

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,
Petitioner,

v.

MOTION OFFENSE, LLC,
Patent Owner.

IPR2024-00286
IPR2024-00287
Patent 11,611,520 B1¹

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

BEAMER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order applies to each of the above-identified proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

BACKGROUND

The Board received an email dated March 19, 2025, from Patent Owner's counsel, requesting authorization to file supplemental evidence. Specifically, Patent Owner sought authorization to file (1) a corrected version of Exhibit 2026 ("corrected provisional application") in IPR2024-00286, and (2) a motion to submit evidence that allegedly shows Petitioner has not complied with 37 C.F.R. § 42.51(b)(1)(iii), including with respect to new arguments raised in its reply briefs filed in IPR2024-00286 and IPR2024-00287. *See* Ex. 3002.² Patent Owner also sought a one-week extension of the deadline for its sur-reply briefs in IPR2024-00286 and IPR2024-00287 so that Patent Owner could submit its supplemental evidence with the briefs, or alternatively, Patent Owner sought to "submit a supplemental filing identifying the evidence with a concise statement concerning relevance so that it may be addressed at the hearing." *Id.*

According to the email from Patent Owner's counsel, Petitioner opposed Patent Owner's requests for the following reasons:

First, in its Reply in IPR2024-00286, Petitioner responded to the Exhibit 2026 that was filed by the Patent Owner. Petitioner would be prejudiced if Patent Owner submits a new exhibit in support of its arguments because Patent Owner never filed the provisional application that Patent Owner now wants to introduce and because Petitioner's and Dr. Mowry's arguments were directed to the provision application that Patent Owner filed as Exhibit 2026. Second, Petitioner has not violated 37 CFR 42.51(b)(1)(iii) because none of Dr. Mowry's testimony in this proceeding is inconsistent with anything he testified to before. Motion Offense is belatedly raising this now,

² We cite to exhibits filed in IPR2024-00286. Similar exhibits have been filed in IPR2024-00287.

after having decided not to depose Dr. Mowry regarding his original declaration, thus giving Dropbox no opportunity to respond in its Reply. It would be unfair to allow Patent Owner in its Sur-Reply to accuse Petitioner of not having complied with 37 CFR 42.51(b)(1)(iii) without giving Petitioner an opportunity to respond in a brief. Patent Owner also had a chance to question Petitioner's expert Dr. Mowry on any alleged inconsistent evidence in a deposition after the Board's institution decision but declined to conduct any deposition at that stage of the trial. Further, the PTAB Trial Practice Guide indicates that Patent Owner's Sur-Reply "may not be accompanied by new evidence other than deposition transcripts." 2019 PTAB Trial Practice Guide at 73.

Id.

The Board denied Patent Owner's requests via email on March 20, 2025. Ex. 3002. Specifically, the Board denied as untimely Patent Owner's request to file the corrected provisional application in IPR2024-00286 because Patent Owner failed to file a corrected version of the exhibit in response to a request from the Board dated May 31, 2024. *See id.*; Ex. 3003. The Board also denied as untimely Patent Owner's request to file evidence that allegedly shows Petitioner has not complied with 37 C.F.R. § 42.51(b)(1)(iii) and Patent Owner's request for a one-week extension to submit its sur-reply briefs because the Board already permitted Patent Owner to extend the February 21, 2025 deadline for its sur-reply briefs three times. *See* Ex. 3002. Patent Owner filed its Sur-Reply on March 20, 2025 and requested a conference call with the Board on March 26, 2025. *Id.*

DISCUSSION

The Board held a conference with counsel for the parties to discuss Patent Owner's requests on March 28, 2025. Judges Giannetti, Beamer, and

Raevsky participated in the conference. A court reporter was present on the call. Patent Owner filed a transcript of the conference. *See* Ex. 2054.

Petitioner was represented by Gregory Lantier, and Patent Owner was represented by Derek Dahlgren. Lead counsel for Patent Owner did not participate in the conference. The panel was advised that lead counsel was traveling and unable to participate in the conference call. *Id.* at 8:9–14, 10:9–17. A discussion of the parties’ arguments and our decision is below.³

Corrected version of Exhibit 2026

During the call, Patent Owner renewed its request to file a corrected version of Exhibit 2026 in IPR2024-00286. Patent Owner argued that there is good cause for the correction because back-up counsel for Patent Owner did not receive the Board’s email from May 31, 2024 and its lead counsel did not make back-up counsel aware of the email from the Board. Ex. 2054, 4:14–5:14. Patent Owner offered to file a declaration from lead counsel to explain why Patent Owner did not respond to the Board’s request. *Id.* at 4:23–5:2. Patent Owner argued further that there is good cause for the correction because the correct provisional application number was identified in the table of exhibits and the provisional application is incorporated by reference in other documents in the case. *Id.* at 5:9–21. Patent Owner contended Petitioner would not be prejudiced by the Board granting its

³ We note that Petitioner contends Patent Owner’s sur-reply briefs filed in IPR2024-00286 and IPR2024-00287 include improper new arguments and evidence. *See* Ex. 2054, 20:23–22:7. Petitioner indicated that it intends to file motions to exclude the allegedly improper evidence and arguments according to the scheduling orders in effect in the above-listed cases. *Id.* Accordingly, we do not address those issues at this time.

