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Filed on behalf of Dropbox, Inc.

By: Scott Bertulli, Reg. No. 75,886 (Lead Counsel)
Gregory Lantier (*pro hac vice* to be filed) (Backup Counsel)
Trishan Efram, Reg. No. 74,075 (Backup Counsel)
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109
Email: scott.bertulli@wilmerhale.com
gregory.lantier@wilmerhale.com
trishan.esram@wilmerhale.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.
Petitioner

v.

MOTION OFFENSE, LLC
Patent Owner

IPR2024-00286 and IPR2024-00287
U.S. Patent No. 11,611,520

**PETITIONER'S PETITION RANKING AND EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

Petitioner’s Ranking and Explanation of Material Differences Between Petitions

Pursuant to the November 2019 Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”), Dropbox respectfully submits this paper to “identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” *See* CTPG at 59–61.

I. EXPLANATION WHY THE BOARD SHOULD EXERCISE ITS DISCRETION TO INSTITUTE ADDITIONAL PETITIONS IN THIS CASE

A. Patent Owner has asserted a large number of lengthy claims in litigation

Patent Owner (“PO”) asserted the ’520 patent against Dropbox in a complaint filed on April 24, 2023. *See Motion Offense, LLC v. Dropbox, Inc.*, No. 6:23-cv-00303 (W.D. Tex.). In its September 20, 2023 Preliminary Infringement Contentions, PO alleged infringement of *twenty-three* of the ’520 patent’s twenty-four total claims. EX1023 (PO’s “preliminary Infringement Contentions with respect to claims 1–12 and 14–24 of U.S. Patent No. 11,611,520.”).

As the CTPG recognizes, “there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation.” CTPG at 59. In the present case,

Petitioner’s Ranking and Explanation of Material Differences Between Petitions PO has asserted a large number of claims in the pending litigation and two petitions are necessary to address all claims asserted by PO. *Id.* (“In such cases two petitions by a petitioner may be needed...”).

Moreover, the ’520 patent’s claims are of extreme length. Including their preambles, independent claim 9 contains *sixteen* limitations, independent claim 14 contains *fifteen* limitations, independent claim 22 contains *twelve* limitations, independent claim 1 contains *eleven* limitations, and independent claim 7 contains *seven* limitations. In total, the twenty-four claims addressed in Dropbox’s two petitions are over *eight columns* long. EX1001 at 49:6–57:20. Two petitions are necessary to provide the Board with sufficient detail and explanation of how the prior art discloses and/or renders obvious each of the numerous claim limitations at issue in a concise, well-organized, easy-to-follow manner that is supported by readily identifiable evidence of record. CTPG at 39. Dropbox’s request for two petitions is also consistent with prior Board decisions. *See e.g., Adobe Inc. v. SynKloud Technologies, LLC*, IPR2020-01392, Paper 8 at 8–10 (Mar. 11, 2021) (finding “Petitioner’s showing for two petitions is reasonable” where some “claims are lengthy or complex, necessitating several pages of explanation.”).

B. Each petition challenges a distinct set of claims

There is no overlap of claims challenged by each petition. Dropbox’s first petition, in IPR2024-00286, challenges claims 1–8 and 17–21 of the ’520 patent.

Petitioner’s Ranking and Explanation of Material Differences Between Petitions

Claims 1, 7, and 17 are independent claims and claims 2–6, 8, and 18–21 depend only on independent claims 1, 7, and 17, respectively. Dropbox’s second petition, in IPR2024-00287, challenges claims 9–16 and 22–24 of the ’520 patent. Claims 9, 14, and 22 are independent claims, and claims 10–13, 15–16, and 23–24 depend only on independent claims 9, 14, and 22, respectively.

C. Each distinct set of claims recites disparate features, necessitating different prior art and issues to be addressed for each petition

Not only is there no overlap in challenged claims by claim number, but each set of claims recites different limitations and functionality from the claims challenged in the other petition, necessitating a second petition to describe and analyze those limitations and features not present in the first petition. In particular, claims 1–8 and 17–21 challenged in IPR2024-00286 focus on “folder sharing,” where a network user can share folders with another network user. The challenged “folder sharing” claims include limitations such as “receive, from the first node via the at least one network, *an indication to share the at least one folder*,...” “based on the receipt of the *indication of the at least one folder*, the indicia associated with the at least one email address, and the *indication to share the at least one folder* via the at least one network; generate at least one email message *identifying the at least one folder* and including *a reference to the at least one folder*,...”. EX1001, claim 1; *see also id.*, claims 7 and 17. Differently, claims 9–16 and 22–24 challenged in IPR2024-00287 focus on “file request,” where a network user can request that

Petitioner’s Ranking and Explanation of Material Differences Between Petitions another network user upload a file. The challenged “file request” claims are replete with limitations that include “the file request”—“file request” appears eleven different times in claim 9 alone. *See id.*, claim 9; *see also id.*, claims 14 and 22 (“causing, at a first node, display of: a first user interface element that includes a textbox, *for collecting a file request description for at least one file...*”).

Limited to a single petition, both the technology and the disclosures of the prior art cannot be fully developed. Indeed, every ground presented in IPR2024-00286 for the “folder sharing” claims relies on Dropbox’s own “Houston” patent as the primary reference, whereas every ground presented in IPR2024-00287 for the “file request” claims relies on a completely different primary reference to “Riepling.” The petitions each explain the different features of the “folder sharing” and “file request” claims, respectively, and detail how the necessarily different references demonstrate these principles in an efficient, but fulsome way to help the Board in understanding and evaluating the claims and prior art. In sum:

Petition	Challenged Claims	Claim Focus	Primary Art
IPR2024-00286	1–8 17–21	Folder Sharing	Houston
IPR2024-00287	9–16 22–24	File Request	Riepling

D. Dropbox has filed only two petitions challenging the ’520 patent

With this paper, Dropbox files only two petitions challenging the ’520 patent, collectively addressing all twenty-four claims. Dropbox has no intention of filing any future petitions challenging the ’520 patent. Accordingly, the filing,

Petitioner's Ranking and Explanation of Material Differences Between Petitions consideration, and institution of the present two petitions do not rise to the level of patent owner abuse or burden on the Board's resources contemplated by the CTPG. Moreover, Dropbox submits that the two proceedings can be coordinated and a similar or common schedule adopted, thus decreasing any inconvenience to the Board or PO. To the extent the Board or PO may express concern that consideration and institution of both petitions may strain the Board's finite resources, Dropbox is willing to work with the Board and PO to help preserve resources, create efficiency, and further ensure the final determinations issue on time for both petitions.

II. DROPBOX RESPECTFULLY REQUESTS INSTITUTION OF BOTH PETITIONS

Because numerous, lengthy claims are asserted by PO, and those claims address disparate features requiring two different sets of prior art and analysis, Dropbox believes both filed petitions merit consideration and institution. Although Dropbox respectfully requests institution of both petitions, in accordance with the Board's guidance, Dropbox provides a ranking of IPR2024-00286 first and IPR2024-00287 second.

Respectfully submitted,

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/Scott Bertulli/
Scott Bertulli, Lead Counsel
Registration No. 75,886