

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,
Petitioner,

v.

MOTION OFFENSE, LLC,
Patent Owner.

IPR2024-00287
Patent 11,611,520 B1

Before THOMAS L. GIANNETTI, NORMAN H. BEAMER,
and SCOTT RAEVSKY, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

On January 22, 2024, Dropbox, Inc. (“Petitioner”) filed a Petition (“Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 9–16 and 22–24 of U.S. Patent No. 11,611,520 B1 (“the ’520 patent”). Paper 4. On April 30, 2024, Motion Offense, LLC (“Patent Owner”) responded by filing a Preliminary Response (“Prelim. Resp.”), pursuant to 35 U.S.C. § 313. Paper 10.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and any Preliminary Response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons explained below, we determine that Petitioner has established a reasonable likelihood that it would prevail with respect to at least one challenged claim. Accordingly, we institute an *inter partes* review as to the challenged claims and grounds raised in the Petition.

II. BACKGROUND

A. The ’520 Patent

The ’520 patent is titled “Methods, Systems, And Computer Program Products For Processing A Data Object Identification Request In A Communication.” Ex. 1101, code (54). The ’520 patent is a continuation-in-part of, *inter alia*, U.S. Patent Application Nos. 13/624,906 and 13/626,635 (“the ’906 application” (Ex. 2004) and “the ’635 application” (Ex. 2002), respectively). *Id.* at code (63). Both applications are

incorporated by reference into the '520 patent in their entirety. *Id.* at 1:53–62. The subject matter of the challenged claims appears to most closely track a so-called “File Request” embodiment primarily disclosed in the '906 application.¹ *See* Pet. 1; Prelim. Resp. 6.

In particular, a pertinent example process is illustrated starting with Figure 6A, reproduced below.

¹ We make no findings here as to the sufficiency of written description support for the challenged claims, including whether support for the claimed subject matter is properly based on the prior applications incorporated by reference.

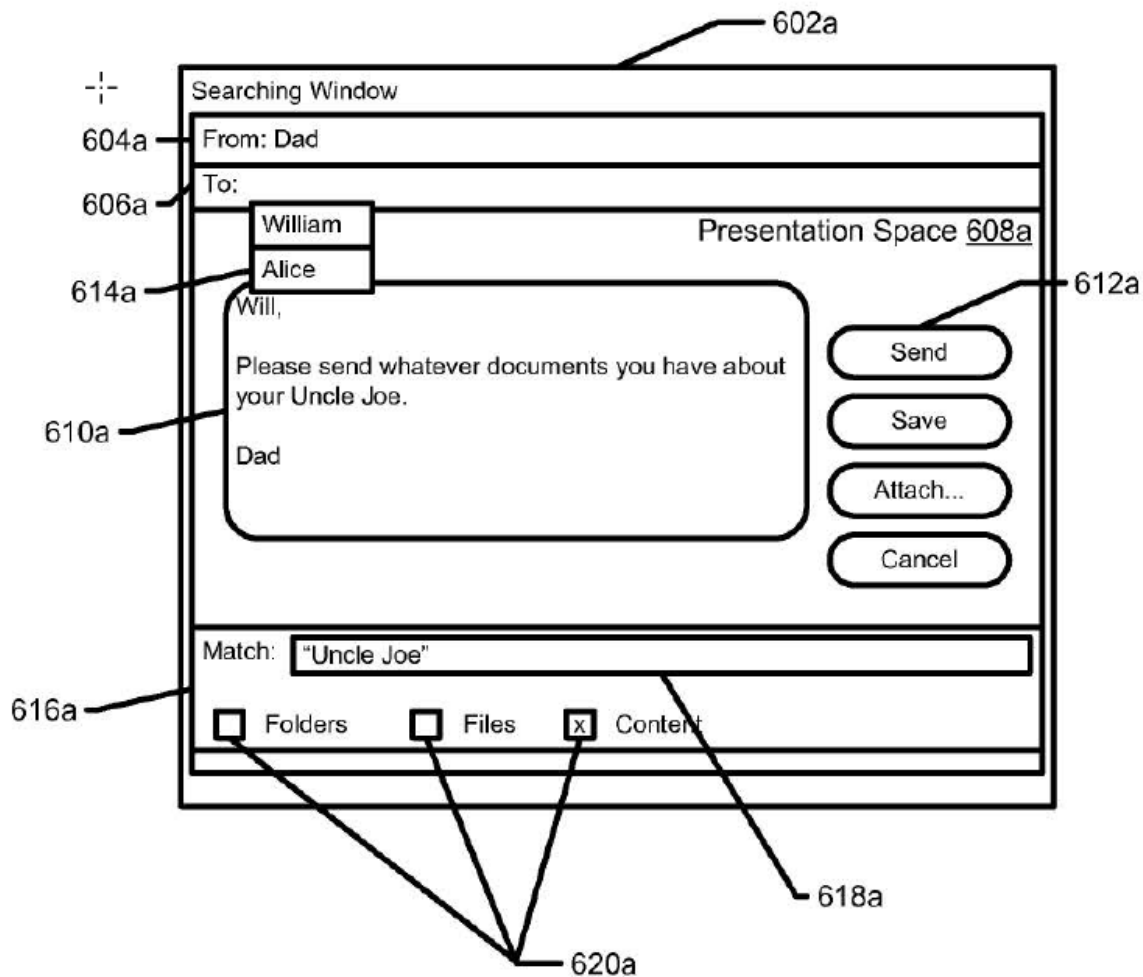


FIG. 6A

Figure 6A is a user interface including communications agent window 602a. Ex. 2004 ¶¶ 20, 111.

Communications agent window 602d includes contactor UI element 604a (“Dad”), contactee UI element 606a (“William”), user message UI element 610a and send UI element 612a in presentation space 608a, and data object information UI element 616a that includes match textbox UI element 618a. Ex. 2004 ¶¶ 111, 125, 126. Textbox 618a allows a user to enter a keyword expression for a data object identification request (in this example, “Uncle Joe”). *Id.* ¶ 126. A request can also include, *inter alia*, date and/or time

criteria. *Id.* ¶ 180. Selecting send UI element 612a causes a message including the data object identification request to be sent to the contactee. *Id.* ¶ 111.

Figure 6D is reproduced below.

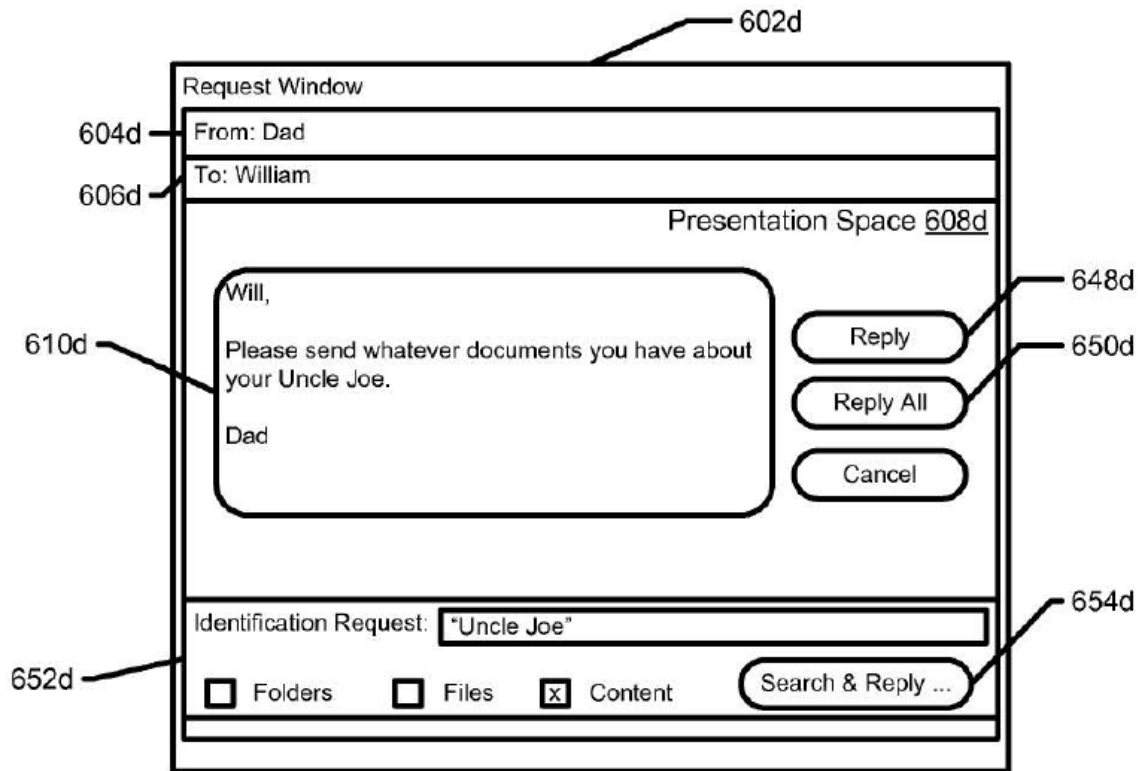


FIG. 6D

Figure 6D is request window UI element 602d, presenting a message received from contactor Dad to contactee William. Ex. 2004 ¶ 166.

