

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

DROPBOX, INC.,

Plaintiff / Counterclaim
Defendant,

v.

MOTION OFFENSE, LLC,

Defendant / Counterclaim
Plaintiff.

Civil Action No. 6:20-cv-00251-ADA

JURY TRIAL DEMANDED

**MOTION OFFENSE, LLC'S OPPOSITION TO DROPBOX, INC'S
MOTION FOR PARTIAL SUMMARY JUDGMENT**

Dated: February 8, 2021

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I. INTRODUCTION

Motion Offense, LLC respectfully submits this Opposition to Dropbox, Inc.’s Motion for Partial Summary Judgment (D.I. 61) (the “Motion”). At issue is whether the asserted patents¹ are entitled to a priority date earlier than October 3, 2017. Dropbox alleges that prior to this date, there was no written description support for the purported “external messaging limitations” of the asserted claims. That is wrong. The asserted claims of the patents in suit are adequately supported by U.S. Patent Application Nos. (D.I. 61-4) (the “’906 application”) and 13/626,635 (D.I. 61-5) (the “’635 application”), (collectively the “Original Applications”).² Dropbox has failed to prove otherwise and meet its exacting burden.

To begin, Dropbox argues that an “external messaging node” is required regarding certain “send,” “receive,” and “generation” elements of the asserted claims. But the claims do not require any “external messaging node.” Moreover, even if this flawed interpretation was required, the Original Applications clearly disclose such an external messaging node and thus support an earlier priority date. Indeed, Dropbox fails to account for multiple disclosures in the Original Applications that provide support for the asserted claims.

Dropbox also errs by lumping all the claims together while only discussing the language of claims 1 and 3 of the ’158 patent in any detail, which it incorrectly asserts are “representative.” That is, Dropbox mistakenly assigns the *same interpretation to different limitations* without explanation, which undermines its entire Motion. The differences in claim language matter. Dropbox’s expert even admitted that at least one of the asserted claims *was*

¹ The five asserted patents are U.S. Patent Nos. 10,013,158 (D.I. 43 at Ex. A, the “’158 patent”), 10,021,052 (D.I. 43 at Ex. B, the “’052 patent”), 10,303,353 (D.I. 43 at Ex. C, the “’353 patent”), 10,587,548 (D.I. 43 at Ex. D, the “’548 patent”), and 10,613,737 (D.I. 43 at Ex. E, the “’737 patent”) (collectively the “patents in suit”).

² Motion Offense asserts that the claims of the patents in suit are entitled to a priority date of at least July 25, 2012, but refers to the Original Applications to rebut Dropbox’s flawed arguments.

entitled to priority to the Original Applications because of the different language used. Because Dropbox failed to analyze each claim separately, and its own expert admitted that one of the challenged claims is entitled to the earlier priority date, Dropbox's assertion that claims 1 and 3 of the '158 patent are representative fails, as does its entire motion which is based on the same.

In sum, and as set forth in more detail below, Dropbox's Motion should be denied.

II. BACKGROUND

The asserted patents are continuations-in-part ("CIPs") of the Original Applications. The family history of the asserted patents may be found in the Declaration of Michael Smith ("Smith Decl."), filed concurrently herewith, at ¶19. The specifications of the asserted patents are the same as the Original Applications with the exception of the inclusion of citations found in the "Related Application" section and the "Summary" section. (Smith Decl. at ¶20.) The inclusions do not alter the priority date of the asserted patents.

The asserted patents relate to methods and systems for sharing files, folders, and other data via a network without attaching the specific files, folders etc. to a message. (*E.g.*, '906 app., ¶¶3, 6, 11, 46, 60, 103, 111-114, 124, 127.) Instead, for example, a link to the specific files or folders may be included. (*Id.*) Fig. 5 of the '906 application shows a general depiction of an embodiment of the invention, with first and second nodes connected via a network that includes path nodes and a service provider node. (Smith Decl., ¶22.) The '906 application describes Figure 5 as illustrating exemplary devices for providing the execution environment of Figure 4, reproduced below as well. ('906 app., ¶103.)

