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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.
Petitioner

v.

MOTION OFFENSE, LLC
Patent Owner

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

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I. INTRODUCTION

The Petition demonstrates invalidity. Nothing in Patent Owner's ("PO's") Response casts any doubt that claims 9-16 and 22-24 are unpatentable. PO arguments that the Board already correctly rejected, and proposes a claim construction that it does not rely on for its patentability arguments.

II. CLAIM CONSTRUCTION

Term	PO's proposed construction	Petitioner's proposed construction
"representation of the at least one file" (claims 11, 12, 16, 22)	a file that can be displayed at the user's node, but whose at least one file content is stored remotely and is not communicated to the user till the user initiates the communication	Plain and ordinary meaning

PO seeks a distorted claim construction for the phrase "representation of the at least one folder" that PO does not even rely on for its arguments.[1] Because construing the term is not "necessary to resolve the controversy," the Board need not

[1] Although PO argues that "Grounds 2, 4, 5, and 6" fail because no reference discloses the creation of a representation of the at least one file in a location among one or more folders on the file explorer interface as claimed (POR, § V.E.2), that argument is not premised on PO's erroneous claim construction.

engage in claim construction. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). If the Board does engage in claim construction, the Board should adhere to the term's plain and ordinary meaning as PO's construction is erroneous on multiple fronts. EX1127, ¶¶13-14.

First, no construction is needed. The straightforward 7-word claim term simply refers to some sign or symbol that stands in the place of (*i.e.*, represents) the "at least one file" referred to in the claims. There is no reason that this requires construction, much less PO's 33-word construction. EX1127, ¶¶13-14.

Second, PO's construction is facially nonsensical. PO equates "representation" of a ***file*** with the "***file***" itself.[2] *See* POR, 13. This is inconsistent with the claim language. Claim 22 says that the "representations" are "displayable" via a webpage or a file explorer interface— suggesting that, consistent with the claim term's plain meaning, the "representation" of the file is a sign or symbol standing in the place of (*i.e.*, representing) a file, not files themselves. Indeed, PO's expert, Dr. Smith, recognized that a representation of something, like the image of a flag or a Microsoft word icon, is not the same as what the image represents, *i.e.*, a nation or a computer application. *See* EX1128, 29:04-30:07, 32:15-36:01. And he agreed in

[2] Emphasis added unless otherwise stated.

general that "a file is the basic unit of storage," *i.e.*, something ***distinct*** from a representation. *See id.*, 46:08-21; EX1127, ¶¶15-16.

Third, PO never justifies why any construction is needed. PO's argument is based primarily on other claim language (POR, 16-21). But if other claim language requires (as PO argues) that the requested file "is stored remotely and is not communicated to the user till the user initiates the communication," it is unclear why it is necessary to inject that concept into the term "representation of the at least one file" as well. EX1127, ¶¶17-20.

Fourth, PO's Frankenstein construction plucks phrases out of context and rearranges them into an incorrect, overly narrow construction. POR, 16-21. The core language of PO's proposed construction—requiring that the requested file be stored remotely and "not communicated to the user till the user initiates the communication"—is not language from a claim relating to file requests. Rather, that language mirrors language from claim 17—which relates to ***folder*** sharing, not ***file*** requests. EX1101, 55:24-31. PO tries to justify this language by citing element 22[i]. POR, 19. But PO's construction transforms 22[i]'s ***permissive*** language (sending an email without an attachment "*for permitting avoidance*" of communicating the file until the user initiates the communication) to more restrictive language that ***requires*** avoidance of such communication ("*is stored remotely and*

is not communicated to the user till the user initiates the communication.[3] EX1127, ¶¶12-20.

Moreover, element 22[i] does not even include the claim term at issue. The disputed claim term appears in only elements 22[h], [j], and [k], which relate to different aspects of the claimed invention and which, unlike 22[i], do not involve or mention the second email or the presence or absence of an attachment. Forcing language relating to email attachments into other claim elements relating to representations of the requested file highlights how strained PO's claim construction is. *See* EX1127, ¶¶17-18.

Finally, PO's reliance on the '635 application, which is an abandoned related application incorporated by reference, fails to support its incorrect construction (POR, 21-24)—fails to support PO's incorrect construction. PO's argument appears to be that because one claim in the abandoned '635 application required a "data object" be stored "in the second execution environment" and "accessing the representation [by the first execution environment] includes accessing the data object from the second data store," that means the detailed claims of the '520 patent

[3] PO's expert was unable to explain whether the proposed construction was permissive. EX1128, 118:13-120:17.

must be read to require that a requested file not be communicated to the requester "till the user initiates the communication." POR, 21-23. No claim construction principle supports importing limitations from abandoned related applications into the claims of a granted patent. Moreover, the cited portions of the application (POR, 23-24) do not support PO's construction: they do not indicate what initiates the "accessing" of the data object, and even if that accessing requires the requester/user to initiate the communication, nothing precludes a communication of the data object separate from that accessing. *See* EX1127, ¶21.

Ultimately, no construction is needed for this simple phrase. PO's arguments for patentability do not even turn on its erroneous construction. Moreover, the claims are invalid as obvious under either PO's erroneous construction or the plain and ordinary meaning. The Board need not and should not construe this term. EX1127, ¶22.

III. RIEPLING IS PRIOR ART

PO argues Riepling is not prior art to the '520 patent because Riepling is an abandoned patent application and is therefore entitled to only its 2013 publication date, not its 2011 filing date. POR, 31. PO also argues the challenged claims are entitled to at least a September 25, 2012 priority date. POR, 30-31. Because Riepling is entitled to its 2011 filing date, PO's second argument is irrelevant.

