

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DROPBOX, INC.,
Petitioner,

v.

MOTION OFFENSE, LLC,
Patent Owner.

IPR2024-00287
Patent 11,611,520 B1

Before THOMAS L. GIANNETTI, JENNIFER S. BISK,
and NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)
Dismissing Petitioner's Motion to Exclude
37 C.F.R. § 42.64

I. INTRODUCTION

On January 22, 2024, Dropbox, Inc. (“Petitioner”) filed a Petition (“Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 9–16 and 22–24 of U.S. Patent No. 11,611,520 B1 (“the ’520 patent”). Paper 4. On April 30, 2024, Motion Offense, LLC (“Patent Owner”) responded by filing a Preliminary Response, pursuant to 35 U.S.C. § 313. Paper 10. On July 25, 2024, we instituted *inter partes* review. Paper 11. Subsequently, Patent Owner filed a Response (“PO Resp.”), Petitioner filed a Reply (“Reply”), and Patent Owner filed a Sur-Reply (“Sur-Reply”). Papers 20, 27, 36. According to the Sur-Reply, claim 13 has been disclaimed. Sur-Reply 5, n. 5. An oral hearing was held on April 23, 2025, and a copy of the transcript was entered into the record. Paper 45 (“Tr.”).

Additionally, Petitioner filed a Motion to Exclude Evidence (Paper 40), to which Patent Owner filed an Opposition (Paper 41), and Petitioner filed a Reply (Paper 44).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a). Based on the complete record, we find that Petitioner has shown, by a preponderance of the evidence, that claims 9–12, 14–16 and 22–24 of the ’520 patent are unpatentable. We also dismiss as moot Petitioner’s Motion to Exclude.

II. BACKGROUND

A. *The ’520 Patent*

The ’520 patent is titled “Methods, Systems, and Computer Program Products for Processing a Data Object Identification Request in a

Communication.” Ex. 1101, code (54). The ’520 patent is a continuation-in-part of, *inter alia*, U.S. Patent Applications Nos. 13/624,906 and 13/626,635 (“the ’906 application” (Ex. 2004) and “the ’635 application” (Ex. 2002), respectively). *Id.* at code (63). Both applications are incorporated by reference into the ’520 patent in their entirety. *Id.* at 1:53–62. The subject matter of the challenged claims appears to most closely track a so-called “File Request” embodiment primarily disclosed in the ’906 application.¹ *See* Pet. 1; PO Resp. 2.

The ’520 patent purports to address “a need for methods, systems, and computer program products for processing a data object identification request in a communication.” Ex. 1101, 2:13–15. Generally, the file request embodiment involves a first user requesting a file from second user by sending a first email identifying matching criterion for the file, to which the second user responds with a second email containing a file “identification response” (such as a URL link to the file), but not the file itself. *Id.*, Figs. 2A, 2B, ¶ 179.

In particular, a pertinent exemplary process is illustrated starting with Figure 6A, reproduced below.

¹ We make no findings here as to the sufficiency of written description support for the challenged claims, including whether support for the claimed subject matter is properly based on the prior applications incorporated by reference.

