

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

**DECLARATION OF MICHAEL SMITH, PH.D., IN SUPPORT OF
MOTION OFFENSE, LLC'S OPPOSITION TO DROPBOX'S MOTION
FOR PARTIAL SUMMARY JUDGMENT**

I, Michael Smith, declare as follows:

I. INTRODUCTION

1. I am currently an independent consultant.
2. This declaration is based on my own personal knowledge. I make this declaration in support of Motion Offense, LLC in its Opposition to Dropbox, Inc.'s ("Dropbox") Motion for Partial Summary Judgment (the "Motion" or "Mot.").

II. QUALIFICATIONS AND EXPERIENCE

3. I hold two degrees from Cambridge University: (1) a Bachelor of Arts degree in Electrical Sciences earned in 1978; and (2) a Master of Arts degree in Electrical earned in 1978. I also hold two degrees from Stanford University: (1) a Master of Sciences in Electrical Engineering earned in 1981 and (2) a Doctor of Philosophy (Ph.D.) in Electrical Engineering earned in 1985.

4. From 2000–2004, I acted as CTO of a fabless networking semiconductor start-up, iReady, for TCP/IP/RDMA/iSCSI/IPsec networking protocol offload. I was responsible for: the basic technology ideas; recruiting the engineering team; all aspects of design: architecture and IP, design methodology, emulation, verification; system debug, testing, bringup; and standards work. I developed the iReady patent portfolio. I helped sell iReady and its IP to nVidia in 2004.

5. From 2004–2007, I was employed with nVidia, acting as a Chief Architect working in the division that is now the Tegra group. I was responsible, for example, for MCP55, the highest volume nVidia AMD chipset. I was involved in all aspects of systems design: chipset, graphics, memory, peripherals, networking, software (drivers, firmware) from product conception through to high-volume production. I worked with marketing to specify products, with software and hardware engineers on design, and with sales in the field.

6. From 2007–2009, I was Chief Architect and CTO of MetaRam, a KPCB fabless semiconductor start-up that built chips to aggregate DRAM for very high capacity DIMMs. I hired the initial MetaRAM team and then managed all of engineering except silicon design. I wrote and filed 30 patents in 6 months and helped sell the MetaRAM IP to Google in 2010. From 2009–2010. I consulted Google on IP strategy, IP portfolio development, patent prosecution, and high-value litigation.

7. At present, I am involved with two entities. Since 2011, I have acted as Founder and owner of P4TENTS1. This entity consults on all aspects of IP prosecution and litigation, analyzes and values IP and patent portfolios. P4TENTS1 also develops IP including complete patent portfolios. Therefore, I have a deep understanding of patents from a technical perspective.

8. Since 2014, and in addition to my work with P4TENTS1, I have worked with Weaved, renamed remote.it as part-time CTO. This team is made up of ex-iReady team

members. Through my work, I help this start-up provide networking for the Internet of Things using custom network protocols.

9. In addition, prior to 2000, I served in the following capacities: (i.) IBM (United Kingdom) Ltd, Hursley, England and IBM T.J. Watson Research Center, New York - Worked on DRAM and analog CMOS ASICs. (ii.) University of Hawaii: Professor. I created and developed the first undergraduate ASIC program in the US. I also received a National Science Foundation Presidential Young Investigator award from President Ronald Reagan. My principle area of research was hardware for networking and internet protocols. I also advised 45 graduate students. (iii.) Eastman Kodak, New York: I worked to create some of the first CMOS digital camera IC designs. (iv.) University of California, Berkeley: I worked to create the first undergraduate course on IC design. (v.) Xilinx, San Jose: I helped develop the Xilinx University Program and, with NSF, introduced the FPGA into IC design courses worldwide; I helped develop the first FPGA development platform with Stanford and Actel. (vi.) VLSI Technology and Compass Design Automation, San Jose: Chief Scientist; I designed one of the first ASICs using logic synthesis, a Viterbi decoder; architect for the first ASIC cell library for synthesis. (vii.) Apple Computer: I worked in the Advanced Technology Group on ASIC design projects including the Newton. I also developed and gave one of the first telelectures between Stanford, Apple. Developed the DACcafe website including one of the first online textbooks, "ASICs on the Web."

III. MATERIALS CONSIDERED

10. I have considered the materials listed in this declaration as well as the patents in suit, their prosecution histories, as well as related patents and applications. This includes the

Motion, the references cited by Dropbox, Dropbox's expert declaration, and other exhibits cited in this proceeding.

11. I am being compensated at my regular and established rate of \$300 per hour. My compensation is not dependent on the outcome of this proceeding.

IV. LEGAL STANDARDS

12. I am not an attorney. I have been informed regarding certain legal principles. I am not opining on the law, however. I set forth my understanding of the legal principles as they have been explained to me below.

A. Claim Construction

13. I have been informed that claim terms are to be given their plain and ordinary meaning as a person of skill in the art ("POSITA") would have understood them at the time of the invention when read in light of the claims and in view of the specification and prosecution history. I also have been informed by counsel that the most important evidence to consider in construing the claims is the "intrinsic" record, which I am informed includes the claim language, the patent specification, and the prosecution history of the patent and its family members. I understand that the person of ordinary skill in the art must read the claim terms in the context of the claim itself, as well as in the context of the entire patent specification.

14. I have been informed that there are two exceptions to this general principle. I have been informed that a patentee can choose to expressly define a term, and that this is called lexicography. I have also been informed that a patentee can choose to disclaim a particular meaning of a term. I have been informed that both lexicography and disclaimer must be clear and unmistakable.

15. I also understand that, in interpreting the meaning of the claims, one may consider “extrinsic” evidence, which are documents and testimony other than the patent and its prosecution history. I understand this evidence is considered in such a way as to ensure that a claim is construed in a way that is consistent with the understanding of those of skill in the art at the time of the claimed invention. I understand, however, that extrinsic evidence may not be relied on if it deviates from the meaning of claim language provided by the intrinsic evidence, particularly if the applicant has explicitly defined a term in the intrinsic record.

16. I have also been informed that there is a doctrine known as the doctrine of claim differentiation in which different claim language is presumed to have a different meaning. Similarly, I am informed that under this doctrine, a dependent claim is narrower in scope than the claim it depends from, and that accordingly, the claim it depends from is presumed to be broader in scope. I am informed that therefore a dependent claim can help inform a POSITA as to the meaning of a term in the claim it depends from.