Presentation space 608d of request window 602d includes user message UI element 610d, which includes a text portion of the message provided by contactor 604a, and reply UI element 648d. Ex. 2004 ¶ 166. Data object identification request UI interface element 652d includes the data object identification request (“Uncle Joe”) submitted by contactor Dad. *Id.*

Contactee *William* authorizes the request by selecting search and reply UI element 654d. *Id.*

Figure 6E is reproduced below.

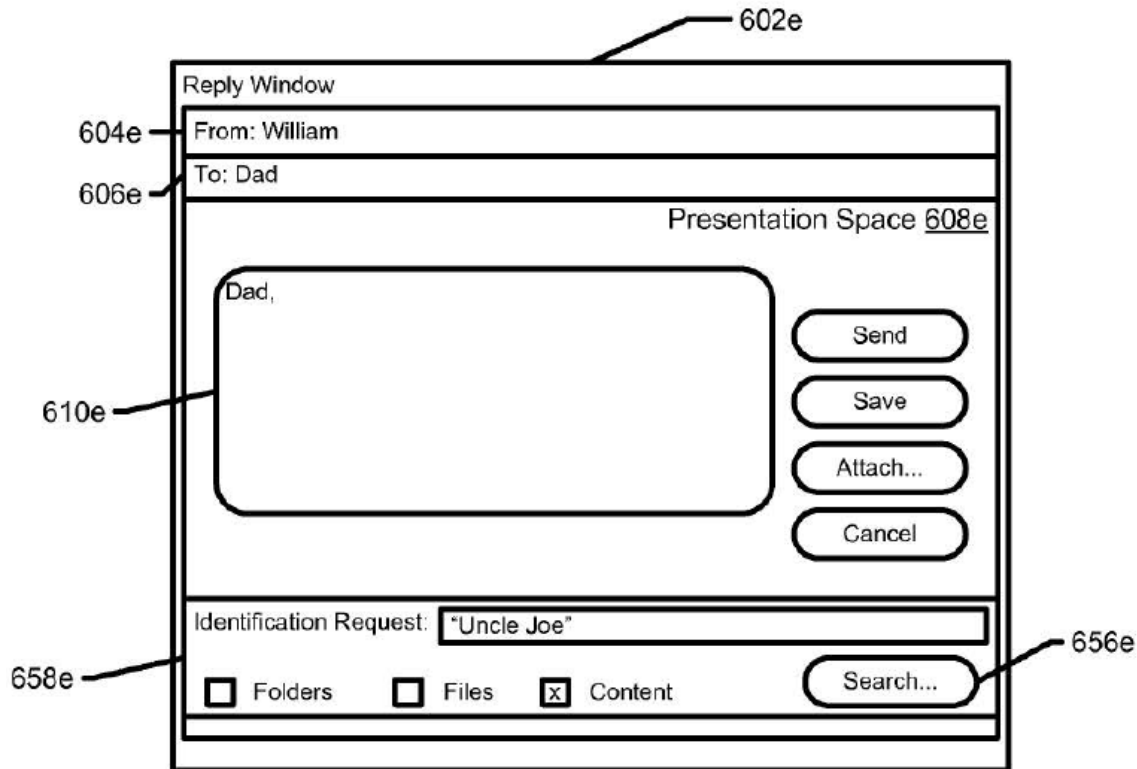


FIG. 6E

Figure 6E is reply window UI element 602e, presented when contactee William selects reply UI element 648d of Figure 6D. Ex. 2004 ¶ 167.

Search UI element 656e of reply window UI element 602e is selected to locate data objects that match the data object identification request provided in data object identification (“Uncle Joe”) requested UI element 658e.

Ex. 2004 ¶ 167. Matching data objects may be located and included in a data object identification response. *Id.* at Fig. 6F, ¶ 172. Selection of the Send UI element triggers a response back to original contactor (Dad) in the

form of a second message, depicted in MIME email format in Figure 8B reproduced below.

800b

```
MIME-Version: 1.0
Content-Type: multipart/mixed; boundary="--toOo---OoOt-----"

--toOo---OoOt-----
Content-Type: text/plain
Dad,

See attached.

Love,
William
--toOo---OoOt-----
Content-Type: application/query-response

FILE://Documents/Family/FamilyHistory.docx
FILE://Documents/Letters/XmasLetter-2012.pdf
--toOo---OoOt-----
```

The diagram illustrates the structure of the email content portion 800b. A bracket labeled 802b groups the text from 'Dad,' to 'William'. A line labeled 806b points to the 'Content-Type: application/query-response' header. A bracket labeled 804b groups the two file URIs listed below.

FIG. 8B

Figure 8B includes an exemplary content portion 800b of an email message, including user readable message portion 802b and data object identification response portion 804b, which is as a list of URIs identifying data objects in a file system of the contactee's environment. Ex. 2004 ¶¶ 137, 179.

Figure 6B is reproduced below.

