

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 RESPONSE

Under 37 C.F.R. § 42.120

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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Submitted Electronically via PTAB E2E

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	2
	A. Priority Applications	2
	B. Overview of the '520 Patent	2
	C. Challenged Claims	6
	D. Person of Ordinary Skill in the Art	7
	E. Cited References	8
	1. <i>Riepling</i>	8
	2. <i>Manzano</i>	8
	3. <i>Meisels</i>	10
	4. <i>Garcia</i>	10
III.	CLAIM CONSTRUCTION	13
	A. Legal Principles	13
	B. “representation of the at least one file”	15
	1. The Claim Language Supports Patent Owner’s Proposed Construction	16
	2. The Specification Supports Patent Owner’s Proposed Construction	21
IV.	LEGAL PRINCIPLES	24
	A. Priority and Written Description	24
	B. Prior Art Available Under 35 U.S.C. § 311(b)	25
	C. Obviousness	26
V.	Petitioner Has Not Met Its Burden for Any Claim	30
	A. The Challenged Claims Are Entitled to At Least a September 25, 2012 Priority Date	30

B.	<i>Riepling</i> Does Not Qualify As a Prior Art Patent Application Under 35 U.S.C. § 311(b), So All Grounds Fail.....	31
1.	Under § 311(b), Abandoned Patent Applications—Unlike Patents—Are Available as Prior Art Only as of Their Publication Date	31
2.	<i>Riepling</i> Is Not a Prior Art “Patent” Under § 311(b) Because It Never Issued as a Patent.....	34
3.	<i>Riepling</i> Is Not a Prior Art “Printed Publication” Available Under § 311(b) Because It Was Not Publicly Accessible Before the Challenged Claims’ Priority Date	34
C.	Grounds 1 and 3: Petitioner Has Failed to Show that Claims 9, 10, 14, and 15 Are Obvious Over <i>Riepling</i> or <i>Riepling</i> and <i>Meisels</i>	37
1.	<i>Riepling</i> Does Not Teach Claim Element 9[b] Because It Does Not Teach “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”	37
2.	<i>Riepling</i> Does Not Teach Claim Element 9[g] Because It Does Not Teach a “first message” That Indicates “at least one of the date or the time on which the file request is based” and “the file description describing the at least one file in connection with the file request”	42
3.	<i>Riepling</i> Does Not Teach Claim Element 9[l] Because It Does Not Teach “a second message that includes an eighth user interface element, and that does not include a file attachment with the second message”	48
4.	<i>Riepling</i> Does Not Teach Claim 10	51
5.	<i>Riepling</i> Does Not Teach Claim 14	51
6.	<i>Riepling</i> Does Not Teach Claim 15	52
7.	For Ground 3, <i>Meisels</i> Does Not Cure <i>Riepling</i> ’s Deficiencies	53

D.	Grounds 3 and 4: Petitioner Has Failed to Show that Claims 9, 10, 14, and 15 Are Obvious Over <i>Riepling</i> and <i>Meisels</i> , and that Claims 11–13, 16, 22–24 Are Obvious over <i>Riepling</i> , <i>Manzano</i> , and <i>Meisels</i> under 35 U.S.C. § 103	55
E.	Grounds 2, 4, 5 and 6: Petitioner Has Failed to Show that Claims 11–13, 16, and 22–24 Are Obvious over any combination of <i>Riepling</i> , <i>Manzano</i> , <i>Meisels</i> and <i>Garcia</i> under 35 U.S.C. § 103	57
1.	These Grounds Fail for the Same Reasons as Grounds 1 and 3 with Respect to <i>Riepling</i> and <i>Meisels</i>	57
2.	Grounds 2, 4, 5 and 6 Also Fail Because No Reference Discloses the Creation of a Representation of the at Least one File in a Location Among One or More Folders on the File Explorer Interface as Claims	58
VI.	CONCLUSION	61

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Acceleration Bay, LLC v. Activision Blizzard, Inc.</i> , 908 F.3d 765 (Fed. Cir. 2018)	26, 35
<i>ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.</i> , 694 F.3d 1312 (Fed. Cir. 2012)	29, 46, 51
<i>Advanced Display Sys., Inc. v. Kent State Univ.</i> , 212 F.3d 1272 (Fed. Cir. 2000)	25
<i>Allergan USA, Inc. v. MSN Labs. Priv. Ltd.</i> , 111 F.4th 1358 (Fed. Cir. 2024)	25
<i>Apple Inc. v. Contentguard Holdings, Inc.</i> , IPR2015-00442, Paper 9 (PTAB July 13, 2015)	passim
<i>Arendi S.A.R.L. v. Apple Inc.</i> , 832 F.3d 1355 (Fed. Cir. 2016)	46
<i>Ariad Pharms., Inc. v. Eli Lilly & Co.</i> , 598 F.3d 1336 (Fed. Cir. 2010)	24, 25
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	27
<i>Brown v. Guild</i> , 90 U.S. 181 (1874)	26, 34
<i>Carella v. Starlight Archery & Pro Line Co.</i> , 804 F.2d 135 (Fed. Cir. 1986)	35
<i>Cook Grp. Inc. v. Bos. Sci. Scimed, Inc.</i> , 809 F. App'x 990 (Fed. Cir. 2020)	29
<i>Cordis Corp. v. Boston Scientific Corp.</i> , 561 F.3d 1319 (Fed. Cir. 2009)	36
<i>Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC</i> , 57 F.4th 1001 (Fed. Cir. 2023)	14

Case IPR2024-00287
Patent No. 11,611,520
Patent Owner Response

<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	26
<i>In re Bayer</i> , 568 F.2d 1357 (C.C.P.A. 1978).....	35
<i>In re Gordon</i> , 733 F.2d 900 (Fed. Cir. 1984)	29
<i>In re Hall</i> , 781 F.2d 897 (Fed. Cir. 1986)	35
<i>In re Klopfenstein</i> , 380 F.3d 1345 (Fed. Cir. 2004)	35
<i>In re Lister</i> , 583 F.3d 1307 (Fed. Cir. 2009)	36
<i>In re Magnum Oil Tools Int’l.</i> , 829 F.3d 1364 (Fed. Cir. 2016)	26, 27
<i>In re NTP, Inc.</i> , 654 F.3d 1279 (Fed. Cir. 2011)	30
<i>In re Omeprazole Patent Litig. v. Apotex Corp.</i> , 536 F.3d 1361 (Fed. Cir. 2008)	28
<i>In re Urbanski</i> , 809 F.3d 1237 (Fed. Cir. 2016)	28
<i>In re Wertheim</i> , 646 F.2d 527 (CCPA 1981)	26, 34
<i>Innogenetics</i> , 512 F.3d at 1373 (Fed. Cir. 2008)	27
<i>InTouch Techs., Inc. v. VGo Communs., Inc.</i> , 751 F.3d 1327 (Fed. Cir. 2014)	28
<i>Johns Manville v. Knauf Insulation</i> , IPR2018-00827, Paper 9 (PTAB Oct. 16, 2018).....	passim

<i>Juno Therapeutics, Inc. v. Kite Pharma, Inc.</i> , 10 F.4th 1330 (Fed. Cir. 2021)	25
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	30
<i>Lockwood v. Am. Airlines, Inc.</i> , 107 F.3d 1565 (Fed. Cir. 1997)	25
<i>NTP, Inc. v. Research In Motion, Ltd.</i> , 418 F.3d 1282 (2005).....	15
<i>Ortho-McNeil Pharm. v. Mylan Labs</i> , 520 F.3d 1358 (Fed. Cir. 2008)	29
<i>P&G v. Teva Pharms. USA, Inc.</i> , 566 F.3d 989 (Fed. Cir. 2009)	29
<i>Paice LLC v. Ford Motor Co.</i> , 881 F.3d 894 (Fed. Cir. 2018)	24, 25
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	14, 17, 19, 22
<i>Plas-Pak Indus. v. Sulzer Mixpac AG</i> , 600 F. App’x 755 (Fed. Cir. 2015)	29
<i>Qualcomm Inc. v. Apple Inc.</i> , 24 F.4th 1367 (Fed. Cir. 2022)	25, 35
<i>Rexnord Corp. v. Laitram Corp.</i> , 274 F.3d 1336 (Fed. Cir. 2001)	15, 19
<i>Russello v. United States</i> , 464 U.S. 16 (1983).....	33
<i>Samsung Elecs. Co. v. Elm 3DS Innovations, LLC</i> , 925 F.3d 1373 (Fed. Cir. 2019)	15
<i>SightSound Techs., LLC v. Apple Inc.</i> , 809 F.3d 1307 (Fed. Cir. 2015)	15

<i>Unigene Labs., Inc. v. Apotex, Inc.</i> , 655 F.3d 1352 (Fed. Cir. 2011)	27
<i>Univ. of Md. Biotechnology Inst. v. Presens Precision Sensing GmbH</i> , 711 F. App'x 1007 (Fed. Cir. 2017)	29
<i>Valve Corp. v. Ironburg Inventions Ltd.</i> , 8 F.4th 1364 (Fed. Cir. 2021)	35
<i>Vas-Cath Inc. v. Mahurkar</i> , 935 F.2d 1555 (Fed. Cir. 1991)	24
<i>Virtek Vision Int'l ULC v. Assembly Guidance Sys., Inc.</i> , 97 F.4th 882 (Fed. Cir. 2024)	27, 46, 51
<i>VLSI Tech. LLC v. Patent Quality Assurance LLC</i> , No. 23-2298 (Fed. Cir.)	31
<i>Voter Verified, Inc. v. Premier Election Sols., Inc.</i> , 698 F.3d 1374 (Fed. Cir. 2012)	35
Statutes	
35 U.S.C. § 103	2
35 U.S.C. § 122	36
35 U.S.C. § 311	1, 25, 32
Regulations	
37 C.F.R. § 42.65	28

TABLE OF EXHIBITS

Exhibit	Description
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
2005	Declaration of Dr. Michael Smith
2006	<i>Garcia</i> Figure 12
2007	'520 Patent Priority Chain
2008	<i>Garcia</i> Assignment to SugarSync, Inc.
2009	<i>Garcia</i> Assignment to Dropbox, Inc.
2010	Dropbox Litigation – D.I. 72 Motion Offense, LLC's Opposition to Dropbox, Inc.'s Motion for Partial Summary Judgment
2011	Dropbox Litigation – D.I. 72-3 Declaration of Michael Smith, Ph. D, in Support of Motion Offense, LLC's Opposition to Dropbox, Inc.'s Motion for Partial Summary Judgment
2012	Dropbox Litigation – Deposition of Michael John Sebastian Smith, Ph.D, Tuesday, February 9, 2021
2013	Dropbox Litigation – D.I. 115 Order Denying Plaintiff Dropbox, Inc.'s Motion for Partial Summary Judgment
2014	<i>Riepling</i> Notice of Abandonment

I. INTRODUCTION

The Board should uphold claims 9–16 and 22–24 of U.S. Patent No. 11,611,520 (“the ’520 patent,” EX1001) for at least four reasons.

First, Petitioner has not met its burden because *Riepling* (EX1107)—relied upon in every Ground—is not available as prior art. Under 35 U.S.C. § 311(b), a petitioner in an *inter partes* review may rely “only on the basis of prior art consisting of patents or printed publications.” But *Riepling* is neither a prior-art patent nor a prior-art patent application. Rather, it is an abandoned patent application that was published in 2013, well after the priority date of the challenged claims in 2012. (EX2014.) And because *Riepling* is the basis for every Ground, all Grounds fail.

Second, the asserted references fail to disclose every limitation of the challenged claims, much less in the manner recited.

Third, and regardless of the foregoing, Petitioner has not articulated any motivation for modifying *Riepling* in the manner advanced by Petitioner.