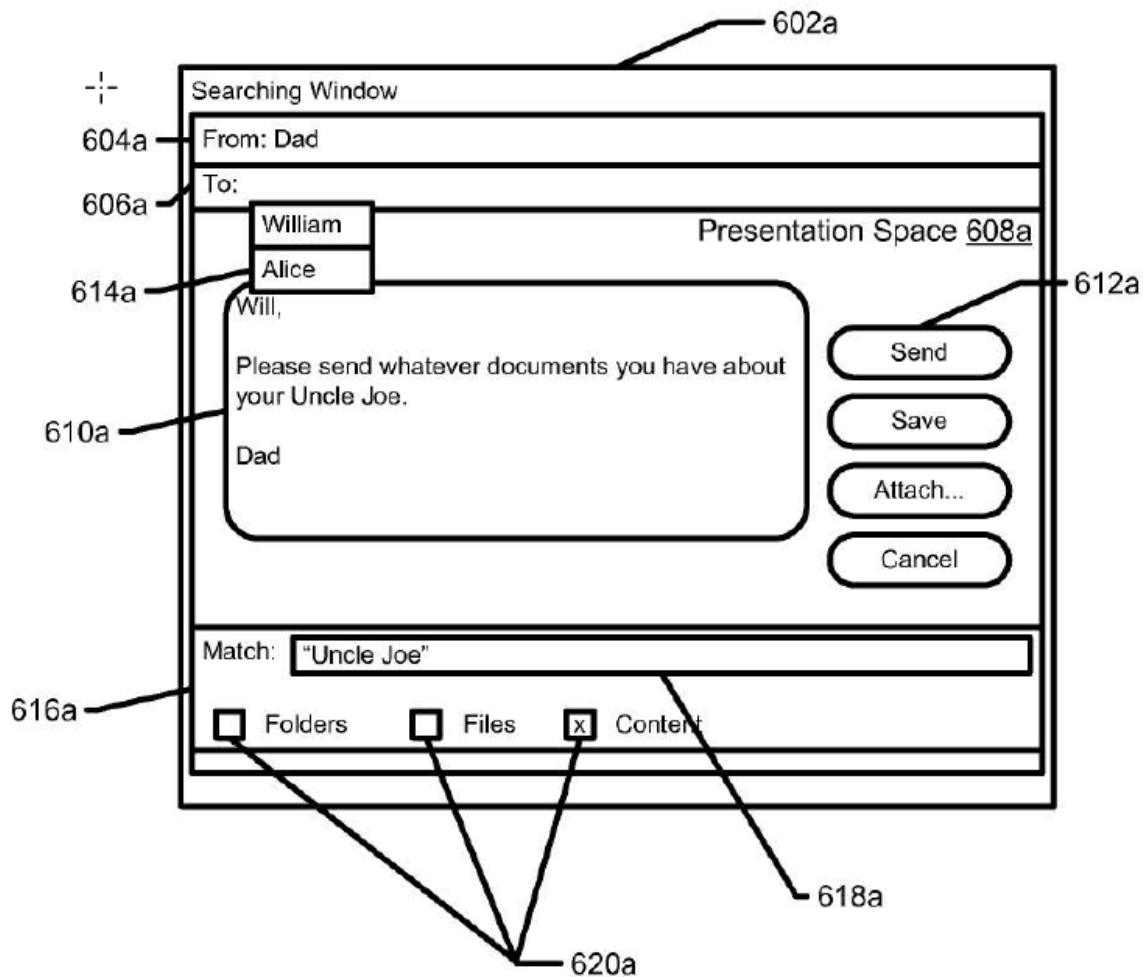


FIG. 6A

Figure 6A is a user interface including communications agent window 602a. Ex. 2004 ¶¶ 20, 111.

Communications agent window 602a includes contactor UI element 604a (“Dad”), contactee UI element 606a (“William”), user message UI element 610a and send UI element 612a in presentation space 608a, and data object information UI element 616a that includes match textbox UI element 618a. Ex. 2004 ¶¶ 111, 125, 126. Textbox 618a allows a user to enter a keyword expression for a data object identification request (in this example, the request is for files containing the text, “Uncle Joe”). *Id.* ¶ 126. A request

can also include, *inter alia*, date and/or time criteria. *Id.* ¶ 180. Selecting send UI element 612a causes a first message including the data object identification request to be sent to the contactee. *Id.* ¶ 111.

Figure 6D depicts the first message and is reproduced below.