B. Priority and Written Description

17. I have been informed by counsel that for a patent claim to be entitled to an earlier application’s filing date, one requirement is that the earlier application provide “written description” support for the claim. I have been informed that the written description requirement is satisfied when the patent owner provides adequate support for the claims. I have been informed that the written description requirement exists to distinguish the invention from those things that came before and requires that the applicant demonstrate that it was in possession of the claimed invention, i.e., that a person of skill in the art would have understood that the applicant actually invented what is claimed. 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

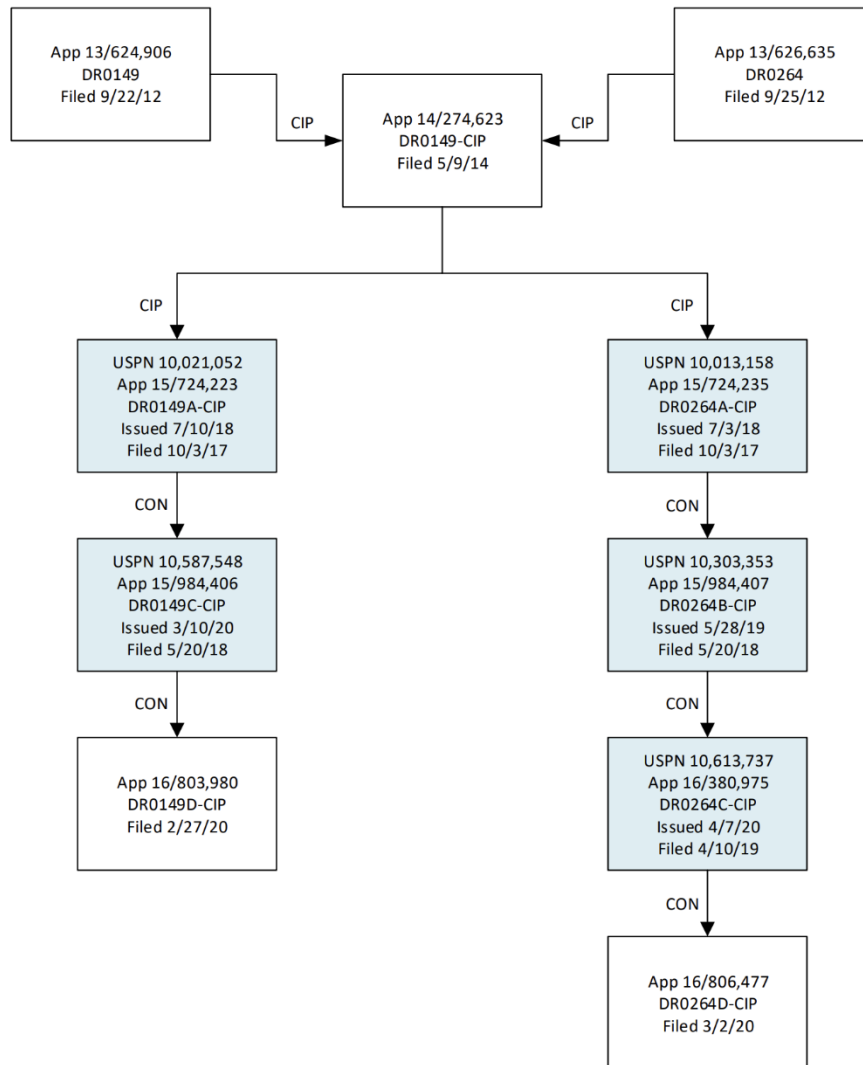
whether the patentee has proven to a POSITA that the invention works, or how to make it work, which is an enablement question.

18. I have been informed that a patent need not teach material that is well-known to a POSITA. I have also been informed that the written description requirement does not require that every claimed element be illustrated in the figures or present in a single embodiment.

V. TECHNOLOGY BACKGROUND

19. I understand that the asserted patents¹ are continuations-in-part (“CIPs”) of U.S. Patent Application Nos. 13/624,906 and 13/626,635 (the “’906 application” and “’635 application” respectively, and collectively the “Original Applications”). For example, the family history of the asserted patents may be found below:

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”).



20. The specifications of the asserted patents are the same as the Original Applications with the exception of the “Summary” section and inclusion of citations found in the following “Related Application” section:

RELATED APPLICATIONS

The present application is a continuation-in-part and claims priority to U.S. patent application Ser. No. 14/274,623 . . . filed May 9, 2014 . . . which is a continuation-in-part and claims priority to U.S. patent application Ser. No. 13/626,635 . . . filed Sep. 25, 2012 . . . and U.S. patent application Ser. No. 13/624,906 . . . filed Sep. 22, 2012 . . .

This application is related to the following U.S. Patent Applications, which are each incorporated herein by reference for all purposes:

U.S. patent application Ser. No. 13/626,635 . . . U.S. patent application Ser. No. 12/833,016 . . . U.S. patent application Ser. No. 12/833,014 . . . U.S. patent application Ser. No. 13/624,906 . . . [and] U.S. patent application Ser. No. 13/624,940 (published under US 2014-0089420 A1) . . . the entire contents of each are herein incorporated by reference for all purposes.

21. Additionally, at a paragraph 3, the '635 application states that "[t]his application is related to the following commonly owned, pending U.S. patent applications: application Ser. No. 13/624,906 (Docket No DRV0001) filed on 2012 Sep., 22, entitled 'Methods, Systems, and Program Products for Processing a Data Object Identification Request in a Communication'". Further, at a paragraph 34, the '635 application states that "[a]ll publications, patent applications, patents, and other references mentioned herein are incorporated by reference in their entirety." The '906 application published as US20140089421A1. In view of the above, I am informed that the disclosure of '906 application is effectively present in the '635 application.

22. Based on my review, 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. 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.)

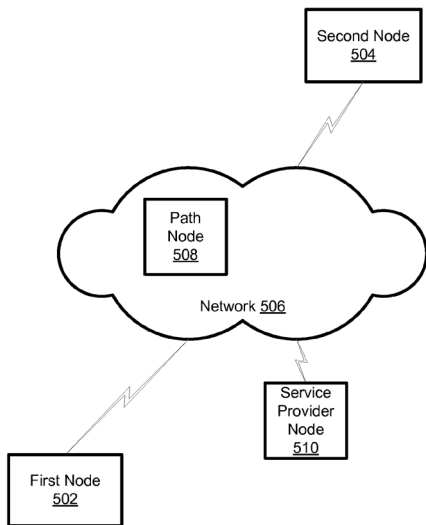


FIG. 5

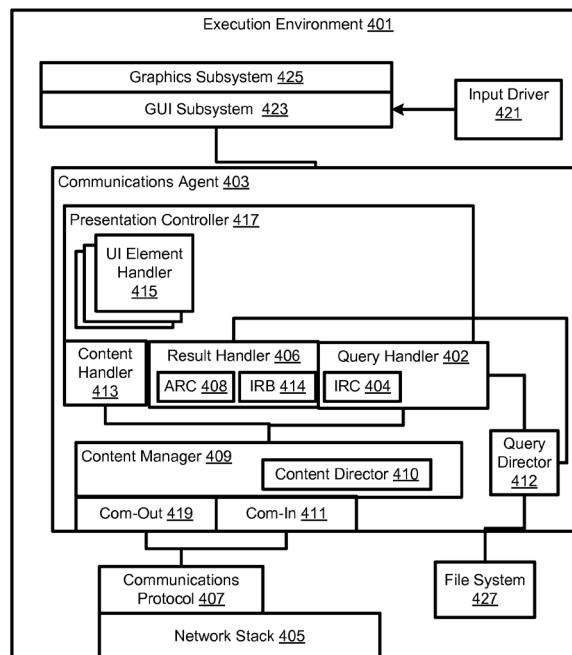


FIG. 4

23. Figure 4 of the '906 application is a block diagram illustrating components of Figures 3A and 3B, “that includes and/or otherwise is provided by one or more nodes.” ('906 application at ¶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 application, ¶102.)