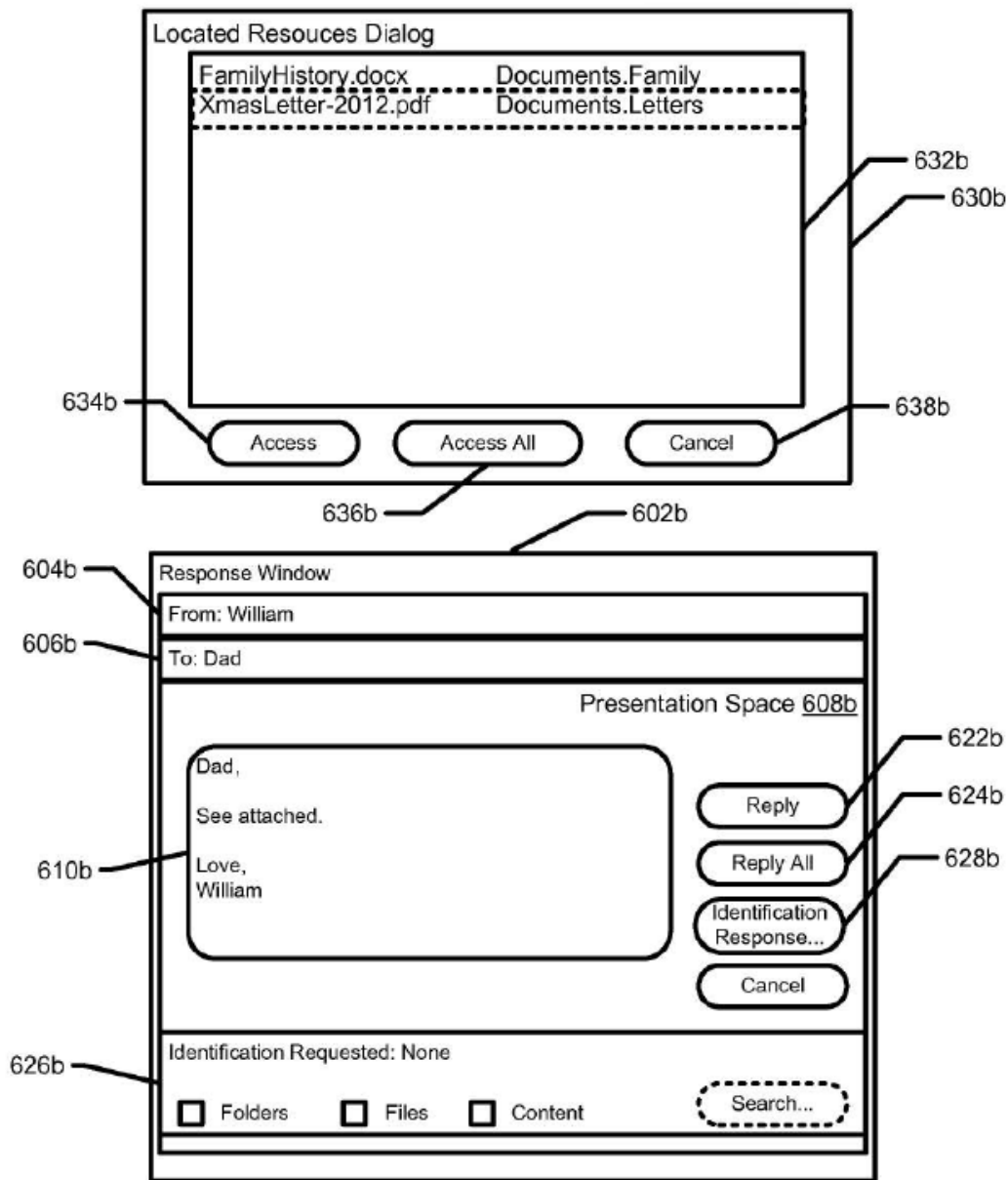


FIG. 6B

Figure 6B includes a response window UI element 602b, and a located resources dialog UI element 630b. Ex. 2004 ¶¶ 146–147.

Response window UI element 602b is presented to the original contactor, who in this window is contactee 606b (“Dad”), upon receipt of the second

email from the original contactee (“William”), who is contactor 604b here. Ex. 2004 ¶ 146. Included in response window UI element 602b is presentation space 608b, which includes a user message UI element 610b and reply UI element 622b, and a data object identification response UI element 628b. *Id.* ¶¶ 146–147.

Selecting element 628b displays located data resources dialog UI element 630b (the upper window in Figure 6B) that includes presentation space 632b for presenting a user detectable representation of the data objects identified in the received data object identification response from the original contactee (“William”). Ex. 2004 ¶ 147. In one embodiment, the data objects themselves are not included in the second message — rather, representations of the identified data objects are presented. *Id.* A “representation” is described, for example, as a window or other visual interface element displayed on a screen of a display presenting information representing a program entity such as a file. *Id.* ¶¶ 47–52, 69. Selection of access UI element 634b allows a request of data objects identified in the data object identification response, which request is sent to original contactee via a third message, in response to which the requested objects are sent as attachments to the original contactor via a fourth message. *Id.* ¶¶ 148–149, 153–154, 156, claim 10.

B. Illustrative Claim

Independent claim 9 is representative, and is reproduced below.²

² The bracketed letters and paragraph arrangement are taken from the Petition but do not impact our analysis. Pet. 84–87.

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:

- [a]: 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;
- [b]: 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;
- [c]: 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;
- [d]: 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;
- [e]: 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;
- [f]: 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;

- [g]: 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;
- [h]: send, to a second node via the at least one network, the first message;
- [i]: 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;
- [j]: 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;
- [k]: 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;

[l]: 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;

[m]: send, to the first node via the at least one network, the second message;

[n]: 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;

[o]: 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.

Ex. 1101, 51:21–52:37.

C. Asserted Grounds

Petitioner asserts that claims 9–16 and 22–24 are unpatentable based on the following grounds.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
9, 10, 14, 15	103(a)	Riepling ³
11–13, 16, 22–24	103(a)	Riepling, Manzano ⁴

³ U.S. Patent Application Publication 2013/0046833 A1 (Ex. 1107) (“Riepling”).

⁴ U. S. Patent Application Publication No. 2010/0005138 A1 (Ex. 1105) (“Manzano”).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
9, 10, 14, 15	103(a)	Riepling, Meisels ⁵
11–13, 16, 22–24	103(a)	Riepling, Manzano, Meisels
11–13, 16, 22–24	103(a)	Riepling, Manzano, Garcia, ⁶
11–13, 16, 22–24	103(a)	Riepling, Manzano, Meisels, Garcia

Pet. 6.⁷ In support of its patentability challenge, Petitioner relies on, *inter alia*, the Declaration of Todd Mowry, Ph.D. Ex. 1102 (“Mowry Decl.”)

D. Real Parties in Interest

The parties identify themselves as the real parties-in-interest. Pet. 2; Paper 7, 2.

E. Related Proceedings

The parties identify *Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:20-cv-00251 (W.D. Tex.); *Motion Offense, LLC v. Dropbox, Inc.*, C.A.

⁵ U.S. Patent Application Publication No. 2012/0278404 A1 (Ex. 1108) (“Meisels”).

⁶ U.S. Patent No. 9,633,125 B1 (Ex. 1104) (“Garcia”).

⁷ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included amendments to 35 U.S.C. §§ 102 and 103 that became effective after the filing of the ’906 and ’635 applications. Petitioner relies only on prior art predating these applications, although it reserves the right to argue that the ’520 patent is not entitled to the filing dates of those applications. Pet. 5, n.1. For present purposes, we apply the pre-AIA version of Section 103, although application of the AIA version would not alter our analysis.

No. 6:23-cv-0303 (W.D. Tex.); and *Dropbox, Inc. v. Motion Offense, LLC*, IPR2024-00286 (PTAB) as related proceedings. Pet. 2; Paper 7, 2.

III. ANALYSIS OF PETITIONER'S GROUNDS

A. *Legal Standards*

To prevail in its grounds for unpatentability, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (2012) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to the patent owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective indicia of non-obviousness (also called secondary considerations), such as

commercial success, long-felt but unsolved needs, and failure of others.⁸ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). We analyze the grounds based on obviousness in accordance with the above-stated principles.

B. Level of Skill in the Art

In determining whether an invention would have been obvious at the time it was made, 35 U.S.C. § 103(a) requires us to resolve the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). Factors that may be considered in determining the level of ordinary skill in the art include, but are not limited to, the types of problems encountered in the art, the sophistication of the technology, and educational level of active workers in the field. *Id.* In a given case, one or more factors may predominate. *Id.*

Petitioner asserts that a person of ordinary skill in the art at the time of the earliest claimed priority date of the '520 patent (September 22, 2012):

would have had at least the equivalent of a Bachelor's degree in electrical engineering, computer science, or a related field and two or more years of experience in a related field such as networked computer systems using Internet protocols. Less work experience may be compensated by a higher level of education, such as a Master's Degree, and vice versa.

Pet. 3–4 (citing Mowry Decl. ¶ 29). Patent Owner does not

⁸ No evidence of objective indicia of non-obviousness is of record concerning the challenged claims.

dispute Petitioner's definition for purposes of its preliminary response.
Prelim. Resp. 22.

Petitioner's proposal is consistent with the level of ordinary skill in the art as reflected by the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *GPAC*, 57 F.3d at 1579. For purposes of this Decision, we apply Petitioner's articulation.

C. Claim Construction

The Petition was accorded a filing date of January 22, 2024. Paper 5, 1. In an *inter partes* review for a petition filed on or after November 13, 2018, a claim "shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b)." 37 C.F.R. § 42.100(b). We apply the claim construction standard from *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (*en banc*).

Claim terms need only be construed to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). Petitioner submits that no claim construction is necessary. Pet. 13–14. Patent Owner does not specifically raise any claim construction issues. *See generally* Prelim. Resp.

No claim construction issues are presented at this stage of the Proceeding.

D. Alleged Obviousness of Claims 9, 10, 14, and 15 over Riepling and Meisels

Petitioner challenges claims 9, 10, 14, and 15 as obvious Riepling alone, and in the alternative over the combination of Riepling and Meisels.

Pet. 14–49, 65–71. For purposes of this Decision, we need only consider the alternative ground based on the combination Riepling and Meisels.

1. Riepling

Riepling, titled “Method And System For Sending A Digital Invitation Requesting A Data Upload,” is an application published February 21, 2013, and filed August 16, 2011. Ex. 1107, codes (54), (43), (22). Riepling is directed to a content sharing service including sending, to a contact, a digital invitation requesting a data upload. *Id.* at Abstr., ¶ 7. Riepling Figure 2 is reproduced below.