PO does not dispute that Riepling is a published patent application. POR, 36. The only dispute is to what priority date Riepling is entitled in an IPR proceeding. PO argues that, in order to constitute prior art available for use in an IPR under 35 U.S.C. § 311(b), an abandoned patent application must have been publicly available as of the challenged patent's priority date. POR, 31-36. PO's position has been rejected by the Federal Circuit in *Lynk Labs Inc. v. Samsung Electronics Co.*, No. 2023-2346, 2025 WL 85559, at *8 (Fed. Cir. Jan. 14, 2025). Under *Lynk Labs.*, Riepling is prior art as of 2011. *Id.*

Moreover, even if Riepling were entitled only to its 2013 publication date, Riepling is still prior art because the challenged claims are entitled to a priority date no earlier than October 3, 2017—the filing date of the '052 patent in the chain of priority. EX1127, § V.

To support its 2012 priority date argument, PO relies on a misleading incomplete summary of the litigation history of the previous Dropbox-Motion Offense litigation, *Motion Offense, LLC v. Dropbox, Inc.*, 6:20-cv-251 (W.D. Tex.) ("MO-DB-1"), and argues that, its expert, Dr. Michael Smith, has provided adequate support here for a September 25, 2012 priority date. POR, 30-31. PO is wrong.

First, PO is collaterally estopped from arguing the '520 patent is entitled to a September 25, 2012 priority date. *SimpleAir, Inc. v. Google LLC*, 884 F.3d 1160, 1165 (Fed. Cir. 2018) ("Under the doctrine of claim preclusion, a judgment on the

merits in a prior suit involving the same parties or their privies bars a second suit based on the same cause of action."). PO's summary of MO-DB-1 ***omits*** that although the District Court denied Petitioner's motion for summary judgment, the Court's final judgment found that PO was not entitled to the September 25, 2012 priority date for the related patents litigated in that case. EX1129 at 2. The '520 patent's challenged claims merely re-claim the same "file request" concepts that were at issue in MO-DB-1. *See* EX1130, 30:24-33:15 ("[t]he other main concept is something called 'file request'"); EX1118, ¶31 (admitting '520 patent claims are "substantially similar" to the patents asserted in MO-DB-1). EX1127, ¶¶23-32.

The coextensiveness of the '520 patent claims with the MO-DB-1 asserted patent claims is confirmed by the terminal disclaimer PO filed in the '520 patent. *SimpleAir*, 884 F.3d at 1168 (terminal disclaimer is "***strong clue*** that a patent examiner and, by concession, the applicant, thought the claims in the continuation lacked a patentable distinction over the parent"). During prosecution of the '520 patent, the Examiner found the subject matter was "not patentably distinct" from claims of the '052, '548, and '215 patents—all of which were tried in MO-DB-1—and issued a "same invention"-type double patenting rejection. EX1114, 190-221. In response, PO did not contest the Examiner's findings, but instead filed a terminal disclaimer. *See id.*, 321.

Second, PO's substantive argument that the patent is entitled to a September

25, 2012 priority date is wrong. PO relies upon a chart prepared by its expert to support its September 25, 2012 priority date argument. POR, 30. However, PO's expert did not provide any explanation for how those citations support the contended priority date. *See* Exhibit 2005, ¶ 84, Appendix 1. As Dr. Mowry explains, those citations do not provide written description support for the claim limitations related to generating an email message. EX1127, ¶¶42-67, 75-100.

IV. THE CHALLENGED CLAIMS ARE UNPATENTABLE

Nothing in PO's Response casts any doubt that claims 9-16 and 22-24 are unpatentable as obvious. PO's arguments for patentability of these claims hinge on misinterpretations of the Petition and mischaracterizations of the prior art. For the following reasons, PO's arguments should be dismissed.

A. Claims 9-10, and 14-15 Are Obvious over Riepling (Ground 1)

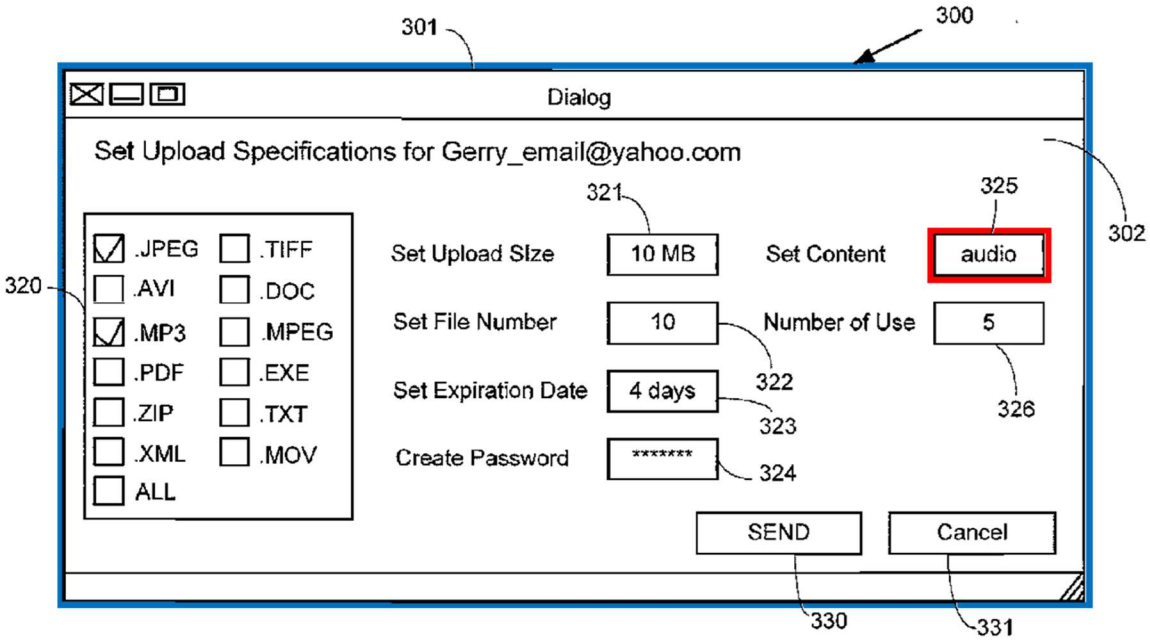
PO largely parrots the same arguments it made in its Preliminary Response ("POPR"; Paper 10) when discussing Riepling's alleged shortcomings—arguments that the Board correctly rejected already. *Compare* POR, 37-40, 42-47, 48-51 *with* POPR, 24-34; DI, 26-29.

