

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,

Petitioner

v.

MOTION OFFENSE, LLC,

Patent Owner

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

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
EXCLUDE EVIDENCE**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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I. INTRODUCTION

While styled as a “Motion to Exclude” evidence (“MTE”), Petitioner does not identify any actual evidence that it seeks to exclude from this proceeding. Nor does Petitioner demonstrate how any of the Federal Rules of Evidence require exclusion of any evidence in the proceeding.

Instead, Petitioner’s arguments all seek to strike portions of PO’s Sur-Reply brief. (*See* EX1137.) However, a motion to exclude is not the proper vehicle strike argument in a brief per the Board’s rules; instead, Petitioner should have sought leave to file a motion to strike. Moreover, the arguments Petitioner seeks to exclude generally concern credibility and preserving PO’s arguments with respect to § 42.51(b)(1)(iii).¹ PO is “obligat[ed] to present its concern to the Board and seek relief” to preserve these issues.² Petitioner’s attacks against PO for doing just that are unfounded, as are its assertion that PO’s request was untimely. The timing was within the range that the Federal Circuit has indicated should normally be acceptable.³ Therefore, the MTE should be denied.

II. ARGUMENT

¹ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272-74 (Fed. Cir. 2017).

² *Alivecor, Inc. v. Apple Inc.*, 130 F.4th 1006, ---, 2025 U.S. App. LEXIS 5311, at *26 (Fed. Cir. 2025).

³ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 n.4 (Fed. Cir. 2017) (stating that seeking supplementation within three weeks of hearing normally should be acceptable).

A. The Allegedly “Unfounded Allegations Of A 37 C.F.R. § 42.51(b)(1)(iii) Violation” Are not Evidence to be Excluded

Petitioner does not identify any *evidence* it seeks for exclusion that contains allegedly “unfounded allegations” in PO’s Sur-Reply. Instead, the MTE only cites portions of the Sur-Reply itself along with attorney argument on why those portions should be excluded. (EX1137; MTE at 2-4.)

However, the proper procedure for addressing whether the Sur-Reply includes “unfounded” argument is to request authorization to file a motion to strike, not filing a motion to exclude. *Puzhen Life USA, LLC, v. Esip Series 2, LLC*, IPR2017-02197, Paper 24 at 48 (PTAB February 27, 2019) (denying patent owner’s motion to exclude and noting that the proper procedure would have been to request authorization to file a motion to strike). To the extent Petitioner is asking the Board to treat the MTE as a motion to strike, the Board should decline to do so. *See id.* at 49 (declining to treat a motion to exclude as a motion to strike because patent owner did not request authorization).

Additionally, the arguments Petitioner seeks to exclude generally concern credibility and preserving PO’s arguments with respect to § 42.51(b)(1)(iii).⁴ PO is “obligat[ed] to present its concern to the Board and seek relief” to preserve these

⁴ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272-74 (Fed. Cir. 2017).

issues.⁵ Petitioner’s attacks against PO for doing just that are unfounded, as are its assertion that PO’s request was untimely. The timing was within the range that the Federal Circuit has indicated should normally be acceptable.⁶ Petitioner’s reference to public availability is misleading and irrelevant. Petitioner has substantial prosecution activities worldwide and litigation dockets as well as numerous other public sources where it may make inconsistent representations. Petitioner is not relieved of its obligations under 37 C.F.R. § 42.51(b)(1)(iii) violation by virtue of information potentially being available from some unidentified public source. The Federal Circuit has expressly noted that the duty to comply with Petitioner’s discovery obligations remains with Petitioner.

Moreover, the MTE violates the PTAB Trial Practice Guide (TPG). Because Petitioner fails to identify any exhibits containing improper evidence, it also fails to “[i]dentify where in the record *the evidence sought to be excluded* was relied upon by an opponent” and “Address objections to *exhibits in numerical order.*” (Nov. 2019 TPG at 79.) Petitioner appears to recognize this latter requirement, because it

⁵ *Alivecor, Inc. v. Apple Inc.*, 130 F.4th 1006, ---, 2025 U.S. App. LEXIS 5311, at *26 (Fed. Cir. 2025).

⁶ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 n.4 (Fed. Cir. 2017) (stating that seeking supplementation within three weeks of hearing normally should be acceptable).

trivially numbers its arguments in this section, but again, no exhibits are identified in numerical order.

Nor does Petitioner explain “why the evidence is not admissible (e.g., relevance or hearsay),” other than a conclusory statement that “irrelevant evidence is inadmissible.” (MTE at 1.) This is insufficient, and Petitioner has not met its burden to show that any evidence should be excluded on this basis.

Rather, Petitioner seeks, alternatively, to “address the weight to be given evidence,” or “address arguments or evidence that a party believes exceeds the proper scope of reply or sur-reply,” both of which are prohibited in a motion to exclude. (Nov. 2019 TPG at 79.) *See also Laird Techs., Inc. v. GrafTech Int’l Holdings Inc.*, Case IPR2014-00025, Paper 45 at 42 (P.T.A.B. March 25, 2015) (a motion to exclude “is not an appropriate mechanism for challenging the sufficiency of evidence or the proper weight that should be afforded an argument”).

