

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,

Petitioner

v.

MOTION OFFENSE, LLC,

Patent Owner

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

PATENT OWNER'S PRELIMINARY RESPONSE

Under 37 C.F.R. § 42.107

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2001	Affidavit of Mr. Derek Dahlgren In Support of Patent Owner's Motion for <i>Pro Hac Vice</i> Admission
2002	U.S. Patent Application No. 13/626,635
2003	U.S. Patent No. 10,713,966
2004	U.S. Patent Application No. 13/624,906

I. INTRODUCTION

Petitioner has not met its burden and its request for *inter partes* review of claims 9-16 and 22-24 of U.S. Patent No. 11,611,520 (“the ’520 patent”, EX1001) should be denied. *First*, the asserted references fail to disclose every limitation of the challenged claims, much less in the manner recited. *Second*, regardless of the foregoing, Petitioner has not articulated any motivation for modifying Riepling in the manner advanced by Petitioner. As explained in more detail below, a POSITA would not have found Petitioner’s hindsight-based modifications to have been obvious, much less actually read on the challenged claims. *Third*, significant secondary indicia confirm that the challenged claims were non-obvious at the time of invention.

For at least these reasons, and those set forth below, the Petition should be denied and the claims upheld.

II. APPLICABLE LEGAL PRINCIPLES

“[T]he decision whether to institute an *inter partes* review is discretionary.” *Unified Patents Inc. v. C-Cation Techs., LLC*, IPR2015-01045, Paper 15 at 3 (PTAB Oct. 7, 2015) (citing 37 C.F.R. § 42.108(a)). Petitioner has the burden to show that it is likely to prevail as to at least one claim of the ’520 patent. 35

U.S.C. § 314; *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

To make a prima facie showing of obviousness under 35 U.S.C. § 103, the Petition must fulfill the requirements set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), including demonstrating that the cited references disclose each element of a challenged claim. *In re Magnum Oil Tools Int'l.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016); *see also Apple Inc. v. Contentguard Holdings, Inc.*, IPR2015-00442, Paper 9 at 12-13 (PTAB July 13, 2015).

Petitioner also has the burden to show there would have been some motivation to modify or combine the asserted prior art, and that the proposed modifications or combinations would render the patented claims obvious. *Johns Manville v. Knauf Insulation*, IPR2018-00827, Paper 9 at 13 (PTAB Oct. 16, 2018) (informative). “Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination.” *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011) (internal citation omitted); *see also In re Magnum Oil Tools Int'l.*, 829 F.3d at 1376. Nor is it enough to show that the references are in the same field of invention or are compatible. *Johns Manville v. Knauf Insulation*, IPR2018-00827, Paper 9 at 17-20 (PTAB Oct. 16, 2018) (informative). There must be some reason for a POSITA to have been motivated to modify the prior art. *Virtek Vision Int'l*

ULC v. Assembly Guidance Sys., Inc., 97 F.4th 882 (Fed. Cir. 2024) (“It does not suffice to simply be known. A reason for combining must exist.”)

Even if individual modifications or choices were obvious, a petition must explain why making all of the changes at once would be obvious. *Apple Inc. v. Contentguard*, Paper 9 at 16-17 (“[T]he mere fact that individual changes might have been obvious does not make doing all of the changes at once obvious.”); *Innogenetics*, 512 F.3d at 1373 (Fed. Cir. 2008) (“[K]nowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.”). The lack of a technological obstacle to combining references, in and of itself, does not justify a finding of obviousness. *See In re Omeprazole Patent Litig. v. Apotex Corp.*, 536 F.3d 1361, 1380-81 (Fed. Cir. 2008).

A reason for combining disparate prior art references or modifying prior art references is critical and should be made explicit. *InTouch Techs., Inc. v. VGo Communs., Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) (internal citation omitted). A conclusory statement relying on a duplicative expert testimony does not meet a

petitioner's burden. *Johns Manville v. Knauf Insulation*, IPR2018-00827, Paper 9 at 13-14 (PTAB Oct. 16, 2018) ("Petitioner merely makes the assertion that it would have been so, and cites to a largely duplicative paragraph of the Hirsekorn Declaration for support. An unsupported statement that combining the teachings of the two references would have been 'well within the skill of a POSA,' because the results of reacting a reducing sugar with an amine reactant 'were well-known and predictable' does not meet Petitioner's burden.") (informative); *see also id.* at 11; 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

Motivation and expectation of success are generally not present where the proposed modification or combination contradicts a reference's basic teachings or is inoperable. *In re Urbanski*, 809 F.3d 1237 (Fed. Cir. 2016) ("if references taken in combination would produce a seemingly inoperative device such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.") (internal quotations omitted); *Cook Grp. Inc. v. Bos. Sci. Scimed, Inc.*, 809 F. App'x 990, 1001 (Fed. Cir. 2020) ("the Board properly weighed the loss of key functions as a relevant factor in the motivation to combine analysis"); *Plas-Pak Indus. v. Sulzer Mixpac AG*, 600 F. App'x 755, 758 (Fed. Cir. 2015); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); *Univ. of Md.*

Biotechnology Inst. v. Presens Precision Sensing Gmbh, 711 F. App'x 1007, 1010 (Fed. Cir. 2017).

Hindsight analysis is inappropriate. Obviousness must be measured “*at the time the invention was made.*” *Ortho-McNeil Pharm. v. Mylan Labs*, 520 F.3d 1358, 1364 (Fed. Cir. 2008) (emphasis in original). A petition must demonstrate a rationale to modify or combine prior art references without relying on the patent disclosure itself. *Apple Inc. v. Contentguard*, Paper 9 at 15, 17; *see also P&G v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 995 (Fed. Cir. 2009); *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (“[T]he expert’s testimony on obviousness was essentially a conclusory statement that a person of ordinary skill in the art would have known, based on the ‘modular’ nature of the claimed components, how to combine any of a number of references to achieve the claimed inventions. This is not sufficient and is fraught with hindsight bias.”). In other words, the Petitioner must not use the patent as a roadmap. *In re NTP, Inc.*, 654 F.3d 1279, 1299 (Fed. Cir. 2011) (internal citation omitted); *see also KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

III. BACKGROUND

A. Priority Applications

The ’520 Patent is a continuation of U.S. Pat. Appl. No. 16/803,980 (now

U.S. Pat. No. 11,044,215), which is a continuation-in-part (“CIP”) of U.S. Patent Application Nos. 15/984,406 filed May 20, 2018, 15/724,223 filed Oct. 3, 2017, and 14/274,623 filed May 9, 2014, which in turn claims priority to U.S. Patent Application Nos. 13/624,906 and 13/626,635 (the “’906 application” and “’635 application” respectively, and collectively the “Original Applications”, attached hereto as EXS 2004, 2002). Both Original Applications are incorporated by reference. (’520 patent, EX1001, at 1:30-39; *see also* ’635 Application, EX2002, at [0003], [0034].)