24. In my opinion, the '906 application provides a number of examples of different distributed configurations, including presenting one or more user-interface elements using a web-page received from a remote server. ('906 application, ¶50.) Figures 6A-6G of the '906 application illustrate various user interfaces that may be presented to a user. ('906 application, ¶¶20-26.) Because these user 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 where additional nodes or servers are involved. 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. (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 application, ¶50; ’635 application, ¶51.)

VI. THE ASSERTED CLAIMS ARE ENTITLED TO THE ORIGINAL APPLICATIONS’ FILING DATE

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

25. In its Motion, Dropbox states the following: “[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.) In my opinion, this is incorrect. The alleged “external node with messaging functionality” was already disclosed in the Original Applications.

26. It is my opinion that, as detailed below, the claims of the asserted patents are supported by the Original Applications. In addition, 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.) In my opinion, this is false. As I detail below, 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.”

27. For example, 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 application, ¶47 ’906 application at ¶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 application, ¶35, ’906 application at ¶33.)

28. 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 application, ¶73; ’906 application, ¶102.)

29. Thus, in my opinion, the Original Applications clearly disclose an “external node.” Therefore, Dropbox’s argument that “new matter” was added in regards to such an external node is wrong.

B. The “Send” and “Receive” Elements are Described Within the Original Applications

30. Based on my review, Dropbox requires the “send” and “receive” limitations to include “intermediary” “external messaging node.” (Motion, 13, 16.) That is wrong. In my opinion, the claims are not limited to any such “intermediary” “external messaging node.” Those words/phrases do not exist in the claims. Additionally, Dropbox’s expert, Dr. Gibbons, admitted that at least claim 5 of the ’353 patent does not require an intermediate messaging node. (Gibbons Tr. at 103:24-107:20.) Thus, it is clear that these supposed “intermediary” “external messaging node” elements simply do not exist in any of the claims.

31. 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. at 12.) In support of this assertion, Dropbox 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. at 12.) Dropbox 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. at 12.)

32. In my opinion, Dropbox’s cited examples, Figs. 6D, 6E, as well as 7 (and the description thereof), contradict Dropbox’s alleged conclusion. 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.” As I noted earlier, the ’635 application at ¶35 expressly discloses that the term “node” used herein 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.”

33. It is my opinion that Figs. 6D and 6E disclose a window UI element that is presented via nodes 502/504. 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). Thus, contrary to Dropbox’s conclusion, there is indeed support for the “sending”/“receiving” limitations. In addition, I must note that 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 application, ¶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.”))

34. I also note that 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 at ¶143 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.

35. 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.”

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.

36. 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, the Original Applications disclose 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. (’635 application at ¶101.)

37. As I established above, 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). It is my opinion that this disclosure, when taken in combination with the explicit 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, makes 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.

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

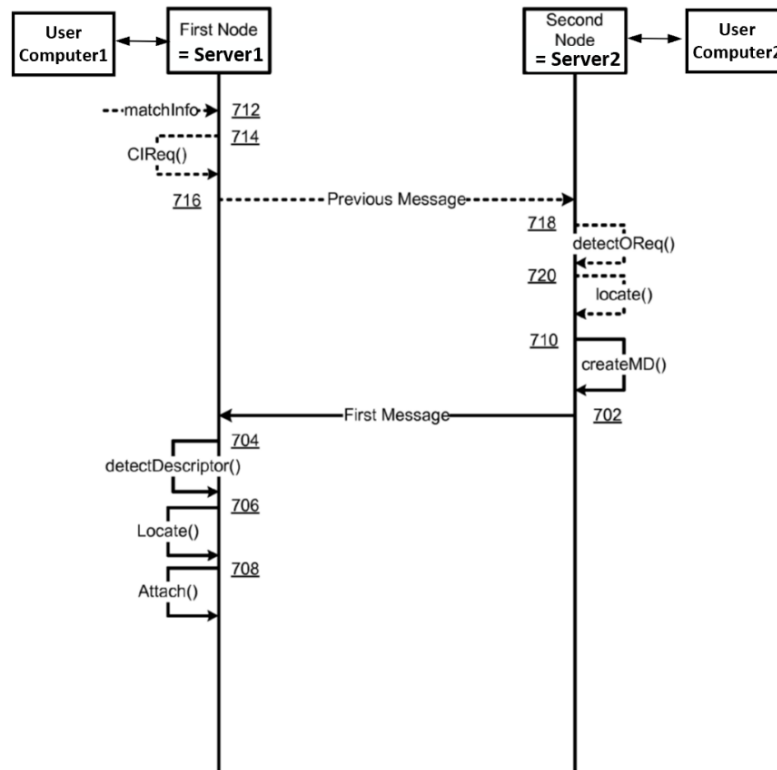


FIG. 7

39. Thus, as shown above, the First/Second Nodes 502/504 of Fig. 7 are 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. This conclusion is confirmed by the disclosure of the ’635 application at ¶73, stating the following:

[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.

40. To this end, regarding annotated Fig. 7 above, it is my opinion that 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. Again, in my opinion, there is clear support for a non-user computer (e.g. Server1/2, etc.) that interoperates with another computer [e.g. a User Computer1/2] to carry out the claimed “send”/“receive” limitations.

41. In my opinion, Dropbox’s expert overlooks or dismisses explicit disclosures (noted above) that establish that the First Node 502 and Second Node 504 (referenced by Figs. 6D, 6E, & 7) are 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. Specifically, it is my opinion that it incorrect to say that “[i]n the Original Applications, all of the steps of the disclosed invention are performed by the user computers.” Instead, as I describe in this declaration, the Original Applications discloses that all of the steps of the claimed invention, in at least one embodiment, may be performed by non-user computers, such as a server.

42. Additionally, it is my opinion that 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. 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. Further, 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.

43. Thus, it is my opinion that the “send/receive” limitations have ample support in the Original Applications. Accordingly, for the forgoing reasons, Dropbox has not shown that the “receive” and “send” elements of the claims in the asserted patents are not adequately disclosed in the Original Applications.

44. It should also be noted that the Figs. 6D and 6E (and the description thereof) are not the only figures that make it clear that the user interfaces disclosed in the Original Applications may be implemented using a web page displayed via a browser on a user computer which, in turn, interoperates with a server. Specifically, in the ’635 application at ¶51, it is disclosed that:

A ‘user interface (UI) element handler’ component, as the term is used herein, includes a component of configured to send information representing a program entity for presenting a user-detectable representation of the program entity by an output device, such as a display. ... The user-detectable representation is presented based on the sent information. Information that represents a program entity for presenting a user detectable representation of the program entity by an output device is referred to herein as “presentation information.” Presentation information may include and/or may otherwise identify data in one or more formats. ... For example, 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.

Thus, it is clearly disclosed that a “UI element handler” is taught to present user interfaces as web pages received from a remote application. Further, the execution environment 401 (of the first/second nodes 502/504) is disclosed to present all of the user interfaces of Figs. 6A-6G, and is also disclosed to include a “UI element handler 415” which, as set forth above, is capable of presenting user interfaces via web pages received from a remote application. Thus, in my opinion, the user interfaces of Figs. 6A-6G are each disclosed, in at least one embodiment, to be

presented as a web page, which is “sent,” in order to “receive” input, as indicated by Figs. 6A-6G (and the description thereof).