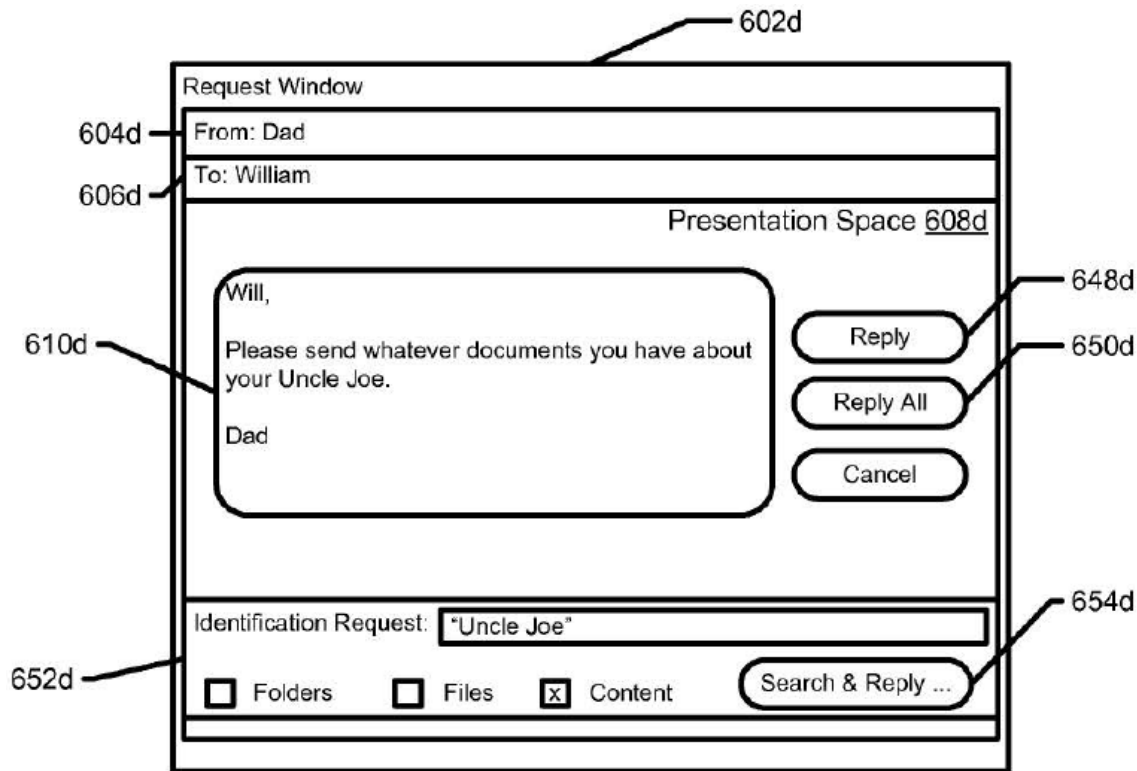


FIG. 6D

Figure 6D is request window UI element 602d, presenting a message received from contactor Dad (604d) to contactee William (606d). Ex. 2004 ¶¶ 23, 166.

Presentation space 608d of request window 602d includes user message UI element 610d, which includes a text portion of the message provided by contactor 604a, and reply UI element 648d. Ex. 2004 ¶ 166. Data object identification request UI interface element 652d includes the data object identification request (“Uncle Joe”) submitted by contactor Dad. *Id.*

Contactee William authorizes the request by selecting search and reply UI element 654d. *Id.*

Figure 6E is reproduced below.

