

Petitioner's Reply to Patent Owner's Opposition to Motion to Exclude Evidence
IPR2024-00286 (U.S. Patent No. 11,611,520)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.
Petitioner

v.

MOTION OFFENSE, LLC
Patent Owner

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

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

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PO's opposition to Petitioner's motion to exclude fails to identify any persuasive reason the Board should allow PO to use its Sur-Reply to circumvent the Board's prior rulings. For all the reasons set forth in its motion and here, Petitioner respectfully requests that the Board exclude the portions of PO's Sur-Reply highlighted in EX1036.

I. ARGUMENT

A. Petitioner's Motion To Exclude Is Procedurally Proper

PO's primary argument is a procedural argument that Petitioner should have filed a motion to strike rather than a motion to exclude. Paper 41 ("Opp."), 1, 4-7. But that argument rings hollow in light of the history of this proceeding and the Board's own order on these issues. On March 25, 2025, Petitioner indicated that it intended to file a motion to strike this material from the sur-replies. EX1038; EX1039. During the March 28, 2025 conference call, the Board asked Petitioner if a "motion to exclude...would provide a sufficient mechanism for addressing" the issues. Petitioner agreed to that vehicle. *Id.*, 21:22-22:07. The Board's subsequent order confirmed that the motion to exclude would address "improper evidence and arguments." Order at 4 n.3 (emphasis added). Thus, PO's procedural argument fails; Petitioner's motion seeks exactly the relief that the Board indicated it could.

B. PO's Arguments Regarding 37 C.F.R. § 42.51 Fail

PO argues that its evidence and arguments with respect to 37 C.F.R. § 42.51 are (1) relevant and (2) timely. They are neither.

PO first contends that its argument in its Sur-Reply that Petitioner violated 37 C.F.R. § 42.51(b)(1)(iii) was a “proper preservation of rights and thus relevant.” Opp. 1, 4-5, 8. PO cites *AliveCor, Inc. v. Apple Inc.*, 104. F.4th 1006, 1019 (Fed. Cir. 2025), but *AliveCor* does not support PO's position. *AliveCor* lists ways that a party can preserve an argument for an appeal, including telling the Board it believed the opposing party was violating its discovery obligation. But PO did that *before* its Sur-Reply, and the Board properly rejected the allegation. There was no reason for PO to raise that argument *again* in its Sur-Reply—other than to evade the Board's prior decision.

PO also argues that Petitioner's statement that the materials PO now seeks to add were “publicly available” is “misplaced” because it is Petitioner's obligation to adhere to § 42.51(b)(1)(iii) regardless of whether material is publicly available. Opp. 6. But Petitioner's statement that the disputed materials were “publicly available” related to the *timeliness* of PO's allegations and merely quoted the Board's own reasoning as to why it was not credible that PO was unable to obtain evidence earlier—in the Board's words, because PO “admits that most of the evidence was publicly available.” Paper 40 at 2 (quoting Order at 6-7). Moreover,

Petitioner *did* comply with its obligations under § 42.51(b)(1)(iii), and Petitioner has countered each of PO's arguments otherwise. *See generally* Paper 40.

PO next argues that its timing in raising its arguments "is within the range that...should normally be acceptable." Opp. 1, 5, 7 (citing *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272-74 (Fed. Cir. 2017)). As an initial matter, this is an argument that the Board has already rejected twice. And for good reason. Nearly all of the late-identified evidence here was available long before PO filed its POR, and the Board supplied multiple reasons for its decision. *See* EX3002; Order at 4-7. This case therefore stands in sharp contrast to *Ultratec*, where the new evidence could not have been obtained earlier and the Board offered "no reasoned basis" for its decision to exclude the evidence. 872 F.3d at 1272-73.

C. PO's Arguments for its Copy and Paste of "Houston II" Fail

Besides the arguments above, PO makes three arguments as to why it should be allowed in its Sur-Reply to copy and paste the text of the "Houston II" provisional application that the Board already told PO it could not add as an exhibit at this late stage. None of those arguments has merit.

PO first attempts to shift the blame to Petitioner, arguing that it was Petitioner's responsibility to provide Houston II because of the requirement to provide printed publications relied upon in a Petition. Opp. 2 n.6. But Petitioner did not rely on Houston II and thus did not need to supply it.

PO next wrongly argues that Petitioner has waived its objections because PO's Sur-Reply is "the same or substantially similar" to its Patent Owner's Preliminary Response ("POPR"), and Petitioner "made no objection nor preserved any such objections" in response to the POPR. *Id.*, 3. But Petitioner had no right to respond to the POPR and instead responded at the appropriate time—in response to the Patent Owner Response ("POR"). Petitioner did not waive any argument.

Finally, PO argues that the Houston II provisional is not new or untimely because it is legally "part of the specification" of Houston itself. Opp. 8-10. But the cases PO cites are in the context of how to interpret claim language¹ or stand for the proposition that a reference must be considered for all that it teaches.² None of the cases support the proposition that evidence a party chooses to rely on in an IPR proceeding need not be filed as an exhibit. *See* 37 C.F.R. § 42.63.

¹ *Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022); *X2Y Attenuators, LLC v. Int'l Trade Comm'n*, 757 F.3d 1358, 1362-63); *Trs. of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1365-66 (Fed. Cir. 2016).

² *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)

II. CONCLUSION

Petitioner requests that the Board exclude from this proceeding the statements from PO's Sur-Reply that Petitioner has highlighted in EX1036, and the new evidence therein.

Respectfully submitted,

/Trishan Eram/

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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")

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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]
1038	March 27, 2025 Email from Petitioner to the Board
1039	March 25, 2025 Email from Petitioner to Patent Owner (Attachment to EX1038)

CERTIFICATE OF SERVICE

I hereby certify that, on April 18, 2025, I caused a true and correct copy of the foregoing materials:

- Petitioner's Reply to Patent Owner's Opposition to Motion to Exclude Evidence
- Exhibits 1038-1039
- Updated Table of Exhibits

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Respectfully Submitted

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