45. Further, at paragraph 161 of 13/626,635, which is a replica of the disclosure of the '158 Patent, it is disclosed that “[t]he various UI elements may be presented by one or more UI element handler components 415 in communications agent 403 in execution environment 401 of first node 502” and “[t]he various UI elements may be presented by one or more UI element handler components 415 in communications agent 403 operating in execution environment 401 of second node 504.” Thus, it is my opinion that it is clearly disclosed that the “UI element handler” is taught to be included in an “execution environment 401” of the first/second nodes 502/504.

46. Still yet, as set forth in the following paragraphs, it is clearly disclosed that all Figs. 6A-6G are presented via the disclosed “execution environment 401” which, as set forth above, is disclosed to include a “UI element handler” 415 that, again as set forth above, is taught to present the user interfaces as web pages received from a remote application.

47. For example, the '635 application discloses the following:

FIG. 6A illustrates a view window UI element 602 a as an exemplary user interface that may be presented by communications agent 403 operating in execution environment 401 of first node 502 to present data received in a communication, such as first message 702, from execution environment 401 of second node 504.

(‘635 application at ¶102.)

In response to detecting the mount descriptor in first message 702, execution environment 401 of first node 502 may present a view window UI element 602 b in FIG. 6B including data received in the first message 702 to a user of execution environment 401 of first node 502 as described with respect to FIG. 6A.

(‘635 application at ¶106.)

FIG. 6C illustrates another exemplary user interface that execution environment 401 of first node 502 may present to the user to allow the user to instruct execution

environment 401 of first node 502 to mount and/or otherwise attach a representation of a data object identified in a mount descriptor to a location in a data store of execution environment 401 of first node 502.

(‘635 application at ¶108.)

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.

(‘635 application at ¶122.)

FIG. 6E illustrates an exemplary user interface that may be presented by communications agent 403 operating in execution environment 401 of first node 502.”

(‘635 application at ¶144.)

FIG. 6F illustrates a window, view window UI element 602 f, presenting an exemplary representation of a message, such as previous message 716, received in a communication from execution environment 401 of first node 502 by second node 504.

(‘635 application at ¶161.)

FIG. 6G illustrates a results window UI element 670 g includes results pane UI element 672 g including representations of two data objects located and/or otherwise identified by data store navigator component 406 based on the data object request.

(‘635 application at ¶165.)

48. Similarly, the ’906 application discloses the following:

FIG. 6A illustrates an exemplary user interface that may be presented by communications agent 403 operating in execution environment 401 of first node 502. A UI element handler component 415 may operate to present a user interface element to allow a user to identify data object information.

(’906 app. at ¶125.)

FIG. 6B illustrates a data object identification requested query UI interface element 626 b where the presented term “None” may be defined to indicate no data object identification request was detected by the content manager component 409 in execution environment 401 of first node 502 in the communication received by

execution environment 401 of first node 502 from second node 504 via network 506.

(’906 app. at ¶146.)

In response to receiving second message 714, execution environment 401 of first node 502 may present, in a manner described above, data received in the message to a user of execution environment 401 of first node 502 as described with respect to FIG. 6C.

(’906 app. at ¶150.)

FIG. 6D illustrates a window, request window UI element 602 d, presenting an exemplary representation of a message received from execution environment 401 of first node 502 in a communication with second node 504.

(’906 app. at ¶166.)

FIG. 6E, illustrates a reply window UI element 602 e that, in an aspect, may be presented by communications agent 403 in execution environment 401 of second node 504 in response to an user input corresponding to reply UI element 648 d detected by a corresponding UI element handler component 415.

(’906 app. at ¶167.)

FIG. 6F, illustrates an identify in response dialog UI element 660 f that, in an aspect, may be presented by communications agent 403 in execution environment 401 of second node 504 in response to processing the data object identification request to locate matching data objects.

(’906 app. at ¶172.)

FIG. 6G illustrates another exemplary user interface that execution environment 401 of first node 502 may present to the user to allow the user to instruct execution environment 401 of first node 502 to construct and send a request.

(’906 app. at ¶150.)

49. Even still, the ’635 application at ¶81, it is clearly disclosed that “a user interface element handler component in an execution environment 401 may be received in a communication. For example, a communication... may include an HTML content type portion and a script content type portion.” Further still, at paragraph 124 of the ’906 application, it is

disclosed that “data object information may be received by a query handler component in a message received via a network. For example, a user may identify data object information to a browser operating in a client node. The browser may send the data object information via a network communicatively coupling the client node to a web service provider node. The web service provider node may include a query handler component that may operate to receive the data object information identified in the message from the browser.”

50. Thus, as set forth above, it is clearly disclosed that all Figs. 6A-6G are, in one embodiment, presented via the disclosed “execution environment 401” which, as set forth above, is disclosed to include a “UI element handler” 415 that, again as set forth above, is taught to present the user interfaces as web pages received from a remote application. Thus, the user interfaces of Figs. 6A-6G are all each clearly disclosed, in one embodiment, to be presented as a web page, which is “sent” from a server to a computer (e.g. user computer) in order to “receive” input at the server from the computer (e.g. user computer), as taught by Figs. 6A-6G (and the description thereof). To this end, contrary to Gibbon’s conclusion, the “send” and “receive” limitations (at issue) are indeed clearly supported by the Original Applications.

51. The foregoing conclusion is even further supported by other disclosures that are present in one or more published U.S. applications that are incorporated by references. For example, at Paragraph 96 of US20140089420A1, which is incorporated by reference in one or more of the Original Applications, it is taught that “FIG. 7 includes a dataflow that illustrates a present message 704 that may be internal to execution environment 401 of first node 502 and/or may include a message sent to a remote execution environment, such as an execution environment including a browser to send presentation information to present, via an output device, a representation of the data object descriptor received in first message 702.”

52. Dropbox also by focuses on “path nodes” that allegedly merely “relay” messages, thus giving the false impression that those disclosures are the only disclosures that could conceivably support the claim limitations at issue. Dropbox’s expert double down on such argument at Paragraph ¶53 when he opines: “Moreover, the description of “path node” that relays information between the two user computers is the only disclosure of an intermediary/external node that would be involved in communications between users. Because the Original Applications’ intermediary/external node only “relay[s]” messages, it is not generating an email message.” involved in communications between users. Because the Original Applications’ intermediary/external node only “relay[s]” messages, it is not generating an email message.”

53. First, as I will discuss below, I disagree with Dropbox’s argument that ‘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.’

54. Further, it is my opinion that Dropbox’s primary focus on just the disclosed “path nodes,” should be disregarded as a red-herring. Specifically, Dropbox concludes, falsely, 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.” This is incorrect. In my opinion, as noted in the cited excerpts above, there is clearly support for the “sending”/“receiving” limitations independent of any disclosure of “path nodes” which do, in fact, also support the “sending”/“receiving” limitations, as noted above.

55. Finally, as a practical matter, it is my opinion that the cited claims in Appendix A are simply not similarly-situated and, therefore, should not survive or fail based on the allegations in

Dropbox's Motion. For example, Dropbox appears to acknowledge this on Page 11 of Dropbox's Motion when it argues "[w]hile claim 1, unlike claim 3, does not expressly discuss the use of an intermediary external messaging node, Motion Offense reads claim 1 and all other claims that do not expressly discuss an intermediary external messaging node on Dropbox's server functionality in its infringement contentions. Moreover, a person of ordinary skill in the art would understand claim 1 to require an external messaging node."