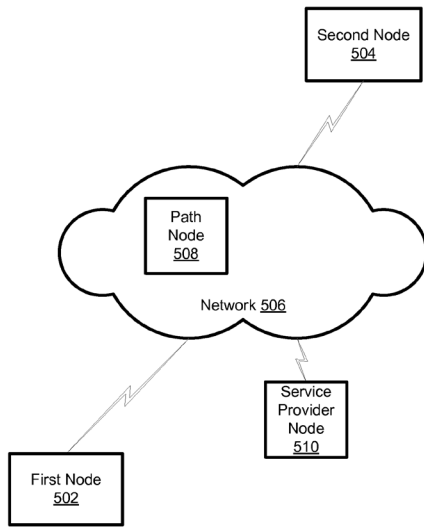


FIG. 5

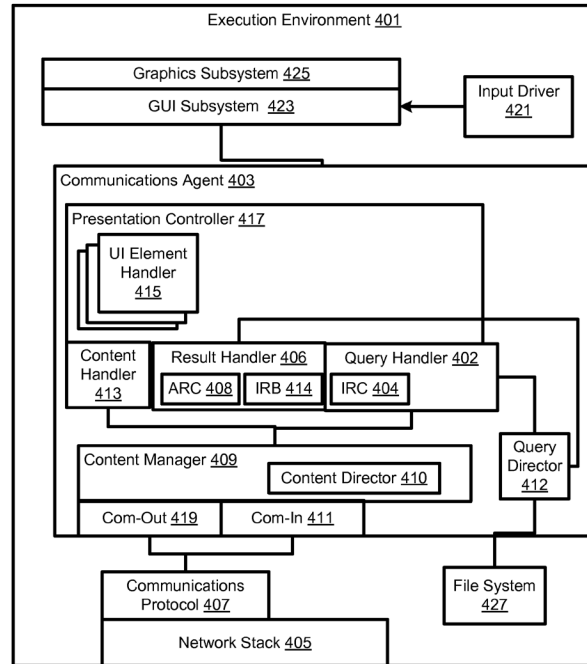


FIG. 4

The '906 application notes that Figure 4 is a block diagram illustrating components of Figures 3A and 3B, “that includes and/or otherwise is provided *by one or more nodes.*” ('906 app., ¶101.) The '906 application further notes that components in Figures 3A and 3B “may each be *distributed across more than one node and/or execution environment.* For example, such an arrangements [sic] *may operate at least partially on a browser in a one node and at least partially in a server in another node interoperating via a network.*” ('906 app., ¶102; Smith Decl., ¶23.)

The '906 application provides many examples of distributed configurations, including presenting one or more user-interface elements using a web-page received from a remote server. ('906 app., ¶50; Smith Decl., ¶24.) Figures 6A-G of the '906 application show various user interfaces that may be presented to a user. ('906 app., ¶¶20-26; Smith Decl., ¶24.) Because these interfaces may be provided using a browser interoperating with a server, this is but one example where the Original Applications describe *distributed versions* of the systems and methods with *additional nodes or servers.* (Smith Decl., ¶24.) This includes, for example, the

functionality regarding receiving “an indication of the at least one folder,” “indicia associated with at least one email address,” and “an indication to share the at least one folder” and “generation” of an email message. (Smith Decl., ¶24; *cf.* Mot. at 7.) Dropbox itself cites to Figs. 6D and 6E as disclosing email generation, (Mot. at 3), which, according to the Original Applications, may be implemented using *a web-page provided by a remote server*. (’906 app., ¶50; Smith Decl., ¶24.)

III. LEGAL STANDARD

A. Summary Judgment

Summary judgment is granted shall be granted “if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a); *see also Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). “A material fact is one that when resolved in favor of one party might affect the outcome.” *Sossamon v. Lone Star State of Tex.*, 560 F.3d 316, 326 (5th Cir. 2009). “A genuine issue arises when the evidence is sufficient for a reasonable jury to return a verdict for the nonmoving party.” *Id.* At summary judgement, it is **not** the judge’s function to weigh the evidence and determine the truth of the matter but rather to determine whether there is a genuine issue for trial. *Tolan v. Cotton*, 572 U.S. 650, 657 (2014). “As a general rule, summary judgment is inappropriate where an expert’s testimony supports the non-moving party’s case.” *Vasudevan Software*, 782 F.3d at 68 (quoting *Provenz v. Miller*, 102 F.3d 1478, 1490 (9th Cir. 1996)).

When present, genuine disputes over material facts should be resolved in favor of the non-movant. *Id.*; *see also Invitrogen Corp.*, 424 F.3d at 1379. Only when the non-movant’s arguments are “blatantly contradicted by the record, so that no reasonable jury could believe it” should a court reject the non-movants version of the facts. *Scott v. Harris*, 550 U.S. 372, 380-81 (2007). This is because summary judgment is a final adjudication on the merits, which must be

employed cautiously. *Hulsey v. State*, 929 F.2d 168, 170 (5th Cir. 1991). For that reason, if the court bases its opinion on theories not advanced by a party, it is required to give the other side notice and an opportunity to respond. Fed. R. Civ. P. 56(f).

B. Priority

Claims are entitled to a previous application's filing "so long as that application contains adequate written description under 35 U.S.C. § 112." *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d 1364, 1371 (Fed. Cir. 2011) (internal citation omitted.) Written description, and consequently questions of priority, are questions of fact that are highly context specific and thus should be dealt with on a case by case basis. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The test is whether the disclosure of the patent reasonably would have conveyed to a POSITA that the inventor had possession of the claimed subject matter as of the filing date. *Vasudevan Software v. MicroStrategy, Inc.*, 782 F.3d 671, 682 (Fed. Cir. 2015). In other words, written description is about whether a POSA can recognize that what is claimed corresponds to what is described; it is **not** about whether the patentee has proven to a POSITA that the invention works, or **how to make it work**, which is an enablement question.³ *CenTrak, Inc. v. Sonitor Techs.*, 915 F.3d 1360, 1366 (Fed. Cir. 2019). Regarding a continuation-in-part, "the key question is whether the descriptive matter is present in the original application, not whether it is also present in any added disclosure." *Nintendo of Am., Inc. v. iLife Techs., Inc.*, 717 F. App'x 996, 1001 (Fed. Cir. 2017).