1. Riepling Renders Claim 9 Obvious

PO only contests whether Riepling discloses or renders obvious elements 9[b], 9[g], and 9[l]. POR, 37-51. PO's arguments are wrong.

(a) Riepling discloses element 9[b]

PO reiterates its POPR arguments that Riepling does not teach element 9[b], which requires the file requester to provide "a file description via the first user interface element that includes a textbox," where the file description "describ[es]" the requested file. *Compare* POR, 37-40 *with* POPR, 24-27. Petitioner cited **content field 325** in Riepling's Figure 3 (shown below) as the "first user interface element that includes a textbox." Pet., 17-19.



EX1107, FIG. 3

The Board correctly rejected PO's arguments. *See* DI, 28-29 ("We agree with Petitioner that set content field 325 of Riepling sufficiently teaches or suggests claim requirement 9[b].").

First, PO argues Riepling does not teach that content field 325 "is a file description" because Riepling "does not describe" content field 325 outside of Figure 3. POR, 37-38. But the function of content field 325 is clear. Riepling explains Figure 3 "presents a diagram of an upload parameter dialog [301] for specifying upload parameters"—allowing the requester to specify parameters relating to the requested file, such as the file format ("file format check boxes 320") and the maximum file size ("size limit field 321"). In this context, box 325—labeled "Set Content" and containing the word "audio"—is logically understood to be a box that the requester can use to specify the content of the requested file—*i.e.*, "a file description." As Dr. Mowry explained, a POSITA "would have understood that the content field 325 is a text field for describing the content being requested [(*e.g.*, 'audio')]." EX1102, ¶70; *see also* DI, 29 ("the 'Set Content' entry is "audio," which is a file description"). Indeed, for Figure 3, where "audio" is identified in content field 325 and MP3 is one of the file formats checked for the requested file, PO admits that Riepling uses the word "audio" for "***describing*** the MP3 audio format." POR, 38. Thus, by PO's own admission, the word "audio" is a *file* ***description***.

Second, PO argues Riepling does not specify that **content field 325** includes a textbox and could be, for example, "a dropdown list or other type of selection area." POR, 38. But the Board correctly noted that, "[a]s Petitioner's expert explains, given that the fields of Figure 3 are generally described as text fields, one

of ordinary skill would have understood that this description applied to field 325." DI, 29. Thus, Riepling's **content field 325** is a "*first user interface element that includes a textbox*." In any event, even if content field 325 were a dropdown list, the difference between a textbox and a dropdown list would not be a patentable distinction that would make the '520 patent non-obvious over Riepling's teachings.

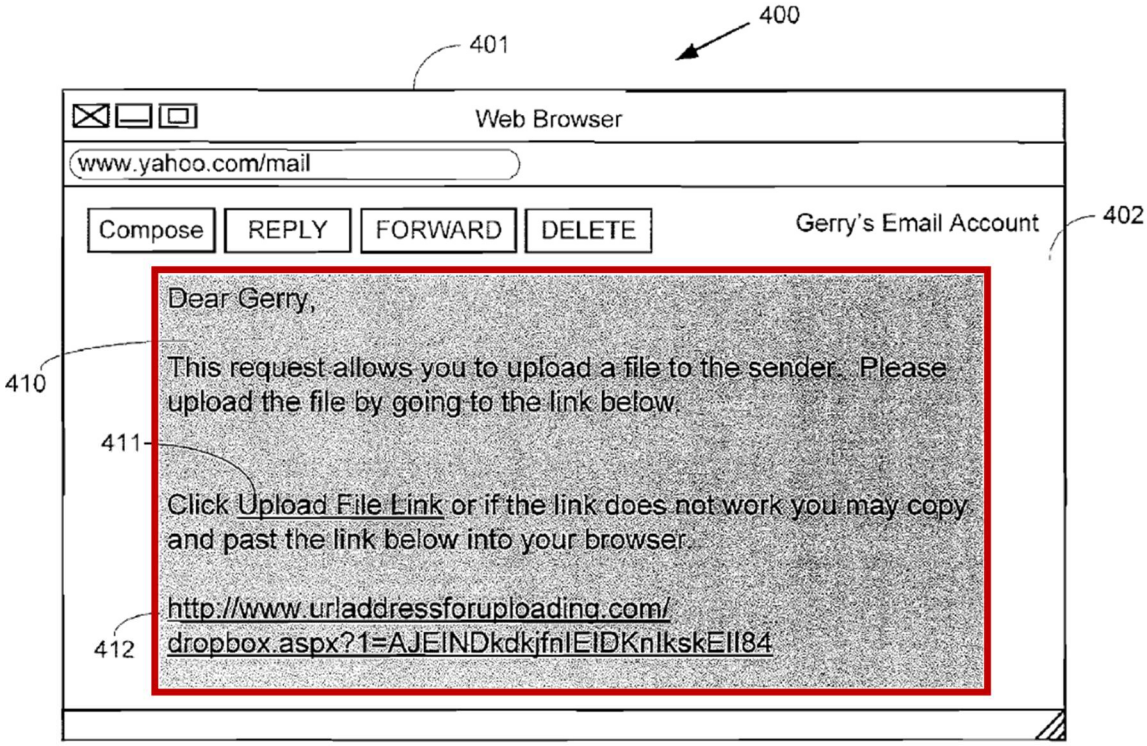
Third, PO argues Petitioner's and the Board's interpretation of Riepling's Figure 3 must be wrong because "field 320 has a checkmark next to '.JPEG,' which is a file format that does not include audio." POR, 39. But, Riepling explains "it may be possible for audio files such as MP3 files to contain non-MP3 data, such as JPEG data embedded within the MP3 files." EX1107, ¶32. Contrary to PO's argument, a requester asking for an audio file (via content field 325) and checking the .MP3 and .JPEG file format check boxes 320 as shown in Figure 3 is fully consistent with Riepling: it ensures the uploader can upload an audio MP3 file with embedded JPEG content. EX1127, ¶¶101-104.