B. Overview of the ’520 Patent

As it pertains to this proceeding, the ’520 patent generally relates to methods and systems to request a file to be shared via a network without attaching the specific files, folders etc. to a message (referred to as the “File Request embodiment”), which was disclosed in the Original Applications. At a high-level, the File Request embodiment discloses that through a combination of capabilities or operations involving a message with a file request, the requested file may be shared without an attachment included with another message that is responsive to the foregoing file request. (’906 application, EX2004, at Abstract.) Instead, the file(s) is stored on a server and, in embodiments, may be downloaded to the recipient’s local drive only in response to detection of an indication to open or

access the file(s) in the folders(s).

The '906 application describes a technique for a first user to cause to be sent “a first message including a data object identification request ... wherein the first message is addressed to the second user.” ('906 application, EX2004, at [0127]). In response to such first message, the '906 application discloses “a second message that includes a data object identification response that identifies a data object ..., wherein the second message is addressed to the first user and the data object is not received in the second message.” ('906 application, EX2004, at [0137] and Fig. 2A, reproduced below.)

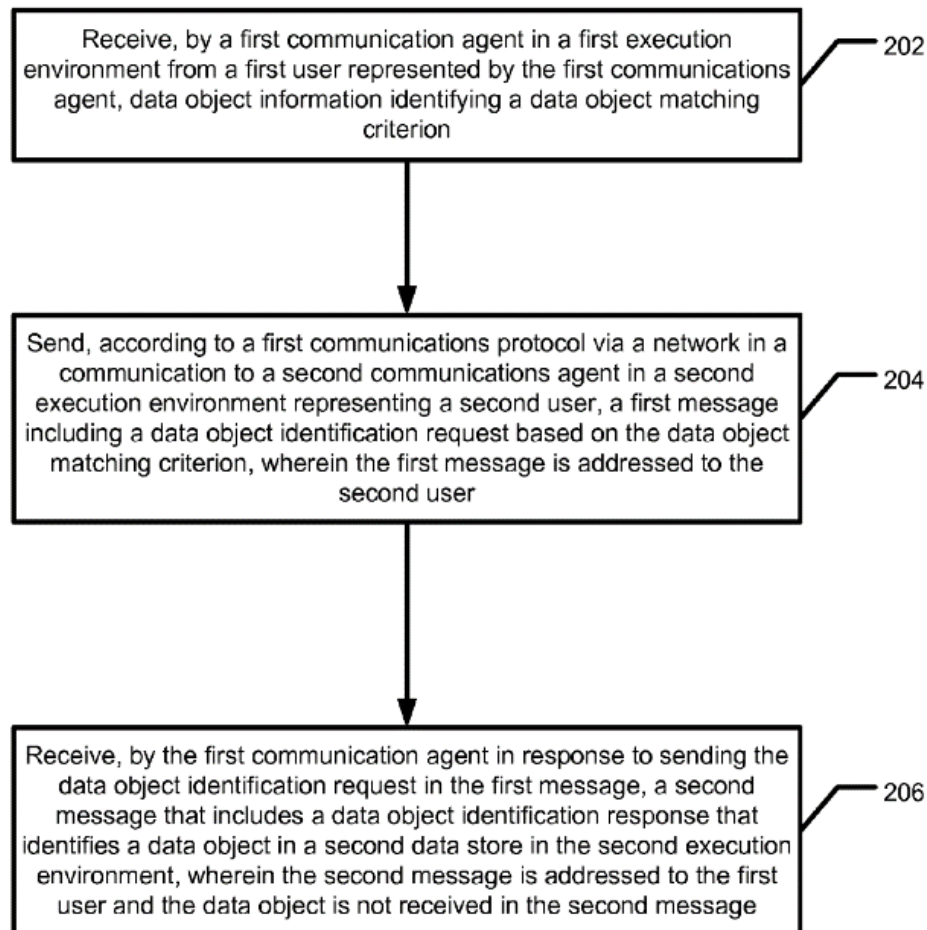


FIG. 2A

This apparatus comprises at least one non-transitory memory storing instructions and at least one processor that can execute these instructions. ('906 application, EX2004, at [0035], [0038], [0052], [0053], [0209], [0210].) When the apparatus executes these instructions, it causes, at a first node, the display of a first

interface for use in creating a file request requesting at least one file. ('906 application, EX2004, at [0100], [0111], [0115]-[0117].) An example of this first user interface is seen in FIG. 6A of the '906 application, copied below:

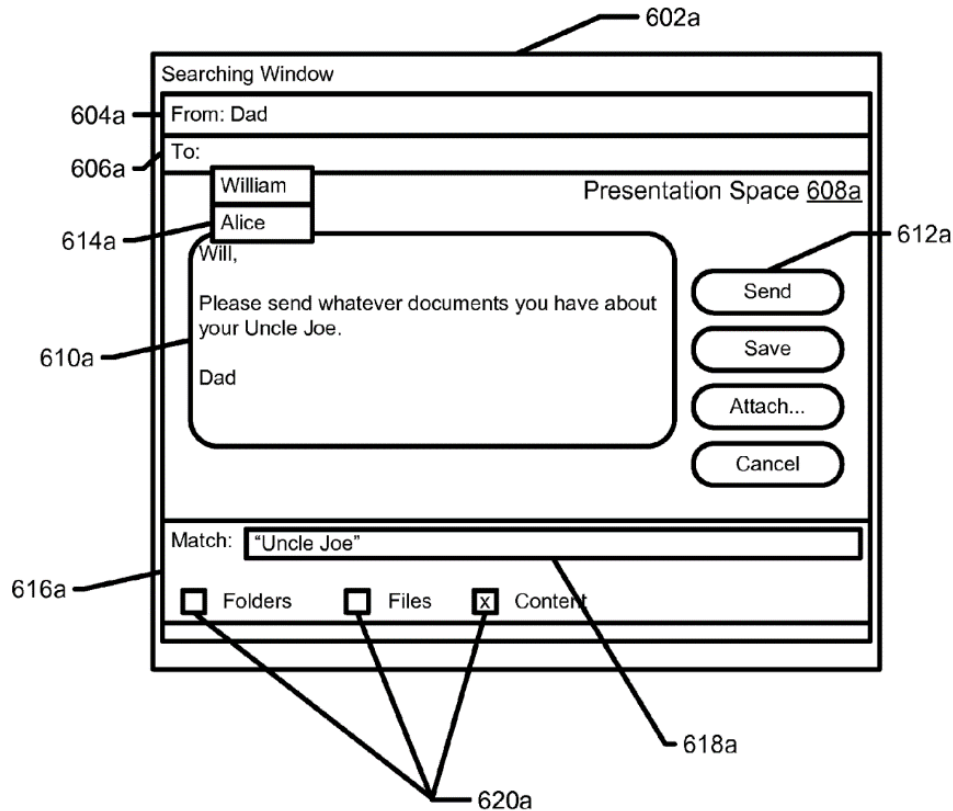


FIG. 6A

The first interface (*e.g.*, a Match window 616a in Fig. 6A above) includes a first user interface element (that includes a textbox) to receive a file description describing the at least one file in connection with the file request (*e.g.*, text box 618a above). ('906 application, EX2004, at [0125]-[0126].) The first interface

also includes a second user interface element to receive an indication of a date or a time, so that the file request may be based on the date or the time as, for example, “additional matching criteria.” (’906 application, EX2004, at [0092]-[0093], [0133], [0175], [0180].)