Nor must a single embodiment disclose every claimed limitation. Indeed, "the specification's focus on one particular embodiment or purpose cannot limit the described invention where that specification expressly contemplates other embodiments and purposes." *ScriptPro LLC v. Innovation Associates, Inc.*, 833 F.3d 1336, 1341 (Fed. Cir. 2016). Likewise, a

³ Unless indicated otherwise, all emphasis in this Brief is added.

patent need not teach material that is common and well known. *Visual Memory LLC v. NVIDIA Corp.*, 867 F. 3d 1253, 1261 (Fed. Cir. 2017); *see also Loom Co. v. Higgins*, 105 U.S. 580, 586 (1881). Consequently, “[t]he written description does not require that every claimed element be illustrated in the figures, particularly in predictable arts and where the element not depicted is conventional and not ‘necessary for the understanding of the subject matter sought to be patented.’” *Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1362 (Fed. Cir. 2018) (quoting 35 U.S.C. § 113). A movant contesting the level of disclosure needed should explain *why* a POSITA would need to see such details in the specification; failure to do so presents a genuine dispute of material fact. *CenTrak, Inc.*, 915 F.3d at 1368.

IV. ARGUMENT

A. The Asserted Claims Add No New Matter Compared to the Original Applications

Dropbox goes to great lengths to insinuate that “new matter” was added to the CIPs of October 3, 2017. In its Motion, Dropbox leads with the following argument: “[t]hat is the date on which the inventor first filed a continuation-in-part patent application that added an external node with messaging functionality *to the specification*—that is, a node that is separate from the user computers and that generates messages such as emails.” (Mot. at 1.) This is incorrect and irrelevant. The alleged “external node with messaging functionality” was already disclosed in the Original Applications. (Smith Decl. at ¶25.) Any other alleged additions are irrelevant: “the key question is whether the descriptive matter is present in the original application, not whether it is also present in any added disclosure.” *Nintendo*, 717 F. App’x 996 at 1001.

As shown below, the claims that were added *are supported* by the Original Applications. (Smith Decl. at ¶26.) Dropbox, itself, contradicts its assertion when it argues, later in its Motion, that the October 3, 2017 CIPs made “no significant changes to the written description.” (Mot. at 6.) Still, Dropbox perpetuates its false narrative in setting up more specific arguments regarding

particular claim limitations. For example, Dropbox makes blanket assertions such as “in the Original Applications, all of the steps of the disclosed invention *are performed by the user computers*.” (Mot. at 4-5.) This is false. (Smith Decl. at ¶26). In *all* of the specifications (including the Original Applications), it is taught that the “node[s]” that are disclosed to carry out the various steps of the disclosed embodiments may all be at least partially performed utilizing a “server.” (Smith Decl., ¶26).

For example, as shown in the excerpts below, each claimed “node” is disclosed to refer to “*one or more devices*” and such “devices,” in turn, are disclosed to be inclusive of “*servers*,” “*distributed systems*,” in addition to “*personal computers*,” and other suitable devices:

the terms “*device*” and “*node*” used herein may refer to *one or more devices and nodes, respectively*, providing and/or otherwise included in an execution environment unless clearly indicated otherwise.

(’635 app., ¶48, ’906 app., ¶46.)

Exemplary *devices* ... include personal computers, notebook computers, tablet computers, *servers*, portable electronic devices, handheld electronic devices, mobile devices, multiprocessor devices, *distributed systems*, consumer electronic devices, *routers*, *communication servers*, and/or any other suitable devices. Those skilled in the art will understand that the components illustrated in FIG. 1 are exemplary and may vary by particular execution environment.”

(’635 app., ¶35, ’906 app., ¶33; Smith Decl., ¶27.) In addition, the Original Applications disclose that the arrangement of components for performing the methods of Figs. 2A and 2B may “each be distributed across more than one node and/or execution environment” and “such [an] arrangement[s] may operate *at least partially in a browser* in a one [execution environment/node] and *at least partially* in a *server* in another [execution environment/node] *interoperating via a network*.” (’635 app., ¶73; ’906 app., ¶102; Smith Decl., ¶28.)

Accordingly, the Original Applications indisputably disclose an “external node.” (Smith Decl. at ¶29.) Thus, Dropbox’s argument that “new matter” was added in regard to such an external node is irrelevant at best, *see Nintendo*, 717 F. App’x at 1001, and wrong at worst.