Fourth, *Riepling* in combination with *Manzano*, *Meisels and Garcia* do not disclose every limitation of claims 11–13, 16, and 22–24 in any of Petitioner’s grounds and those claims are separately patentable for this additional reason.

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

II. BACKGROUND

A. Priority Applications

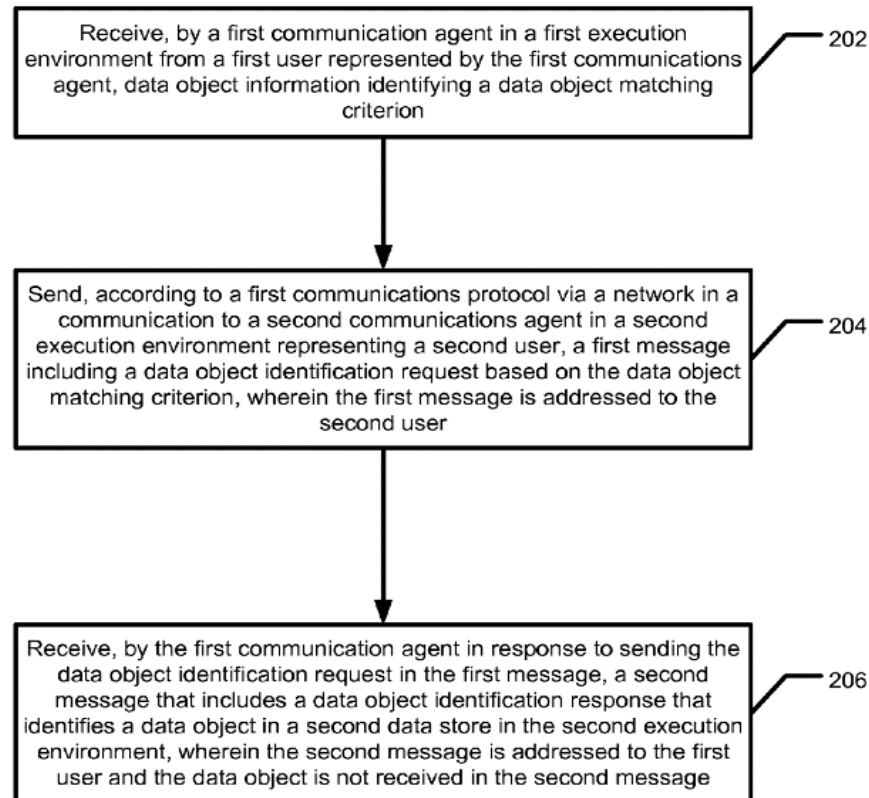
The '520 Patent claims priority to U.S. Patent Application Nos. 13/624,906 and 13/626,635 (the "'906 application" and "'635 application" respectively, and collectively the "Original Applications", attached hereto as EXS 2004, 2002), filed on September 22, 2012 and September 25, 2012 respectively. The '635 application incorporates the '906 application by reference, (EX2002, ¶¶3, 34), and both Original Applications are incorporated by reference in the '520 patent, (EX1001, 1:52–62.) and provide written description support for the challenged claims. (EX2005, ¶23.) The Original Applications were also incorporated by reference in all subsequent applications leading to the '520 patent. (EX2007.)

B. Overview of the '520 Patent

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 and instead allow remote access to the contents of the file (referred to as the "File Request embodiments"), which were disclosed in the Original Applications. (EX2005, ¶24.) At a high level, the File Request embodiments involve requesting a file where the requested file is shared without attaching it to a responsive message. (EX2004, at Abstract.) Instead, the file(s) is stored remotely and may be downloaded to the recipient's local drive when the recipient seeks to

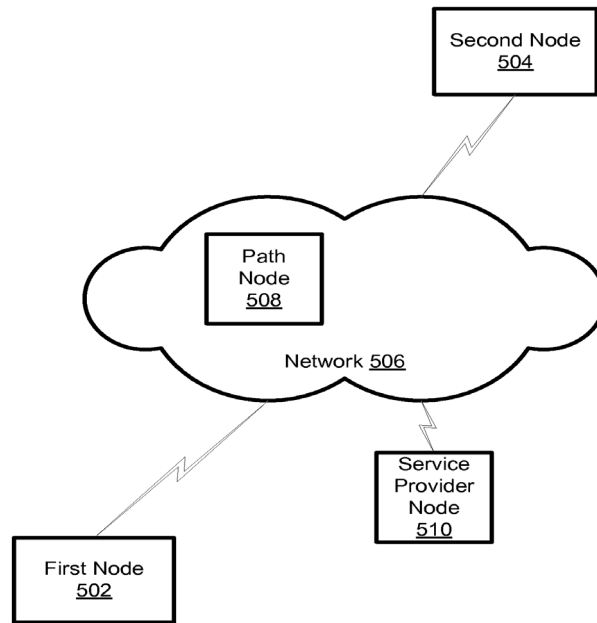
open or access a reference or representation of the file(s). (EX2004 at [0150] , [0151] , [0162]; EX2005, ¶24.)

The '906 application describes techniques for causing the steps set forth in Figure 2A. (EX2004, [0137], Fig. 2A; EX2005, ¶25.)

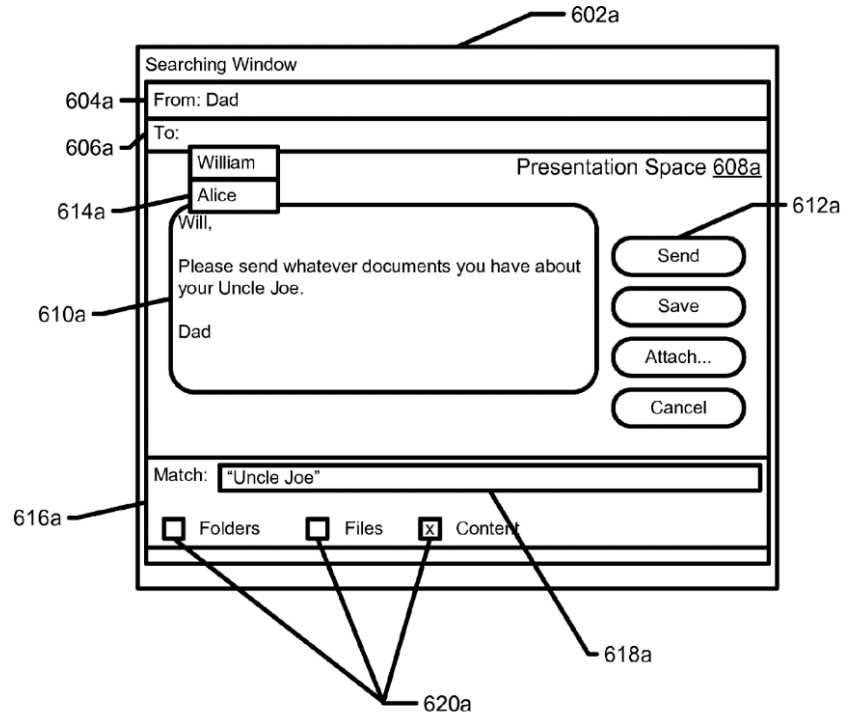


In embodiments, non-transitory memory stores instructions and one or more processors execute these instructions. (EX2004, [0035]-[0038], [0052]-[0053], [0209]-[0210]; EX2005, ¶26.) In embodiments, the software is stored remotely and accessible via a network. (EX2004, [0102], [0124], [0162], [0171]; EX2005, ¶26.)

In some embodiments, a web-services-provider node may interoperate with users' client nodes through browsers, (EX2004, [0123]–[0124]; EX2005, ¶27), as illustrated in Figure 5, reproduced below. (EX2005, ¶27.)



When the web-services-node executes these instructions, it causes, the display of an interface at a first node, for use in creating a file request . (EX2004, [0100], [0111], [0115]–[0117]; EX2005, ¶28.) An exemplary interface is included in FIG. 6A:



(EX2005, ¶28.)

The interface (*e.g.*, a Match window 616a in Fig. 6A above) includes an interface element to receive a description of the requested file (*e.g.*, text box 618a above). (EX2004, [0125]–[0126]; EX2005, ¶29.) It may also include another interface element to receive an indication of a date or a time on which the request is based as “additional matching criteria.” (EX2004, [0092]–[0095], [0133], [0175], [0180]; EX2005, ¶29.)

Additional interfaces may be displayed (*e.g.*, Presentation Space 608a in Fig. 6A above) with other interface elements (*e.g.*, 606a) to receive indicia associated with an email address to send the file request. (EX2005, ¶30.) The interface also includes an interface element to send the request (612a). (EX2004, at [0111],

[0115].) In response, the recipient may locate files to identify in a response or the second node may automatically identify and response with information regarding the requested file(s). In each instance, the response to the requestor does not include the requested files as an attachment. Instead, a reference to the file is presented to the requestor or a representation of the requested file may be presented to the requestor located in a location amongst one or more folders in the requestor's file system. The above features are broadly covered via the challenged claims of the '520 Patent. (EX2005, ¶38.)

C. Challenged Claims

Petitioner challenges claims 9–16 and 22–24 of the '520 patent. Of those, the challenged independent claims are claims 9, 14, and 22.

The Board stated that claim 9 is illustrative in its Institution Decision. (Paper 11 at 9.) That is not the case. (EX2005, ¶40.) For example, claim 11 depends on claim 9 and further requires that the apparatus is configured such that in response to the receipt of an indication of the selection of the seventh user interface element, a 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 file is accessible via the second message and the file explorer interface. While implicit in claim 9 (regarding the reference) and claim 11 (regarding the

representation), claim 12 clarifies that the first node does not store the at least one file until it is requested by a user at the first node using the representation (of claim 11) or reference (of claim 9). Claim 22 and its dependent claims, and dependent claim 16 likewise include limitations directed to representations and must be evaluated independently of claim 9. (*Id.*)

D. Person of Ordinary Skill in the Art

For purposes of this response only, Patent Owner does not dispute Petitioner's definition of a POSITA. Patent Owner 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.

E. Cited References

1. *Riepling*

Petitioner relies on U.S. Patent App. Pub. No. 2013/0046833 to Riepling et al. (“*Riepling*”) (EX1107), “filed on August 16, 2011 and published on February 21, 2013, as § 102(e) prior art.” (Pet. at 5.) *Riepling* was abandoned during prosecution. (EX2014.)

Riepling is titled “Method and System for Sending a Digital Invitation Requesting a Data Upload” and purports to address a way for registered users of a content sharing service to receive content from unregistered users “in a convenient and secure manner” through the use of invitations. (EX1107 at Abstr., ¶¶[0002], [0007]-[0008]; EX2005, ¶45.) It purports to do so while protecting registered users from security concerns such as, among other things, unsolicited messages from unregistered accounts. (EX1107 ¶[0004]; EX2005, ¶45.)

2. *Manzano*

Petitioner relies on U.S. Patent App. Pub. No. 2010/0005138 to Manzano et al. (“*Manzano*”) (EX1105), “published on January 7, 2010, as § 102(b) prior art.” (Pet. at 5.) *Manzano* is titled “Electronic File Sharing” and purports to address problems involving “exchang[ing] large files using awkward prior-art methods such as e-mail attachments” (EX1105 ¶[0003]; EX2005, ¶46.) *Manzano* teaches sharing files between devices using “mobile agents” or a “mobile agent

object” that exists on a first computer system and can “transplant itself” to a second computer system, while preserving its current execution state. (EX1105 ¶¶0016]; EX2005, ¶46.) This is performed by the mobile object creating another mobile object that functions as a “proxy object” on the server. (EX1105 ¶¶0035]; EX2005, ¶46.)