56. In my opinion, this is just one example of how Dropbox is attempting to improperly conflate issues and use irrelevant factors (e.g. assertion of claims) to determine claim scope. Specifically, a broader claim can read on the same infringing functionality (that narrower claims read on), without invoking the issues outlined in Dropbox's Motion. In this case, and in my opinion, Claims 1 and 19 of the '158 patent simply do not require any specific destination of the information, object, indication, etc., but rather that such items are simply "sent." See excerpts from Appendix A below.

APPENDIX A
“Send” and “Receive” Limitations in Asserted Independent Claims

Claim 1 of the '158 patent:

[a first node including at least one non-transitory memory in communication with at least one processor, the first node configured to:]

...

send, from the first node via at least one network, the information associated with the at least one folder;

...

send, from the first node via the at least one network, the object associated with the at least one email address;

...

send, from the first node via the at least one network, the indication of the selection of the third user interface element;

Claim 19 of the '158 patent:

[A computer-implemented method, comprising:]

...

sending, from the first node via the at least one network, the indication of the at least one folder;

...

sending, from the first node via the at least one network, the indicia associated with the at least one email address;

...

sending, from the first node via the at least one network, the indication to share the at least one folder;

57. Thus, it is my opinion, contrary to Dropbox's allegations, that a person of ordinary skill in the art would not necessarily understand claim 1 of the '158 patent to require an external messaging node. For example, such items may, in one embodiment among others that are

covered by Claims 1 and 19 of the '158 patent, be indirectly OR directly sent in an e-mail from a first node, to a second node.

58. In my opinion, these same issue arises in Claims 1 and 10 of the '052 patent, Claim 1 of the '353 patent, Claim 5 of the '353 patent, Claim 19 of the '353 patent, Claim 1 of the '548 patent, and Claim 29 of the '737 patent.

59. Additionally, in Dropbox's expert declaration, Dropbox makes some inaccurate statements in an attempt to justify lumping all of the claims together based on the specific allegations outlined in Dropbox's motion. For example, at item 40 on page 13 of Dropbox's expert declaration, Dropbox's expert states:

"The structure of claim 1 makes clear that, unlike in the Original Applications, the email message is not generated by the user computer and must be generated by an external messaging node. Because the "information associated with at least one folder," cannot be sent to the second user computer without an email address (the second piece of information), the "information associated with at least one folder" cannot be sent directly to the second user computer and must be sent via an external messaging node. Moreover, if the "information associated with at least one folder" had already been sent to the second user computer, the requirement of sending an indication to share the folder would be redundant. Finally, claim 1 makes clear that while the first user computer is separately sending the three pieces of information, the second node receives an email message. Something, i.e., the external messaging node, is therefore required to take those separate pieces of information and combine them into the email message received at the second node."

60. In my opinion, this statement is riddled with errors that are legal in nature and, as I have been informed, do not require expert testimony to refute. Yet in my opinion, as to the argument that "the email message is not generated by the user computer and must be generated by an external messaging node," there is nothing in the claim that says the email message is not generated by the user computer. In fact, claim 1 of the '158 patent, by its broader nature, is silent as to which node generates the email. This is purposeful. In my opinion, it seems Dropbox's expert attempts to create an inference to fill this gap by improperly assuming that the

claims require “the first user computer is separately sending the three pieces of information.”

Dropbox’s expert goes even further by arguing that there is an implied order in sending the three pieces of information, when he opines that ‘because the “information associated with at least one folder,” cannot be sent to the second user computer without an email address (the second piece of information), the “information associated with at least one folder” cannot be sent directly to the second user computer and must be sent via an external messaging node,’ as so forth.

However, there are no claim limitations that require “separate” sending of the three pieces of information, let alone any specific order thereof.

61. Importantly, it is my opinion that any proper construction would not result in the importation of the term “separate” or mandate an order in the claims, in view of the following dependent claims and the Doctrine of Claim Differentiation, which are merely illustrative (as there may be others):

Claim 16 of '158:

16.....

said indicia associated with the at least one email address is received before the indication of the at least one folder;

said indicia associated with the at least one email address is received after the indication of the at least one folder;

Claim 25 of '052:

25....

said first message is received in response to the indication of the selection of the fourth user interface element being sent;

said second message is received in response to the indication of the selection of the seventh user interface element being sent;

said first message is received after the indication of the selection of the fourth user interface element being sent with at least one operation therebetween;

said first message is received after the indication of the selection of the fourth user interface element being sent with no operation therebetween;

said second message is received after the indication of the selection of the seventh user interface element being sent with at least one operation therebetween;

said second message is received after the indication of the selection of the seventh user interface element being sent with no operation therebetween;

62. Thus, such dependent claims clearly claim the “separation” and “order” of various instances of “receipt,” which would, in my opinion, preclude any improper importation of such “separation” and “order” limitations into the independent claims. It would be improper to import “separation” and “order” limitations into the independent claims, when the dependent claims clearly require the opposite conclusion under the Doctrine Claim Differentiation.

63. It thus appears that Dropbox is attempting to rely on the fact that the receive and send acts (in the method claims) and capabilities (in the system/apparatus claims) are claimed to be “received” or “sent” in separate claim elements, in order to somehow argue that such acts/capabilities require multiple/ordered instances of “receive” or multiple/ordered instances of “sent.”

64. For example, to point out the irrationality of what Dropbox’s expert is proposing, consider the following two hypothetical claims.

1. An apparatus, comprising:
a processor configured to:
receive a first message; and
receive a second message.
2. An apparatus, comprising:
a processor configured to: receive a first message and a second message.

65. Clearly, in my opinion, absent anything contrary in the intrinsic record, the foregoing claims have the same scope.

66. 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.

67. At paragraph 21 of the Gibbons declaration, Gibbons concludes that “[i]n the Original Applications, all of the steps of the disclosed invention are performed by the user computers.” At paragraph 36 of the Gibbons declaration, Gibbons states that the claim “limitations further describe an external messaging node that actively communicates back and forth with that user computer in order to receive those individual pieces of information” and concludes that ‘the Original Applications do not describe the “send” and “receive” limitations as claimed because the Original Applications only describe intermediary nodes that are passive with respect to the information that they relay between the two user computers.’ At paragraph 42 of the Gibbons declaration, Gibbons concludes that “[a] POSITA would not have understood the Original Applications to disclose an external messaging node that gathers separately transmitted pieces of information in order to generate an email message. ... the only intermediary nodes/servers described in the Original Applications are used to store user data, locate stored user data, or act as a proxy to simply relay information along a network path.” At paragraph 44 of the Gibbons declaration, Gibbons concludes that “the Original Applications only describe an intermediary node between two user computers that can relay messages and do not describe an intermediary node that can separately communicate with the first user computer for the purpose of generating a message which it subsequently sends to the second user computer.”

68. To support the above conclusions in paragraphs 21, 36, 42, and 44 of the Gibbons declaration, at paragraph 22 of the Gibbons declaration, Gibbons states that “Figures 6D, 6E, and 7 of the ’635 Application all show messages composed at and sent from one user computer to another user computer.” Further, at paragraph 43 of the Gibbons declaration, Gibbons states that ‘the Original Applications disclose “edit windows” in Figures 6D and 6E that allow a user to generate emails to request content and to share content.’ Thus, in my opinion, it is clear that

Gibbons relies on Figures 6D, 6E, and 7 of the '635 Application in support of the above conclusions in paragraphs 21, 36, 42, and 44 of the Gibbons Declaration.