B. The “Send/Receive” Elements are Described in the Original Applications

1. The Asserted Claims do not Universally Require an External Node

As a threshold matter, while Dropbox only takes issue with the “send” and “receive” elements in the claims, Dropbox continues to refer to such limitations as requiring an “intermediary” “external messaging node.” (Mot., 13, 16.) That is wrong. The claims are not limited to any such “intermediary” “external messaging node.” (Smith Decl., ¶30.) Those words/phrases do not exist in the claims and Dropbox has not advanced a construction via *Markman* to advocate for their inclusion. (See DI. 54, 58, and 60.) In fact, Dropbox’s expert, Dr. Gibbons, admitted that at least claim 5 of the ’353 patent does *not* require an intermediate messaging node. (Dr. Gibbons Deposition Transcript, filed concurrently herewith, (“Gibbons Tr.”) at 103:24-107:20.) To this end, these supposed “intermediary” “external messaging node” elements simply do not exist in any of the claims (Smith Decl., ¶30), and the claims should not be limited thereby, nor should there be a requirement imputed upon Motion Offense to identify support for such claim limitations when they do not exist.

2. The Priority Applications Disclose External Nodes and Servers

In discussing the “send” and “receive” limitations, Dropbox summarily concludes that the “Original Applications do not provide written description support for an external messaging node that gathers pieces of information in order to generate an email message.” (Mot., 12.) In support of this bald assertion, Dropbox merely argues that “the Original Applications describe the first user computer as being responsible for gathering information for an email and generating the email that it then sends to the other user computer.” (Mot., 12.) Dropbox then goes on to state that “the Original Applications describe ‘edit windows’ which allow a user computer to generate emails to request content and to share content,” relying on Figs. 6D and 6E of the ’635 application. (Mot., 12.)

But Dropbox’s cited examples, Figs. 6D, 6E, and 7 (and the descriptions thereof), *contradict* Dropbox’s conclusion. (Smith Decl., ¶32). For example, the ’635 application at ¶122 discloses that “FIG. 6D, illustrates an *edit window UI element 602d* that, in an aspect, may be presented by communication agent 403 in execution environment 401 of second *node 504* in response to a user input to create a new email” and at ¶144 that “FIG. 6E illustrates an exemplary user interface that may be presented by communications agent 403 operating in execution environment 401 of first *node 502*.” (Smith Decl., ¶32). But as noted earlier, the ’635 application at ¶35 expressly discloses that the term “node” may refer to “*one or more devices*” and “[e]xemplary *devices* included in and/or otherwise providing suitable execution environments for configuring according to the subject matter include ...*servers*, ... *distributed systems*, ... *communication servers*, and/or any *other suitable devices*.” (Smith Decl., ¶32).

Thus, Figs. 6D and 6E disclose a window UI element that is presented via nodes 502/504, where the original disclosure makes it abundantly clear that each such “node” may, in one embodiment, include “one or more devices,” including a “server” or “communication server” “and” any “other suitable device” such as one or more “personal computers, notebook computers, tablet computers, ... portable electronic devices, handheld electronic devices, mobile devices,” etc. (i.e. a “distributed system,” as explicitly disclosed) (Smith Decl., ¶33). To this end, contrary to Dropbox’s erroneous conclusion, there is support for the “sending/receiving” limitations. The Original Applications also tie the specific functionality depicted in Figs. 6D and 6E to a distributed system involving a user web page providing interface elements interacting with a remote application, e.g., server. (’906 app., ¶50 (“*a web page received by a user agent from a remote application provider may include HTML, ECMAScript, and/or byte code for presenting one or more UI elements included in a user interface of the remote application.*”)); ’635 app., ¶51.)

Another example in the paragraph that precedes the description of Fig. 6E (cited by Dropbox) elaborates on what is disclosed above. Specifically, the '635 application discloses:

In various aspects, IMC component 410 may receive matching information from a user via one or more UI element handler components 415. The matching information may be received, in response to a user input detected by an input device of an execution environment 401 that includes the IMC component 410. Alternatively or additionally, matching information may be received by an IMC component in a message received via a network. For example, a user may identify matching information to a browser operating in a client node. The browser may send the matching information via a network communicatively coupling the client node to a web server provider node. The web server provider node may include an IMC component that may operate to receive the matching information identified in the message from the browser. In another aspect, an IMC component may be provided in whole or in part by execution environment 401 of node 502 to a browser in another execution environment.

('635 app., ¶143; Smith Decl., ¶34.)

Additionally, the notion that information may be received, by a server from a client node, in connection with other information (beyond the aforementioned “matching information”), is further confirmed by the '635 application at ¶173, where it is disclosed that:

One or more schemas may alone or together define one or more of valid data object information, match information, a data object request, and/or a mount descriptor. A schema, as just described, may be identified based on a data received and/or otherwise identified by an execution environment hosting a communications agent via the network from another execution environment hosting communications agent.”

(Smith Decl., ¶35.) Similarly, at ¶186 of the '906 application, it is disclosed that:

One or more schemas may alone or together define one or more of valid data object information, a data object identification request, data object identification response, an access request, and/or an access response. A schema, as just described, may be identified based on data received and/or otherwise identified by a node hosting a communications agent via the network from another node hosting a communications agent.