Fourth, PO wrongly argues that because Riepling's Figure 5—a dialog for the uploader—includes "file description text field 513" for the uploader to describe the files chosen for uploading, the requester would not also include a file description when requesting the file. POR, 39-40. But the uploader's ability to add a description of the file being uploaded is entirely consistent with the requester first describing what type of file is being requested. Indeed, as Dr. Mowry explained, it is desirable

for the requester to provide a file description "to inform the sender 117 of the kind of file the requester 111 is requesting." EX1102, ¶96. The Board correctly dismissed PO's argument because "[t]he fact that the Figure 5 response also includes a file description does not undercut Petitioner's reliance on set content field 325." DI, 29.

(b) Riepling renders obvious element 9[g]

Element 9[g] requires, in part, generating "a first message" to be sent to the second node (the uploader) "indicating the at least one of the date or the time on which the file request is based," and also including "the file description describing" the requested file. Petitioner explained that Riepling renders these elements obvious, based on Riepling's **digital invitation 410**. PO's arguments otherwise (POR, 42) again recycle arguments the Board correctly rejected. *See* DI, 29-31.



EX1107, FIG. 4

As discussed above, a requester will use Riepling's Figure 3 dialog 301 to designate a "file description" (via content field 325). Moreover, PO does not dispute that the requester will also designate "*at least one of a date or a time*" (as required by element 9[c]) via the invitation expiration field 323, which provides "a valid time window" for uploading the requested file. EX1107, ¶33; *see also* Pet., 17-20; POR, 37-51.

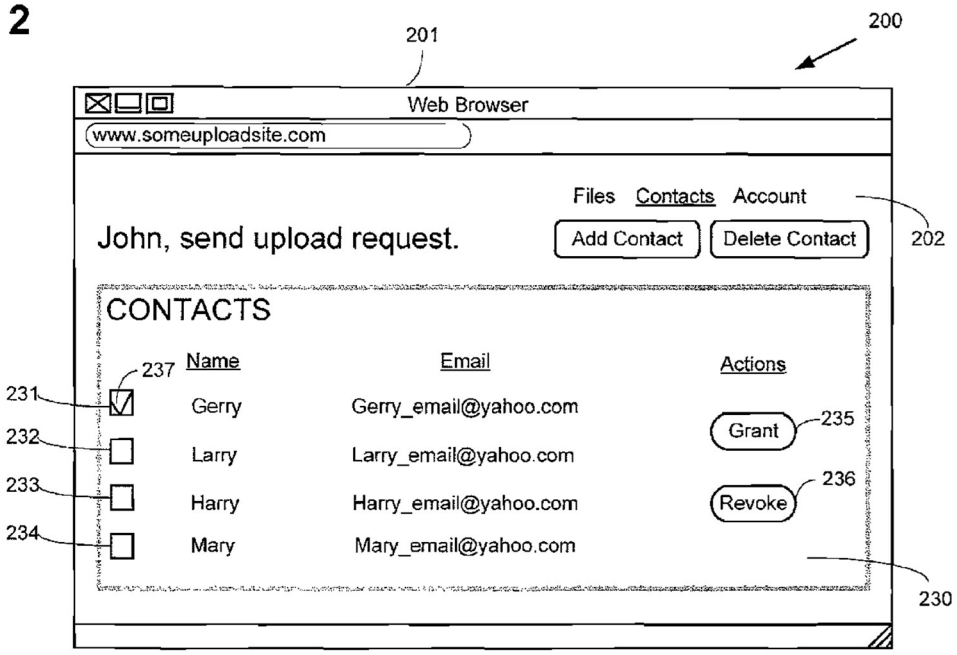
PO argues Riepling does not render element 9[g] obvious because Riepling's digital invitation 410 ("first message") does not show the file description or the designated date or time. But as Dr. Mowry explained and the Board agreed, a POSITA "would have understood that Riepling's digital invitation was not limited

to digital invitation 410 in Figure 4," and it would have been obvious to include in the invitation both the file description and date or time that the requester designated. DI, 30-31 (citing EX1102, ¶¶95-96."). PO's counterarguments are unavailing.

First, PO incorrectly argues Petitioner "fails to describe any motivation to modify Riepling in such a way or why such a design choice would be obvious." POR, 46. Not so. Petitioner expressly explained "[a] POSITA would have found it an obvious design choice to include these pieces of information in the digital invitation ***in order to inform sender 117 of the kind of file requester 111 is requesting and by when requester 111 would like to receive the file***." Pet., 31 (citing EX1102, ¶96). A requester would obviously not want the uploader to guess the type of file requested, or to be unaware of the time window in which requester wants to receive the file. *See* DI, 31 ("such would have been an obvious design choice in order to inform the recipient of the message of the kind of file being requested and by when the file was to be received"). Moreover, nothing suggests that any alleged differences between element 9[g] and Riepling would result in any unexpected results or otherwise constitute an inventive feature that would render claim 9 non-obvious to a POSITA.