69. At paragraph 13/626,635 ¶122, it is disclosed that “FIG. 6D, illustrates an edit window UI element 602 d 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 “FIG. 6E illustrates an exemplary user interface that may be presented by communications agent 403 operating in execution environment 401 of first node 502.” Thus, in my opinion, FIGs. 6D and 6E clearly disclose a window UE element that is presented via “node” 504 and 502, respectively.

70. At paragraph 13/626,635 ¶48 and US 13/624,906 ¶46, it is disclosed that “[t]he terms “network node” and “node” in this document both refer to a device having a network interface component for operatively coupling the device to a network. Further, 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.” In my opinion, US 13/626,635 et al. thus discloses that the term “node” refers to “one or more devices,” which clearly contemplates that each “node” 504 and 502 may include more than one device (i.e. a plurality of devices).

71. At paragraph 35 of the '635 application and paragraph 33 of the '906 application it is disclosed that “[e]xemplary devices included in and/or otherwise providing suitable execution environments for configuring according to the subject matter 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.” The Original Applications thus, in my opinion, disclose that the “one or more devices” to which the term “node” refers, may include a “communication server” “and” an “other suitable device” including but not limited to one or more “personal computers, notebook computers, tablet computers, ... portable electronic devices, handheld electronic devices, mobile devices,” etc. To this end, they both implicitly and explicitly disclose that that the “one or more devices” may include a “distributed system” including a “server” “and” a user “computer” (e.g. one or more “personal computers, notebook computers, tablet computers,” etc.).

72. As to Fig. 7 relied upon by Gibbons, in one 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. one or more “personal computers, notebook computers, tablet computers,” etc.).

73. For example, the '635 application discloses the following:

FIG. 7 includes a data flow that illustrates a detect descriptor data flow 704 that may be internal to execution environment 401 of first node 502 and/or that may include a message received via network 506 by first node 502.

('635 app. at ¶98.)

FIG. 7 includes a data flow message that illustrates a locate data flow 706 that may be internal to execution environment 401 of first node 502 and/or that may include a message received via network 506 by first node 502

('635 app. at ¶101.)

FIG. 7 includes data flow message that illustrates an attach data flow 708 that may be internal to execution environment 401 of first node 502 and/or that may include a message received via network 506 by execution environment 401 of first node 502.

('635 app. at ¶110.)

Create mount descriptor data flow 710 may be internal to execution environment 401 of second node 504 and/or may include interoperation by execution environment 401 of second node 504 via a network with another node

(‘635 app. at ¶121.)

FIG. 7 includes a data flow message that illustrates a match information data flow 712 that may occur at least partially in execution environment 401 of first node 502 and/or may include a message (not shown) received via network 506 by execution environment 401 of first node 502.

(‘635 app. at ¶141.)

FIG. 7 includes data flow message that illustrates a create data object request (CIReq) data flow 714 that may be internal to execution environment 401 of first node 502 and/or may include a message received via network 506 by first node 502.

(‘635 app. at ¶146.)

FIG. 7 includes a data flow message that illustrates a detect data object request (detectOReq) data flow 718 that may be internal to execution environment 401 of second node 504 and/or may include interoperation with another node via a network. . . . Locate message 720 may be internal to execution environment 401 of second node 504 and/or may include a message exchanged with a remote device, such as database server and/or a network attached storage device providing storage locations for some or all of a file system of execution environment 401 of second node 504.

(‘635 app. at ¶157.)

74. Similarly, the ‘906 application discloses the following:

FIG. 7 includes dataflow message 702 that illustrates a data flow internal to execution environment 401 of first node 502 and/or a message received via network 506 by execution environment 401 of first node 502.

(‘906 app. at ¶123.)

FIG. 7 includes dataflow message 704 that illustrates a data flow internal to execution environment 401 of first node 502 and/or message received via network 506 by execution environment 401 of first node 502.

(‘906 app. at ¶128.)

FIG. 7 includes a dataflow message 708 that illustrates a detect data object identification request dataflow that may be internal to execution environment 401 of second node 504 and/or may include interoperation with another node via a network.

(’906 app. at ¶162.)

Dataflow message 712 may be internal to execution environment 401 of second node 504 and/or may include interoperation by execution environment 401 of second node 504 via a network with another node.

(’906 app. at ¶171.)

FIG. 7 includes dataflow message 716 that illustrates a present message that may be internal to execution environment 401 of first node 502 and/or may be a message sent to a remote device, such as a node including a browser, to send presentation information to present, via an output device, a representation of the data object identification response received in second message 714. FIG. 7 also includes dataflow message 718 that illustrates a create access request message that may be a data flow internal to execution environment 401 of first node 502 and/or a message received via network 506 by execution environment 401 of first node 502.

(’906 app. at ¶144.)

FIG. 7 includes a dataflow message 720 that illustrates a third message that includes an access request to access a data object identified in the data object identification response received in second message 714.

(’906 app. at ¶149.)

75. 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, etc.) another node (e.g. a user “computer”) to perform the various disclosed operations. This is confirmed, at ¶101 of the ’635 application, where each and every relevant operation of Fig. 7 discloses a “data flow” that may be “internal” to the “first node” “AND” may include a “message received via network

506”/“interoperation” with another node. Again, this is represented by marked-up Fig. 7, reproduced below.