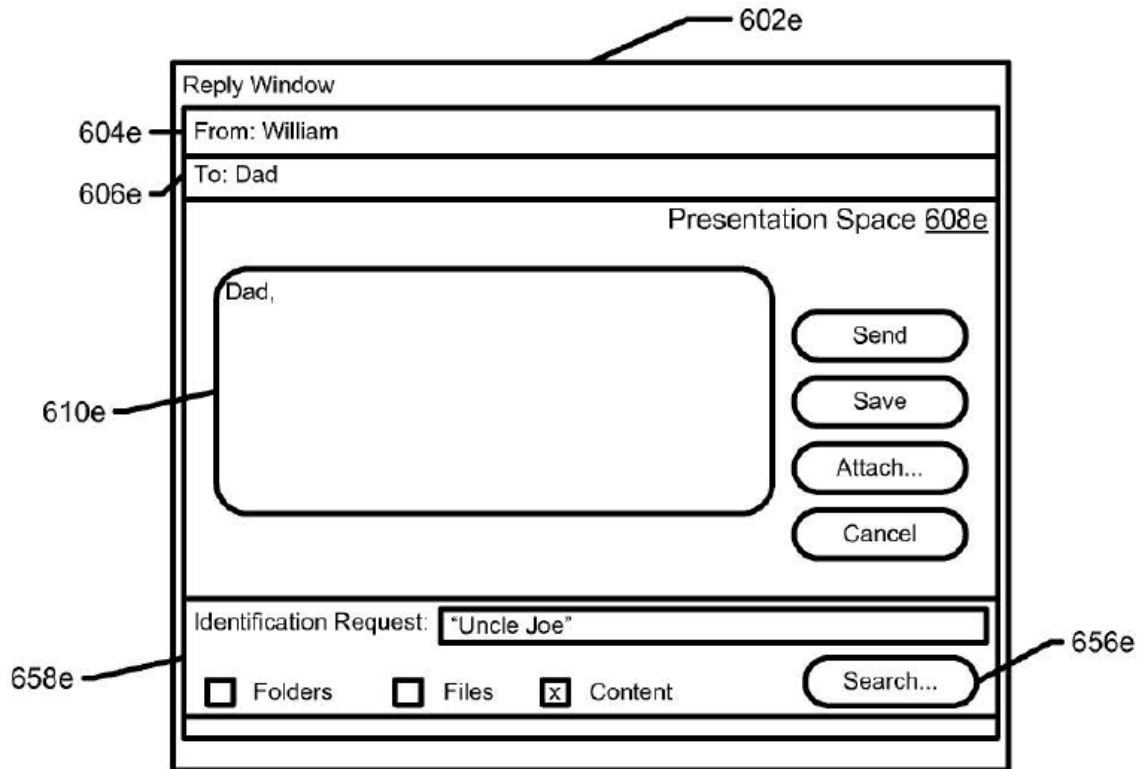


FIG. 6E

Figure 6E is reply window UI element 602e, presented when contactee William selects reply UI element 648d of Figure 6D. Ex. 2004 ¶¶ 24, 167.

Search UI element 656e of reply window UI element 602e is selected to locate data objects that match the data object identification request provided in data object identification (“Uncle Joe”) requested UI element 658e. Ex. 2004 ¶ 167.

Figure 6F is reproduced below.

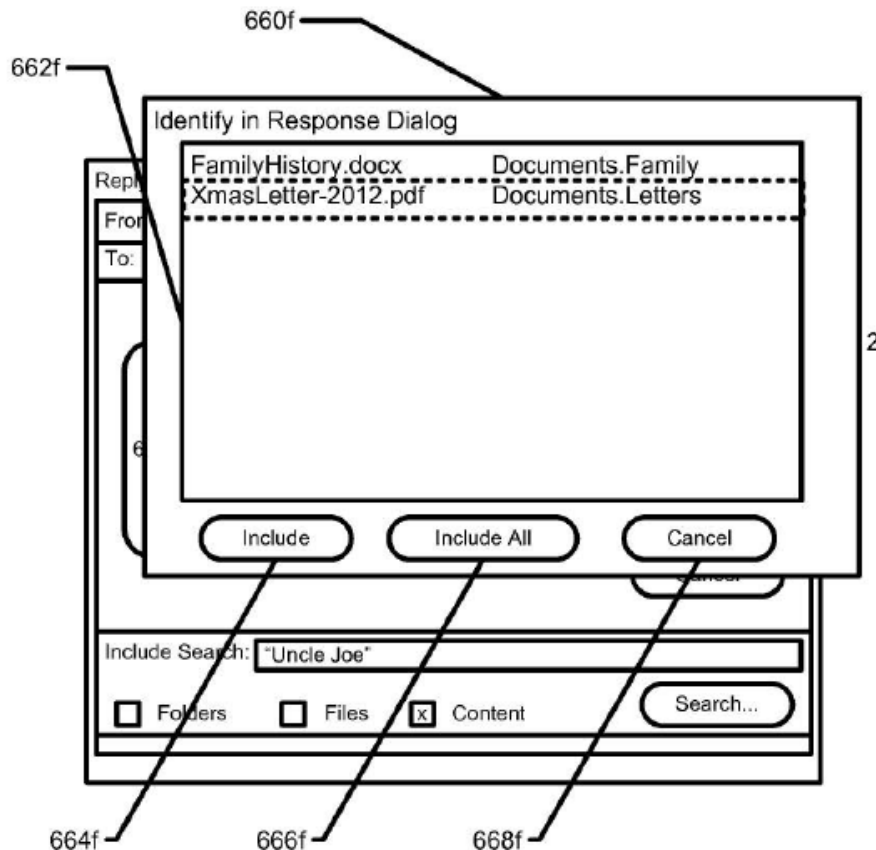


FIG.6F

Figure 6F is identify in response dialog UI element 660f, presented when contactee William selects Search UI element 656e of Figure 6E. Ex. 2004 ¶¶ 25, 172.

Identify in response dialog UI element 660f includes results pane UI element 662f including representations of two files (“FamilyHistory.docx” and “XmasLetter-2012.pdf”) identified by a query based on the data object identification request “Uncle Joe.” Ex. 2004 ¶ 172. Contactee William can select the files to be included in a data object identification response by using include UI element 664f or include all UI element 666f. *Id.* Once the files are selected, then selection of the Send UI element (unnumbered) in

reply window UI element 602e of Figure 6E triggers a data object identification response back to original contactor (Dad) in the form of a second message. *Id.* ¶ 137.

Figure 6B depicts the second message and is reproduced below.