Second, PO wrongly argues that no "date or time" or "file description" can be added to Riepling's digital invitation 410 because there is no place to add such information in Riepling's Figure 2's request interface 202. POR, 43-44.

Fig. 2

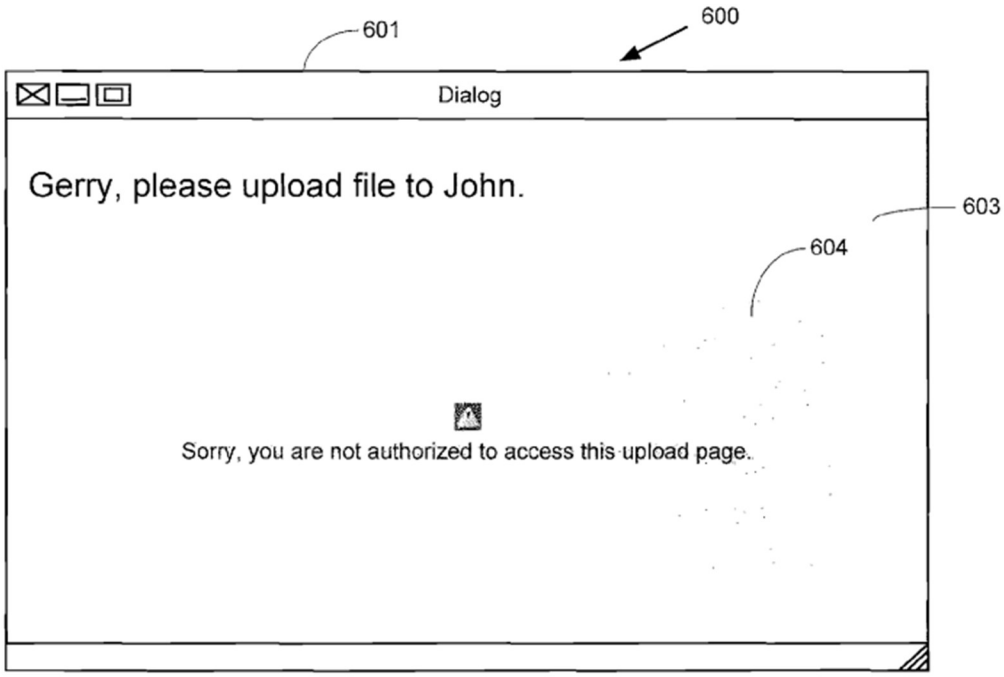


EX1107, FIG. 2

Figure 2 is a request interface for a requester to "select[] a contact to receive a digital invitation requesting a data upload." EX1107, ¶24. PO admits (POR, 45), that "[o]nce grant access button 235 has been used, content sharing service 105 … may ***begin creating*** a digital invitation for transmission to the contact." EX1107, ¶26; *see also* POR, 43-44 (arguing only that digital invitation 410 "***may***"—not must—"be generated after the user selects which recipients will receive the file request). Nevertheless, PO appears to read "begin creating" as "finish creating" and argues that after the requester selects the grant access button 235, no information beyond that identified in Figure 2 can be included in the digital invitation 410 (POR, 44). But nothing in Riepling indicates the Figure 3 upload parameters cannot be added to the digital invitation after the user hits the grant access button 235 in Figure 2. To

the contrary, Riepling explicitly discloses that Figure 3's send button 330 "may be used to send a digital invitation restricted by the one or more upload parameters specified in upload parameter dialog 301." EX1107, ¶34; *see also* Pet., 30; EX1102, ¶95; EX1128, 134:15-21 (PO's expert agreeing with Riepling's ¶34 statement). If the digital invitation can be "restricted" by the parameters specified in Figure 3, then the digital invitation could clearly include the corresponding information identified in Figure 3.

Third, the Board already rejected PO's argument that Riepling's disclosure of blocked interface 603 in Figure 6—where **revocation** message 604 is shown to someone whose previously sent invitation has been **revoked**—means that digital invitation 410 cannot include the "file description" and the "date or time." POR, 46-47.



EX1107, FIG. 6

Riepling describes blocked interface 603 as one example of how a requester can restrict the invitation (for example, by using "**revoke** access button 236" in Figure 2). *See* EX1107, ¶¶27, 46, 47. But as the Board correctly found, "the fact that Riepling discloses additional provisions for revoking a digital invitation does not undercut Petitioner's arguments," explained above, regarding the inclusion of the file description and date/time in the digital invitation. DI, 31. EX1127, ¶¶105-108.

Fourth, PO's vague assertion that Petitioner's subsequent file request patent applications "suggests that the file-request inventions of the '520 patent were not obvious" is misplaced. POR, 47. PO neither analyzes the substance of Petitioner's applications or nor compares them to the challenged claims. Moreover, whether

Petitioner filed patent applications on "file-request functionality" has no bearing on the issue here—whether Riepling renders obvious element 9[g].

(c) Riepling renders obvious element 9[l]

Element 9[l] requires generating a second message to be sent back to the requester to indicate that the file request has been responded to, and the message must "include[] an eighth user interface element" (which will later allow the requester to access the requested file) and must "***not*** include a file attachment." Petitioner explained Riepling renders this element obvious because it discloses "user accounts may receive an alert message or any other type of notification message alerting the other accounts of the data upload" (EX1107, ¶45), and it would have been obvious to incorporate a clickable link as the required "eighth user interface element." PO's counterarguments are meritless.