IPR2024-00286
IPR2024-00287
Patent 11,611,520 B1

request because Petitioner was copied on the May 31, 2024 email from the Board but did not address the issue. *Id.* at 5:22–6:3.

Petitioner opposed Patent Owner’s request. Petitioner contended that regardless of whether Patent Owner had the opportunity to correct Exhibit 2026 earlier in the proceeding, Patent Owner’s request is untimely at this stage. Ex. 2054, 15:14–20. Petitioner contended that it was not the Board’s responsibility to identify the issue with Exhibit 2026 for Patent Owner, and Petitioner would be prejudiced if the Board grants Patent Owner’s request because Petitioner’s briefs address Exhibit 2026, not the corrected provisional application. *Id.* at 15:21–16:6.

We do not find Patent Owner’s arguments persuasive. Good cause does not exist for Patent Owner to file a corrected version of Exhibit 2026 in IPR2024-00286 because Patent Owner’s request is untimely. A lack of diligence on Patent Owner’s part does not constitute good cause for allowing Patent Owner to file a corrected version of a document when Patent Owner failed to do so for almost a year, and the hearing in the proceeding is less than a month away. Filing a corrected exhibit at this late date and under these circumstances would be prejudicial to Petitioner and not in the interests of justice. Accordingly, we *deny* Patent Owner’s request to file a corrected version of Exhibit 2026 in IPR2024-00286.

Evidence that Petitioner has not complied with 37 C.F.R. § 42.51(b)(1)(iii)

Patent Owner requested authorization to file a motion to submit evidence that allegedly shows Petitioner has not complied with 37 C.F.R. § 42.51(b)(1)(iii), including an expert report discussing damages from unrelated district court litigation, documents from the prosecution history of

Petitioner's patents, and testimony from Petitioner's witness, Dr. Mowry. Ex. 2054, 6:17–14:10. Patent Owner sought authorization to file a motion to submit supplemental information because it is in the interests of justice to “make sure that there's a record of the information that [Patent Owner] believe[s] should be included in the record and considered by the board” and “to have that record available for any appellate review.” *Id.* at 7:10–24. Patent Owner argued that it did not discover the expert report discussing damages until March 17, 2025, when it was filed in an unrelated district court case involving Petitioner. *Id.* at 8:9–10:8. Patent Owner contended that while some of the information was publicly available, it was Petitioner's responsibility to bring the information to the attention of Patent Owner and the Board. *Id.* at 12:1–14:10.

Petitioner opposed Patent Owner's request. Petitioner contended that Patent Owner's arguments are untimely and should have been made in the Patent Owner Response because all but one of the materials Patent Owner seeks to file were available to Patent Owner before its Patent Owner Response was due. Ex. 2054, 17:6–22. Petitioner contended it would be prejudiced if the Board grants Patent Owner's request because the hearing in these IPRs is less than a month away. *Id.* at 18:7–20. Petitioner further contended that there are no inconsistencies between Petitioner's positions in these IPRs and the documents Patent Owner seeks to submit. *Id.* at 16:24–17:5, 18:23–19:7.

We are not persuaded that allowing Patent Owner to file a motion to submit supplemental information is in the interests of justice. Patent Owner's request is untimely, and Petitioner would be prejudiced as the

IPR2024-00286
IPR2024-00287
Patent 11,611,520 B1

hearings in these proceedings are less than a month away. We are also not persuaded that Patent Owner would be able to show that the supplemental information reasonably could not have been obtained earlier. Patent Owner admits that most of the evidence was publicly available. Ex. 2054, 13:5–14:10. We are also not persuaded that the recently filed expert report discussing damages is sufficiently material to the issues before us to warrant reopening the evidentiary record at this late stage. The report is from district court litigation that is unrelated to this proceeding, the expert report was not written by Dr. Mowry, and the expert who drafted the report is not a technical witness. *See id.* at 9:9–10:8. Accordingly, we *deny* Patent Owner’s request to file a motion to submit supplemental information in IPR2024-00286 and IPR2024-00287.

ORDER

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner’s request to file a corrected version of Exhibit 2026 in IPR2024-00286 is *denied*; and

FURTHER ORDERED that Patent Owner’s request to file a motion to submit supplemental evidence in IPR2024-00286 and IPR2024-00287 is *denied*.

IPR2024-00286
IPR2024-00287
Patent 11,611,520 B1

FOR PETITIONER:

Trishan Efram
trishan.esram@wilmerhale.com

FOR PATENT OWNER:

George Gordon
Andrew Sherman
andrew@agordonlawfirm.com
asherman@devlinlawfirm.com