Fig. 2

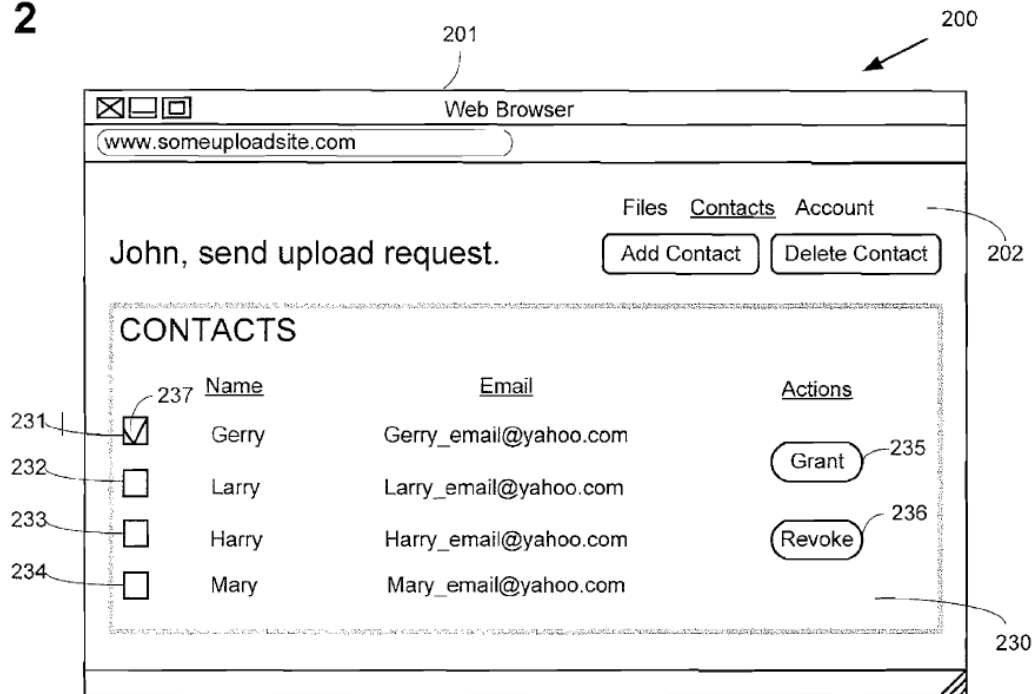


Figure 2 depicts a web browser request interface 201 for selecting a contact to receive a digital invitation requesting a data upload. Ex. 1107 ¶¶ 11, 24.

In this example, by selecting email address box 231 and grant access button 235, user John grants user Gerry access to a server, and designates Gerry's

email to receive an invitation to upload files to the server. Ex. 1107

¶¶ 24, 26.

Riepling Figure 3 is reproduced below.

Fig. 3

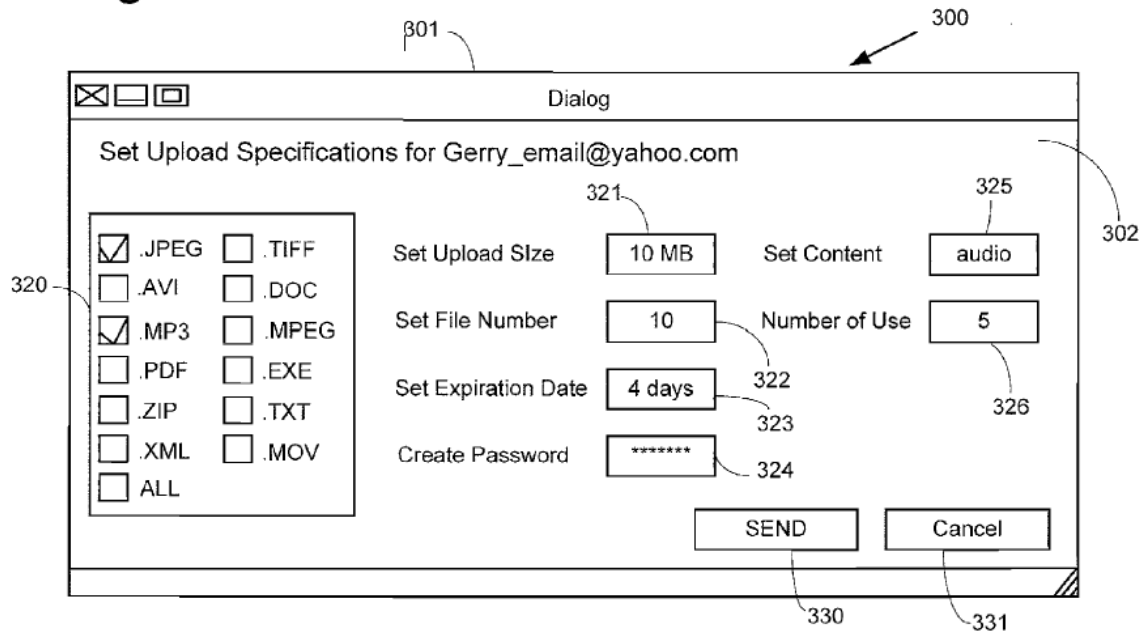


Figure 3 depicts an upload parameter dialog for specifying upload parameters. Ex. 1107

¶¶ 12, 28.

Upload parameter dialog 301 is presented in response to the above selection of email contacts, and allows specifying upload parameters including file format check boxes 320, size limit field 321, file number field 322, invitation expiration field 323, invitation password field 324, set content field 325, and number of uses field 326. Ex. 1107 ¶¶ 28–29. These fields may be text fields. *Id.* ¶ 31. Although not shown in the figure, other upload parameters restricting the data upload based upon data composition may be specified from upload parameter dialog 301. *Id.* ¶ 31. Send button 330 is

used to send a digital invitation restricted by the one or more upload parameters specified in upload parameter dialog 301. *Id.* ¶ 34.

Riepling Figure 4 is reproduced below.

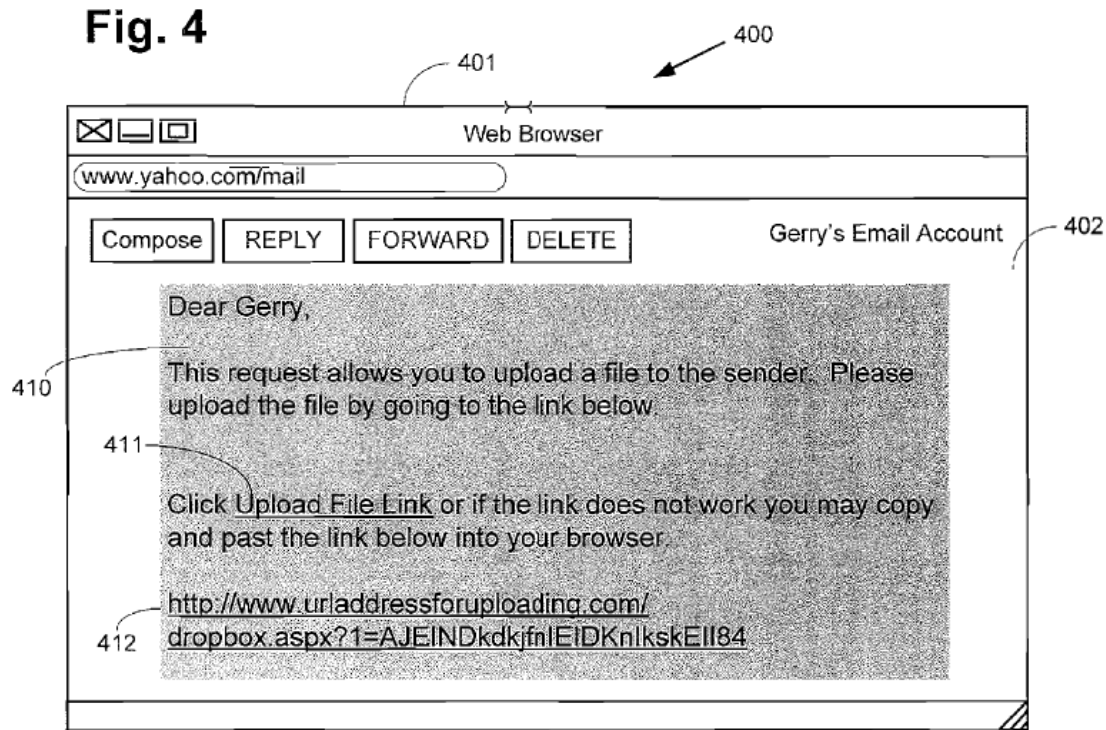


Figure 4 depicts a digital invitation containing a unique location identifier. Ex. 1107 ¶¶ 13, 35.