Specifically, *Manzano*’s Figure 3 describes that a user may share files between a first computer and a second computer using a “file transfer application” with “file transfer clients” running at each computer device. (EX1105 ¶¶0032]; EX2005, ¶47.) *Manzano* teaches that files may be shared with the second computer by placing them—such as by dragging and dropping them—in a designated folder. (EX1105 ¶¶0033], [0046]–[0049]; EX2005, ¶47.) The server transfers portions of the shared file to the second computer by creating a separate mobile object that informs the recipient client of the file transfer. (EX1105 ¶¶ [0036], [0039]; EX2005, ¶47.) In the process, the recipient client creates an electronic file folder in which the transferred file will be placed (EX1105 ¶¶0041]), and displays a progress meter at the sending client to indicate the status of the file transfer, (EX1105 ¶¶0046]), and informs the sending client application of the file transfer completion, (EX1105 ¶¶0043]). (EX2005, ¶47.)

In this context, if a file does not already exist at the second computer in the electronic file folder, it is indicated by a “ghosted” icon. (EX1105 ¶¶0050];

EX2005, ¶48.) The user may then selectively download all such files that do not already exist on the second computer. (EX1105 ¶¶[0051]; EX2005, ¶48.) The recipient-side operation is further shown in Figure 5, which describes that the recipient computer creates a mobile object, which in turn creates a proxy object at the server to establish a network connection. (EX1105 at Fig. 5; ¶¶[0059]–[0061]; EX2005, ¶48.) The proxy object provides each portion of a file to be transferred to the recipient client in the specially created electronic folder. (EX1105 ¶¶[0041], [0062]; EX2005, ¶48.)

3. *Meisels*

Petitioner relies on U.S. Patent App. Pub. No. 2012/0278404 to Meisels et al. (“*Meisels*”) (EX1108), “filed on April 28, 2011 and published on November 1, 2012, as § 102(e) prior art.” (Pet. at 6.) *Meisels* is titled “Upload of attachment and insertion of link into electronic messages,” and relates to creating a link for an email attachment that may be sent in the email message “along with or in place of” the attachment. (EX1108 at Abstr., ¶[0003]; EX2005, ¶49.) The attachment is uploaded to a network location, and selecting the link “generally retrieves the content that is pointed to by the link,” i.e., the attachment. (EX1108 ¶¶[0023], [0028], [0034], [0035]; EX2005, ¶49.)

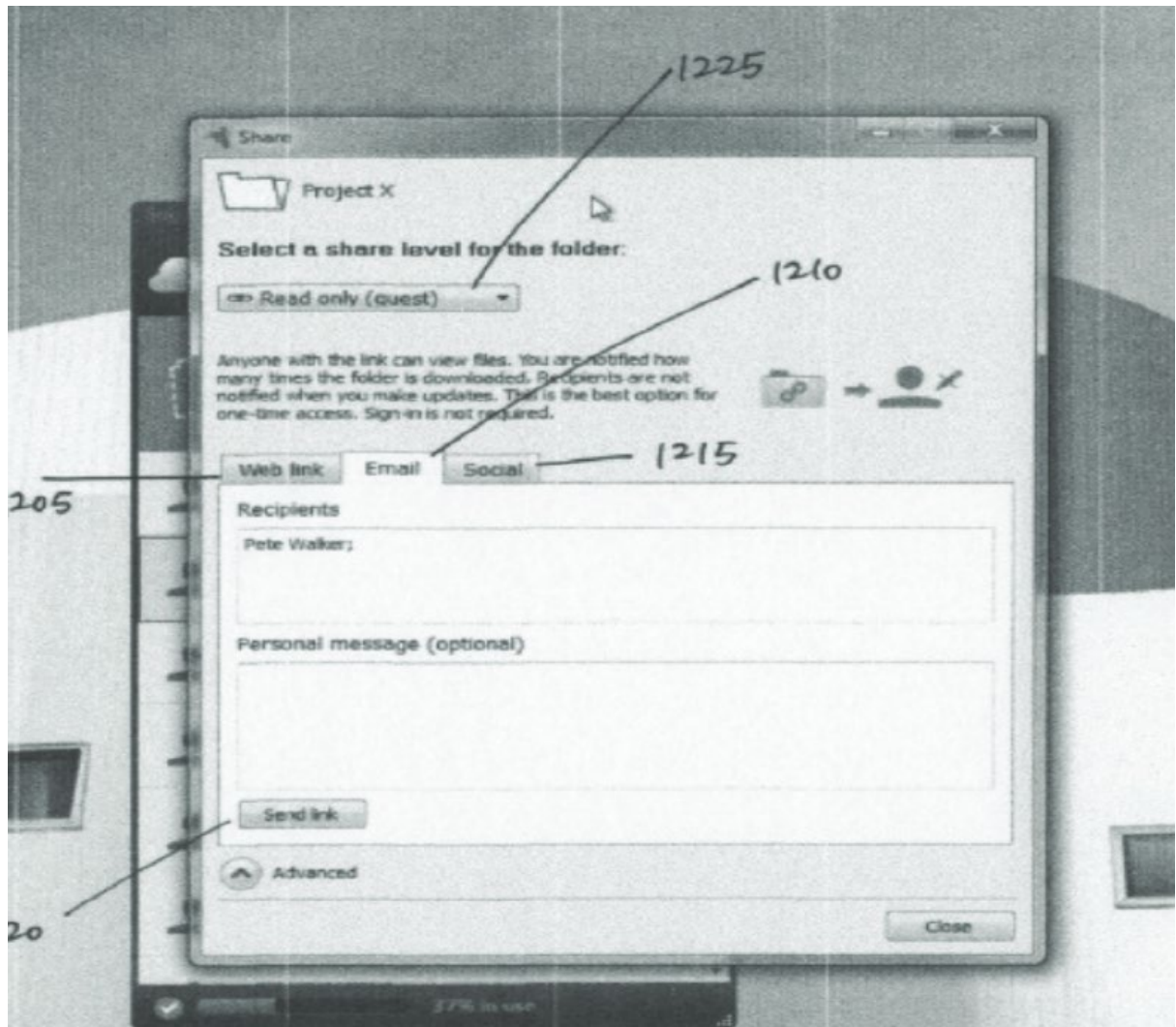
4. *Garcia*

Petitioner relies on U.S. Patent No. 9,633,125 to Garcia et al. (“*Garcia*”) (EX1104), “filed on August 10, 2012 and issued on April 25, 2017, as § 102(e) prior art.” (Pet. at 6.) *Garcia* is a patent originally assigned to SugarSync, Inc. that was assigned to Dropbox in 2014. (EX2008–2009.) *Garcia* purports to describe the operation of the then-existing SugarSync. (EX1104, Figs. 3–19; EX2005, ¶50.)

Garcia relates to “a system, method, and computer program . . . for enabling a user to synchronize, manage, and share files and folders across a plurality of client devices and a synchronization server.” (EX1104, Abstract, 1:12–15, 1:39–42; EX2005, ¶51.) *Garcia* further describes that a client can share a folder with another client by generating and sending an email with a link to and identifying the shared folder, instead of an attachment. (EX1104, 10:32–34, 10:38–40, 11:39–43, Figs. 11–12; EX2005, ¶51.) While *Garcia* does not describe the process of a recipient receiving such an email or accessing a shared folder in much detail, it does state that “in one embodiment, when a user drags a folder to a particular contact, *the folder* or *link to the folder* is automatically sent (via email, text, or other means) to the contact,” (EX1104, 11:16–19)¹, and “when the contact clicks on the link to folder 115, the *contents* of the folder are shared with the contact,” (EX1104, 11:29–31). (See also EX1104, 10:32–43 (web link to download);

¹ All emphasis is added unless otherwise indicated.

EX2005, ¶51.) While Garcia's FIG. 12 is not legible, a higher resolution of the figure is available as supplemental content on PAIR and reproduced below:



(EX2006; EX2005, ¶51.) The window shown in Garcia FIG. 12 has “email” selected and states “Anyone with the link can view files. You are notified how many times the folder is downloaded.” (EX2006; EX2005, ¶51) At the bottom, there is a button stating “Send Link.” (EX2006; EX2005, ¶51.) Thus, Garcia

discloses that the recipient of the shared folder downloads the *contents* of the folder when the link is accessed. (EX2005, ¶51.) It does *not* disclose the creation of a representation of the folder at the receiving node or representations of any files. (*Id.*) At most, it suggests that the receiving user’s *other devices (i.e., other nodes)* may show the shared folder as a representation.

III. CLAIM CONSTRUCTION

Patent Owner proposes that the Board construe the term “representation of the at least one file,” which appears in claims 11–12, 16, and 22:

Term	Patent Owner’s proposed construction
“representation of the at least one file”	a file that can be displayed at the user’s node, but whose at least one file content is stored remotely and is not communicated to the user till the user initiates the communication

It is necessary to construe this term because Petitioner’s arguments and the Board’s Institution Decision rely on an incorrect assumption about what it means. (EX2005, ¶53.) Patent Owner respectfully proposes that construing this term correctly will be dispositive for at least claims 11–12, 16, and 22–24 and reveal that Petitioner has failed to satisfy its burden.

A. Legal Principles

In an *inter partes* review proceeding, “a claim of a patent . . . 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), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b). Under this standard, the Board must determine how a POSITA would understand a claim term “in the context of the entire patent, including the specification.” *Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC*, 57 F.4th 1001, 1008 (Fed. Cir. 2023) (quoting *Phillips*, 415 F.3d at 1313).

“[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). “To begin with, the context in which a term is used in the asserted claim can be highly instructive.” *Id.* at 1312–13.

But the claims “do not stand alone”; instead, they are “part of ‘a fully integrated written instrument,’ consisting principally of a specification.” *Id.* at 1315 (internal citation omitted). “For that reason, claims ‘must be read in view of the specification, of which they are a part.’” *Id.* at 1315. The specification is “always highly relevant” to claim construction; it is “the single best guide to the meaning of a disputed term.” *Id.* at 1315.

The Board may consider “[o]ther claims of the patent in question, both asserted and unasserted,” as “valuable sources of enlightenment as to the meaning

of a claim term.” *Id.* at 1314. “[T]he usage of a term in one claim can often illuminate the meaning of the same term in other claims.” *Id.* at 1314.

Moreover, a claim term should be construed consistently throughout a patent. *See Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001). “Where multiple patents derive from the same parent application and share many common terms,” the Board “must interpret the claims consistently across all asserted patents.” *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, 925 F.3d 1373, 1378 (Fed. Cir. 2019) (quoting *SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1316 (Fed. Cir. 2015)); *see also NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1293.

B. “representation of the at least one file”

Term	Patent Owner’s proposed construction
“representation of the at least one file”	a file that can be displayed at the user’s node, but whose at least one file content is stored remotely and is not communicated to the user till the user initiates the communication

The ’520 patent claims recite two “representation[s] of the at least one file”: a “first” representation and a “second” representation. Each of these representations of a file can be displayed at the user’s node in a location among one or more folders, just like an ordinary file, either via a web page or in the requesting node’s client-based file explorer application. (EX2005, ¶59.) But each

representation of a file is different than an ordinary file for two reasons: (1) the representation's file contents are stored not at the user's node but instead remotely, despite the representation being displayed at the user's node; and (2) the representation's file contents are not communicated to the user till the user initiates a request for them. (*Id.*)

For the reasons discussed below, this proposed construction is consistent with the claim language of challenged claims 11–12, 16, and 22–24, as well as the claim language of claims 1 and 7–8, and the specification, including the Original Applications incorporated by reference. (EX2005, ¶60.)

1. The Claim Language Supports Patent Owner's Proposed Construction

The term “representation of the at least one file” appears at least in elements 22[h], [j], and [k] of independent claim 22:

22[h]: 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;

22[j]: 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;

22[k]: 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.

These claim elements provide a “highly instructive” starting point for understanding the term. *See Phillips*, 415 F.3d at 1312–13; EX2005, ¶62. In particular, these elements show that there are two “representation[s] of the at least one file” (i.e., a “first” and “second” representation), each of which is created in response to different inputs under different circumstances, and each of which can be displayed at the user’s node by different means. (EX2005, ¶62.)