(Smith Decl., ¶35.)

Additional support is present with respect to Fig. 7, which Dropbox relies heavily upon in its briefing. Specifically, Dropbox argues that “[w]here the Original Applications describe nodes

external to the user computers, those nodes are solely “path nodes” that merely “relay” messages between the user computers without modification, or that are used to store or locate stored user data. See, e.g., *id.* at Fig. 7, ¶ [0085].” (Mot. at 12.) But, as described by the Original Applications, it is disclosed that *each and every* relevant operation of Fig. 7 discloses a “*data flow*” that may be “internal” to the “first node” “or “may include a “*message received via network 506*” by “*interoperation*” with another node. (Smith Decl., ¶36.)

As established earlier, in one disclosed embodiment, each disclosed node (including both nodes shown in Fig. 7 referenced above), is *explicitly* taught to include “one or *more devices*” including a “*server*” and a user “*computer*” (e.g. personal computers, notebook computers, tablet computers) (i.e. a “*distributed system*,” as explicitly disclosed). (Smith Decl., ¶37.) When this disclosure is taken in combination with the *explicit* disclosure, as cited above, that Fig. 7 teaches a “data flow” which may be “*internal*” to the “*first node*” and may include a “*message received via network 506*” and/or “*may include interoperation*” with another node, it is clear that, in one embodiment, the First/Second Nodes 502/504 of Fig. 7 may each be a “*server*” that interoperates with (e.g. receives a message from) another node (e.g. a *user “computer”*) to perform the various disclosed operations. (Smith Decl., ¶37.)

This is shown below in Fig. 7, annotated to illustrate these teachings:

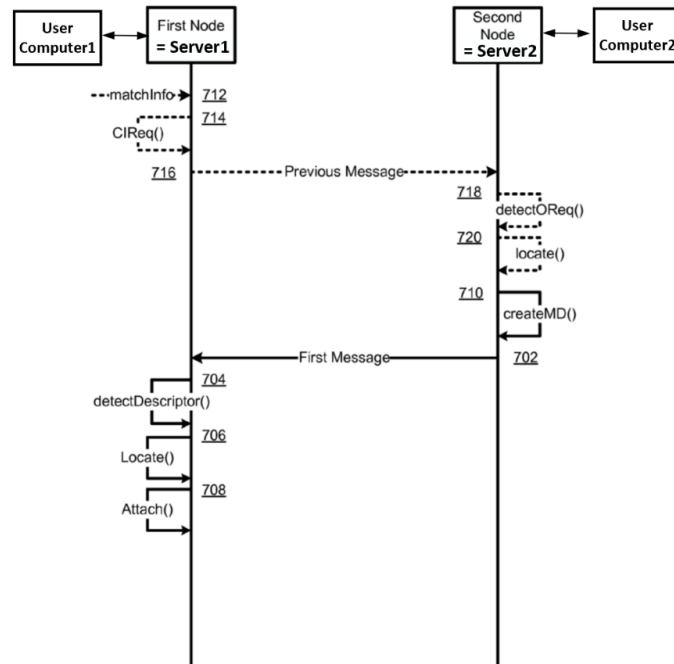


FIG. 7

Thus, as shown above, the First/Second Nodes 502/504 of Fig. 7 are **explicitly** disclosed, in one embodiment, to include a non-user computer (e.g. Server1/2) that **interoperates** with another computer (e.g. a User Computer1/2) to carry out the claimed “send”/“receive” limitations.

(Smith Decl., ¶39.) This conclusion is confirmed by the disclosure of the ’635 application:

[T]he various adaptations and analogs of the arrangement in FIG. 3A as well as the various adaptations and analogs of the arrangement in FIG. 3B illustrated and described herein are not exhaustive. For example, those skilled in the art will see based on the description herein that arrangements of components for performing the method illustrated in FIG. 2A and the method illustrated in FIG. 2B may each be **distributed** across **more than one node and/or execution environment**. For example, such **arrangements may operate at least partially in a browser in a one execution environment and at least partially in a server in another execution environment interoperating via a network**.

(’635 app., ¶73; Smith Decl., ¶39.) To this end, regarding annotated Fig. 7 above, there is ample disclosure that the Server1 may perform the various disclosed operations and may further **interoperate** with a **browser** of the User Computer1 in order to distribute functional components to perform the disclosed operations. (Smith Decl., ¶40.) Again, there is clear support for a non-

user computer (e.g. Server1/2, etc.) that interoperates with a user computer to carry out the claimed “send/receive” limitations. (Smith Decl., ¶40.)