First, PO does not dispute that Riepling's notification message is a second message. Instead, PO argues it would not have been obvious to include a clickable link. POR, 48-51. PO mischaracterizes Petitioner's argument and suggests Petitioner sought to bodily incorporate the link (unique location identifier 411) from Riepling's digital invitation 410 into Riepling's notification message to constitute the required "eighth user interface element"—which PO says would be nonsensical because "when Riepling's initial digital invitation is created and sent, no files have been uploaded," so there would be no reason to include a link to access any files.

POR, 49. But, that was not Petitioner's argument. Rather, Petitioner made an obviousness argument based on that link. Petitioner explained that "[a]lthough Riepling does not explicitly disclose that its notification message (i.e., 'second message') 'includes an eighth user interface element,'" Riepling nevertheless "expressly describes including 'unique location identifier 411,' which may be a clickable link, in its digital invitation 410 (i.e., 'first message')" and that it "would have been ***obvious*** to a POSITA ***to implement Riepling's notification message the same way***"—i.e., "to include a link." Pet., 36.

Second, PO wrongly argues "Petitioner fails to describe any motivation to modify Riepling in such a way or why such a design choice would be obvious." POR, 50. But Petitioner explained that including a link in Riepling's notification message that points to the file uploaded by a requestee "would permit the owner of a user account to access and download the uploaded data without inclusion of a file attachment." Pet., 36 (citing EX1102, ¶109).

In any event, Petitioner explained in that 9[l] is also disclosed by Meisels. Pet., 65-67 (citing EX1102, ¶¶192-193). PO does not challenge that it would have been obvious to include a link as taught by Meisels into Riepling's notification message. *See* Section IV.B *infra*.

2. Riepling renders claim 10 obvious

PO does not raise substantive arguments for claim 10. POR, 51.

3. Riepling renders claim 14 obvious

PO argues Riepling does not teach elements 14[b], 14[d], and 14[j] for the same reasons it does not teach elements 9[b], 9[g], and 9[l], respectively. POR, 51-52. But, as explained in the Petition and above, Riepling ***does*** teach elements 9[b], 9[g], and 9[l]. PO does not dispute that Riepling teaches the remaining limitations of claim 14. *Id.*

4. Riepling renders claim 15 obvious

Claim 15 recites "*the first message and the second message are email messages*." PO does not dispute that Riepling's digital invitation 410 is a "*first message*" and an email message, and that Riepling's notification message is a "*second message*." PO's only dispute is whether the second message is an email message. POR, 52 (citing EX1107, ¶45). PO's argument fails.

First, PO wrongly argues that because one embodiment discloses sending alerts "within content sharing service," it cannot be an email. *Id.* PO ignores that Riepling discloses also that "**one or more user accounts may receive** an alert message **or <u>any other type</u> of notification message**." EX1107, ¶45. A POSITA would have understood this broad disclosure by Riepling to include email messages. *See* Pet., 47 (citing EX1102, ¶138).

Second, none of the citations PO relies upon (POR, 52 (citing EX1107, ¶¶21, 29, 30, 56) state that registered users will not receive an email response from an

unregistered user. They merely explain that "unregistered users are enabled to upload files to registered users" without registering (EX1107, ¶56). Nothing in Riepling excludes notifying a registered user. Moreover, to the extent PO is intending to suggest that the fact that in another embodiment of Riepling, a registered user "may specify which other user accounts are to receive the notifications" means a registered user would not receive notification (POR, 50 (citing EX1107 ¶45)), that misreads Riepling. Identifying ***additional*** user accounts to receive notifications does not undercut also notifying the registered user. EX1127, ¶¶109-110.

B. Claims 9-10, 14-15 Are Obvious over Riepling and Meisels (Ground 3)

PO's only argument for Ground 3 is that Meisels does not teach elements 9[l] and 14[j]. POR, 53-55; *see also id.*, 55-57. PO is wrong.

Elements 9[l] and 14[j] require generating a second message to be sent back to the requester to indicate that the file request has been responded to, and the message must "include[] an eighth [or sixth] user interface element" (which will later allow the requester to access the requested file) and must "***not*** include a file attachment." As explained in Section IV.A.1(c), Riepling renders these elements obvious. Petitioner relied on Meisels for the user interface element to the extent that Riepling were found to not teach these limitations. *See* Pet., 65-67.

PO does not dispute that Meisels teaches the required "user interface element" of elements 9[l] and 14[j]. PO acknowledges Meisels "relates to creating a link for an email attachment that may be sent in the email message 'along with or in place of' the attachment" (POR, 10 (citing EX1108, Abstract, ¶3)) and that "Meisels 'discloses an electronic message with an automatically inserted [] link to a document in place of the document attachment itself'" (POR, 53 (quoting DI, 21)).

PO also does not dispute that it would have been obvious to include a link as taught by Meisels into Riepling's notification message to permit a user to access and download the uploaded data without inclusion of a file attachment. *See* EX1102, ¶109; *see also* DI, 27, n.2.

PO argues "Meisels's process is divorced entirely from any other interfaces or software processes," so that a user must "manually create an email" with the link instead of the email being automatically generated (as required by elements 9[l] and 14[j]). POR, 53-54. But Petitioner does not rely on Meisels for the process of creating the second message. Petitioner argues only that it would have been obvious to add a link (*i.e.*, "an eighth[/sixth] user interface element") as taught by Meisels into Riepling's notification message. Pet., 65-66. There is no dispute that Riepling discloses the required process of generating and sending of a notification message.

Similarly, PO's argument that "[t]here is also no indication in Meisels that selection of one of its inserted links can 'cause … display of at least one fourth

interface with a reference to' one of its uploaded attachments 'for allowing access' to that attachment" is misplaced. POR, 55. This argument, at best, relates to element 9[o], for which Petitioner does ***not*** rely on Meisels. Regardless, a POSITA would have understood that, in Meisels, clicking on the link in the email would open an interface that displays and provides access to the uploaded file, similar to Riepling's data availability interface 702 with file entry link 703. *See* EX1107, ¶49, Figure 7. EX1127, ¶¶111-113.