First, these claim elements show that a “representation of the at least one file” is itself a file because it can be stored “in a location among one or more folders,” either at the “at least one server” (in 22[h] and [j]) or at the “first node” (in 22[k]). (EX2005, ¶63.)

Second, these claim elements show that there are two representations of a file—a “first” and “second” representation—and both representations can be displayed at the user’s node. (EX2005, ¶64.) The first representation is “displayable” at the user’s node (i.e., the “second node”) “via at least one web page” (in 22[h] and [j]), and the second representation is “displayable” at the user’s

node “via the file explorer interface of the client-based file explorer application” (in 22[k]). (*Id.*)

Third, these claim elements show that the first and second representations of the file are created by in response to different inputs, at different times, in different places. (EX2005, ¶65.) The first representation is created in response to “a signal for causing creation of a first representation of the at least one file” (in 22[h]). (*Id.*) The first representation then stored at “the at least one server,” and is “display[ed] . . . via at least one web page” at the first node (in 22[h] and [j]). (*Id.*) On the other hand, the second representation is caused to be created “based on the detection of the indication of the selection of the seventh user interface element,” utilizing “code” that is received at the first node (in 22[k]). (*Id.*) The code is stored at the first node and caused to be used “with a file explorer interface of a client-based file explorer application” to create the second representation and “display[]” it via a file-explorer interface at the first node. (*Id.*)

The “representation[s] of the at least one file” do not contain the contents of the file(s) when they are first created. (EX2005, ¶66.) This is shown by the language of claim element 22[i]. (*Id.*) In claim element 22[i], the user at the first node has already indicated that it wants to request a file from a user at the second node. (*Id.*) So after the requested file has been uploaded by a user at the second node, the method generates an email notifying the requestor that its request has

been responded to, and sends it to the requestor at the first node. (*Id.*) The email identifies information about the uploaded file and includes an HTTP link, but—importantly—“does not include a file attachment.” (*Id.*) Claim element 22[i] explains why:

22[i]: . . . for **permitting avoidance of the at least one file from being communicated to and stored at the first node via the second email,**

(*Id.*) With this, claim element 22[i] provides two key pieces of information about the “representation[s] of the at least one file”: (1) the contents of the files corresponding to the representation (i.e., “**at least one file**”) are “**store[d]**” on the “**at least one server**” (see 22[j]); and (2) those contents are not automatically “**communicated**” to “**the first node,**” nor are they “**stored at the first node.**”

(*Id.*) Accordingly, Patent Owner incorporates this information in its proposed construction of “representation of the at least one file”: i.e., “a file that can be displayed at the user’s node, but whose at least one file content is **stored remotely** and is **not communicated to the user till the user initiates the communication.**” (*Id.*)

These aspects of Patent Owner’s proposed construction are further supported by the language of claim 16. *See Phillips*, 415 F.3d at 1314 (“[o]ther claims of the patent in question, both asserted and unasserted,” are “valuable sources of enlightenment as to the meaning of a claim term”); *Rexnord*, 274 F.3d at 1342

(claim terms should be construed consistently throughout a patent); EX2005, ¶67.

Specifically, the term “representation of the at least one file” appears in dependent claim 16 in the following context:

16. The apparatus of claim 15, wherein the apparatus is configured such that,

in response to the receipt of the indication of the selection of the fifth user interface element, **a 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 is displayed utilizing a client-based file explorer application,

such that the at least one file is accessible via both the second message and the file explorer interface, wherein the apparatus is further configured such that the second message is sent **without including the at least one file as an attachment of the second message**,

and **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**, both **for avoiding the at least one file from having to be communicated to and stored at the first node until the at least one file is requested by a user at the first node using the representation or the reference**.

Therefore, claim 16 (via independent claim 14) specifies that: (1) the contents of the representation of the at least one file are not “**stored**” at the first node, despite the representation existing among one or more folders in the first node’s file-explorer interface; and (2) the contents of the representation of the at least one file are not communicated to the user at the first node “**until the at least**

one file is requested by a user at the first node using the representation or the reference.” (EX2005, ¶68.)

And as explained above, this avoidance of communicating the contents of the uploaded file automatically to the first node is recited by and consistent with element 22[i]. (EX2005, ¶69.)

Likewise, claim 12 (via independent claim 9) further supports Patent Owner’s proposed construction for the same reasons: i.e., the content of the representation of the at least one file are not **“stored”** at the first node, nor are they **“communicated to”** the user at the first node till the user **“request[s]”** it:

12. The apparatus of claim 11, wherein the apparatus is configured such that the second message is sent **without including the at least one file as an attachment of the second message**, and

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,

both for avoiding the at least one file from having to be communicated to and stored at the first node until the at least one file is requested by a user at the first node using the representation or the reference.

(EX2005, ¶70.)

2. The Specification Supports Patent Owner’s Proposed Construction

The '520 patent's specification is "highly relevant to the claim construction analysis," *see Phillips*, 415 F.3d at 1315, and further supports Patent Owner's proposed construction of "representation of the at least one file": i.e., "a file that can be displayed at the user's node, but whose at least one file content is **stored remotely** and is **not communicated to the user till the user initiates the communication.**" (EX2005, ¶71.) In particular, the '635 application—which the '520 patent claims priority to and incorporates by reference (EX1001, 1:52–62; *see also* EX2003 ¶¶3, 34)—makes clear that the contents of the representations' files are **stored remotely** rather than at the user's node and are **not communicated to the user till the user initiates the communication.** (EX2005, ¶71.)

For example, claim 1 of the '635 application claims a method in which a second user shares "a data object **in a second data store**" with a first user:

1. A method for sharing a data object in a data store via a communication, the method comprising:

receiving, by a first communications agent in a first execution environment according to a first communication protocol via a network from a second communications agent in a second execution environment, a first message, in a communication and addressed to a first user represented by the first communications agent, that includes a mount descriptor that identifies **a data object in a second data store in the second execution environment**;

detecting the mount descriptor;

determining a first location in a first data store in the first execution environment;
and

creating, based on the mount descriptor, **a representation of the data object at the location, wherein accessing the representation includes accessing the data object from the second data store,**

wherein performing at least one of the preceding actions comprising the method includes execution of an instruction by a processor.

(EX2005, ¶72.)

This claim has two steps that are relevant here. (EX2005, ¶73.) First, a “representation of the data object” is created at the first user’s “first location in a first data store”—which corresponds to claims 22 (as well as 11 and 16) of the ’520 patent’s creation of a “[second] representation of the at least one file” at the first node. (*Id.*) And second, the first user “**access[es] the representation**” at the first user’s location, which “**access[es] the data object from the second data store.**” (*Id.*) In other words, the contents of the file representation are **stored remotely** (i.e., “in a second data store”) rather than at the user’s node and are not **accessed** by the user till the user **accesses the representation.** (*Id.*)

Claims aside, the ’635 application’s specification also supports Patent Owner’s proposed construction because it repeatedly describes a “representation,

of the data object” as being located at the user’s node (“in the first data storage”). (See, e.g., EX2002 ¶¶8–13, 109, 135; EX2005, ¶74.) Further, “**when [the representation is] accessed[,]**” the user “**access[es] the data object from the second data store**” (i.e., the server) rather than from within the representation at the user’s node. (*Id.*; EX2005, ¶74.)

IV. LEGAL PRINCIPLES

A. Priority and Written Description

“The priority date for later-added patent claims depends on when the claimed subject matter first appeared in the chain of patent applications from which the claims arose.” *Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 906 (Fed. Cir. 2018). “For claims to be entitled to a priority date of an earlier-filed application, the application must provide adequate written description support for the later-claimed limitations.” *Id.*

The test for written description involves “an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “The invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991). “A specification adequately describes an invention when it ‘reasonably conveys to those skilled in the art that the inventor had possession of

the claimed subject matter as of the filing date.” *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 1335 (Fed. Cir. 2021) (quoting *Ariad*, 598 F.3d at 1351). The invention need not be described using the same terms. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

Originally filed claims are considered in the § 112 analysis. *Allergan USA, Inc. v. MSN Labs. Priv. Ltd.*, 111 F.4th 1358, 1374 (Fed. Cir. 2024). The written description inquiry also requires that the specification and any references incorporated by reference be evaluated together. *Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 911 (Fed. Cir. 2018). By incorporating material by reference, “the material is effectively part of the host document as if it were explicitly contained therein.” *Paice LLC v. Ford Motor Co.*, 881 F.3d 894, 906–07 (Fed. Cir. 2018) (citing *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000)).

B. Prior Art Available Under 35 U.S.C. § 311(b)

Congress strictly limited the scope of IPRs. “A petitioner in an inter partes review” may challenge claims as unpatentable “only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). Thus, a reference may not serve as a basis for an IPR unless it is “a prior art patent or prior art printed publication.” *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367, 1375 (Fed. Cir. 2022).

Patent applications published only after the challenged patent’s priority date, and ultimately abandoned, are neither prior-art patents nor prior-art printed publications under § 311(b). They are not prior art “patents” because they never issued as patents. *Brown v. Guild*, 90 U.S. 181, 210–11 (1874); *In re Wertheim*, 646 F.2d 527, 532 (CCPA 1981). And they are not prior-art “printed publications” because they were “not publicly accessible before the critical date.” *Acceleration Bay, LLC v. Activision Blizzard, Inc.*, 908 F.3d 765, 772 (Fed. Cir. 2018). So they cannot serve as the basis for challenging patents in IPR.

C. Obviousness

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.

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); *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).

V. PETITIONER HAS NOT MET ITS BURDEN FOR ANY CLAIM

Petitioner has not demonstrated that a POSITA would have found the challenged claims obvious on any ground. (EX2005, ¶82.)

A. The Challenged Claims Are Entitled to At Least a September 25, 2012 Priority Date

The challenged claims have written-description support in the Original Applications, both of which the '520 patent claims priority to and incorporates by reference in their entirety. (EX2005, ¶83.) For purposes of this proceeding, PO relies on the September 25, 2012 filing date of the '635 application, which incorporated by reference the entire contents of the '906 application. Exemplary supporting citations for each challenged claim are set forth the written description support chart appended to the Declaration of Dr. Smith. (EX2005 at Appendix 1).

In a prior litigation, Nos. 20-cv-00251-ADA and 21-cv-758-ADA (W.D. Tex.) (the “Dropbox litigation”), PO alleged Dropbox infringed predecessor patents to the '520 patent. Dropbox challenged their priority date and PO opposed (EX2010). The District Court, citing to Dr. Smith’s supporting declaration (EX2011) and deposition testimony (EX2012), denied Dropbox’s motion (EX2013). Here, again, Dr. Smith provides irrebuttable support for the challenged claims’ September 25, 2012, priority date. (EX2005, Appx. 1.)

Therefore, the challenged claims are entitled to a priority date as least as early as September 25, 2012. (EX2005, ¶85.)

B. *Riepling* Does Not Qualify As a Prior Art Patent Application Under 35 U.S.C. § 311(b), So All Grounds Fail

Riepling is a patent application filed in 2011, published in 2013, and then abandoned. (EX2014.) Petitioner uses *Riepling* as the primary reference in each of its Grounds.

Meanwhile, the priority date of the challenged claims is at least as early as 2012, which is before *Riepling*'s publication date in 2013. Therefore, under 35 U.S.C. § 311(b), *Riepling* is not available as prior art to the '520 patent in this *inter partes* review proceeding unless it qualifies as a "printed publication" as of its filing date in 2011 rather than its publication date in 2013. Under § 311(b) and Federal Circuit caselaw, it does not.