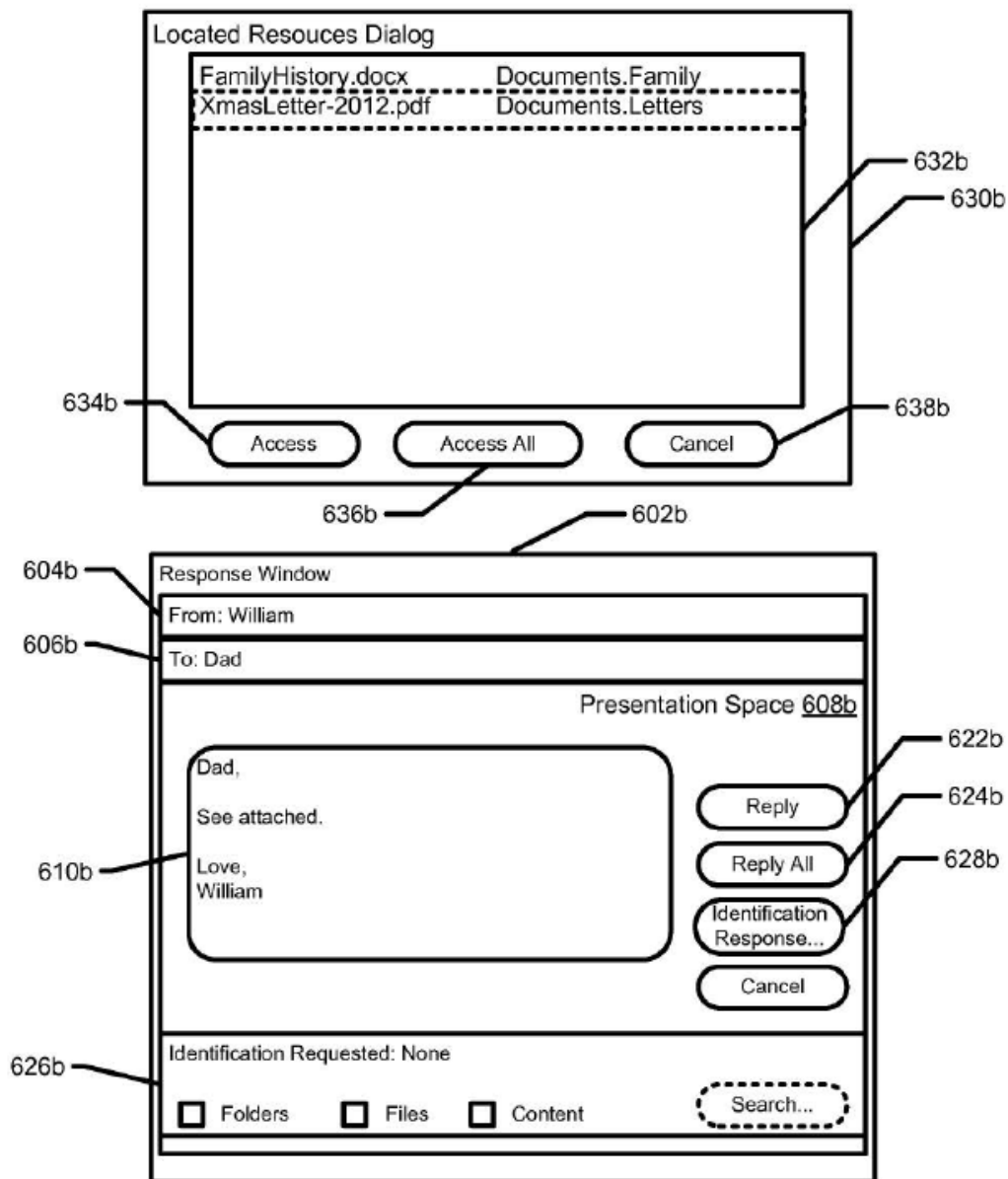


Figure 6B depicts response window UI element 602b and located data resources dialog UI element 630b. Ex. 2004 ¶¶ 21, 146–147.

Response window UI element 602b depicts the second message response back to original contactor (Dad), here listed in contactee UI element 606b, with element 602b further depicting contactor UI element 604b (“William”) and presentation space 608b containing user message UI element 610b, reply UI element 622b, and data object identification response UI element 628b. Ex. 2004 ¶¶ 146–147.

This second message is in a MIME email format illustrated in Figure 8B reproduced below.