Also displayed is at least one second interface (*e.g.*, Presentation Space 608a in Fig. 6A above) with a third user interface element (*e.g.*, a contactee user interface element 606a) to receive indicia associated with at least one email address, so that the email address is used to send the file request. Still yet, the second interface is equipped with a fourth user interface element (*e.g.*, a Send button user interface element 612a), where a receipt of an indication of a selection of the fourth user interface element indicates that the file request is to be caused to be sent. (’906 application, EX2004, at [0111].)

In response to the receipt of the indication of the selection of the fourth user interface element and based on the file description, the indication of the at least one of the date or the time, and the indicia associated with the at least one email address; a first message addressed to the at least one email address and including the file request, is generated and sent. To inform the user of the second node, the first message indicates the date or the time on which the file request is based. (’906 application, EX2004, at [0092]-[0093], [0133], [0175], [0180].) An example

of this first message is seen in FIG. 6B of the '906 application, copied below:

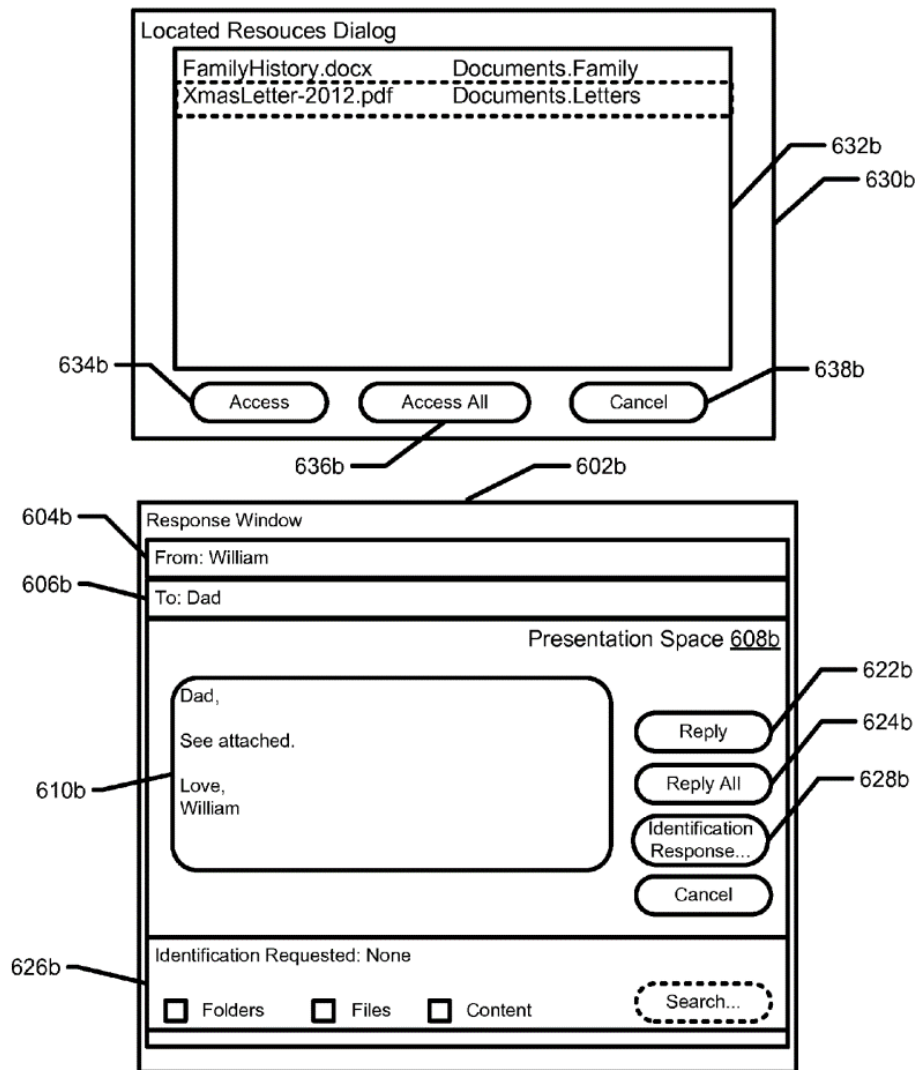


FIG. 6B

As disclosed, the first message includes a fifth user interface element and at least one sentence including the file description describing the at least one file in connection with the file request. ('906 application, EX2004, at [0100], [0111], [0146]-[0148].)

By this design, an indication of a selection of the fifth user interface element of the first message may be received, which indicates that the file(s) is to be uploaded in response to the file request. In response, a third interface is displayed for use in uploading the at least one file in response to the file request. ('906 application, EX2004, at Fig. 6B and description thereof). Such third interface (*e.g.*, Located Resources Dialog interface 630b in Fig. 6B) includes a sixth user interface element for receiving an indication of a selection the at least one file (*e.g.*, the displayed list of files within 632b) and a seventh user interface element for receiving an indication that the at least one file is to be caused to be uploaded (*e.g.*, an Access or Access All user interface element 634b or 636b). An indication of a selection of the seventh user interface element results in the generation and sending of a second message indicating that the file request has been responded to, where the second message includes an eighth user interface element, and does not include a file attachment with the second message. ('906 application, EX2004, at [0150].) An example of this second message is seen in FIGS. 6C and/or 6G of the '906 application, reproduced below:

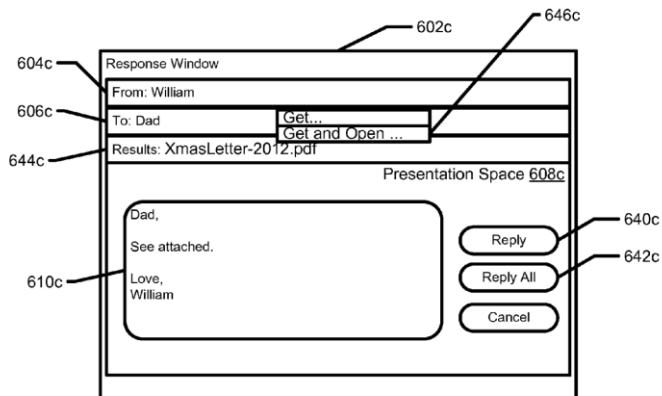


FIG. 6C

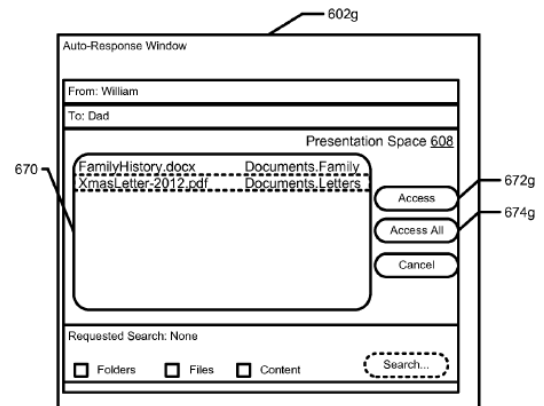


FIG. 6G

In response to a receipt of an indication of the selection of the eighth user interface element of the second message, a fourth interface is displayed with a reference to the at least one file for allowing access to the at least one file at the first node. ('906 application, EX2004, at [0150]-[0151], [0142], [179].)