1. Under § 311(b), Abandoned Patent Applications—Unlike Patents—Are Available as Prior Art Only as of Their Publication Date²

Section 311(b) provides:

A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only

² This issue is currently before the Federal Circuit in *VLSI Tech. LLC v. Patent Quality Assurance LLC*, No. 23-2298 (Fed. Cir.), except that Patent Owner advances additional arguments in support of *Riepling* not being available as prior art which Patent Owner respectfully requests the Board address in order to have a fully developed record for any potential appeal.

on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

35 U.S.C. § 311(b).

Importantly, § 311(b) lists “patents” and “printed publications” as separate prior-art categories, even though patents become printed publications once they issue as patents. Yet § 311(b) does not list patent *applications* as a separate prior-art category, even though patent applications become printed publications once they are published. So Congress must have understood “patents” and “printed publications” to be separate concepts in § 311(b), with patents being subject to different treatment such as qualifying as prior art as of their 102(e) date. But not so for patent applications, which Congress left out altogether—presumably on purpose. Tellingly, printed publications are mentioned in 102(a) and 102(b), but *not* 102(e), which refers to patents and patent applications. There is no statutory basis for 102(e) to printed publications; doing so would render the inclusion of “patents” separately from “printed publications” in § 311(b) meaningless.

The distinction between the various categories of prior art can be confirmed by comparing § 311(b) to other patent statutes. For example, pre-AIA § 102 lists “patent[s]” and “printed publication[s]” as separate categories of prior art (§ 102(a)–(b))—but then lists “application[s] for patent” as its own category (§ 102(e)(1)). Likewise, the current AIA version of § 102 lists “patent[s],” “printed

publication[s],” and “application[s] for patent” as separate prior-art categories. § 102(a)(1)–(2). There is no reason to conclude that Congress conflated any of these categories when drafting § 311(b).

Moreover, Congress knew how to make additional categories of prior art available to patent challengers in other contexts. For example, in infringement litigations, Congress allows patent challengers to use prior art from any category listed in § 102.³ But in an *inter partes* review, Congress allowed only two of them: “patents” and “printed publications.” See § 311(b). In other words, Congress could have made other categories of prior art available to a Petitioner under § 311(b)—for example, “application[s] for patent”—but it did not, presumably “intentionally and purposefully[.]” See *Russello v. United States*, 464 U.S. 16, 23 (1983) (“[W]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.”).

³ See, e.g., 35 U.S.C. § 282(b)(2) (allowing defendants in infringement actions to assert invalidity “on any ground specified in part II [including § 102] as a condition for patentability”); see also § 321(b) (allowing a “petitioner in a post grant review” to challenge a patent “on any ground that could be raised under” § 282(b)(2)–(3)).

In sum, § 311(b) distinguishes “patents” from “printed publications,” but does not list “patent applications” at all. So, unlike for patents—which a petitioner can use as prior art under § 311(b) as of the patent’s earliest priority date, regardless of public accessibility—there is no reason to treat patent applications differently than any other printed publication under § 311(b). Either a patent application becomes a patent and is treated as a “patent[]” under § 311(b), or it does not and is treated like any other printed publication under § 311(b). Congress could have treated patent applications differently, and it did in many other patent statutes, but not in § 311(b).

2. *Riepling* Is Not a Prior Art “Patent” Under § 311(b) Because It Never Issued as a Patent

A patent application cannot qualify as a “patent[]” under § 311(b) if the applicant abandons it before it issues as a patent. *See Brown v. Guild*, 90 U.S. 181, 210–11 (1874); *In re Wertheim*, 646 F.2d 527, 532 (CCPA 1981). *Riepling* was abandoned and never issued as a patent, so it does not qualify as a “patent[]” under § 311(b). (EX2014.)

3. *Riepling* Is Not a Prior Art “Printed Publication” Available Under § 311(b) Because It Was Not Publicly Accessible Before the Challenged Claims’ Priority Date

For a patent application to qualify as a “printed publication[,]” it must have been publicly accessible before the challenged claims’ priority date. *See Acceleration Bay, LLC v. Activision Blizzard, Inc.*, 908 F.3d 765, 772 (Fed. Cir.

2018). This has been well-settled law for over forty years, before and after the AIA. *E.g.*, *Valve Corp. v. Ironburg Inventions Ltd.*, 8 F.4th 1364, 1373 (Fed. Cir. 2021) (printed publication “must have been sufficiently accessible” “before the critical date”); *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012) (same); *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009) (same); *In re Klopfenstein*, 380 F.3d 1345, 1348 (Fed. Cir. 2004) (same); *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986) (same); *In re Bayer*, 568 F.2d 1357, 1359 (C.C.P.A. 1978).

Moreover, in an IPR, a “printed publication” under § 311(b) must be “prior art”—i.e., it must have “*exist[ed] at the time of the patent application*” for the challenged patent. *Qualcomm*, 24 F.4th at 1374–75 (emphasis in original). A reference cannot retroactively qualify as a “printed publication” even if it later becomes publicly available after the critical date. *See Acceleration Bay*, 908 F.3d at 773–74; *Infobridge*, 929 F.3d at 1370; *cf. Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 139 (Fed. Cir. 1986) (mailed document becomes “effective as a printed publication under § 102 on the date it reaches the addressee” rather than on the earlier “date of mailing”).

Here, the PTO did not publish *Riepling* until 2013, after the challenged claims’ priority date in 2012. On and before the challenged claims’ priority date, the public could not access *Riepling* because patent applications are confidential

until they are published. *See* 35 U.S.C. § 122(a). Therefore, *Riepling* is not a prior art “printed publication” under § 311(b).

This is consistent with Federal Circuit caselaw. In *In re Lister*, the Court held that a reference did not qualify as a “printed publication”—even though it was available for public inspection at the U.S. Copyright Office—because there was no evidence that POSITA “exercising reasonable diligence” “would have been able to learn of its existence and potential relevance prior to the critical date.” *In re Lister*, 583 F.3d 1307, 1311, 1314–17 (Fed. Cir. 2009). Likewise, in *Cordis Corporation*, the Court found a reference did not qualify as a “printed publication” even though it had been shared with others who, unlike the PTO, were not statutorily required to keep it confidential. *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1335 (Fed. Cir. 2009).

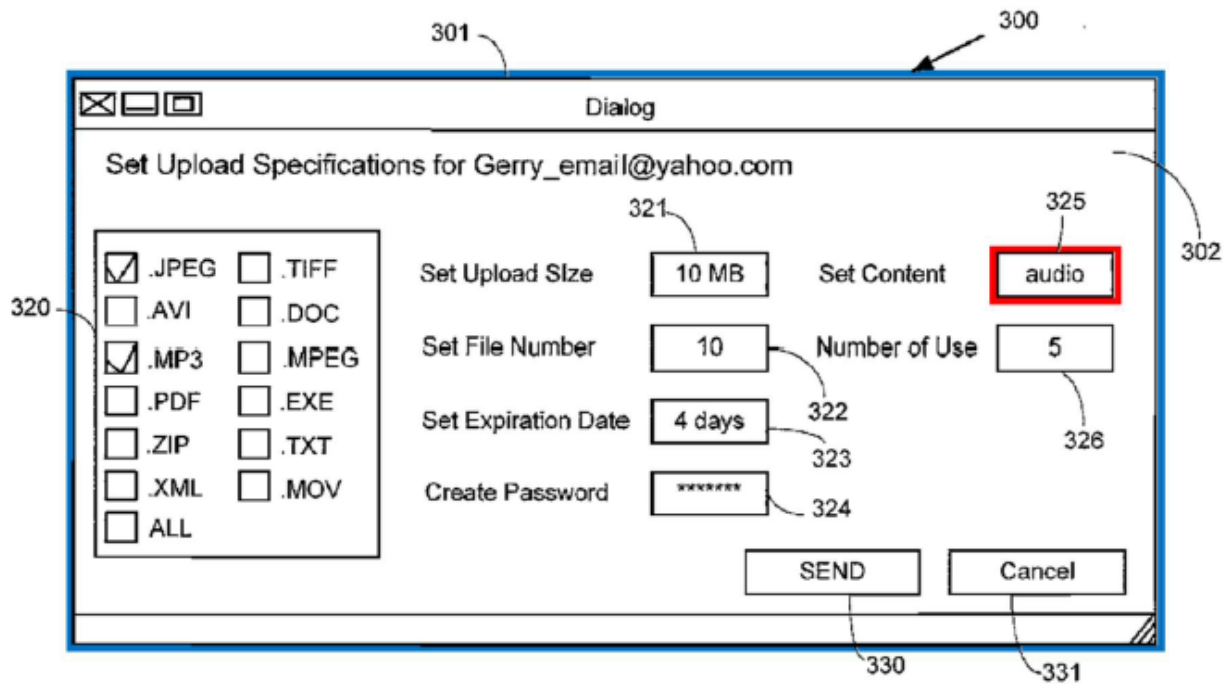
The references in *Lister* and *Cordis* were both more accessible than *Riepling* was as of the challenged claims’ priority date, yet neither reference qualified as a prior art “printed publication.” So too here. Under *Lister* and *Cordis*, *Riepling* does not qualify as a prior art “printed publication” available under § 311(b). And *Riepling* never issued as a patent. The Board should treat it like any other “printed publication” that was not published until 2013 and not allow it to be used here. And because *Riepling* forms the basis of every Ground in the Petition, the Petition fails.

C. Grounds 1 and 3: Petitioner Has Failed to Show that Claims 9, 10, 14, and 15 Are Obvious Over *Riepling* or *Riepling* and *Meisels*

Petitioner has failed to show that *Riepling* alone or in combination with *Meisels* renders claims 9, 10, 14 and 15 obvious. (EX2005, ¶ 86.)

1. *Riepling* Does Not Teach Claim Element 9[b] Because It Does Not Teach “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”

Riepling’s Figure 3 shows a “**dialog 301**” with an “upload parameter interface 302.” (EX2005, ¶ 87.) Within that upload parameter interface 302, *Riepling* shows—but does not describe—what Petitioner calls “**content field 325**”:



(EX1107, Fig. 3 (annotated); *Id.*) Petitioner argues that this “**content field 325**” in Figure 3 teaches claim element 9[b]’s “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 18–19.) But *Riepling* does not teach that Petitioner’s “**content field 325**” is a file description, nor does *Riepling* teach anything about it at all. (EX2005, ¶87.)

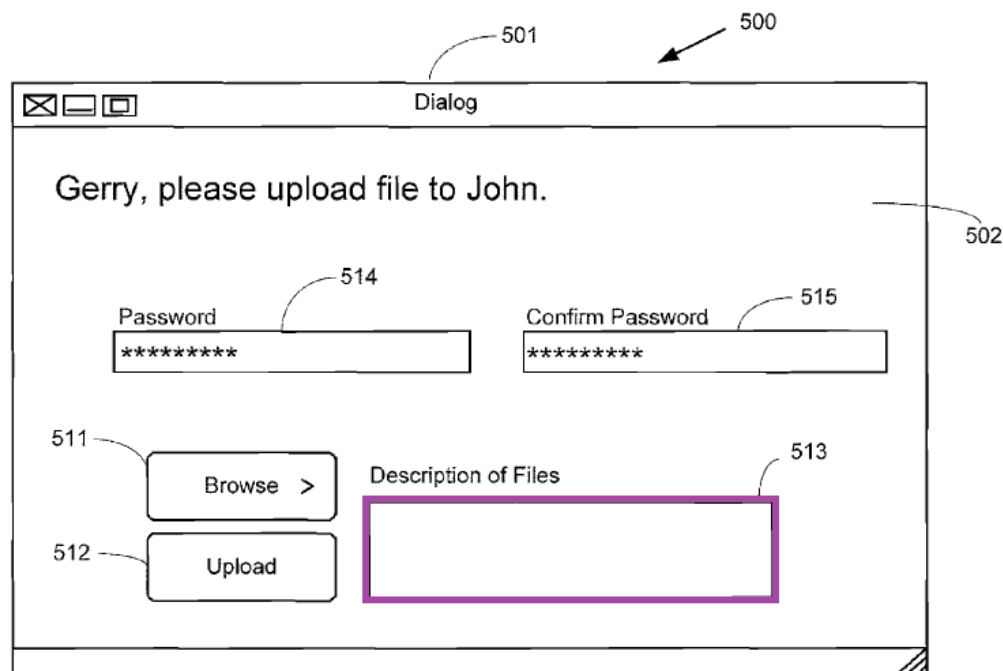
First, *Riepling* does not describe Figure 3’s “**325**” anywhere in its specification. (EX2005, ¶88.) At most, *Riepling* provides two words next to it in Figure 3: “Set Content.” (EX1107, Fig. 3; *Id.*) The phrase “Set Content” does not appear in the specification either. (EX2005, ¶88.)