Web browser 401 includes email interface 402, which includes digital invitation 410 with unique location identifiers 411 and 412. Ex. 1107 ¶ 35. In this example Gerry is receiving the email invitation. *Id.* ¶ 36. Clicking on either of the unique location identifiers launches a dialog associated with the content sharing service. *Id.* ¶ 37.

Riepling Figure 5 is reproduced below.

Fig. 5

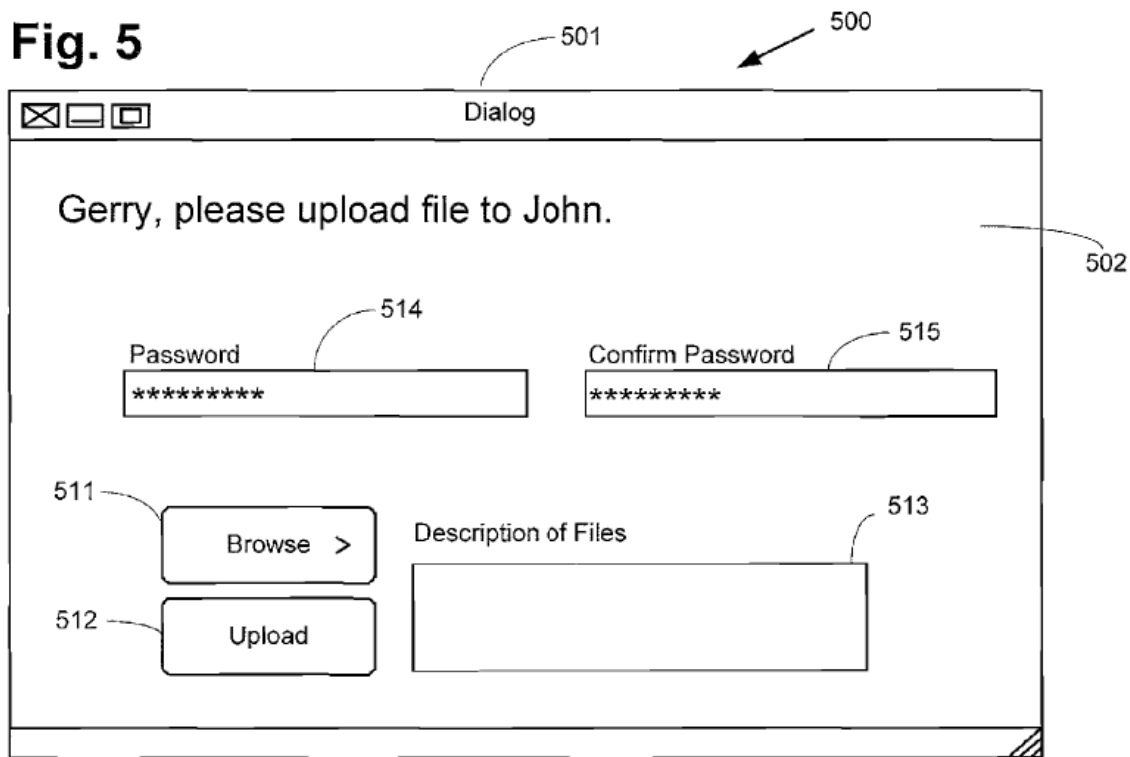


Figure 5 depicts a file upload dialog for selecting data files for uploading. Ex. 1107 ¶¶ 14, 41.

File upload dialog 501 is presented when the recipient of invitation 410 (“Gerry”) clicks on location identifier 411 or 412. Ex. 1107 ¶ 42. Browse button 511 is used to select one or more data files for uploading, file description text field 513 receives a textual description of the data files chosen for uploading, and upload button 512 is used to upload the selected files to the content sharing service. *Id.* ¶ 43. The sender of the digital invitation (“John”) can receive an alert message notification of the upload, permitting downloading the uploaded data. *Id.* ¶ 45.

Riepling Figure 7 is reproduced below.

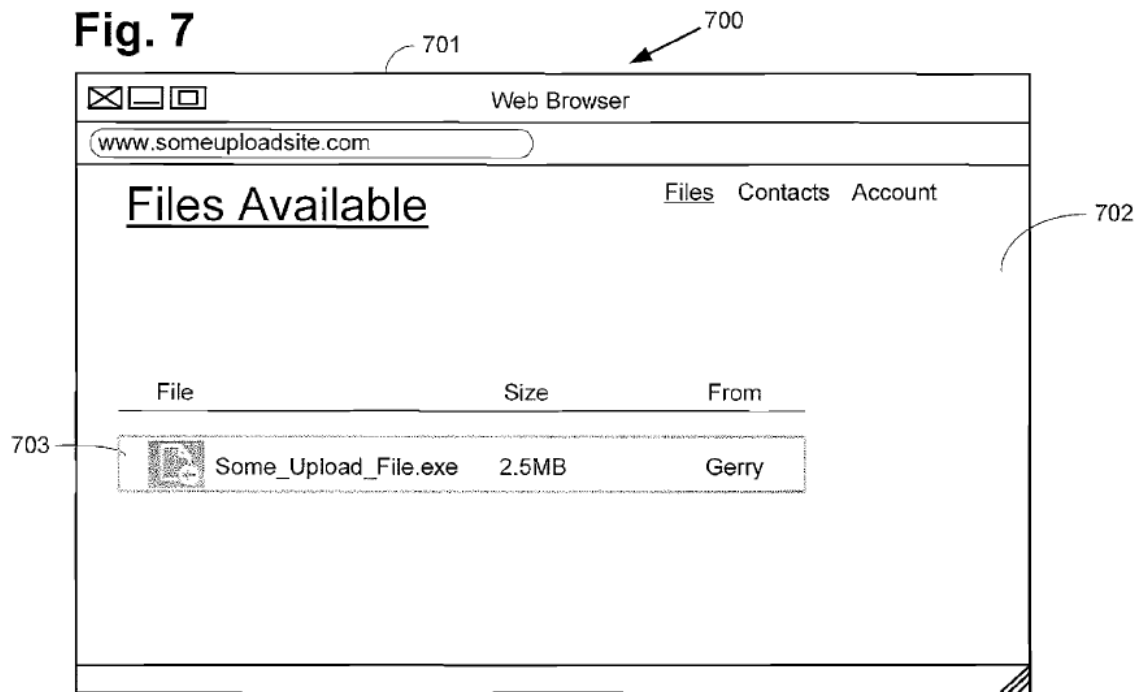


Figure 7 depicts a data availability interface.
Ex. 1107 ¶¶ 16, 48.

Data availability interface 702 allows viewing uploaded data, and file entry link 703 may be used to open or download the actual data file associated with the link. Ex. 1107 ¶ 49.

2. *Meisels*

Meisels, titled “Upload Of Attachment And Insertion Of Link Into Electronic Messages,” is an application published February 21, 2013, and filed August 16, 2011. Ex. 1108, codes (54), (43), (22). *Meisels* discloses an electronic message with an automatically inserted a link to a document in place of the document attachment itself. *Id.* at Abstr., ¶¶ 3, 23.

A portion of Figure 4 is reproduced below.