The requestor is able to view the file(s) uploaded in response to the file request within the same type of client-based file explorer interface as the if a folder containing that file had been shared with them. Specifically, code stored at the first node and configured to cooperate with the client-based file explorer interface may create a representation of the newly uploaded file(s) and display it in a location among other folders on the first node. When the representation of the new

file is created, the first node does not store the files, which were not sent as attachments within the generated email message, within the folder. ('635 application, EX2002, at [0109]-[0119].)

Instead, the client-based file explorer interface shown in Fig. 6B of the '635 application, reproduced above (see '635 application, EX2002, at [107]), may cooperate with file systems or file system clients such as the XtreamFS client, in the same manner as if a folder had been shared with the requestor. ('635 application, EX2002, at [116], [118].) A representation of the uploaded file is displayed at the first node among other possible folders in the client-based file explorer interface. Exemplary third-party file explorer interfaces may include Samba, content management interoperability services (CMIS), Web Distributed Authoring and Versioning (WebDAV), Atom Publishing Protocol (AtomPub), file transfer protocol (FTP), RSS, SSH FTP, the Andrew File System (AFS), the Distributed File System (DFS), and the Network File System (NFS). ('635 application, EX2002, at [115], [118], [119].)

When the requestor indicates to the apparatus to open the file or edit it, for example, by double-clicking it, an indication to open a file within the represented folder may be detected which, at that point, causes retrieval of the file over the network to allow display of the file at the second node. ('635 application, EX2002,

at Fig. 6C and description thereof.)

The above features are broadly covered via the challenged claims of the '520 Patent.

C. Challenged Claims

Petitioner challenges claims 9-16 and 22-24 of the '520 patent. Claims 10-13 depend from claim 9. Claims 15 and 16 depend from claim 14. Claims 23 and 24 depend from claim 22.

Claim 9 recites:

9. An apparatus, comprising:

at least one non-transitory memory storing instructions; and

one or more processors in communication with the at least one non-transitory memory, wherein the one or more processors execute the instructions to:

cause, at a first node, display of a first interface with a first user interface element and a second user interface element, the first interface for use in creating a file request requesting at least one file;

receive, from the first node via at least one network, a file description via the first user interface element that includes a textbox, utilizing the first interface, the file description describing the at least one file in connection with the file request;

receive, from the first node via the at least one network, an indication of at least one of a date or a time via the second user interface element, utilizing the first interface;

cause, at the first node, display of a second interface with a third user interface element and a fourth user interface element, the second interface for use in causing the file request to be sent;

receive, from the first node via the at least one network, indicia associated with at least one email address via the third user interface element, utilizing the second interface, the at least one email address for being used to send the file request;

receive, from the first node via the at least one network, an indication of a selection of the fourth user interface element, utilizing the second interface, where the receipt of the indication of the selection of the fourth user interface element indicates that the file request is to be caused to be sent;

in response to the receipt of the indication of the selection of the fourth user interface element and based on the file description, the indication of the at least one of the date or the time, and the indicia associated with the at least one email address; generate a first message addressed to the at least one email address and including the file request, the first message indicating the at least one of the date or the time on which the file request is based, and further including a fifth user interface element and at least one sentence including the file description describing the at least one file in connection with the file request;

send, to a second node via the at least one network, the first message;

receive, from the second node via the at least one network, an indication of a selection of the fifth user interface element of the first message, where the receipt of the indication of the selection of the fifth user interface element indicates that the at least one file is to be uploaded in response to the file request;

in response to the receipt of the indication of the selection of the fifth user interface element, cause, at the second node, display of a third interface with a sixth user interface element and a seventh user interface element, the third interface for use in uploading the at least one file in response to the file request;

receive, from the second node via the at least one network, an indication of a selection of the seventh user interface element, utilizing the third interface;

in response to the receipt of the indication of the selection of the seventh user interface element, generate a second message that includes an eighth user interface element, and that does not include a file attachment with the

second message, the second message indicating that the file request has been responded to;

send, to the first node via the at least one network, the second message;

receive, from the first node via the at least one network, an indication of a selection of the eighth user interface element of the second message;

in response to the receipt of the indication of the selection of the eighth user interface element of the second message, cause, at the first node, display of at least one fourth interface with a reference to the at least one file for allowing access to the at least one file at the first node.

(EX1001 at 51:21-52:37.)

Claim 14 recites:

14. An apparatus, comprising:

at least one non-transitory memory storing instructions; and

one or more processors in communication with the at least one non-transitory memory, wherein the one or more processors execute the instructions to:

display, at a first node, of a first user interface element, a second user interface element, and a third user interface element, the first user interface element, the second user interface element, and the third user interface element for use in creating a file request requesting one or more desired files;

receive, from the first node via at least one network, text associated with one or more desired files via the first user interface element that includes a textbox, the text describing the one or more desired files in connection with the file request;

receive, from the first node via the at least one network, an object associated with at least one email address via the second user interface element, the at least one email address for being used to send the file request;

based on the text associated with the one or more desired files and the object associated with the at least one email address; generate a first message addressed to the at least one email address and including the file request, the first message including a fourth user interface element and the text associated with the one or more desired files describing the one or more desired files in connection with the file request;

send, to a second node via the at least one network, the first message;

receive, from the second node via the at least one network, a message associated with a selection of the fourth user interface element of the first message for indicating that at least one file is to be uploaded in response to the file request;

in response to the receipt of the message associated with the selection of the fourth user interface element, send a first communication over the at least one network that results in display, at the second node, of a fifth user interface element for use in uploading the at least one file in response to the file request;

receive, from the second node via the at least one network, a message associated with a selection at least one file for being used to upload the at least one file in response to the file request;

receive, from the second node via the at least one network, a message associated with a selection of the fifth user interface element;

in response to the receipt of the message associated with the selection of the fifth user interface element, generate a second message that includes a sixth user interface element, and that does not include a file attachment with the second message, the second message indicating that the file request has been responded to;

send, to the first node via the at least one network, the second message;

receive, from the first node via the at least one network, a message associated with a selection of the sixth user interface element of the second message;

in response to the receipt of the message associated with the selection of the

sixth user interface element of the second message, send a second communication over the at least one network that results in display, at the first node, of a reference to the at least one file; and

allow access, at the first node, to the at least one file via the reference.

(EX1001 at 53:31-54:36.)