Dropbox’s expert clearly overlooks or dismisses disclosures (noted above) that establish, contrary to the conclusions in paragraphs 21, 36, 42, and 44 of the his Declaration, that the First Node 502 and Second Node 504 (referenced by Figs. 6D, 6E, & 7) are indeed disclosed, in one embodiment, to include an *external messaging node*, such as a “*server*,” that communicates back and forth (e.g. *interoperates*) with a user (personal) computer in order to communicate information. (Smith Decl., ¶41.) Specifically, contrary to the conclusion at paragraph 21 of the Gibbons declaration, it is simply wrong to say that “[i]n the Original Applications, *all of the steps* of the disclosed invention are performed by the user computers.” (Smith Decl., ¶41.) Instead, as shown here, in the Original Applications, *all* of the steps of the claimed invention are disclosed, in at least one embodiment, to be performed by *non-user computers*, such as a server.

Contrary to paragraph 36 of the Gibbons declaration, the Original Applications *do* describe the “send” and “receive” limitations (e.g. interoperation) as claimed, because the Original Applications *do not* only describe intermediary nodes that are passive with respect to the information that they relay between two user computers. (Smith Decl., ¶42.) Instead, the Original Applications disclose that the First Node 502 and Second Node 504 (referenced by Figs. 6D, 6E, & 7), in one embodiment, may include an external messaging node, such as a “server,” that communicates back and forth (e.g. interoperates, etc.) with a user computer in order to receive information. (Smith Decl., ¶42.) Further, contrary to paragraphs 42 & 44 of the Gibbons declaration, the Original Applications do not disclose intermediary nodes/servers solely used to store user data, locate stored user data, or act as a proxy to simply relay information along a network path, because again, the First Node 502 and Second Node 504 (referenced by Figs. 6D, 6E, & 7), in at least one embodiment, are expressly disclosed to include an external messaging

node, such as a “server,” that communicates back and forth (e.g. interoperates, etc.) with a user (personal) computer. (Smith Decl., ¶42.) Gibbons admitted as much during deposition. (Gibbons Tr. at 132:9-141:21; 159:8-162:12; 164:5-167:5; 168:14-169:15; 170:15-174:1; and 175:7-177:7.)

As shown by these exemplary disclosures, it is clear that the “send/receive” limitations have ample support in the Original Applications. (Smith Decl. at 43.) Therefore, these claims should be afforded the priority date prior to October 3, 2017 because support exists within the Original Applications. *See Nintendo*, 717 F. App’x at 1001. Accordingly, for the forgoing reasons, Dropbox has failed to meet its burden to show that the “receive” and “send” elements of the claims in the asserted patents are not adequately disclosed in the Original Applications. (Smith Decl., ¶43.) Thus, any arguments that depend from this incorrectly alleged lack of disclosure should be rejected.

C. The “Generation” Element is Disclosed by the Original Applications

1. The Asserted Claims do not Universally Require an External Node

Dropbox argues that there is no written description support prior to October 3, 2017 for the “generation” limitations. According to Dropbox, these limitations recite an “external messaging node” that generates an email to send to the second user computer.

First, as mentioned earlier, the claims are not limited to any such “external messaging node.” Those words/phrases do not exist in the claims and Dropbox has not advanced a construction via the concurrent *Markman* proceedings, to advocate for their inclusion. Thus, reference to such phrase is irrelevant to the issues at hand. Second, at paragraph 23 of the Gibbons declaration, Gibbons admits the following:

The Original Applications further describe generating an email message at a user computer and sending the generated email message from that user computer to another user computer. This is shown, for example, in Figure 7 (e.g., message 716 and message 702) of the ’635 application below.”

In other words, Gibbons admits that the “nodes” (e.g. First Node 502 and Second Node 504) of Fig. 7 disclose the “generating an email message ... and sending the generated email message.” Importantly, as was described above regarding the disclosure of external nodes and servers concerning the “send” and “receive” limitations, the ’635 application discloses, in at least one embodiment, that the term “node” refers to at least a “server.” (Smith Decl., ¶69.) Given this, Gibbons’ statement is an admission that the Original Applications disclose a “server” (e.g. First Node 502 and Second Node 504 of Fig. 7) for “generating an email message . . . and sending the generated email message.” (Smith Decl., ¶79.)

Gibbons’ admissions do not stop there. In addition, Gibbons, through deposition, further admitted that “node 504 generates a message 702,” (Gibbons Tr. at 13:7-9), “receives information that’s used to generate message 702” (*Id.* at 13:13-20 and 16:7-17:24), stating that a “previous message, 716, contains information that is used to generate reply message 702,” (*Id.* at 17:4-10), wherein message 702 could be an email (*Id.* at 13:10-12.) Thus, Gibbons’ declaration overlooks or improperly dismisses explicit disclosures (noted above) which establish that the First Node 502 and Second Node 504 of Fig. 7 are disclosed for “generating an email message ... and sending the generated email message.” (Smith Decl., ¶80.) Specifically, contrary to paragraph 45 of Gibbons’ declaration, a POSA would have understood the disclosures in the Original Applications to indicate that the email message is generated at an external messaging node such as a “server,” in one embodiment. (Smith Decl., ¶80.) Further, contrary to paragraph 48 of Gibbons’ declaration, the Original Applications also do describe the “generation” elements as claimed because they describe an external messaging node, in the form of a “server,” which generates a message and that is not a user computer. (Smith Decl., ¶80.) Similarly, contrary to paragraph 54 of Gibbons’ declaration, there is also a disclosure that an intermediary/external node, in the form of a “server,” generates messages. (Smith Decl., ¶80.)