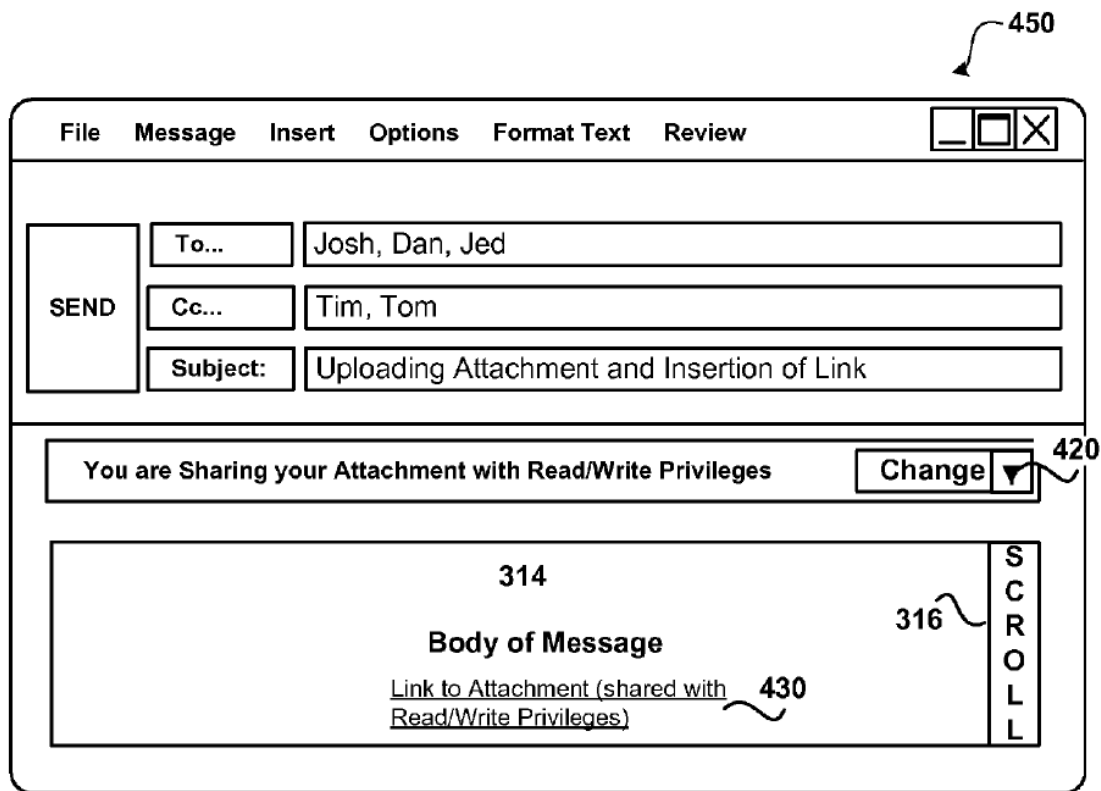


FIG.4

This portion of Figure 4 depicts an electronic message after a user action is received to upload an attachment. Ex. 1108 ¶¶ 7, 43.

Electronic message 450 includes a link to an attachment 430, rather than the attachment itself. Ex. 1108 ¶¶ 43, 45. A link may be in the form of a Uniform Resource Locator (URL) that specifies a network location of where the content is stored. Id. ¶ 23.

3. Motivation To Combine

Petitioner argues that one of ordinary skill in the art would have been motivated to use the teaching of Meisels to include a link to an uploaded document, rather than the document attachment itself, in the above-described alert message notification of Riepling, as discussed further below in

connection with claim limitation 9[1]. Pet. 66–67 (citing Ex. 1108, Figs. 4, 7, ¶¶ 23, 41–45, 54, 56; Mowry Decl. ¶¶ 192–193).

Petitioner argues that this combination would have been motivated because (i) Riepling and Meisels are from the same field of endeavor, directed to sharing files over a network; (ii) that the combination would have yielded expected, predictable results, using known and routine computer programming principles, to modify Riepling’s system to generate an electronic message that includes a link pointing to an uploaded file; (iii) that the combination would have been readily implemented given Meisels’ teachings of inserting, in an electronic message, a link to a shared location where a file is uploaded; (iv) and that the combination was suggested because Meisels expressly disclosed a benefit of sending an email message with a link, to avoid multiple copies of a file from existing at multiple locations, and sending links to one file to multiple recipients and managing permissions on an individual recipient basis. Pet. 67–70 (citing Ex. 1107, Fig. 1, ¶¶ 2, 4, 19; Ex. 1108, Fig. 4, ¶¶ 1, 3, 41–45, 56; Mowry Decl. ¶¶ 194–198). In addition, for reasons similar to the motivation basis, Petitioner argues that a person of ordinary skill in the art would have had a reasonable expectation of success in making the combination. *Id.* at 70–71 (citing Mowry Decl. ¶¶ 199–200).

Patent Owner does not specifically address Petitioner’s arguments regarding the combination of Riepling and Meisels. *See* Prelim. Resp. 38. At this stage, we are persuaded by Petitioner’s expert’s testimony that one of ordinary skill would have applied the document link teachings of Meisels to modify Riepling. Accordingly, for purposes of this Decision, we determine that Petitioner has provided sufficiently articulated reasoning with rational

underpinnings for the proffered combined teachings of Riepling and Meisels.

4. Independent Claim 9

a) Preamble and Requirements 9[a], 9[c]–9[f], and 9[h]–9[o]

For the apparatus preamble of independent claim 9, Petitioner generally relies on the disclosure in Riepling of a system sending a digital invitation requesting a data upload, including a server, processor, and storage database. Pet. 14–15 (citing Ex. 1107, Fig. 1, ¶¶ 19, 63; Mowry Decl. ¶¶ 64–65).⁹

For claim requirement 9[a] of causing a display of a first interface for creating a file request,¹⁰ Petitioner relies on the disclosure in Riepling of upload parameter dialog 301, which includes invitation expiration field 323 and set content field 325. Pet. 15–17 (citing Ex. 1107, Figs. 1, 3, ¶¶ 18, 21, 22, 29, 33; Mowry Decl. ¶¶ 66–69).

For claim requirement 9[c] of receiving an indication of at least one of a date or a time, Petitioner relies on the disclosure in Riepling of invitation expiration field 323 which, for example, may contain text such as “4 days” or “from Jun. 1, 2011, 8:00 am PST until Jun. 5, 2011, 8:00 am PST.” Pet. 19–20 (citing Ex. 1107, Figs. 1, 3, ¶ 33; Mowry Decl. ¶¶ 73–75).

⁹ Based on the present record, we make no determination at this stage of the proceeding that the preamble of claim 9 is limiting.

¹⁰ For economy of presentation, we refer to the portions of claim 9 identified by bracketed letters at Section II.B above, and paraphrase the referenced claim requirement, although the complete language of each claim requirement is the subject of our analysis.

For claim requirement 9[d] of causing a display of a second interface for use in causing the file request to be sent, Petitioner relies on the disclosure in Riepling of web browser request interface 201, which includes list of contact information 230. Pet. 20–21 (citing Ex. 1107, Fig. 2, ¶¶ 4, 24–26; Mowry Decl. ¶¶ 76–78). Petitioner also relies on send button 330, which in the Riepling disclosure appears on Figure 3, which Petitioner associates with the claimed first interface. *Id.* at 22. But Petitioner’s expert testifies that including that interface element on Figure 2 (the proposed second interface) would have been an obvious alternative, given that the order of entering information in Figures 2 and 3 was arbitrary. *Id.* at 22–25 (citing Ex. 1107, Fig. 3, ¶¶ 7, 34, 57; Mowry Decl. ¶¶ 79–82). We note that the ‘906 application embodiment that most closely corresponds to the ’520 claims discloses a single interface that serves as both the first and second claimed interfaces. Ex. 2004, Fig. 6A.

For claim requirement 9[e] of receiving indicia associated with at least one email address, Petitioner relies on the disclosure in Riepling of list of contact information 230, with the associated selection boxes 231–234. Pet. 25–27 (citing Ex. 1107, Fig. 2, ¶¶ 25–26, 34; Mowry Decl. ¶¶ 83–85).

For claim requirement 9[f] of receiving indication of a selection of a user interface element that indicates that the file request is to be caused to be sent, Petitioner relies on the disclosure in Riepling of send button 330, which when selected causes digital invitation 410 to be sent to the indicated email addresses. Pet. 27–28 (citing Ex. 1107, Fig. 3, ¶ 34; Mowry Decl. ¶¶ 86–88).

For claim requirement 9[h] of sending the first message (digital invitation 410, discussed below in connection with claim requirement 9[g]),

Petitioner relies on the disclosure in Riepling of the above-described operation of send button 330, which causes the message to be sent. Pet. 28–29, 31–32 (citing Ex. 1107, Figs. 1, 2, 4, ¶¶ 34–35; Mowry Decl. ¶¶ 90, 92, 97).

For claim requirement 9[i] of receiving indication of a selection of a user interface element that indicates that a file is to be uploaded in response to the file request, Petitioner relies on the disclosure in Riepling of the ability of a user to click on either of unique location identifiers 411 and 412 in digital invitation 410. Pet. 32–33 (citing Ex. 1107 ¶¶ 37, 42; Mowry Decl. ¶¶ 99–100).