Second, the word “audio,” which is inside “**content field 325**,” appears only twice in the specification, both times describing the MP3 audio format. (EX1107 ¶¶30-32; EX2005, ¶89.) Neither the “**content field 325**” nor its contents are mentioned in the specification outside of being shown in Figure 3. (EX2005, ¶89.)

Third, *Riepling* does not teach that “**content field 325**” includes a textbox. (EX2005, ¶90.) At most, *Riepling*’s paragraph 32 of *Riepling* notes that “upload parameter interface 302” can ensure that “files uploaded into their registered user accounts contain only a single type of data.” (*Id.*; EX1107 ¶32.) But it does not specify that “**content field 325**” includes a “textbox” (e.g., it could be a dropdown list or other type of selection area), or “describ[es] the at least one file[.]”

(EX2005, ¶90.) In fact, in Figure 3, “**content field 325**” includes the word “audio” while field 320 has a checkmark next to “.JPEG,” which is a file format that does not include audio. (*Id.*) Contrary to the assertions of Petitioner’s expert, a POSITA would not have understood field “**325**” to “describ[e] the at least one file” being requested—it does not even describe the checked box in the same file-request interface. (EX2005, ¶90.)

Fourth, *Riepling* teaches that file descriptions are included in the response to the file request instead of the file request itself. (EX2005, ¶91.) This is shown in Figure 5, in “**file description text field 513**,” labeled “Description of Files”:



(*Id.*; EX1107 at Fig. 5, ¶¶41-43.) In particular, *Riepling* states that “[f]ile **description text field 513** may receive a textual description of the one or more data files chosen for uploading.” (EX1107, ¶43; EX2005, ¶91.) In other words,

Riepling's file-request recipient (i.e., the uploader) at the second node must add the “**file description**” for the files he is uploading, not the file requestor at the first node. (EX2005, ¶91.) But this is the opposite of the '520 patent's teaching. (*Id.*)

The '520 patent states:

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 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.

(EX1001, 2:1–10). Accordingly, the '520 patent's claimed apparatus receives the file description from the file requestor, not the file-request recipient, so that the file-request recipient can “interpret the request and find a file or other data object that seems to match the request.” (*See id.*; EX2005, ¶91.) *Riepling* does not address this problem and is otherwise silent as to Petitioner's “**content field 325**.” (EX2005, ¶91.) Therefore, *Riepling* does not teach claim element 9[b]. (*Id.*)

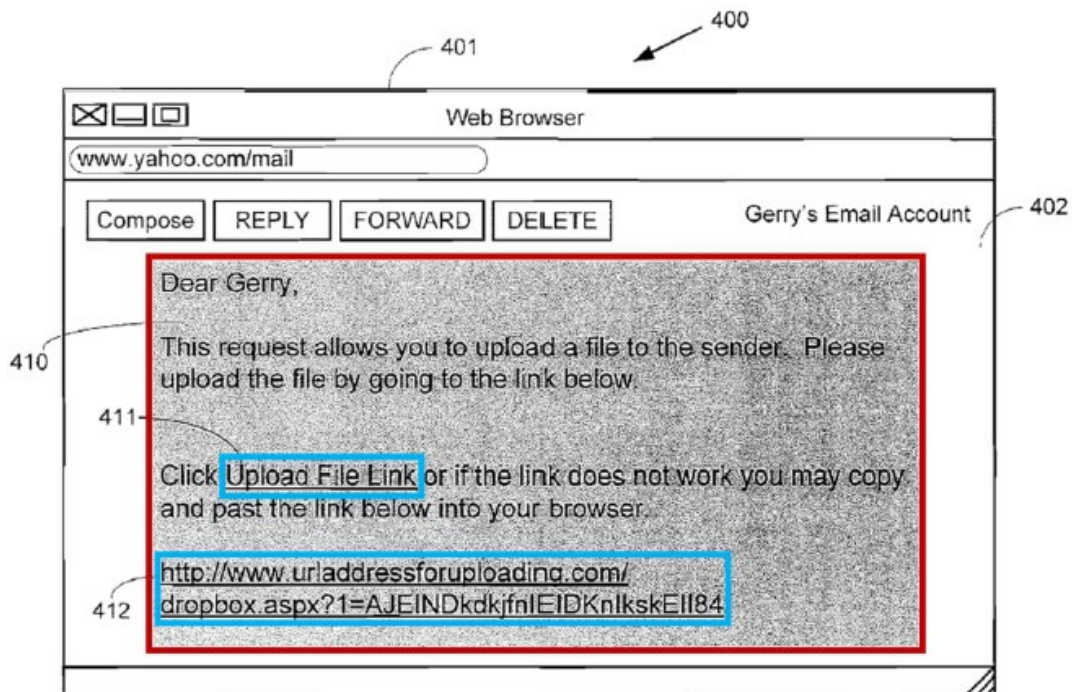
Nonetheless, the Board's Institution Decision found that *Riepling*'s inclusion of a file description in “the Figure 5 response” to the file request “does not undercut Petitioner's reliance on set content field 325” as a file description in the file request itself. (Paper 11 at 29.) But the Board overlooks *Riepling*'s insistence that file descriptions be included in the response to the file request (i.e., in Figure 5) rather than the file request itself (i.e., in Figure 3). (*See* EX1107, Fig. 5, ¶43;

EX2005, ¶92.) In other words, *Riepling* does not teach a system with file descriptions in both the file request and response messages—rather, *Riepling* teaches only one “**file description text field 513**,” and it appears only in the Figure 5 response. (EX2005, ¶92.) Moreover, a POSITA would not have understood Figure 3’s file request to include a “file description” because “**content field 325**” says only “audio,” which does not describe the requested .JPEG files because, by definition, JPEG files do not include audio. (*Id.*) The Board’s determination makes no sense in particular when looking at claim element 9[g], which requires “a first message” that includes “the file description describing the at least one file in connection with the file request.” (*Id.*)

2. ***Riepling* Does Not Teach Claim Element 9[g] Because It Does Not Teach a “first message” That Indicates “at least one of the date or the time on which the file request is based” and “the file description describing the at least one file in connection with the file request”**

Petitioner admits that *Riepling* does not teach two limitations of claim element 9[g]. (Pet. at 30 (noting that *Riepling* “does not explicitly indicate” claim element 9[g]’s “date or the time” limitation, and “does not explicitly include” claim element 9[g]’s “file description” limitation).) Moreover, claim element 9[g] recites that its “first message” is “based on” those two missing limitations. Therefore, *Riepling* fails to teach claim element 9[g]. (EX2005, ¶93.)

Petitioner nonetheless argues that *Riepling*’s “**digital invitation 410**,” shown in Figure 4, corresponds to the claimed “first message”:

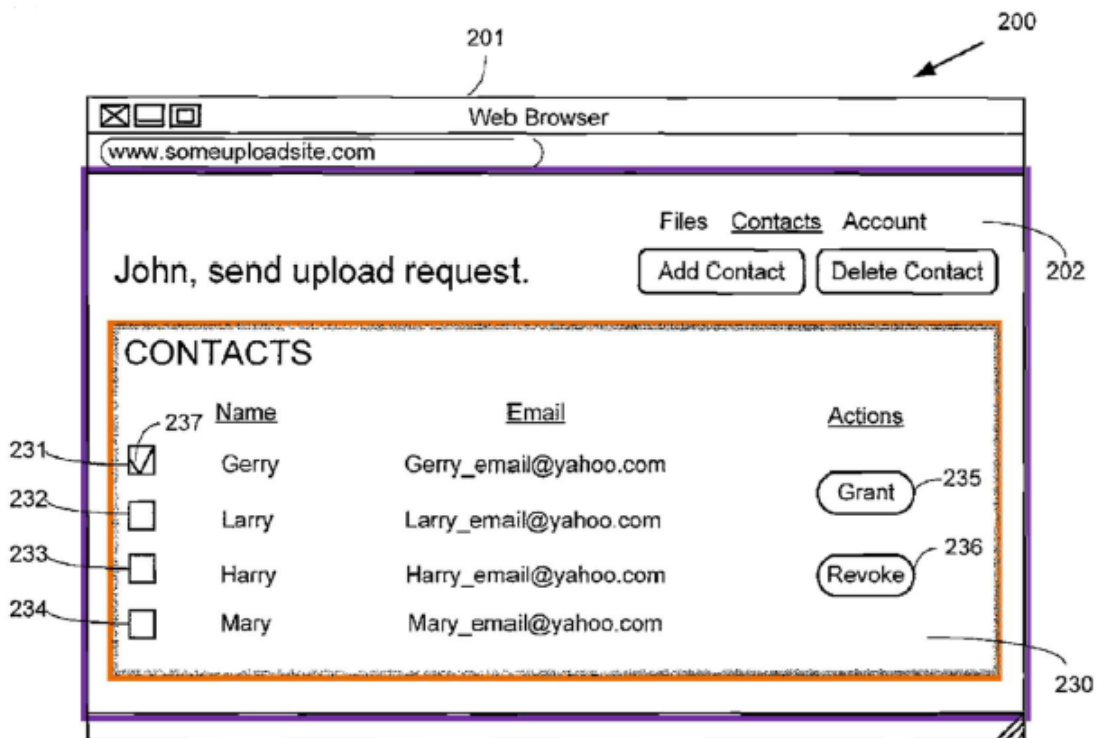


(EX1007, Fig. 4.) But this **digital invitation 410** does not include the “date or time on which the file request is based,” nor the “file description describing the at least one file in connection with the file request,” nor any other information collected by the interface shown in Figure 3’s file request. (EX2005, ¶94.) Indeed, even if the text from Figure 3’s **content field 325** (i.e., “audio”) were considered to be a “file description,” that file description does not appear in the **digital invitation 410**. (*Id.*)