2. Dropbox Misconstrues the “Generation” Element

Dropbox is also relying on a narrow construction of the term “generate” when it argues that there is no support. Contrary to Dropbox’s interpretation, the term “generate” is used very broadly in the specifications of the Original Applications and the patents-in-suit. (Smith Decl., ¶81.) For example, while used in the context of a “data object,” the term “generating” is used to include “creating” an object, and “*modifying/transforming*” an existing object:

Alternatively or additionally, a data object request may include an instruction and/or input for generating a data object, and locating the data object may include generating the data object. *Generating* a data object may include *creating* the data object and/or may include *modifying* and/or otherwise *transforming* an *existing* data object.

(’635 app., ¶168.) This is consistent with extrinsic evidence. The Merriam-Webster dictionary defines “generate” as “to bring into existence / to be the cause of / to define /.” (Available at <https://www.merriam-webster.com/dictionary/generate>; last accessed Jan. 29, 2021.

While support can be found independent of the disclosed “path node” as established below, it would have been well known to a POSA that a “relay” node often *modifies* header, routing, and/or addressing information of *existing* emails, which clearly supports the claims. (Smith Decl., ¶82.) This is further supported in the specification of the Original Applications, where it notes “For purposes of describing the subject matter, a data unit in which data is received by a node is referred to as a *different* data unit than a data unit in which the data is forwarded by the node.” (’906 app., ¶58; Smith Decl., ¶82.) Thus, even the “relay” node would have been considered to “generate” a message in the context of the Original Applications’ disclosure. (Smith Decl., ¶82.)

3. The Original Applications Disclose the Use of External Nodes

Similar to its arguments regarding the “send”/“receive” elements, Dropbox also incorrectly states that “[t]he Original Applications do not provide written description support for

a messaging node distinct from the user computers to ‘generate’ an email as claimed in the asserted patents” (Mot. at 14), and “[t]he Original Applications *only* disclose a *user* computer that generates an email that is sent to another user computer,” (Mot. at 15). (Smith Decl., ¶83.) In doing so, Dropbox again reiterates its flawed arguments regarding the “path node.” But contrary to Dropbox’s assertions, generating a relayed message (albeit a *modified* copy) *does* support the claims. (Smith Decl., ¶83.) That said, there is additional disclosure, independent of the “path node,” that other nodes including a server, are disclosed to be capable of “generating,” as claimed. (Smith Decl., ¶83.)

In support of its erroneous conclusion, Dropbox again cites Figs. 6D and 6E. But, as set forth above regarding the “send/receive” limitations, there is disclosure of a computer other than a user computer, e.g., a “*server*,” to generate an e-mail. (Smith Decl., ¶74.) At ¶73 of the ’635 application, it discloses:

[A]rrangements of components for performing the method illustrated in FIG. 2A and the method illustrated in FIG. 2B may each be *distributed* across *more than one node and/or execution environment*. For example, such *arrangements may operate at least partially in a browser in a one execution environment and at least partially in a server in another execution environment interoperating via a network*.

Additional exemplary support can be found at ¶173 of the ’635 application and ¶186 of the ’906 application. (Smith Decl., ¶84.)

In addition to Figs. 6D and 6E, Dropbox also cites FIG. 7 as “illustrat[ing] a *first message* 702” sent by the second user computer [second node 504] and received by the first user computer [first node 502].” (Mot. at 15.) But, as with the “send/receive” limitations, the description *contradicts* Dropbox’s purported conclusion. (Smith Decl., ¶75. First, as established above, each disclosed node (including the First/Second Nodes 502/504 shown in Fig. 7), is *explicitly* taught to include “one or *more devices*” including a “*server*” and a user “*computer*” (i.e., a “distributed system” as disclosed). (Smith Decl., ¶85.) Second, viewed in combination

with the disclosure that Fig. 7 teaches a “data flow,” which may be “*internal*” to the “*first node*” and may include a “*message received via network 506*” and/or “*may include interoperation*” with *another node*, it is clear that, in at least one embodiment, the First/Second Nodes 502/504 of Fig. 7 may each include a “*server*” that *interoperates* with another node (e.g. a *user computer*) to perform the various disclosed operations. This is clear from the annotated version of Fig. 7, reproduced above at 12. (Smith Decl., ¶85.)

As illustrated above, the First/Second Nodes 502/504 of Fig. 7 are *explicitly* disclosed, in one embodiment, to include a *non*-user computer (e.g., Server1/2) that interoperates with another computer (e.g., a User Computer1/2, etc.) to carry out the claimed “generate” limitations. (Smith Decl., ¶86.) For example, it is clear that Server2 (with interoperation with User Computer2) “generates” the “First Message 702” (e.g., e-mail). (Smith Decl., ¶86.) Accordingly, there is support for a non-user computer (e.g., Server2) that interoperates with another computer (e.g., a User Computer2) to carry out the claimed “generate” limitation. (Smith Decl., ¶86.)