Claim 22 recites:

22. A method, comprising:
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,

a second user interface element, for enabling collection of an indication of at least one of a date or a time,

a third user interface element, for collecting at least one object associated with at least one email address, the at least one object associated with at least one email address being the at least one email address or an alias associated with the at least one email address, and

a fourth user interface element, for detecting an indication of a selection thereof to cause an initiation of a request for the at least one file;

causing generation of a first email, based on the file request description for the at least one file, the at least one object associated with the at least one email address, and the detection of the indication of the selection of the fourth user interface element to cause the initiation of the request for the at least one file, where the first email includes:

at least one sentence including the file request description for the at least one file, and

a fifth user interface element for detecting an indication of a selection thereof;

based on the detection of the indication of the selection of the fifth user interface element of the first email, causing, at the second node, display of:

a sixth user interface element, for collecting an indication of at least one file, and

a seventh user interface element, for detecting an indication of a selection thereof;

receiving, from the second node and at at least one server, a signal for causing creation of a first representation of the at least one file, in a location among one or more folders, that is stored at the at least one server and that is displayable via at least one web page;

causing generation of a second email, based on the detection of the indication of the selection of the seventh user interface element, where the second email:

includes an eighth user interface element for detecting an indication of a selection thereof,

does not include a file attachment, for permitting avoidance of the at least one file from being communicated to and stored at the first node via the second email,

is at least partially pre-written, and

is automatically caused to be received without requiring further user involvement after the detection of the indication of the selection of the seventh user interface element;

causing, at the first node, receipt of the at least one web page, that results in display, at the first node and via the at least one web page, of a file structure that permits access to the first representation of the at least one file that is stored at the at least one server;

causing, at the first node, receipt of code for storage at the first node and

cooperation with a file explorer interface of a client-based file explorer application, for being utilized to:

based on the detection of the indication of the selection of the seventh user interface element, cause creation of a second representation of the at least one file, in a location among one or more folders, that is stored at the first node and that is displayable via the file explorer interface of the client-based file explorer application.

(EX1001 at 56:9-57:11.)

D. Benefits of File Request Embodiment Over the Prior Art

The '520 patent discloses inventions to simply and efficiently process file requests. ('906 application, EX2004, at [0003].) It addresses the above problems by, among other things, allowing a requester to specify deadline criteria and provide a description of the requested file that is communicated to the recipient of the file request along with a link for uploading the requested file. A message is sent to the requestor upon uploading in which the message allows access to the requested file. In some embodiments, a web page is provided to the file requestor with a representation of the requested file and providing code to the requestor's computer that is configured to be stored on the requestor's computer and to cooperate with the file explorer interface of the requestor's client-based file explorer application to cause a representation of the requested file to be created among folders stored on the requestor's computer and displayed via his local file explorer application (e.g., Windows Explorer). The file is not downloaded when

the representation is caused to be created. The contents of the file only downloaded (and stored on the requestor's local drive) in response to a detection of an indication to open them.

Prior art systems did not effectively communicate file request deadlines or file descriptions. To overcome this, the '520 patent requires a "first message" that, in addition to including a file description describing the file in connection with the file request, such "first message indicat[es] the at least one of the date or the time on which the file request is based." By this design, the initial indication (to the request-“ee”) of an existence of the file request (of the request-“or”) takes the form of the “first message” and, importantly, such “first message” itself indicates “the date or the time on which the file request is based.” This gives the recipient of the file request (the request-“ee”) optimal notice of not only the request for the file itself, but also a timeframe for such file request.

E. Person of Ordinary Skill in the Art

For purposes of this preliminary response only, PO does not dispute Petitioner's definition of a POSITA. PO reserves the right to advance a different definition in this or any other proceeding and this is not an admission, concession or waiver in any respect.

IV. CITED REFERENCES

The Petition cites the following references:

- U.S. Patent App. Pub. No. 2013/0046833 to Riepling et al.
 (“Riepling”) (EX1107), published on February 21, 2013;
- U.S. Patent App. Pub. No. 2010/0005138 to Manzano et al.
 (“Manzano”) (EX1105), published January 7, 2010;
- U.S. Patent App. Pub. No. 2012/0278404 to Meisels et al. (“Meisels”) (EX1108), published November 1, 2012; and
- U.S. Patent No. 9,633,125 to Garcia et al. (“Garcia”) (EX1104),
 issued April 25, 2017.

V. THE PETITION GROUNDS SHOULD BE REJECTED ON THE MERITS

Petitioner has not demonstrated that a POSITA would have found the challenged claims obvious over Riepling, alone or in combination with Manzano, Meisels, and/or Garcia.

A. Ground 1: Petitioner Has Failed to Show that Claims 9, 10, 14, and 15 Are Obvious over Riepling under 35 U.S.C. § 103

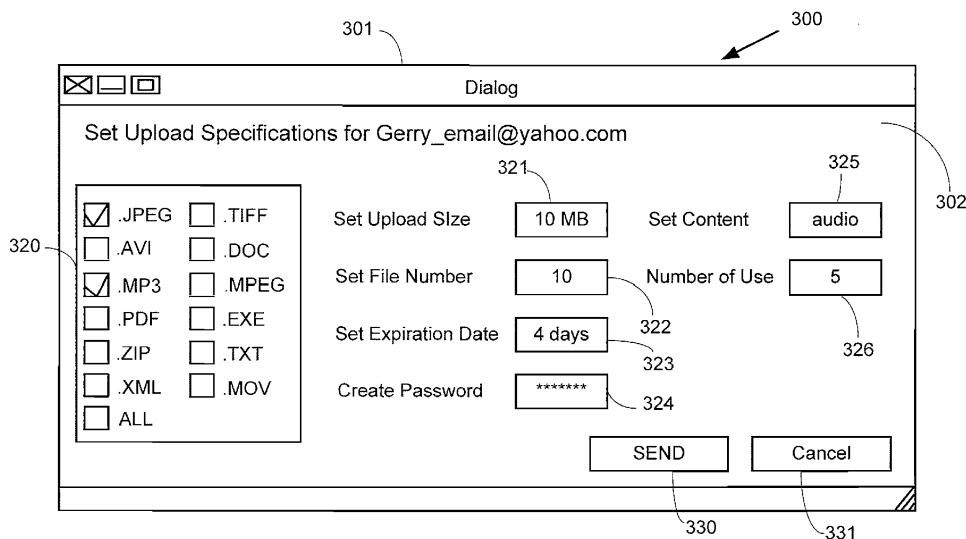
With regard to claims 9, 10, 14, and 15, Petitioner has failed to show a reasonable likelihood that Riepling makes obvious each and every element of the challenged claims.

1. Claim 9

- a. **Riepling Does Not Disclose the Elements “receive, from the first node via at least one network, a file description via the first user interface element that includes a textbox, utilizing the first interface, the file description describing the at least one file in connection with the file request” and “generate a first message addressed to the at least one email address and including the file request, the first message indicating the at least one of the date or the time on which the file request is based, and further including a fifth user interface element and at least one sentence including the file description describing the at least one file in connection with the file request”**

Petitioner labels the first element “9[b]” (Pet. at 84), and addresses it in conjunction with the previous element, 9[a]. Petitioner alleges that “content field 325” satisfies the “first user interface element” (Pet. at 38) and “a file description via the first user interface element that includes a textbox, . . . the file description describing the at least one file in connection with the file request” (Pet. at 38-39).