For claim requirement 9[j] of, in response to the receipt of the indication of the selection of the user interface element of claim requirement 9[i], causing display of a third interface for use in uploading the file in response to the file request, Petitioner relies on the disclosure in Riepling of file upload dialog 501, including upload interface 502 with browse button 511, which is used to select files for uploading, and upload button 512, used to perform data upload. Pet. 33–34 (citing Ex. 1107, Fig. 5, ¶¶ 37, 42–43; Mowry Decl. ¶¶ 101–103).

For claim requirement 9[k] of receiving indication of a selection of a user interface element of the third interface, Petitioner relies on the disclosure in Riepling of using upload button 512 to upload files. Pet. 35 (citing Ex. 1107 ¶ 43; Mowry Decl. ¶¶ 104–105).

For claim requirement 9[l] of, in response to the receipt of the indication of the selection of the user interface element of claim requirement 9[k], generating a second message that that does not include a file attachment, indicating that the file request has been responded to, Petitioner

relies on the disclosure in Riepling that, when a file is uploaded, an alert message is sent to user accounts, which message permits the downloading of the uploaded data. Pet. 35–36 (citing Ex. 1107 ¶ 45; Mowry Decl. ¶¶ 107–110). As discussed above, Petitioner relies on Meisels in combination with Riepling as teaching or suggesting that the alert message would include a link to the uploaded file rather than the file attachment. *Id.* at 65–67 (citing Ex. 1108, Figs. 4, 7, ¶¶ 3, 23, 41–45, 54, 56; Mowry Decl. ¶¶ 192–193).¹¹

For claim requirement 9[m] of sending the second message, Petitioner relies on the disclosure in Riepling of the above-discussed sending of an alert message. Pet. 36–37 (citing Ex. 1107, Fig. 1, ¶ 45; Mowry Decl. ¶¶ 111–112).

For claim requirement 9[n] of receiving an indication of selection of a user interface element in the second message, Petitioner relies on the disclosure in Riepling that the notification message permits downloading of uploaded data, together with the use of a link to the data as taught by Meisels. Pet. 37–38, 65–67 (citing Ex. 1107 ¶ 45; Mowry Decl. ¶¶ 113–114, 192–193).

For claim requirement 9[o] of, in response to the receipt of the indication of the selection of the user interface element of claim requirement 9[n], causing display of a fourth interface with a reference to the file for allowing access the file, Petitioner relies on the disclosure in Riepling of

¹¹ In response to Petitioner’s challenge to claim 9 based on Riepling alone, Patent Owner argues that it would not have been obvious to include a link to the uploaded file, without a file attachment, in the alert message of Riepling. PO Resp. 32–34. However, Patent Owner does not apply this argument to Petitioner’s alternative challenge based on the combination of Riepling and Meisels. *Id.* at 38.

data availability interface 702 with file entry link 703. Pet. 38–39 (citing Ex. 1107, Fig. 7, ¶ 49; Mowry Decl. ¶¶ 115–117).

Patent Owner does not specifically address claim requirements 9[a], 9[c]–9[f], and 9[h]–9[o]. *See generally* Prelim. Resp. For purposes of this Decision, we are persuaded that the record supports Petitioner’s arguments regarding these claim requirements.

b) Requirement 9[b]

For the claim 9[b] requirement of receiving a file description of a file in connection with the file request via an interface that includes a textbox, Petitioner relies on the disclosure in Riepling of set content field 325 in Figure 3, reproduced *supra*. Pet. 17–19 (citing Ex. 1107, Figs. 1, 3, ¶¶ 31–34; Mowry Decl. ¶¶ 70–72). Petitioner’s expert testifies that, based on the description in Riepling of size limit field 321, file number field 322, invitation expiration field 323, invitation password field 324, and number of use field 326 as text fields, one of ordinary skill would have understood that set content field 325 was a text field. *Id.*

Patent Owner argues that Petitioner’s reliance on set content field 325 is in error because Riepling does not describe it in the specification, other than its appearance in Figure 3, and therefore the record does not support Petitioner’s characterization of that field as a file description that includes a textbox. Prelim. Resp. 24–26. Patent Owner also points out that Figure 5 of Riepling includes textbox 513, labeled “Description of Files,” which is part of the response to a file request instead of part of the file request itself, which therefore is not received from the first node as required by the claim. *Id.* at 26–27 (citing Ex. 1107, Fig. 5, ¶¶ 41, 43).

We agree with Petitioner that set content field 325 of Riepling sufficiently teaches or suggests claim requirement 9[b]. As Petitioner's expert explains, given that the fields of Figure 3 are generally described as text fields, one of ordinary skill would have understood that this description applied to field 325. Mowry Decl. ¶ 70. Moreover, in the example of Figure 3, the "Set Content" entry is "audio," which is a file description. The fact that the Figure 5 response also includes a file description does not undercut Petitioner's reliance on set content field 325.

Accordingly, notwithstanding Patent Owner's arguments directed to claim requirement 9[b], for the reasons discussed above, for purposes of this Decision, we are persuaded that the record supports Petitioner's arguments regarding claim requirement 9[b].

c) Requirement 9[g]

For claim requirement 9[g] of, in response to the receipt of the indication of the selection of the user interface element of claim requirement 9[f], generating a first message addressed to the email address and including the file request, indicating the date or time, including a user interface element (used in claim requirement 9[i]), and including at least one sentence including the file description describing the at least one file in connection with the file request, Petitioner relies on the disclosure in Riepling of digital invitation 410, sent in response to send button 330, and which includes unique location identifiers 411 and 412 as the required user interface element. Pet. 28–32 (citing Ex. 1107, Figs. 1–4, ¶¶ 34–36; Mowry Decl. ¶¶ 90–94, 97–98). Petitioner's expert testifies that, based on the disclosure in Riepling that the digital invitation may be "restricted by the one or more

upload parameters specified in upload parameter dialog 301,” it would have been an obvious design choice to include other restrictive parameters in the digital invitation, including content field 325 (e.g., ”audio”) and invitation expiration field 323 (e.g., ”4 days” or ”Jun. 1, 2011, 8:00 am PST until Jun. 5, 2011, 8:00 am PST”). *Id.* at 30–31 (citing Mowry Decl. ¶¶ 95–96).

Patent Owner argues that neither content field 325 nor invitation expiration field 323 would be included in the claimed message because Riepling discloses that digital invitation 410 is sent after the information in Figure 2 is entered and grant access button 235 is selected, but before the information in Figure 3 is entered. Prelim. Resp. 28–29. Patent Owner further argues that Petitioner’s reliance on the disclosure in Riepling that the digital invitation may be “restricted by the one or more upload parameters specified in upload parameter dialog 301” is insufficient because Riepling separately provides for a “revoked digital invitation” dialog that takes into account these additional upload parameter restrictions. *Id.* at 30–31 (citing Ex. 1107, Fig. 6, ¶ 47).

At this stage, Patent Owner appears to be incorrect in asserting that digital invitation 410 is sent after grant access button 235 is selected. Rather, digital invitation 410 appears to be sent after the information of Figure 3 is provided, and send button 330 is selected. Ex. 1107, Fig. 3, ¶ 34. We agree with Petitioner’s expert that one of ordinary skill would have understood that Riepling’s digital invitation was not limited to digital invitation 410 in Figure 4 and would further have included one or more upload parameters shown in dialog 301, including “the file description describing the at least one file in connection with the file request” (e.g., “audio”) and “the at least one of the date or the time” (e.g., “4 days” or “Jun.

1, 2011, 8:00 am PST until Jun. 5, 2011, 8:00 am PST”), per claim requirement 9[g]. Mowry Decl. ¶¶ 95–96. On this record, such would have been an obvious design choice in order to inform the recipient of the message of the kind of file being requested and by when the file was to be received. *Id.* The fact that Riepling discloses additional provisions for revoking a digital invitation does not undercut Petitioner’s arguments.

Accordingly, notwithstanding Patent Owner’s arguments directed to claim requirement 9[g], for the reasons discussed above, for purposes of this Decision, we are persuaded that the record supports Petitioner’s arguments regarding claim requirement 9[g].

d) Conclusion Re Claim 9

Based on our analysis set forth above, we determine, on the current record and for purposes of this Decision, that the information presented in the Petition demonstrates a reasonable likelihood that Petitioner will prevail in establishing that claim 9 is unpatentable under 35 U.S.C. § 103(a) over the combination of Riepling and Meisels.

