO’s Sur-Reply was a proper preservation of rights in this proceeding and thus relevant,

probative and without undue risk of prejudice. *Alivecor, Inc. v. Apple Inc.*, 130 F.4th 1006, ---, 2025 U.S. App. LEXIS 5311, at *26 (Fed. Cir. 2025). PO has met the “low threshold for relevancy” that FRE 401 allows, and the Sur-Reply should not be excluded. *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F. 3d 1396, 1407 (Fed. Cir. 1997). *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 n.4 (Fed. Cir. 2017) (seeking supplementation within three weeks of hearing generally acceptable).

However, the proper procedure for addressing whether the Sur-Reply includes “unfounded” argument would be to request authorization to file a motion to strike, not filing a motion to exclude. *Puzhen Life USA, LLC, v. Esip Series 2, LLC*, IPR2017-02197, Paper 24 at 48 (PTAB Feb. 27, 2019) (denying patent owner’s motion to exclude and noting that the proper procedure would have been to request authorization to file a motion to strike). To the extent Petitioner is asking the Board to treat the Motion as a motion to strike, the Board should decline to do so. Petitioner has not sought authorization. *See id.* at 49 (declining to treat a motion to exclude as a motion to strike because patent owner did not request authorization).

Moreover, the Motion violates the procedures set out in the CTPG. Because Petitioner fails to identify any exhibits containing improper evidence, it also fails to “[i]dentify where in the record *the evidence sought to be excluded* was relied upon by an opponent” and “Address objections to *exhibits in numerical order.*” (CTPG

at 79.) Petitioner appears to recognize this latter requirement, because it trivially numbers its arguments in this section, but again, no exhibits are identified in numerical order. Moreover, arguments as to the proper scope of the exhibits are improper for a motion to exclude. Practice Guide at 79.

Moreover, Petitioner's statement regarding publicly available is misplaced. Petitioner has thousands and thousands of patent assets worldwide as well as numerous legal actions and other public sources of information. PO is not responsible for Petitioner's satisfaction of its obligations according to § 42.51(b)(1)(iii). PO incorporates by reference its correspondence including examples provided in the parties' email correspondence. Nor does Petitioner explain "why the evidence is not admissible (e.g., relevance or hearsay)," other than a conclusory statement that "irrelevant evidence is inadmissible." (MTE at 1.) This is insufficient, and Petitioner has not met its burden to show that any evidence should be excluded on this basis.

Rather, Petitioner seeks, alternatively, to "address the weight to be given evidence," or "address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply," both of which are prohibited in a motion to exclude. (CTPG at 79.) *Laird Techs., Inc. v. GrafTech Int'l Holdings Inc.*, Case IPR2014-00025, Paper 45 at 42 (P.T.A.B. March 25, 2015) (a motion to exclude "is

not an appropriate mechanism for challenging the sufficiency of evidence or the proper weight that should be afforded an argument”).

B. The “Material From Provisional Application No. 61/233,787” Is Not Evidence to be Excluded

Petitioner’s arguments relating to Provisional Application No. 61/233,787 (the “Houston ’787 Provisional”) fare no better. Here, too, Petitioner seeks to strike portions of PO’s Sur-Reply but does not identify any corresponding exhibit it contends is inadmissible hearsay or irrelevant. At best, Petitioner’s arguments go to the timeliness of PO’s citation to the Houston ’787 Provisional rather than its inadmissibility. To the extent Petitioner is referring to PO’s timing with respect to contacting the Board, there is no evidence that was untimely as it fell within the timeframe that the Federal Circuit has stated is normally acceptable for supplementing the record.⁷ PO include the same or substantially the same information in its POPR and Petitioner failed to raise any timely objection and thus all objections are waived. *See also Laird Techs., Inc. v. GrafTech Int’l Holdings Inc.*, Case IPR2014-00025, Paper 45 at 42 (P.T.A.B. March 25, 2015) (a motion to exclude “is not an appropriate mechanism for challenging the sufficiency of evidence or the proper weight that should be afforded an argument”).

⁷ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 n.4 (Fed. Cir. 2017) (seeking supplementation within three weeks of hearing generally acceptable).

Petitioner has provided no basis for any relief. PO's Sur-Reply was proper in this proceeding and thus relevant, probative and without undue risk of prejudice. *Alivecor, Inc. v. Apple Inc.*, 130 F.4th 1006, ---, 2025 U.S. App. LEXIS 5311, at *26 (Fed. Cir. 2025). PO has met the "low threshold for relevancy" that FRE 401 allows, and the Sur-Reply should not be excluded. *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F. 3d 1396, 1407 (Fed. Cir. 1997). Houston II is considered part of the disclosure of Houston as a matter of law. *Netflix, Inc. v. Avago Techs. Int'l*, Nos. 2024 U.S. App. LEXIS 17998, at *21 (Fed. Cir. July 23, 2024) ("By clearly identifying Appendix J, detailing the subject matter it addresses, and pointing to where it is found, Masters makes clear that Appendix J is part and parcel to Masters itself. We therefore conclude that the Board erred when it declined to consider Appendix J for purposes of its analysis."); *see also Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022); *Trs. of Columbia Univ. v. Symantec Corp.*, 811F.3d 1359, 1365-66 (Fed. Cir. 2016). *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-49 (Fed. Cir. 1986); *Recor Med. Inc. v. Medtronic Ireland Mfg. Unlimited Ltd.*, No. 23-2251 slip op.at 5 (Fed Cir. Mar. 27, 2025) ("A reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect . . . We agree with Recor that the Board violated this principle here.") (cleaned up).