Fig. 3



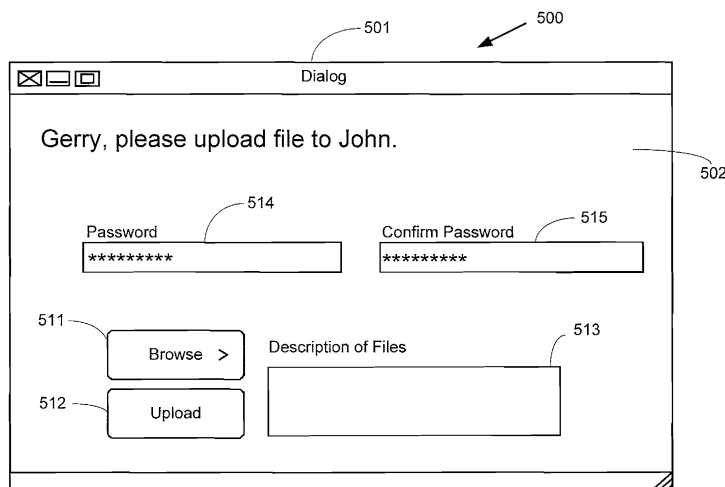
Riepling, FIG. 3

However, nowhere in Riepling is FIG. 3's label "325" addressed. The only information in the specification with respect to label "325" is that of the text next to it in FIG. 3, "Set Content." (Riepling at FIG. 3.) This phrase does not appear in the specification either. Further, the word "audio," which is inside the box that label 325 is pointing to, appears only twice in the specification, both times with respect to describing the MP3 audio format. (Riepling at ¶¶ 30, 32.) Neither the box labeled "325" nor its contents are mentioned in the specification outside of being shown in FIG. 3. Paragraph 32 of Riepling discusses the upload parameter

interface of FIG. 3 and notes that it may be used to ensure “files uploaded into their registered user accounts contain only a single type of data.” (Riepling at ¶32.)

Additionally, Riepling explicitly discloses that file descriptions be included in the **response** to the file request **instead of** the file request itself. This is shown by FIG. 5 of Riepling, textbox 513, labeled “Description of Files”:

Fig. 5



Riepling, FIG. 5

(Riepling at FIG. 5, ¶¶ 41, 43.) In particular, Riepling states, “[f]ile description text field 513 may receive a textual description of the one or more data files chosen for uploading.” (Riepling at ¶ 43.) This puts the onus on the **uploader** to add the claimed “file description” at the claimed “second node” instead of the **requestor** at

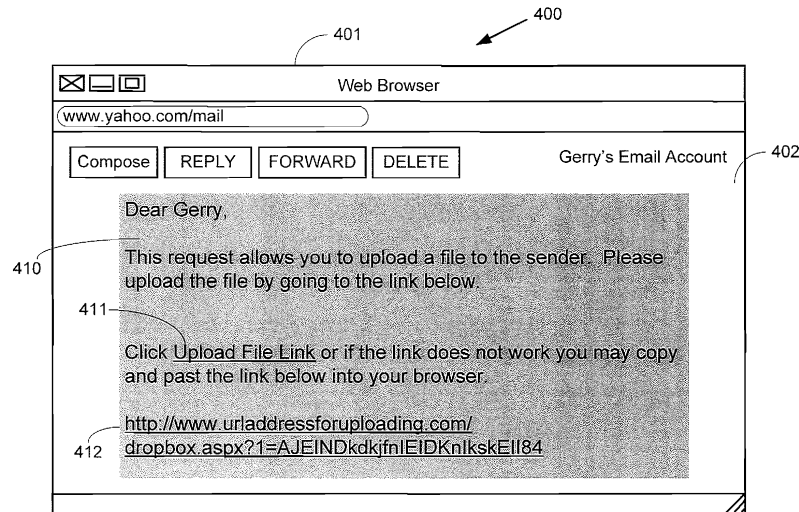
the claimed “first node.” This runs contrary to the teachings of the ’520 patent. In particular, the “Background” of the ’520 patent states the following:

To request an attachment, ***a user typically sends the request as voice and/or text data in a voice and/or text message heard and/or read by another user.*** The request may be as vague or as specific as the language used by the requesting user. The other user must interpret the request and find a file or other data object that seems to match the request. The other user in many cases locates a “matching” resource ***using a program or application other than the communications agent that received the request.***

(’520 patent, EX1001, at 2:1-10) (emphasis added). To account for this, the ***file request interface*** receives a “file description describing the at least one file in connection with the file request,” as recited in the claim language. Riepling does not address this problem and is otherwise silent as to its “Set Content 325” field. Therefore, Riepling does not teach or suggest this claim element, and it would not be obvious (nor does Petitioner claim it is obvious).

Moreover, Petitioner admits that Riepling does not disclose the second element, 9[g], (Pet. at 30), much less connect it to the former element as required by the claim. The email message of Riepling, shown by FIG. 4, includes only the recipient’s name and selectable links. No information allegedly collected by the interface shown in FIG. 3 is included in the message:

Fig. 4

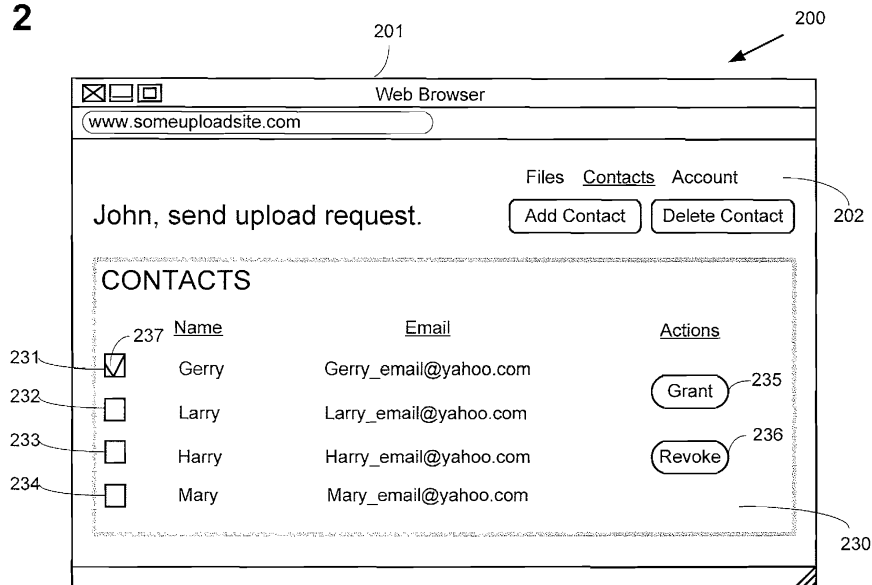


Riepling, FIG. 4

No “date or time on which the file request is based” or “file description describing the at least one file in connection with the file request” is indicated in the message, as required by the claim language.

In fact, Riepling’s message may be generated after the user selects which recipients will receive the file request via the interface shown in Riepling’s FIG. 2, without regard to any information collected by Riepling’s FIG. 3 interface: “Once grant access button 235 has been used, content sharing service 105, using processor 102, may begin creating a digital invitation for transmission to the contact”:

Fig. 2



Riepling, FIG. 2

(Riepling at ¶ 26.) As shown in FIG. 2, only contact information is selectable. No “date or time” or “file description” is possible to add or select. Thus, any “digital invitation” that is created after “grant access button 235 has been used” would not include such attributes, as confirmed by Riepling’s FIG. 4, shown above.