5. Claims 10, 14, and 15

For claim requirement 10 of basing the file indication on the received date or time of claim requirement 9[c], Petitioner relies on the disclosure in Riepling that invitation expiration field 323 is used to specify a time window of a data upload associated with the digital invitation. Pet. 39–40 (citing Ex. 1107, ¶ 33; Mowry Decl. ¶¶ 118–119).

Independent claim 14 includes requirements commensurate with independent claim 9, and Petitioner’s and Patent Owner’s arguments with

respect to that claim are substantially similar to those regarding claim 9. Pet. 40–47; Prelim. Resp. 35–36, 38.

Claim 15 depends from claim 14 and further requires:

- the first message and the second message are email messages;
- the object includes the at least one email address or an alias associated with the at least one email address;
- the second message is at least partially pre-written and is automatically generated without user involvement after the receipt of the message associated with the selection of the fifth user interface element; and
- the message associated with the at least one file is conditionally received based on whether a date-related criterion or a time-related criterion is met.

Ex. 1101, 54:37–49. For claim 15, Petitioner relies on the disclosure in Riepling that digital invitation 410 (“the first message”) “may be a textual email message,” and argues that it would have been obvious that the alert message (“the second message”) would also be an email. Pet. 47 (citing Ex. 1107, ¶¶ 36, 45; Mowry Decl. ¶¶ 138–139). Petitioner further relies on the email addresses associated with selection boxes 231–234 in list of contact information 230. *Id.* at 47–48 (citing Ex. 1107, ¶¶ 25–26; Mowry Decl. ¶¶ 140–141). Also, Petitioner argues that one of ordinary skill would have known that the alert message would have been automatically generated by the content sharing service and would have been at least partially pre-written. *Id.* at 48 (citing Ex. 1107, ¶ 45; Mowry Decl. ¶¶ 142–143). Finally, Petitioner relies on its analysis of claim 10 for date/time condition of claim 15. *Id.* at 48.

Other than its arguments discussed above relating to claim 9, which Patent Owner also makes for the commensurate requirements of claim 14, and which we have considered, Patent Owner does not further specifically respond to Petitioner's arguments regarding these claims. Prelim. Resp. 34–36, 38. Accordingly, we determine, on the current record and for purposes of this Decision, that the information presented in the Petition demonstrates a reasonable likelihood that Petitioner will prevail in establishing that claims 10, 14, and 15 are unpatentable under 35 U.S.C. § 103(a) over the combination of Riepling and Meisels.

E. Alleged Obviousness of Claims 11–13, 16, and 22–24 over Riepling, Manzano, and Meisels

Petitioner alternatively challenges claims 11–13, 16, and 22–24 as obvious over the combination of (i) Riepling and Manzano; (ii) Riepling, Manzano, and Meisels; (iii) Riepling, Manzano, and Garcia; and (iv) Riepling, Manzano, Meisels, and Garcia. Pet. 49—83. For purposes of this Decision, we need only consider the combination of Riepling, Manzano, and Meisels.

Manzano, titled “Electronic File Sharing,” is an application published January 7, 2010, and filed April 21, 2009. Ex. 1105, codes (54), (43), (22). Manzano is directed to sharing of electronic files among electronic devices. *Id.* ¶ 2. Manzano provides for user interfaces displayed on the displays of electronic devices that correspond to respective electronic folders or windows into which files may be placed. *Id.* ¶ 32. File icons are displayed to visually indicate whether a file has been downloaded locally or is being shared but located on a remote device — if remote, the icon can be

“ghosted” (*i.e.*, rendered semi-transparent). *Id.* ¶ 50. A user may right-click on the icon to download the associated file, at which time the icon will become unghosted. *Id.* ¶ 51.

Petitioner argues that one of ordinary skill in the art would have been motivated to use the teaching of Manzano to allow creation of electronic folders or windows on displays of the Riepling user devices (modified to include links to files as taught by Meisels) into which uploaded files may be placed, with displayed file icons that serve as representations of the transferred files. Pet. 49–53, 65–66 (citing Ex. 1105, Figs. 2, 3, 6, ¶¶ 2, 29–30, 32–38, 41, 50–52; Ex. 1108, Figs. 4, 7, ¶¶ 23, 41–45, 54, 56; Mowry Decl. ¶¶ 146–154, 192–193).

Petitioner argues that this combination would have been motivated because (i) Riepling, Meisels, and Manzano are from the same field of endeavor, directed to sharing files over a network; (ii) that the combination would have yielded expected, predictable results, using known and routine computer programming principles, to modify Riepling’s system to have a file-transfer application that would display a ghosted icon of the uploaded file until the file is requested to be downloaded; (iii) that the combination would have been readily implemented using basic computer programming principles to modify Riepling’s system to include Manzano’s teachings of using a ghosted icon; (iv) and that the combination was suggested because one of ordinary skill would have recognized the benefit of not storing a file at a node until a user requests the file be downloaded. Pet. 53–55, 67–70 (citing Ex. 1105, Fig. 2, ¶¶ 2, 29, 32–38, 41, 50–52; Ex. 1107, Fig. 1, ¶¶ 2, 4, 19; Ex. 1108, Fig. 4, ¶¶ 1, 3, 41–45, 56; Mowry Decl. ¶¶ 155–159, 194–198). In addition, for reasons similar to the motivation basis, Petitioner

argues that a person of ordinary skill in the art would have had a reasonable expectation of success in making the combination. *Id.* at 55–57, 70–71 (citing Mowry Decl. ¶¶ 160, 199–200).

Patent Owner does not specifically address Petitioner’s arguments regarding the combination of Riepling, Manzano, and Meisels. *See* Prelim. Resp. 36–38. At this stage, we are persuaded by Petitioner’s expert’s testimony that one of ordinary skill would have applied the ghosted icon teachings of Manzano to modify the Riepling/Meisels combination. Accordingly, for purposes of this Decision, we determine that Petitioner has provided sufficiently articulated reasoning with rational underpinnings for the proffered combined teachings of Riepling, Meisels, and Manzano.

For most of the requirements of claims 11–13, 16, and 22–24, Petitioner relies on disclosures in Riepling, and on the use of links to files in Meisels, which are discussed above in connection with claims 9, 10, 14, and 15. Pet. 49–67. The above-discussed disclosure in Manzano of ghosting of file icons is relied on for the following additional claim requirements regarding displaying representations of transferred files:

Claim 11: “creation of a representation of the at least one file is caused, at the first node, in a location among one or more folders on a file explorer interface that is not a web page and utilizes a client-based file explorer application, such that the at least one file is accessible via . . . the file explorer interface.” Ex. 1101, 52:43–51; Pet. 49–53.

Claim 12: “a storage at the first node does not store the at least one file when the creation of the representation of the at least one file is caused.” Ex. 1101, 52:52–60; Pet. 57.

Claim 16: See claims 11 and 12. Pet. 59.

Claim 22: “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.” Ex. 1101, 57:5–11; Pet. 63–64.

Other than its arguments discussed above relating to claim 9, which Patent Owner also makes for the commensurate requirements of claims 14 and 22, and which we have considered, Patent Owner does not further specifically respond to Petitioner’s arguments regarding these claims. Prelim. Resp. 34–38. Accordingly, we determine, on the current record and for purposes of this Decision, that the information presented in the Petition demonstrates a reasonable likelihood that Petitioner will prevail in establishing that claims 11–13, 16, and 22–24 are unpatentable under 35 U.S.C. § 103(a) over the combination of Riepling, Manzano, and Meisels.

IV. CONCLUSION

After considering the evidence and arguments presented in the Petition and the Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that at least one claim of the ’520 patent is unpatentable. Accordingly, we institute an *inter partes* review on all the challenged claims and all of the grounds presented in the Petition. See 37 C.F.R. § 42.108(a); *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *AC Techs. S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1364 (Fed. Cir. 2019) (“[I]f the Board institutes an IPR, it must . . . address all grounds of unpatentability raised by the petitioner.”). At this stage of the proceeding, we have not made a final determination as to the patentability of these challenged claims.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314, *inter partes* review is instituted as to the challenged claims of the '520 patent with respect to all grounds of unpatentability presented in the Petition; and

FURTHER ORDERED that *inter partes* review is commenced on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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