Petitioner's timeliness arguments should be rejected as well. *Twitter, Inc. v. Vidstream, LLC*, IPR2017-00829, Paper 68, 47-48 (PTAB Jan. 28, 2019) (noting that "timeliness arguments are not properly the subject of a motion to exclude, which should seek to exclude evidence as inadmissible, but rather should have been filed as a motion to strike because they seek to exclude belatedly presented evidence that Patent Owner contends exceeds the proper scope of reply."). According to the CTPG, Petitioner was required to seek authorization from the Board to file a motion to strike PO's arguments relying on the Houston '787 Provisional. (CTPG at 79-81.) Because Petitioner failed to do so, its arguments regarding the Houston '787 Provisional should be rejected.

In any event, Petitioner is legally wrong that the Houston '787 Provisional is "new" or untimely evidence that should be excluded. As PO informed the Board on March 28, 2025, it is settled law that a provisional patent application expressly incorporated by reference into a non-provisional application becomes part of the specification of the patent issuing from the later-filed non-provisional application. *See* 37 C.F.R. § 1.57(c), (e); MPEP § 2163.07(b) ("The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new

matter.”). Petitioner waived its objections as similar reproductions were included in PO’s POPR on April 30, 2024.

Petitioner’s attempt to distinguish *Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022) and *X2Y Attenuators, LLC v. Int’l Trade Comm’n*, 757 F.3d 1358, 1362-63) is meritless. As PO clarified, those cases are merely exemplary. (EX2054 at 23:8-18.) The fact that the Federal Circuit relied on this fundamental understanding of incorporation by reference to address “claim construction” issues does not limit the principle to “claim construction,” as Petitioner suggests. *Netflix, Inc. v. Avago Techs. Int’l*, Nos. 2024 U.S. App. LEXIS 17998, at *21 (Fed. Cir. July 23, 2024) (“By clearly identifying Appendix J, detailing the subject matter it addresses, and pointing to where it is found, Masters makes clear that Appendix J is part and parcel to Masters itself. We therefore conclude that the Board erred when it declined to consider Appendix J for purposes of its analysis.”); *see also Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022); *Trs. of Columbia Univ. v. Symantec Corp.*, 811F.3d 1359, 1365-66 (Fed. Cir. 2016). *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-49 (Fed. Cir. 1986); *Recor Med. Inc. v. Medtronic Ireland Mfg. Unlimited Ltd.*, No. 23-2251 slip op.at 5 (Fed Cir. Mar. 27, 2025) (“A reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and

attempting to protect . . . We agree with Recor that the Board violated this principle here.”) (cleaned up).

Here, the Houston ’787 Provisional is legally part of the Houston reference relied on by Petitioner, its expert, and the Board in the Institution Decision. The Board is therefore required to consider the teachings of the Houston ’787 Provisional in its analysis of the teachings of Houston. Contrary to Petitioner’s assertions, PO’s arguments based on the Houston ’787 Provisional are not untimely, irrelevant, or inadmissible. Neither the Houston ’787 Provisional nor PO’s arguments should be excluded. The Houston ’787 Provisional was reproduced in substantially the same or same form in PO’s POPR and referred to by application number in PO’s POR and Dr. Smith’s declaration.

Moreover, Petitioner’s assertions of “prejudice” from the Houston ’787 Provisional ring hollow. (MTE at 5-7.) Tellingly, Petitioner fails to articulate what the prejudice is. For example, Petitioner alleges that “any alleged probative value of this new evidence is substantially outweighed by a danger of unfair prejudice.” (MTE at 7.) However, Petitioner fails to explain what prejudice it will face from the inclusion of the Houston ’787 Provisional, how it is “unfair,” or how any such prejudice “outweigh[s]” the probative value of the Houston ’787 Provisional (which, as explained above, is material to understanding the operation of Houston). There is no prejudice here. Otherwise Petitioner would have said what it is.

For example, while Petitioner complains that it “does not have a full and fair opportunity to respond to these late made assertions [regarding the allegedly ‘unfounded allegations of a 37 C.F.R. § 42.51(b)(1)(iii) violation’],” (*see* MTE at 3), it does not make the same argument in connection with the Houston ’787 Provisional. Nor could it. Drew Houston, the named inventor of the Houston ’787 Provisional and the Houston non-provisional reference (EX1003), is the founder and CEO of Petitioner. Petitioner cannot credibly argue that it could not have been aware of the prosecution history of Houston, including the disclosures of the Houston ’787 Provisional.

IV. CONCLUSION

For the foregoing reasons, Petitioner’s Motion to Exclude should be denied in its entirety.⁸

⁸ PO reserves the right to supplement or amend or revise its response to the fullest extent allowed. PO reserves all rights and nothing contained herein is to be considered a waiver or forfeiture of any right. PO has responded proportionally to the level of specificity provided by Petitioner and reserves the right to respond to any Reply Petitioner may file or otherwise.

Dated: April 11, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that there are 2,901 words in this paper, excluding any table of contents, table of authorities, mandatory notices under 37 C.F.R. § 42.8, certificate of word count, certificate of service, or appendix of exhibits. This certification relies on the word count of the word-processing system used to prepare this paper.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on April 11, 2025, the foregoing document is being served via electronic mail upon the following counsel of record for Petitioner:

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