Petitioner admits that Riepling’s “digital invitation 410,” shown in FIG. 4, does not indicate the claimed “date or time” or “file description”, but alleges that it would be “an obvious design choice.” (Pet. at 30.) Petitioner fails to describe *any* motivation to modify Riepling in such a way or why such a design choice would be obvious. Precedent requires that there be some reason. Petitioner provides none.

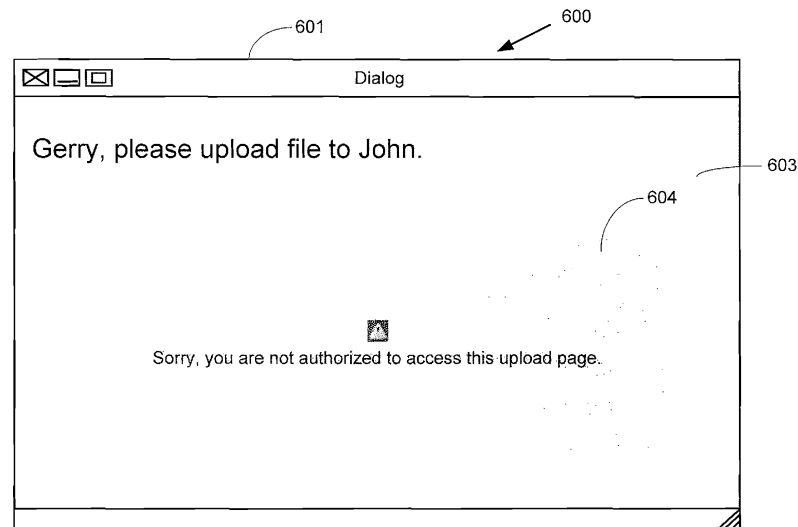
Therefore, Petitioner has failed to meet its burden of obviousness. *See, e.g., Johns Manville*, IPR2018-00827, Paper 9 at 13; *Virtek*, 97 F.4th 882; *Apple Inc. v. Contentguard*, Paper 9 at 15-17; *ActiveVideo Networks*, 694 F.3d at 1327.

Regardless, to support its claim of obviousness, Petitioner cites to a single line from the specification indicating that the digital invitation, shown by FIG. 4, may be “restricted by the one or more upload parameters specified in upload parameter dialog 301 [shown by FIG. 3].” (Pet. at 30, citing Riepling at ¶ 34.) However, whether upload parameters are **restricted** has no bearing on what is **indicated** in the invitation. Riepling accounts for restrictions using an **entirely separate** interface:

[A]s previously explained, some upload parameters may also place restrictions on the digital invitation. Blocked interface 603 may occur when a user such as, for example, sender 117 of FIG. 1 may attempt to access content sharing service 105 through a unique location identifier of a revoked digital invitation.

(Riepling at ¶ 47.) Interface 603 is shown by FIG. 6:

Fig. 6



Riepling, FIG. 6

So, Riepling accounts for parameter restrictions using an interface unrelated to the digital invitation. There is no teaching or indication in Riepling that the “date or time on which the file request is based” or “file description describing the at least one file in connection with the file request” could or would be included in the digital invitation, as required by the claim language. Petitioner is using the ’520 patent as a roadmap to account for this argument, which is improper hindsight. (’520 patent, EX1001, at 2:1-10). Notably, Petitioner filed patent applications on file request functionality years later, which refute its present litigation-based arguments made years later. (*See, e.g.*, U.S. Patent No. 10,713,966, EX2003.)

b. Riepling Does Not Disclose the Element “generate a second message that includes an eighth user interface element, and that does not include a file attachment with the second message, the second message indicating that the file request has been responded to”

Petitioner labels this language as part of element “9[1]” (Pet. at 85) and admits that Riepling does not disclose this element (Pet. at 35-36). Petitioner cites to Riepling’s description that, “one or more user accounts may receive . . . [a] notification message alerting the other accounts of the data upload. . . . The notification messages may permit the downloading of the uploaded data through the one or more user accounts.” (Pet. at 35-36, citing Riepling at ¶ 45.) But nothing in these statements, or anywhere else in Riepling, teaches or suggests that any such “notification message” includes “an eighth user interface element” **and** “does not include a file attachment,” as required by the claim language.

Petitioner dismisses this as obvious because “Riepling expressly describes including ‘unique location identifier 411,’ which may be a clickable link, in its digital invitation 410,” and so “[a]ccordingly, it would have been obvious to a POSITA to implement Riepling’s notification message the same way[.]” (Pet. at 36.) However, when Riepling’s initial digital invitation is created and sent, no files have been uploaded. So no files exist that could be accessed or included as attachments. Moreover, the initial digital invitation is being sent to a person that

does not have a registered user account. (Riepling at ¶¶ 21, 29, 30, 56.) The alert message is provided to a **“user account”** in contrast. (Riepling at ¶ 45.) The opposite is true **after** files have been uploaded, and the specification is silent regarding the contents of any “notification message.”

The specification is explicit that a user must access uploaded files through a specific interface: “Once a data upload has been successfully performed, the owner of the registered user account may view the uploaded data by accessing data availability interface 702[.]” (Riepling at ¶ 49.) There is no indication that this interface may be accessed via a “notification message.”

At best, the specification indicates that receipt of a notification “may **permit** the downloading of the uploaded data **through the one or more user accounts.**” (Riepling at ¶ 45.) Such permission is given by “the owner of the registered user account” that created the file request, as this owner “may specify which other user accounts are to receive the notifications.” (Riepling at ¶ 45.) That a notification **indicates permission** to access an uploaded file does not mean that the notification message **includes any elements**, let alone the “eighth user interface element” required by the claim language. In particular, the language of claim 9 requires that the “eight user interface element” may be selected such that “in response to the receipt of the indication of the selection of the eighth user interface element of the

second message,” the claimed apparatus “cause[s], at the first node, display of at least one fourth interface with a reference to the at least one file for allowing access to the at least one file at the first node.” (See claim element 9[o], Pet. at 86-87.) No such teaching is found in Riepling.

Though Petitioner alleges that “it would have been obvious to a POSITA to implement Riepling’s notification message the same way that Riepling expressly taught for the digital invitation 410” (Pet. at 36; EX1102 at ¶ 109), Petitioner fails to describe *any* motivation to modify Riepling in such a way or why such a design choice would be obvious. Precedent requires that there be some reason. Petitioner provides none. Therefore, Petitioner has failed to meet its burden of obviousness. See, e.g., *Johns Manville*, IPR2018-00827, Paper 9 at 13; *Virtek*, 97 F.4th 882; *Apple Inc. v. Contentguard*, Paper 9 at 15-17; *ActiveVideo Networks*, 694 F.3d at 1327.

Therefore, Riepling does not teach or suggest this claim element, and it would not be obvious.

2. Claim 10

Claim 10 depends on claim 9. For at least the reasons set forth above with respect to claim 9, Petitioner has not put forward sufficient evidence that Riepling renders claim 10 obvious.