Still yet, the ’635 application at ¶124 discloses the following:

[T]he arrangement in FIG. 3B, includes *descriptor generator component* 314 that is operable for *creating a mount descriptor* for accessing the data object from the second data store by a first data store in a first execution environment including a first communications agent that represents a first user. FIG. 4 illustrates *descriptor generator component* 414 as an adaptation and/or analog of *descriptor generator component* 314 in FIG. 3B.

Further, the ’635 application disclose that “[d]escriptor generator component 414 in execution environment 401 of *second node 504* may *provide the mount descriptor* to *content manager component* 402 to *include* and/or otherwise identify the *mount descriptor* in a communication . . . such as an *email*,” (’635 app., ¶127), where “FIG. 4 illustrates *content manager component* 402 as an adaptation and/or analog of *content manager component* 302 in FIG. 3B,” (*id.*, ¶132).

Thus, as established above, FIG. 3B discloses a *descriptor generator component* 314 to *generate* (e.g., “create” the mount descriptor), and a *content manager component* 302 that

includes the mount descriptor in an *email*. (Smith Decl., ¶88.) Importantly, as set forth in the excerpts below, the components of Fig. 3B that perform the methods of Figs. 2A/2B, including the *descriptor generator component* 314 and the *content manager component* 302, are disclosed to operate in a *server* that interoperates with another node. As indicated earlier, the Original Applications discloses that arrangements of components may each be distributed across more than one node and/or execution environment and that such arrangements may operate at least partially in a browser in a one execution environment and at least partially in a server in another execution environment interoperating via a network. (Smith Decl., ¶88.)

By virtue of these disclosures (and Gibbon’s admission noted earlier), there is indisputable support for a “server” that interoperates with a user computer to “generate” an “e-mail,” as claimed. (Smith Decl., ¶99.) Therefore, these claims should be afforded the priority date prior to October 3, 2017 because support exists within the Original Applications. *See Nintendo*, 717 F. App’x at 1001. At a minimum, there is a genuine issue of material fact precluding the grant of summary judgment on this basis. (*See id.*)

D. Dropbox has not Met its Burden With Respect to All Claims

1. Dropbox Failed to Consider Each Claim Individually

Finally, Dropbox erred by asserting the cited claims in Appendices A and B are similarly situated and represented by claims 1 and 3 of the ’158 patent. (Smith Decl. at ¶97.) For example, most of the claims in Appendix B do not claim “generate,” but rather “cause generation of.” Examples may be found in claims 9, 28, and 44 of the ’548 patent, and claims 3 and 29 of the ’737 patent. The additional context of the claimed “generation” is paramount since those claims do not require “generation” but rather the “causation” thereof. (Smith Decl., ¶97.) Gibbons admitted that the analogous language “display” and “cause display” were clearly different in scope. (Gibbons Tr. at 61:21-63:5.) Regardless, a node can “cause” generation of a

message by sending a control signal, providing information required for the message generation, *without* actually “generating” the message itself. (Smith Decl., ¶87.) The same is true of the “send/receive” limitations. (Smith Decl., ¶97.)

Dr. Gibbons explained that he “didn’t distinguish between generate and cause generate.” (Gibbons Tr. at 67:17-18.) In addition, Dr. Gibbons’ declaration “doesn’t specifically refer to the words “cause generation.” (*Id.* at 68:12-13.) Similarly, Dr. Gibbons did not distinguish between “sending” and “causing sending” because he “didn’t feel it was necessary,” a fundamentally flawed approach. (*See id.* at 68:20-23.) When confronted with the specific claim language used, Dr. Gibbons responded that “[m]y declaration *doesn’t go into detail on the specific structure of the language used in each of these claims.*” (*Id.* at 74:2-4.)

Thus, a very large swath of the challenged claims does not even include the issues allegedly at play in Dropbox’s Motion. These issues alone are fatal to Dropbox’s Motion, and certainly are genuine disputes of material fact that preclude summary judgment.

2. Dropbox Admits that at Least Claim 5 of the ’353 Patent is Entitled to Support in the Original Applications

In addition to the failure to analyze each claim separately, Gibbons admitted that some claims of the asserted patents are supported by the Original Applications. (*See* Gibbons Tr. at 105:5-18.) Specifically, Gibbons admits that claim 5 of the ’353 patent has support. (*Id.*)

V. CONCLUSION

For at least the foregoing reasons, Dropbox has not met its burden to show that the claims of the asserted patents are not entitled to a priority date earlier than October 3, 2017. At a minimum, there are genuine issues of material fact precluding summary judgment. Thus, Dropbox’s Motion should be denied.

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CERTIFICATE OF SERVICE

I hereby certify that on February 8, 2021, I caused a copy of this document to be served by transmitting it via e-mail or electronic transmission to counsel of record for Defendant.

/s/ Timothy Devlin

Timothy Devlin