C. Claims 11-13, 16, and 22-24 Are Obvious over Riepling, Manzano, and Meisels (Ground 4)

Ground 4 explained that claims 22-24 are obvious over Riepling, Manzano, and Meisels to the extent that the Riepling-Manzano combination does not teach "the second email: includes an eighth user interface element" as recited by element 22[i]. PO appears to address element 22[i] using the same arguments it provided for element 9[l]. POR, 55-57. PO's arguments fail for the reasons discussed in Section IV.B.

D. Claims 11-13, 16, and 22-24 Are Obvious over Riepling and One or More of Manzano, Meisels, and Garcia (Grounds 2, 4, 5, and 6)

1. Claims 11-13 and 16 are unpatentable

PO argues that claims 11-13 and 16 fail for the same reasons PO presented for claims 9 and 14. POR, 57. But as the Petition explained and as discussed above, claims 9 and 14 are obvious over Riepling alone or in combination with Meisels.

And, as explained in the Petition and in Section IV.D.3 *infra*, Riepling and one or more of Manzano, Meisels, and Garcia disclose or render obvious the additional limitations of claims 11-13 and 16, making those claims unpatentable.

2. Claims 22-24 are unpatentable

PO argues that claims 22-24 fail for the same reasons PO presented for claim 9. POR, 58. But as the Petition explained and as discussed above, claim 9 is obvious over Riepling alone or in combination with Meisels. And, as explained in the Petition and in Section IV.D.3 *infra*, Riepling and one or more of Manzano, Meisels, and Garcia teach the additional limitations of claims 22-24, making those claims unpatentable.

3. Manzano and Garcia each teach creation of a representation of at least one file in a location among one or more folders on a file explorer interface

Claims 11-13, 16, and 22-24 require creating a representation of the requested file at the first node (the requester's system) "in a location among one or more folders" either "on a file explorer interface" (claims 11 and 16) or "displayable via the file explorer interface" (claim 22). PO incorrectly argues no reference teaches this limitation. POR, 58-61. In fact, Manzano and Garcia each do.

Petitioner explained that Manzano's ghosted icon 600 corresponds to "*a representation of the at least one file*" created in a folder in a file explorer interface. Pet., 49-53 (citing EX1102, ¶¶149-153). PO does not dispute this. In fact, PO and

its expert acknowledge that, in Manzano, "if a file does not already exist at the second computer in the electronic file folder, it is indicated by a 'ghosted' icon" and "[t]he user may then selectively download all such files that do not already exist on the second computer." POR, 9-10 (citing EX1105, ¶¶50-51); EX2005, ¶48.

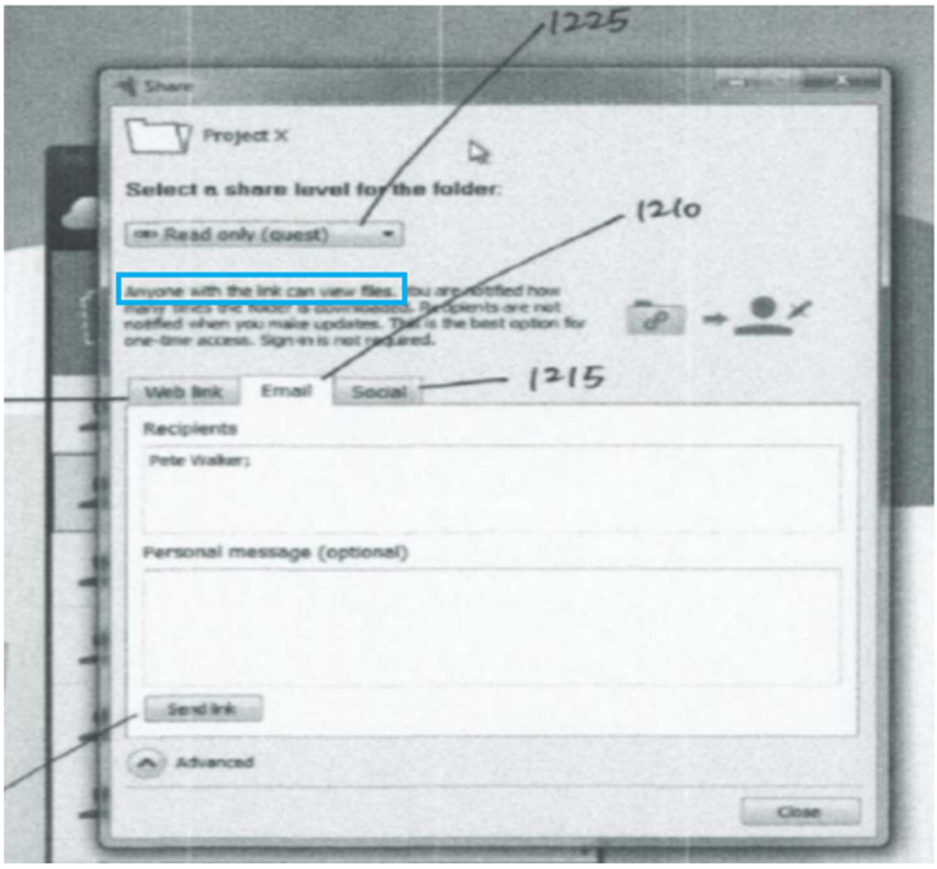
Instead, PO argues Manzano does not disclose a representation of a file being created in a location "***among*** one or more folders on a file explorer interface" because Manzano "only discloses transferring files ***into*** a specific folder that is created for the files." POR, 59. But, the presence of a ghosted file ***in*** a folder itself implies that the representation of the file is ***among*** at least one folder. Moreover, Petitioner explained that a POSITA would have found it obvious that Riepling's system as modified by Manzano could have displayed the ghosted icon of the file "among" other folders in the sense that the file could exist in a folder alongside other folders. Pet., 63-64. In fact, PO's expert agreed that a folder "can hold both files and additional folders." EX1128, 42:7-43:2. EX1127, ¶¶114-116.