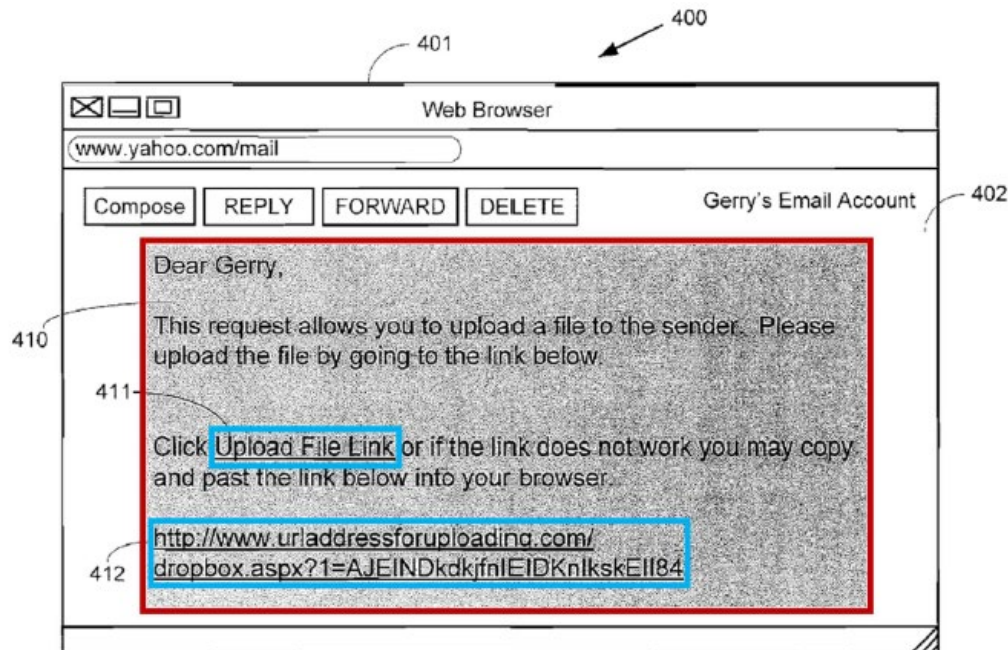
Nonetheless, Petitioner argues that *Riepling* teaches that its **digital invitation 410** may be “restricted by the one or more upload parameters specified in upload parameter dialog 301.” (Pet. at 30.) But claim element 9[g] claims more than merely “restrict[ing]” the first message: i.e., the first message must “indicat[e] . . . the date or the time on which the file request is based,” and “further includ[e] . . . at least one sentence including the file description[.]” (EX2005, ¶95.) *Riepling*’s **digital invitation 410** does neither. (*Id.*) Indeed, antecedent basis for “the file description” requires that it be not just any file description but the file description from claim element 9[b], which was absent there and is absent again here. (*Id.*)

In fact, *Riepling*’s **digital invitation 410** may be generated after the user selects which recipients will receive the file request via the **request interface 202** shown in *Riepling*’s Figure 2, without regard to any information collected by

Riepling's file-request interface in Figure 3. (EX1107 ¶26 (“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”; EX2005, ¶96.) Yet in Figure 2's **request interface 202**, only a **list of contact information 230** is selectable:



(EX1007, Fig. 2; *Id.*) No “date or time” or “file description” is possible to add or select. (EX2005, ¶96.) Thus, any “digital invitation” that is created based on Figure 2's **request interface 202** would not include these limitations of claim element 9[g]. (*Id.*) And *Riepling*'s **digital invitation 410** does not include them either:



(EX1107, Fig. 3; *Id.*)

The Board noted that “[a]t this stage, Patent Owner appears to be incorrect in asserting that digital invitation 410 is sent after grant access button 235 [in Figure 2] is selected” (Paper 11 at 30.) But Patent Owner does not argue that selecting the grant access button 235 in Figure 2’s **request interface 202** *sends* the **digital invitation 410**, but rather that selecting the grant access button 235 allows the content sharing service 105 to “*begin creating*” it, as stated in *Riepling*’s ¶26. (POPR, 28–29; EX2005, ¶97.) And at that point, neither of claim 9[g]’s required limitations (i.e., “date or time” or “file description”) would have been specified. (EX2005, ¶97.)

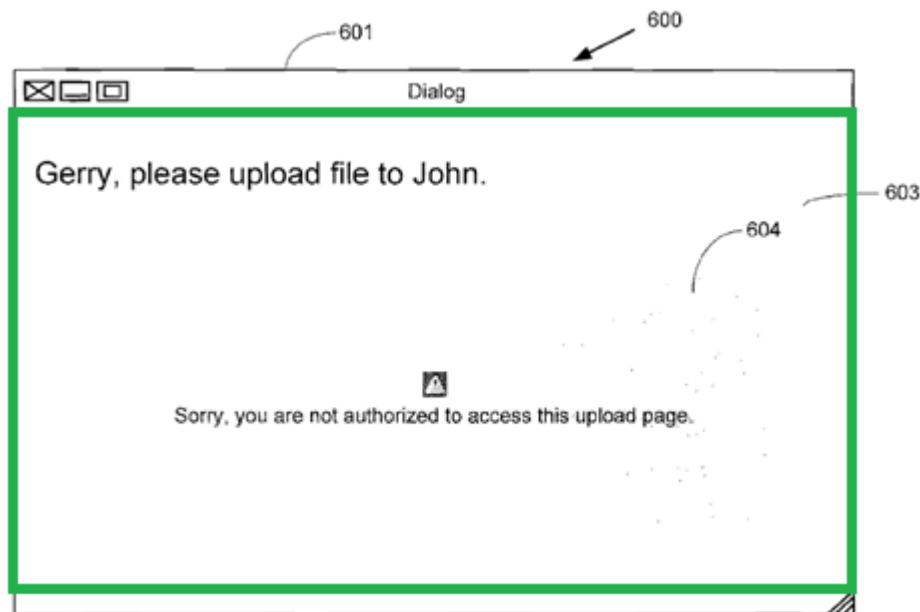
Petitioner admits that *Riepling*’s “**digital invitation 410**,” shown in FIG. 4, does not indicate the claimed “date or time” or “file description,” but alleges that it

would be “an obvious design choice.” (Pet. at 30.) Yet Petitioner fails to describe any motivation to modify *Riepling* in such a way or why such a design choice would be obvious. (EX2005, ¶98.) Precedent requires that there be some reason, and Petitioner provides none. Therefore, Petitioner has failed to meet its burden. *See, e.g., Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016) (“‘common sense’—whether to supply a motivation to combine or a missing limitation—cannot be used as a wholesale substitute for reasoned analysis and evidentiary support, especially when dealing with a limitation missing from the prior art references specified.”); *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.

At most, Petitioner cites to a line from the specification indicating that the **digital invitation 410**, 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 (EX1107 ¶34).) But whether upload parameters are *restricted* has no bearing on what is *indicated* in the invitation. (EX2005, ¶99.) Indeed, *Riepling* accounts for restrictions using a separate interface, **blocked interface 603**:

[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.

(EX1107 ¶ 47; *Id.*) **Blocked interface 603** is shown by FIG. 6:



(EX2005, ¶99.)

In sum, *Riepling* does not teach 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 **digital invitation 410**, as required by the claim element 9[g]. (EX2005, ¶100.) Instead, Petitioner uses the ’520 patent as a roadmap to support its argument, which is improper hindsight. (*Id.*; EX1001, 2:1–10) Notably, Petitioner filed patent applications on file-request functionality years later, which suggests that the file-request inventions of the ’520 patent were not obvious. (*E.g.*, EX2003; EX2005, ¶ 100.)

Notwithstanding the above, the Institution Decision found Petitioner’s expert opinion persuasive. (Paper 11 at 30–31.) However, for purposes of the Institution

Decision, the Board did not have the benefit of Patent Owner’s expert opinion, submitted herewith. First, the “file description” could not have been included in *Riepling*’s invitation because it does not exist at the request stage, as described above. (EX2005, ¶101.) Second, the digital invitation is created before the upload parameters are set, and there is otherwise ***no indication in the specification*** that any such parameters are included in an invitation. (*Id.*) Indeed, the message sent requesting a file from a contact does not include the “file description” in the message or an indication of the date/time on which it is based. (*Id.*) Petitioner and its expert fail to adequately describe how or why such a design choice would be obvious given *Riepling*’s shortcomings. (*Id.*)

3. *Riepling* Does Not Teach Claim Element 9[1] Because It Does Not Teach “a second message that includes an eighth user interface element, and that does not include a file attachment with the second message”

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 EX1107 ¶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. (EX2005, ¶102.)

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. (EX2005, ¶ 103.) So no files exist that could be accessed or included as attachments. (*Id.*) Moreover, the initial digital invitation is being sent to a person that **does not have a registered user account**. (EX1107 ¶¶21, 29, 30, 56; *Id.*) The alert message is provided to **a “user account”** in contrast. (EX1107 ¶45; EX2005, ¶103.) The opposite is true **after** files have been uploaded, and the specification is silent regarding the contents of any “notification message.” (EX2005, ¶103.)

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[.]” (EX1107 ¶49; EX2005, ¶104.) There is no indication that this interface may be accessed via a “notification message.” (*Id.*)

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*.” (EX1107 ¶45; EX2005, ¶105.) 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.” (EX1107 ¶45; EX2005, ¶105.) 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. (EX2005, ¶105.) In particular, the language of claim 9 requires that the “eighth 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* element 9[o], Pet. at 86–87.) No such teaching is found in *Riepling*. (EX2005, ¶105.)

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 ¶109), Petitioner fails to describe *any* motivation to modify *Riepling* in such a way or why such a design choice would be obvious. (EX2005, ¶106.) Precedent requires that there be some

reason. Petitioner provides none. Therefore, Petitioner has failed to meet its burden of obviousness. *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. (EX2005, ¶107.)

4. *Riepling* Does Not Teach 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. (EX2005, ¶ 108.)

5. *Riepling* Does Not Teach Claim 14

a. *Riepling* Does Not Teach Claim Element 14[b]

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]. (EX2005, ¶109.)

b. *Riepling* Does Not Teach Claim Element 14[d]

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]. (EX2005, ¶110.)

c. *Riepling* Does Not Teach Claim Element 14[j]

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]. (EX2005, ¶111.)

6. *Riepling* Does Not Teach 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. (EX2005, ¶112.)

In addition, claim 15 recites that “the first message and the second message are email messages.” Petitioner admits that this claim element is not taught by *Riepling*, instead asserting it to be “conventional” because email “is so popular.” (Pet. at 47.) Regardless of email’s so-called “popularity” at the time of invention, *Riepling*’s alerts are sent only “within [*Riepling*’s] content sharing service,” ***not*** via email. (EX1107 ¶45; EX2005, ¶113.) This results in a situation such that the requesting, ***registered*** user will ***never*** receive an email response from a requestee, ***unregistered*** user. (EX1107 ¶¶21, 29, 30, 56; EX2005, ¶113.) *Riepling* makes no allowances or exceptions in this regard and does not teach or make obvious this element of claim 15. (EX2005, ¶113.)

Petitioner has therefore failed to demonstrate that claims 9, 10, 14, and 15 are rendered obvious over *Riepling*. Therefore, Ground 1 of the Petition fails. (EX2005, ¶114.)

7. For Ground 3, *Meisels* Does Not Cure *Riepling*'s Deficiencies

Ground 3 relies on both *Riepling* and *Meisels* for claims 9, 10, 14 and 15, but *Meisels* fails to disclose the missing elements noted above. (EX2005, ¶115.) Indeed, Petitioner does not even assert that *Meisels* discloses claim elements 9[b], 9[g], or 15 and purports to rely on *Meisels* only for elements 9[l] and 14[j]. (Pet. at 65–66.) Otherwise, Petitioner relies on Petitioner's arguments in Ground 1 regarding all other required claim elements of independent claims 9 and 14 and dependent claims 10 and 14. (Pet. at 59–64.) As described above, Petitioner's arguments fall short because *Riepling* does not teach or suggest every element of independent claims 9 and 14, or their dependent claims 10 and 15. Therefore, Ground 3 of the Petition fails. (EX2005, ¶115.)

With respect to claim element 9[l], Patent Owner refutes *Riepling*'s teachings with respect to Ground 1, above. *Meisels* “discloses an electronic message with an automatically inserted [] link to a document in place of the document attachment itself.” (Paper 11 at 21.) But *Meisels*'s process is divorced entirely from any other interfaces or software processes. (EX2005, ¶116.) A user must manually create an email, manually confirm to upload an attachment to insert

a link to the attachment, and manually send the email to its recipient. (*Id.*; EX1108 ¶¶3, 37, 59) Then, selecting the link merely retrieves the attachment. (EX1108 at ¶ 23 (“Using the link generally retrieves the content that is pointed to by the link.”); EX2005, ¶116.)