Moreover, Petitioner’s assertions of “prejudice” ring hollow. (MTE at 5-7.) PO has met the “low threshold for relevancy” that FRE 401 allows, and the Sur-Reply should not be excluded. *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F. 3d 1396, 1407 (Fed. Cir. 1997). *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 n.4 (Fed. Cir. 2017) (seeking supplementation within three weeks of hearing generally acceptable). Tellingly, Petitioner fails to articulate what the prejudice is. For example, Petitioner alleges that “any probative value . . . is clearly outweighed

by the risk of prejudice because Petitioner does not have a full and fair opportunity to respond to these late-made assertions.” (MTE at 3.) However, as set forth in further detail below, the specific “unfounded allegations of a 37 C.F.R. § 42.51(b)(1)(iii) violation” are not “unfounded”:

- First, PO’s argument that Petitioner’s characterizations of Garcia between the -286 IPR and this proceeding are inconsistent is not “unfounded.” PO cited specific paragraphs from both proceedings to show inconsistencies. Petitioner is free to address these discrepancies between its arguments at the hearing.
- Second, the fact that Dropbox pointed to the statement “When the contact clicks on the link to folder 1115, the contents of the folder are shared with the contact” as support for claims that delivered content to the contact in response to the contact in response to selecting the link should not be surprising to Petitioner or prejudice it. PO was merely highlighting the inconsistencies between its arguments during prosecution of successive patent applications based on Garcia and its arguments in this proceeding. Petitioner can hardly claim surprise from a description of its characterizations of Garcia in other proceedings.
- Third, the fact that Petitioner’s patent applications directed to file request functionality and filed years later demonstrate that Petitioner’s arguments

are based on pure hindsight is neither unfounded nor untimely. Petitioner overlooks PO's EX2003, which as is an example of such a file request patent applied for and granted to Petitioner. (See also POPR at 31.) There is no surprise or prejudice here.

- Fourth, PO's observation that "Petitioner has not served any information as routine discovery and . . . it is exceedingly unlikely that Petitioner has no inconsistent information with its positions in this proceeding" is neither evidence to be excluded nor untimely or prejudicial. Notably, Petitioner cannot dispute this statement or identify any routine discovery it produced. Nor does Petitioner dispute that it has available to it significant information about Garcia and its progeny, and its other file request patent applications. There is no prejudice from this statement.
- Petitioner's expert Dr. Mowry has made numerous inconsistent representations along with Petitioner as exemplified in the parties correspondence and the numerous examples identified by PO, which are incorporated herein by reference. PO also incorporates its responses to Petitioner's MTE in the co-pending IPR with respect to each alleged issue set forth in Petitioner's MTE.

Indeed, other than its blanket statement that it "does not have a full and fair opportunity to respond," Petitioner does not identify any actual prejudice to it from

the statements it seeks to exclude. For example, Petitioner does not elaborate on what, if any, arguments it could have made in rebuttal or the factual bases for those statements, and again fails to provide any routine discovery to address PO's concerns. The arguments Petitioner seeks to exclude generally concern credibility and preserving PO's arguments with respect to § 42.51(b)(1)(iii).⁷ PO is "obligat[ed] to present its concern to the Board and seek relief" to preserve these issues.⁸ Petitioner's attacks against PO for doing just that are unfounded, as are its assertion that PO's request was untimely. The timing was within the range that the Federal Circuit has indicated should normally be acceptable.⁹ To the extent anything included in Petitioner's MTE concerns patents or printed publications, PO notes that Petitioner is responsible for providing copies of all patents and printed publications relied on under 35 U.S.C. § 312 in addition to the other requirements specified therein.¹⁰

⁷ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272-74 (Fed. Cir. 2017).

⁸ *Alivecor, Inc. v. Apple Inc.*, 130 F.4th 1006, ---, 2025 U.S. App. LEXIS 5311, at *26 (Fed. Cir. 2025).

⁹ *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1273 n.4 (Fed. Cir. 2017) (stating that seeking supplementation within three weeks of hearing normally should be acceptable).

¹⁰ PO reserves the right to supplement or amend or revise its response to the fullest extent allowed. PO reserves all rights and nothing contained herein is to be considered a waiver or forfeiture of any right. PO has responded proportionally to the level of specificity provided by Petitioner and reserves the right to respond to any Reply Petitioner may file or otherwise.

III. CONCLUSION

For the foregoing reasons, Petitioner's Motion to Exclude should be denied in its entirety.

Dated: April 11, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that there are 1,625 words in this paper, excluding any table of contents, table of authorities, mandatory notices under 37 C.F.R. § 42.8, certificate of word count, certificate of service, or appendix of exhibits. This certification relies on the word count of the word-processing system used to prepare this paper.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on April 11, 2025, the foregoing document is being served via the Patent Office electronic filing system, and electronic mail upon the following counsel of record for Petitioner:

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