3. Claim 14

- a. Riepling Does Not Disclose the Element “receive, from the first node via at least one network, text associated with one or more desired files via the first user interface element that includes a textbox, the text describing the one or more desired files in connection with the file request”**

Petitioner labels this element “14[b]” (Pet. at 89-90). Riepling does not teach or suggest this claim element for at least the same reasons that Riepling does not teach or suggest the “file description” aspects described above for element 9[b] in Section V.A.1.a.

- b. Riepling Does Not Disclose the Element “generate a first message addressed to the at least one email address and including the file request, the first message including a fourth user interface element and the text associated with the one or more desired files describing the one or more desired files in connection with the file request”**

Petitioner labels this language as part of element “14[d]” (Pet. at 90). Riepling does not teach or suggest this claim element for at least the same reasons that Riepling does not teach or suggest the aspects described above for element 9[g] in Section V.A.1.a.

- c. Riepling Does Not Disclose the Element “generate a second message that includes a sixth user interface element, and that does not include a file attachment with the second message, the second message indicating that the file request has been responded to”**

Petitioner labels this language as part of element “14[j]” (Pet. at 91).

Riepling does not teach or suggest this claim element for at least the same reasons that Riepling does not teach or suggest the aspects described above for element 9[l] in Section V.A.1.b.

4. Claim 15

Claim 15 depends on claim 14. For at least the reasons set forth above with respect to claim 14, Petitioner has not put forward sufficient evidence that Riepling renders claim 15 obvious.

Petitioner has therefore failed to demonstrate a reasonable likelihood that claims 9, 10, 14, and 15 are rendered obvious over Riepling. Therefore, Ground 1 of the Petition fails.

B. Ground 2: Petitioner Has Failed to Show that Claims 11-13, 16, and 22-24 Are Obvious over Riepling and Manzano under 35 U.S.C. § 103

With regard to claims 11-13 and 16, and 22-24, Petitioner has failed to show a reasonable likelihood that the combination of Riepling and Manzano makes obvious each and every element of the challenged claims.

1. Claims 11-13 and 16

Petitioner purports to rely on Manzano only for elements of dependent claims 11-13 and 16, which rely on either independent claim 9 (claims 11-13) or independent claim 14 (claim 16). (Pet. at 49.) Petitioner does not rely on Manzano for independent claims 9 or 14, which, as set forth above, are not obvious

over Riepling. Therefore, for the reasons set forth above with respect to Ground 1, Petitioner has not demonstrated a reasonable likelihood that claims 11-13 and 16 are rendered obvious over Riepling in further view of Manzano.

2. Claims 22-24

Petitioner purports to rely on Manzano only for elements 22[h], 22[j], and 22[k]. (Pet. at 59-64.) Otherwise, Petitioner relies on Riepling and Petitioner's arguments regarding independent claim 9. (Pet. at 59-64.) For example, with respect to claim element 22[a], Petitioner relies on its arguments for claim elements 9[a] and 9[b]. (Pet. at 59.) With respect to claim element 22[e], Petitioner relies on its arguments for claim elements 9[g] and 9[h]. (Pet. at 60.) With respect to claim element 22[i], Petitioner relies on its arguments for claim elements 9[l], 9[n], and other elements that also depend on the arguments for claim elements 9[l] and 9[n]. (Pet. at 63.) But for at least the reasons described above with respect to Ground 1, Riepling does not teach or suggest all of these elements of claim 9.

For example, Riepling does not teach or suggest the "file description" aspects for element 9[b] described above in Section V.A.1.a, the aspects for element 9[g] described above in Section V.A.1.a, and/or the aspects for element 9[l] described above in Section V.A.1.b.

Therefore, Riepling does not teach or suggest at least the above claim elements of independent claim 22, and Ground 2 of the Petition fails.

C. Grounds 3 and 4: Petitioner Has Failed to Show that Claims 11-13, 16, and 22-24 Are Obvious over Riepling and Meisels and that Claims 11-13, 16, 22-24 Are Obvious over Riepling, Manzano, and Meisels under 35 U.S.C. § 103

Petitioner purports to rely on Meisels only for elements 9[l], 14[j], and 22[i]. (Pet. at 65-66.) Otherwise, Petitioner relies on Petitioner's arguments in Grounds 1 and 2 regarding all other required claim elements of independent claims 9, 14, and 22. (Pet. at 59-64.) As described above with respect to Grounds 1 and 2, Petitioner's arguments fall short because Riepling, alone or in combination with Manzano, does not teach or suggest every element of independent claims 9, 14, and 22, or their dependent claims 11-13, 16, 23, and 24.

Therefore, Grounds 3 and 4 of the Petition fail.

D. Grounds 5 and 6: Petitioner Has Failed to Show that Claims 11-13, 16, and 22-24 Are Obvious over Riepling, Manzano, and Garcia or Riepling, Manzano, Meisels, and Garcia under 35 U.S.C. § 103

Petitioner purports to rely on Garcia only for claim elements of dependent claims 11 and 16, and claim elements 22[h], 22[j], and 22[k]. (Pet. at 71-72.) Otherwise, Petitioner relies on Petitioner's arguments in Grounds 2-4 regarding all other required claim elements. (Pet. at 71.) As described above with respect to

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Grounds 2-4, Petitioner's arguments fall short because Riepling, alone or in combination with Manzano, does not teach or suggest every element of independent claims 9, 14, and 22, or their dependent claims 11-13, 16, 23, and 24.

Therefore, Grounds 4 and 5 of the Petition fail.

VI. CONCLUSION

For the foregoing reasons, the Petition should be denied.

Dated: April 30, 2024

DEVLIN LAW FIRM LLC

/ Derek Dahlgren /
Derek Dahlgren (*pro hac vice*)
1526 Gilpin Avenue
Wilmington, DE 19806
(302)-449-9010
ddahlgren@devlinlawfirm.com

Attorneys for Patent Owner

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that there are 7,806 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,

/ Derek Dahlgren /
Derek Dahlgren (*pro hac vice*)

Attorney for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on April 30, 2024, I caused a true and correct copy of the foregoing materials to be served via the Patent Office electronic filing system, and electronic service via email to the following attorneys of record pursuant to Petitioner's consent.

LEAD COUNSEL	BACKUP COUNSEL
Scott Bertulli (Reg. No. 75,886) Wilmer Cutler Pickering Hale & Dorr LLP 60 State Street Boston, MA 02109 Telephone: (617) 526-6223 scott.bertulli@wilmerhale.com	Gregory Lantier (<i>pro hac vice</i> to be filed) Wilmer Cutler Pickering Hale & Dorr LLP 60 State Street Boston, MA 02109 Telephone: (617) 526-6223 gregory.lantier@wilmerhale.com Trishan Efram (Reg. No. 74,075) Wilmer Cutler Pickering Hale & Dorr LLP 60 State Street Boston, MA 02109 Telephone: (617) 526-6223 trishan.esram@wilmerhale.com

/ Derek Dahlgren /
Derek Dahlgren (*pro hac vice*)