In contrast, the claimed “second message” of claim element 9[l] is generated ***“in response to the receipt of the indication of the selection of the seventh user interface element”*** and “includes an eighth user interface element” such that the claimed apparatus will, “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.***” (claim elements 9[l] and 9[o].) Likewise, in claim element 14[j], the “claimed second message” of claim 14 element 14[j] is generated ***“in response to the receipt of the message associated with the selection of the fifth user interface element”*** and “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.” (claim elements 14[m]–[n].) There is no indication in *Meisels* of generating a message “in response to” anything, let alone that of the claimed “user interface

element[s].” (EX2005, ¶117.) There is also no indication in *Meisels* that selection of one of its inserted links can “cause . . . display of at least one fourth interface with a reference to” one of its uploaded attachments “for allowing access” to that attachment. (*Id.*)

Riepling does not make up for these deficiencies, and therefore, *Riepling*, alone or in combination with *Meisels*, does not teach or suggest every element of claims 9 and 14 does not render them obvious. (EX2005, ¶118.)

D. Grounds 3 and 4: Petitioner Has Failed to Show that Claims 9, 10, 14, and 15 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 *Meisels* and/or *Manzano*, does not teach or suggest every element of independent claims 9, 14, and 22, or their dependent claims 10–13, 15–16, 23, and 24. Therefore, Grounds 3 and 4 of the Petition fail. (EX2005, ¶119.)

With respect to claim element 9[l], Patent Owner refutes *Riepling*’s teachings with respect to Ground 1, above. *Meisels* “discloses an electronic message with an automatically inserted [] link to a document in place of the

document attachment itself.” (Paper 11 at 21.) But *Meisels*’s process is divorced entirely from any other interfaces or software processes. (EX2005, ¶120.) A user must manually create an email, manually confirm to upload an attachment to insert a link to the attachment, and manually send the email to its recipient. (*Id.*; e.g., EX1108 ¶¶3, 37, 59.) Then, selecting the link merely retrieves the attachment. (EX2005, ¶120; EX1108 ¶23 (“Using the link generally retrieves the content that is pointed to by the link.”).)

In contrast, the claimed “second message” of claim element 9[l] is generated ***“in response to the receipt of the indication of the selection of the seventh user interface element”*** and “includes an eighth user interface element” such that the claimed apparatus will, “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.***” (claim elements 9[l] and 9[o].) There is no indication in *Meisels* of generating a message “in response to” anything, let alone that of the claimed “user interface element[s].” (EX2005, ¶121.) There is also no indication in *Meisels* that selection of one of its inserted links can “cause . . . display of at least one fourth interface with a reference to” one of its uploaded attachments “for allowing access” to that attachment. (*Id.*)

Riepling does not make up for these deficiencies, and therefore, *Riepling*, alone or in combination with *Meisels*, does not teach or suggest every element of claim 9 and does not render claim 9 obvious. (EX2005, ¶122.)

E. Grounds 2, 4, 5 and 6: Petitioner Has Failed to Show that Claims 11–13, 16, and 22–24 Are Obvious over any combination of *Riepling*, *Manzano*, *Meisels* and *Garcia* under 35 U.S.C. § 103

With regard to claims 11–13 and 16, and 22–24, Petitioner has failed to show that the combination of *Riepling*, *Manzano*, *Meisels*, and *Garcia* makes obvious each and every element of the challenged claims. (EX2005, ¶123.)

1. These Grounds Fail for the Same Reasons as Grounds 1 and 3 with Respect to *Riepling* and *Meisels*

a. 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.) Likewise, Petitioner purports to rely on *Garcia* only for claim elements of dependent claims 11 and 16. (Pet. at 71–72.) Petitioner does not rely on either *Manzano* or *Garcia* for independent claims 9 or 14, which, as set forth above, are not obvious over *Riepling* alone or in combination with *Meisels*. (EX2005, ¶124.) Therefore, for the reasons set forth above with respect to Grounds 1 and 3, Petitioner has not demonstrated that claims 11–13 and 16 are rendered obvious over *Riepling* alone or in combination with *Meisels* in further view of *Manzano*, or both *Manzano* and *Garcia*. (*Id.*)

b. Claims 22–24

Petitioner purports to rely on *Manzano* and *Garcia* only for elements 22[h], 22[j], and 22[k]. (Pet. at 59–64, 71–72.) Otherwise, Petitioner relies on *Riepling* and Petitioner’s arguments regarding independent claim 9 for independent claim 22. (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.) For at least the reasons described above with respect to Grounds 1 and 3, *Riepling* does not teach or suggest all of these elements of claim 9, including for example, the “file description” aspects for element 9[b], 9[g], and/or 9[l] described above and neither *Meisels*, *Manzano* nor *Garcia* cure those deficiencies. (EX2005, ¶125.) Therefore, Grounds 2, 4, 5 and 6 fail for the same reasons. (*Id.*)

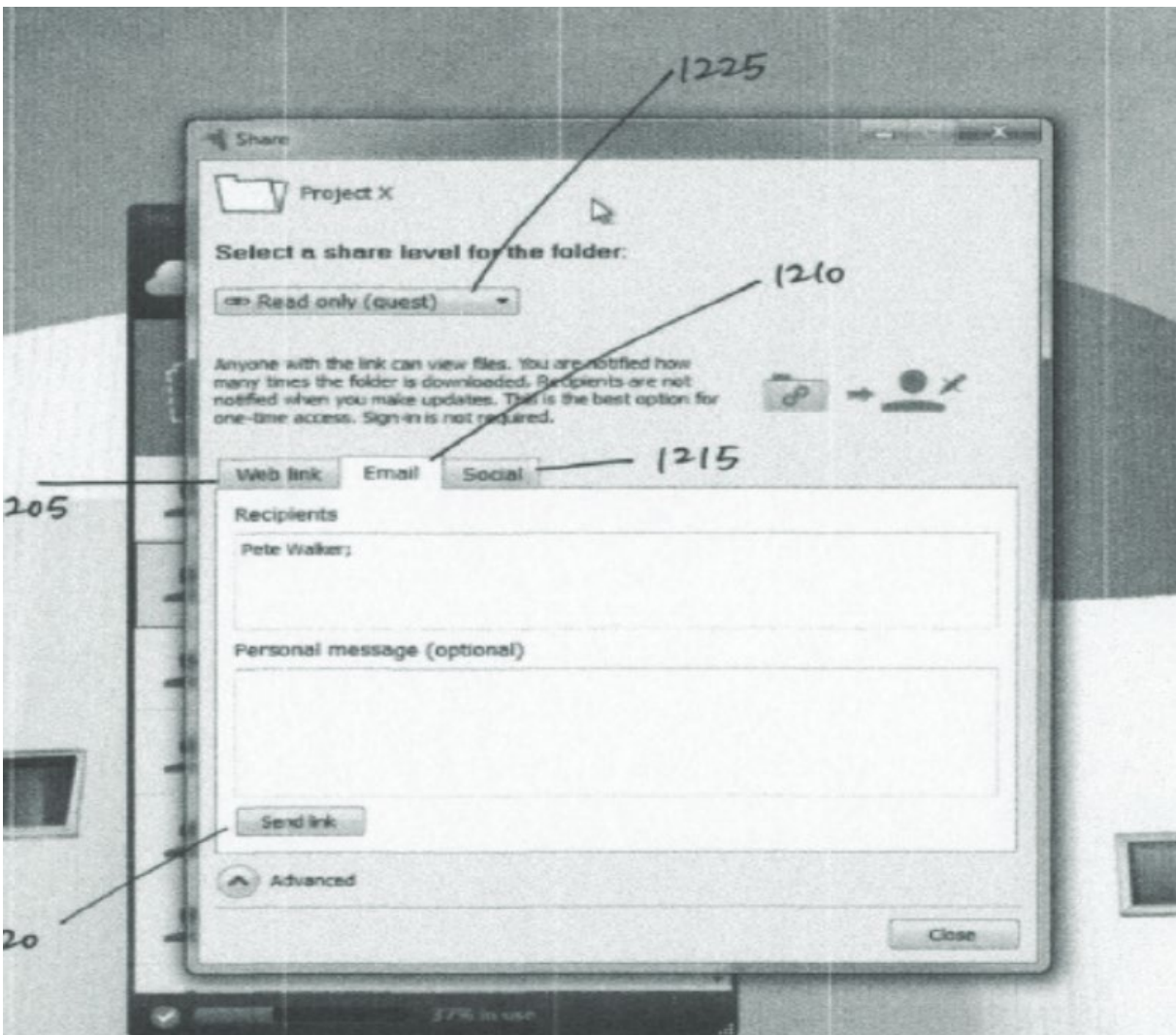
2. Grounds 2, 4, 5 and 6 Also Fail Because No Reference Discloses the Creation of a Representation of the at Least one File in a Location Among One or More Folders on the File Explorer Interface as Claims

Claims 11–13, 16 and 22–24 require the capability to cause “a 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.” (EX2005, ¶126.)

Petitioner does not assert this is taught by *Riepling* and it is not taught by *Manzano*. (*Id.*) *Manzano* discloses that a recipient client is instructed “to set up an electronic file folder into which the transferred file will be place.” (*Id.*; EX1105 ¶ [0041].) It does not disclose a representation of a file being created in a location among one or more folders on a file explorer interface as recited in claims 11–13, 16 and 22–24. (EX2005, ¶126.) Indeed, *Manzano* only discloses transferring **files** into a specific folder that is created for the files. (*Id.*; *E.g.*, EX1105, ¶¶[0041], [0052].) It does not disclose the creation of a representation in a location among one or more folders on the client’s client-based file explorer application. (EX2005, ¶126; *E.g.*, EX1105, ¶¶[0041], [0052].)

Petitioner does not assert this limitation is taught by *Meisels* nor is it taught by *Garcia*. (EX2005, ¶127.) *Garcia* discloses that the recipient of a shared folder **does download** the **contents** of the shared folder at the node where the folder share invitation is received. (*Id.*) That the user’s **other devices** (e.g., different nodes) may show representations of the shared folder is beside the point. (*Id.*) *Garcia* does not disclose the creation of a representation at the node where the invitation to the shared folder is received. (*Id.*) *Garcia* discloses “in one embodiment, when a user drags a folder to a particular contact, **the folder** or **link to the folder** is automatically sent (via email, text, or other means) to the contact,” (EX1104, 11:16–19), and “when the contact clicks on the link to folder 115, the **contents** of

the folder are shared with the contact,” (EX1104, 11:29–31.) (EX2005, ¶127; *See also* EX1104 at 10:32–43 (web link to download).) A higher resolution image of Figure 12 available on PAIR is reproduced below and further demonstrates that the recipient of the folder share **downloads** the contents (i.e., files) in response:



(EX2006; EX2005, ¶127.) As shown above, the window shown in *Garcia* Figure 12 has “email” selected and states “Anyone with the link can view files. You are

notified how many times the folder is downloaded.” (EX2006; EX2005, ¶127.) At the bottom, there is a button stating “Send Link.” (EX2006; EX2005, ¶127.) Thus, *Garcia* discloses that the recipient of the shared folder receives a link and downloads the *contents* of the folder (*i.e.*, the files) when the link is accessed. (EX2005, ¶127.) It does **not** disclose the creation of a representation of the folder or any representation of the files at the receiving node. (*Id.*) For this reason, Petitioner has not shown that claims 11–13, 16, or 22–24 are unpatentable under any Ground. (*Id.*)

Therefore, Petitioner’s remaining Grounds fail for these additional reasons. (EX2005, ¶128.)

VI. CONCLUSION

For the foregoing reasons, the Petition should be denied.

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that there are 12,962 words in this paper, excluding any table of contents, table of authorities, mandatory notices under 37 C.F.R. § 42.8, certificate of word count, certificate of service, or appendix of exhibits. This certification relies on the word count of the word-processing system used to prepare this paper.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 1, 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.

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