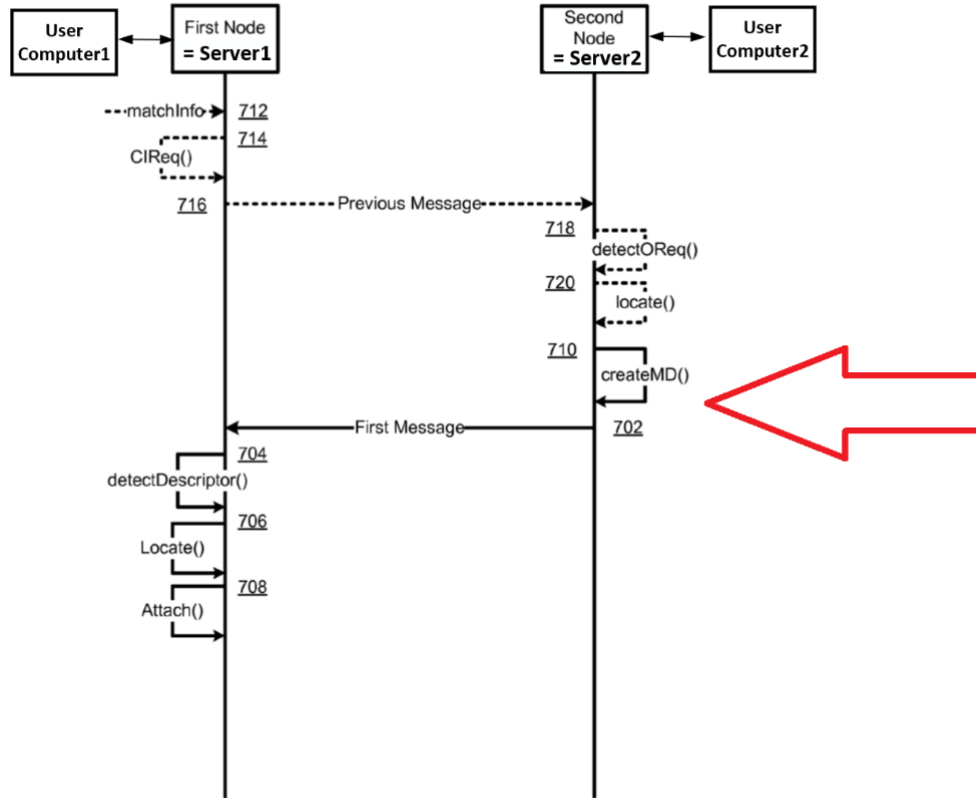


FIG. 7

76. By virtue of the preceding four paragraphs, the Original Applications, in my opinion, thus disclose, in at least one embodiment, that the Node (502 and/or 504) (that presents the graphical user interface of Figure 6D and/or 6E, and are included in Figure 7) each refers to a distributed combination of a “server” and a user “computer” (e.g. personal computer, notebook computer, tablet computer, etc.). Further, in view of this, and the fact that the “nodes” (e.g. Node 502 and Node 504) are explicitly referenced as implementing Figures 6D, 6E, and 7 that Gibbons admits “all show messages composed at and sent from one user computer to another user computer,” Gibbons’ argument is an admission that, contrary to Gibbons’ conclusions in

paragraphs 21, 36, 42 and 44 of the Gibbons declaration, the First Node 502 and Second Node 504 of Fig. 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, etc.) with a user computer in order to receive information.

77. Thus, in my opinion, Gibbons’ clearly overlooks or dismisses explicit disclosures (noted above) that establishes that, contrary to above conclusions in paragraphs 21, 36, 42, and 44 of the Gibbons declaration, 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, etc.) with a user computer in order to receive information. Specifically, contrary to Gibbons’ conclusion at paragraph 21 of his declaration, it is false to say that “[i]n the Original Applications, all of the steps of the disclosed invention are performed by the user computers.” In fact, it is my opinion that in the Original Applications, all of the steps of the claimed invention are indeed disclosed, in at least one embodiment, to be performed by non-user computers. Still yet, contrary to Gibbons’ conclusion at paragraph 36 of his declaration, it is my opinion that the Original Applications do indeed describe the “send” and “receive” limitations (e.g. interoperation, etc.) as claimed, because the Original Applications do not ONLY describe intermediary nodes that are passive with respect to the information that they relay between the two user computers. Instead, the Original Applications explicitly 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. Further, contrary to Gibbons’ conclusion at paragraphs 42 & 44 of his declaration, the Original Applications do not solely disclose

intermediary nodes/servers 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 one embodiment, are explicitly disclosed to 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.

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

78. 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.

79. First, as I discuss above, it is my opinion that the claims are not limited to any such “external messaging node.” Those words/phrases do not exist in the claims. Thus, reference to such phrase is irrelevant to the issues at hand. Second, at paragraph 23 of the Gibbons declaration, Dr. 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.”

Thus, in my opinion, 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.” In my opinion, Gibbons’ admission at paragraph 23, 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,” contrary to paragraphs 45, 48, and 54 of Gibbons’ declaration.

80. In addition, Gibbons, through deposition, further admitted that “node 504 generates a message 702,” (Gibbons Tr. 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, in my opinion, Gibbons’ declaration overlooks and 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.” Specifically, contrary to paragraph 45 of Gibbons’ declaration, it is my opinion that a POSITA 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. Further, it is my opinion that 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. Similarly, in my opinion, there is also a disclosure that an intermediary/external node, in the form of a “server,” generates messages.

81. Dropbox is also relying on a narrow construction of the term “generate” when it argues that there is no support. In my opinion, contrary to Dropbox’s interpretation, the term “generate” is used very broadly in the specifications of the Original Applications and the patents-in-suit. 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 application at ¶168.) In my opinion, this is consistent with common dictionary definitions easily understood by a POSITA. Specifically, as noted by the Merriam-Webster online dictionary: “generate - to bring into existence / to be the cause of / to define /.” (Available at <https://www.merriam-webster.com/dictionary/generate>; last accessed January 29, 2021.)

82. Also, in my opinion, while support can be found independent of the disclosed “path node” as discussed below, it would have been well known to a POSITA that a “relay” node often modifies header, routing, and/or addressing information of existing emails, which clearly supports the claims. In my opinion, this is further supported in the specification of the Original Applications, where it notes “[f]or 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 application, ¶58.) Thus, in my opinion, even the “relay” node would have been considered to “generate” a message in the context of the Original Applications’ disclosure.

83. It is also my opinion that Dropbox incorrectly concludes 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). In doing so, Dropbox again reiterates its misplaced arguments regarding the disclosed “path node.” Contrary to Dropbox’s assertions, it is my opinion that generating a relayed message (albeit a modified copy) does support the claims. In

addition, it is my opinion that there is further disclosure, independent of the cited “path node,” that other nodes including a server, are disclosed to be capable of “generating,” as claimed.

84. Dropbox again cites Figs. 6D and 6E. But, as I 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. 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.

85. 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 conclusion. First, as I previously established, each disclosed node (including the First/Second Nodes 502/504 shown in Fig. 7), is taught to include “one or more devices” including a “server” and a user “computer” (i.e., a “distributed system” as explicitly disclosed). Additionally, it is my opinion that when 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. In my opinion, this is clear from the annotated version of Fig. 7, reproduced below:

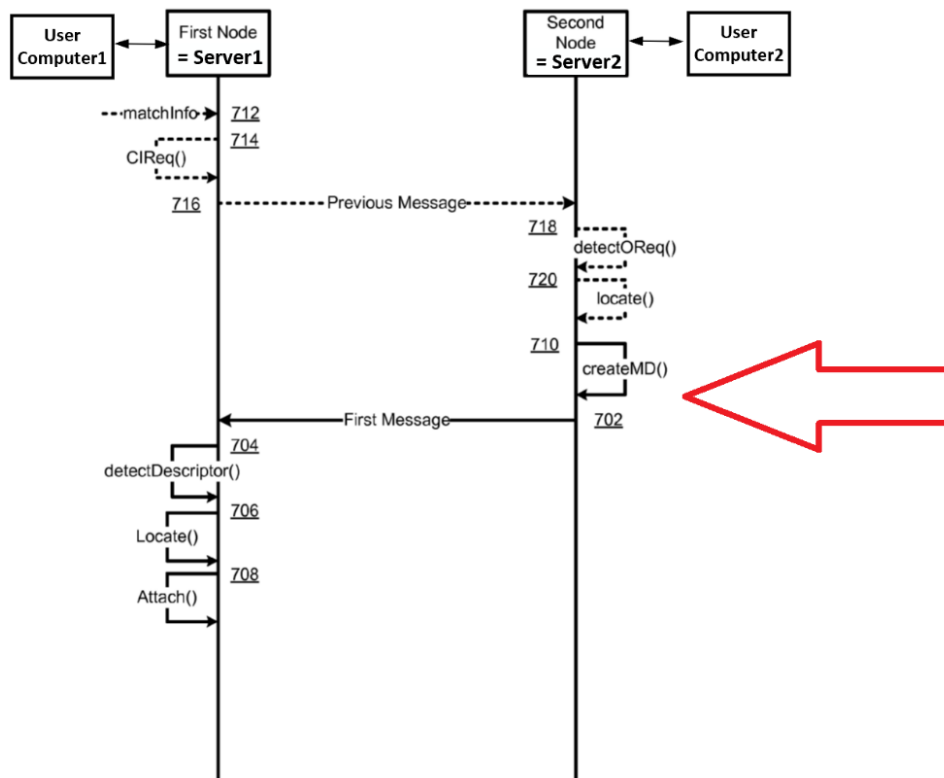


FIG. 7

86. In my opinion, as seen 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, etc.) that interoperates with another computer (e.g., a User Computer1/2, etc.) to carry out the claimed “generate” limitations. It is clear that Server2 (with interoperation with User Computer2) “generates” the “First Message 702” (e.g., e-mail). Accordingly, there is support for a non-user computer (e.g., Server2, etc.) that interoperates with another computer (e.g., a User Computer2, etc.) to carry out the claimed “generate” limitation.

87. Furthermore, in my opinion, 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.

Furthermore, 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. at ¶127), where “FIG. 4 illustrates content manager component 402 as an adaptation and/or analog of content manager component 302 in FIG. 3B,” (id. at ¶132).

88. Thus, in my opinion, 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. 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 I indicated earlier, the Original Applications disclose 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.

89. By virtue of these disclosures (and Gibbon’s admission noted earlier), it is my opinion that there is indisputable support for a “server” that interoperates with a user computer to “generate” an “e-mail,” as claimed.

90. At paragraph 45 of the Gibbons declaration, Gibbons concludes that “[a] POSITA would have understood these disclosures in the Original Applications to indicate that the email message is generated at the user computer, rather than an external messaging node.” At

paragraph 48 of the Gibbons declaration, Gibbons concludes that “[i]n my opinion, and as I describe in more detail below, the Original Applications also do not describe the “generation” limitations as claimed because they never describe an external messaging node that generates an email message and that is not a user computer.” At paragraph 54 of the Gibbons declaration, Gibbons concludes that “instead of having an intermediary/external node generate email messages, the Original Applications disclose that emails are generated at one user computer to be sent to another user computer.”

91. To support the above conclusions in paragraphs 45, 48, and 54 of the Gibbons declaration, at paragraph 23 of the Gibbons declaration, Gibbons admits that “[t]he 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.” Fig. 7 of the ’635 application clearly shows at least one email message (e.g., message 716 and message 702) being generated and sent by First Node 502 and/or Second Node 504. Thus, it is my opinion that 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.”

92. At ¶48 of the ’635 application and ¶46 of the ’906 application, it is disclosed that “[t]he terms “network node” and “node” in this document both refer to a device having a network interface component for operatively coupling the device to a network. Further, 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.” The Original Applications thus disclose that the term “node” refers to “one or more devices.”

93. In addition, as I describe earlier, at ¶35 of the '635 application and ¶33 of the '906 application, it is disclosed that “[e]xemplary devices included in and/or otherwise providing suitable execution environments for configuring according to the subject matter 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.” The Original Applications thus disclose that the “one or more devices” to which the term “node” refers, may include at least a “server.”

94. It is thus my opinion that, by virtue of the preceding two paragraphs, the Original Applications disclose, in at least one embodiment, that the term “node” refers to at least a “server.” Further, by virtue of Gibbons’ admission that the “nodes” (e.g. First Node 502 and Second Node 504) of Fig. 7 disclose the “generating an email message at a user computer and sending the generated email message,” and the explicit disclosure established above that such “nodes” (e.g. First Node 502 and Second Node 504) of Fig. 7 may include at least a “server,” Gibbons’ argument is an admission that, contrary to Gibbons’ conclusions in paragraphs 45, 48, and 54 of the Gibbons declaration, the First Node 502 and Second Node 504 of Fig. 7 are indeed disclosed for “generating an email message ... and sending the generated email message.”

95. Thus, in my opinion, Gibbons’ clearly overlooks and/or improperly dismisses explicit disclosures (noted above) that establish that, contrary to above conclusions in paragraphs 45, 48, and 54 of the Gibbons declaration, the First Node 502 and Second Node 504 of Fig. 7 are indeed disclosed for “generating an email message ... and sending the generated email message.” Specifically, contrary to Gibbons’ conclusion at paragraph 45 of his declaration, it is my opinion

that a POSITA would have understood the disclosures in the Original Applications to indicate that the email message is indeed generated at an external messaging node such as a “server,” in one embodiment. Further, contrary to Gibbons’ conclusion at paragraph 48 of his declaration, the Original Applications also do indeed describe the “generation” limitations as claimed because they do indeed describe an external messaging node, in the form of a “server,” that generates an email message and that is not a user computer. Still yet, contrary to Gibbons’ conclusion at paragraph 54 of his declaration, in addition to the Original Applications disclosing that emails are generated at one user computer to be sent to another user computer, there is also a disclosure that an intermediary/external node, in the form of a “server,” generate email messages.

96. Further, this conclusion is additionally confirmed by the specific disclosure that the “mount descriptor” in 702 of FIG. 7 (cited by Dropbox) is also specifically taught to be generated (e.g. created, constructed, etc.) using a node other than a user node. Specifically, at ¶¶ 121-125 of the ’635 application, it is clearly disclosed that “FIG. 7 includes data flow message that illustrates a create mount descriptor (createMD) data flow 710 data flow to create and/or otherwise construct a mount descriptor that identifies a data object in a data store of execution environment 401 of second node 504. ... Create mount descriptor data flow 710 may be internal to execution environment 401 of second node 504 and/or may include interoperation by execution environment 401 of second node 504 via a network with another node” and the “[c]reate mount descriptor data flow 710 may result from a request from a remote node, described below, and/or may result in access information received in response to user input, also described above” (emphasis added). As noted above in the marked-up Fig. 7, the second node 504 is specifically disclosed to include, in one embodiment, a “server.”

D. Dropbox Did Not Address Every Claim’s Specific Language, Which Differs

97. It is my opinion that 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. 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. In my opinion, the additional context of the claimed “generation” is important because those claims do not require “generation” but rather the “causation” thereof. Gibbons admitted that the analogous language “display” and “cause display” were clearly different in scope. (Gibbons Tr. at 62:22-63:5.) Regardless, it is my opinion that a POSITA would understand that 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. The same is true of the “send/receive” limitations. Neither Dropbox nor Gibbons explains why the variations in language do not matter. I note that various claims of the '548 patent and '737 patent use different language with respect to the “send/receive” elements than the '158 patent that Dropbox incorrectly asserts is representative. *See e.g.*, claims 1, 8, 17 and 26 of the '548 patent; claims 1, 3, 29 and 39 of the '737 patent

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98. My opinions are based upon the information that I have considered to date. I reserve the right, however, to supplement my opinions in the future to respond to any arguments raised by Petitioner and to consider new information that becomes available to me.

99. I declare under the penalty of perjury that all statements made in this Declaration are true and correct.

By: /s/ Michael Smith, Ph.D.
DR. SMITH