Moreover, in Grounds 5 and 6, Petitioner further submitted that, to the extent PO were to argue (as PO now does) that Manzano does not teach "*in a location among one or more folders on a file explorer interface*," Garcia teaches this feature. Pet., 71-78 (citing EX1102, ¶¶201-208). PO does not dispute combining Manzano with Garcia. PO also does not dispute that Garcia teaches this feature.

Instead, PO argues Garcia does not disclose creating "a representation" of the folder or the files because Garcia discloses that the party with whom a folder is being shared will receive a link, and when the party clicks on the link, the contents of the folder are immediately downloaded to the party's computer, without the party being presented with a representation of the contents in a file explorer interface. POR, 59-61. PO's argument is irrelevant and wrong.

PO's first citation (EX1104, 11:29-31) discloses only that "the contents of the folder are **shared** with the contact"—**not downloaded**. The fact that contents are "shared" does not mean—and nowhere does Garcia disclose—that contents are downloaded when the user clicks on the link in the email. To the contrary, Garcia explicitly discloses that, "when a user **double clicks on a file** or item in a remote folder in the virtual drive, the server **downloads its copy of the file**/item to the local synchronization software client (i.e., the client currently being used by the user)." EX1104, 5:35-39; *see also* Pet., 10; EX1102, ¶61. EX1127, ¶¶117-118.

Further, contrary to PO's assertion, Garcia's Figure 12 does not "demonstrate[] that the recipient of the folder share downloads the contents (i.e., files) in response." *See* POR, 60. Figure 12 states "**Anyone with the link can view files.**" It does **not** say that when a user clicks the link, files are **downloaded**. EX1127, ¶¶119-120.



EX2006 (higher resolution of Garcia's Figure 12)

Therefore, for the foregoing reasons, Manzano and Garcia, alone or in combination, teach "a creation of a representation of the at least one file is caused, at the first node, in a location among one or more folders on a file explorer interface." PO does not dispute that the combination of Riepling with one or more of Manzano, Meisels, and Garcia teaches any other limitations of claims 11-13, 16, and 22-24.

V. CONCLUSION

Based on the foregoing and as set forth by the evidence presented in the Petition, claims 9-16 and 22-24 of the '520 patent are unpatentable and should be canceled.

Respectfully submitted,

/Trishan Esram/
Trishan Esram
Registration No. 74,075

UPDATED TABLE OF EXHIBITS

Exhibit	Description
1101	U.S. Patent No. 11,611,520
1102	Declaration of Dr. Todd Mowry
1103	U.S. Patent No. 8,825,597 ("Houston")
1104	U.S. Patent No. 9,633,125 ("Garcia")
1105	U.S. Patent Application Publication No. 2010/0005138 ("Manzano")
1106	U.S. Patent Application Publication No. 2007/0011246 ("Wu")
1107	U.S. Patent Application Publication No. 2013/0046833 ("Riepling")
1108	U.S. Patent Application Publication No. 2012/0278404 ("Meisels")
1109	U.S. Patent Application Publication No. 2013/0067303 ("Kantor")
1110	[Reserved]
1111	[Reserved]
1112	[Reserved]
1113	*Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:20-cv-00251, Jury Verdict Form, May 19, 2023, Dkt. 382
1114	'520 Patent File History
1115	U.S. Patent No. 6,351,776 ("O'Brien")
1116	U.S. Patent Application Publication No. 2008/0320397 ("Do")

Exhibit	Description
1117	[Reserved]
1118	*Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:23-cv-00303, First Amended Complaint for Patent Infringement, July 26, 2023, Dkt. 22
1119	U.S. Patent Application Publication No. 2004/0267705 ("Lemus")
1120	U.S. Patent No. 6,304,948 ("Motoyama")
1121	U.S. Patent No. 7,559,088 ("Cohen")
1122	U.S. Patent Application Publication No. 2003/0182332 ("McBrearty")
1123	*Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:23-cv-00303, Plaintiff's Disclosure of Preliminary Infringement Contentions, September 20, 2023
1124	Declaration of Gregory H. Lantier
1125	Declaration of Liv L. Herriot
1126	Declaration of Todd C. Zubler
1127	Second Declaration of Dr. Todd Mowry
1128	Deposition Transcript of Michael Smith
1129	*Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:20-cv-00251, Judgment, August 29, 2024, Dkt. 439
1130	*Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:20-cv-00251, Trial Transcript, September 9, 2023, Dkt. 402
1131	U.S. Patent No. 10,021,052

Exhibit	Description
1132	Patent Owner's Infringement Contentions

WORD COUNT CERTIFICATE OF COMPLIANCE

I hereby certify that the foregoing Petitioner's Reply to Patent Owner's Response contains 5,565 words as measured by the word processing software used to prepare the document, in compliance with 37 C.F.R. § 42.24(d).

Respectfully submitted,

Dated: January 24, 2025

/Trishan Esram/
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CERTIFICATE OF SERVICE

I hereby certify that, on January 24, 2025, I caused a true and correct copy of the foregoing materials:

- Petitioner's Reply to Patent Owner's Response
- Exhibits 1127-1132
- Updated Table of Exhibits
- Word Count Certificate of Compliance

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