800b

```
MIME-Version: 1.0
Content-Type: multipart/mixed; boundary="--toOo---OoOt-----"

--toOo---OoOt-----
Content-Type: text/plain
Dad,

See attached.
Love,
William
--toOo---OoOt-----
Content-Type: application/query-response

FILE://Documents/Family/FamilyHistory.docx
FILE://Documents/Letters/XmasLetter-2012.pdf
--toOo---OoOt-----
```

The diagram illustrates the structure of a MIME email message. A bracket labeled 802b groups the text portion of the message, including the header, the body text ("Dad, See attached. Love, William"), and the closing boundary line. A line labeled 806b points to the "Content-Type: application/query-response" header. A bracket labeled 804b groups the list of URIs at the bottom of the message.

FIG. 8B

Figure 8B includes an exemplary content portion 800b of an email message, including user readable message portion 802b and data object identification response portion 804b, which is as a list of URIs (Uniform Resource Identifiers) identifying data objects in a file system of the contactee’s environment (*i.e.*, “FamilyHistory.docx” and “XmasLetter-2012.pdf”). Ex. 2004 ¶¶ 137, 179.

Selecting data object identification response UI element 628b in Figure 6B presents located data resources dialog UI element 630b (the upper window in Figure 6B) that includes presentation space 632b for presenting a user detectable representation of the data objects identified in the received data object identification response from the original contactee (“William”) (in this example, “FamilyHistory.docx” and “XmasLetter-2012.pdf”). *Id.* ¶ 147. The data objects themselves are not included in the second message — rather, representations of the identified data objects are presented. *Id.* A “representation” is described, for example, as a window or other visual interface element displayed on a screen of a display presenting information representing a program entity such as a file. *Id.* ¶¶ 47–52, 69.

Selection of access UI element 634b in located data resources dialog UI element 630b allows a request of data objects identified in the data object identification response, which request is sent to original contactee via a third message, in response to which the requested objects are sent as attachments to the original contactor via a fourth message. *Id.* at Fig. 7, ¶¶ 148–149, 153–154, 156, claim 10.

Figure 6G is reproduced below.

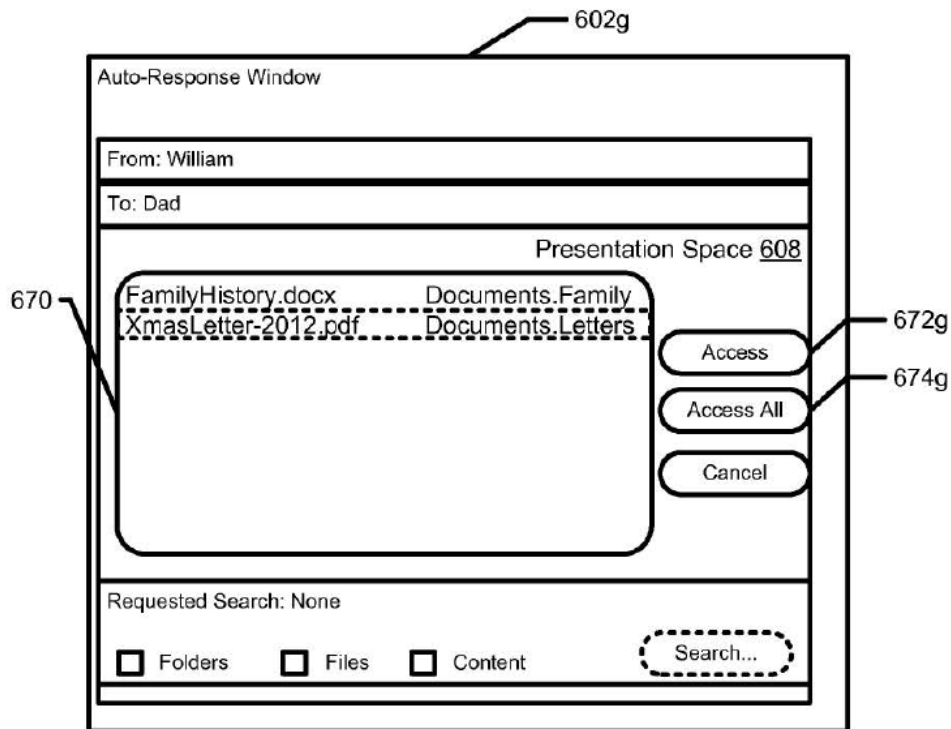


Figure 6G depicts auto-response window UI element 602g. Ex. 2004 ¶¶ 26, 150.

Auto-response window 602g is an alternative to the approach of Figure 6B, and is presented in response to a data object identification response received from the original contactee (“William”) without a user message. Ex. 2004 ¶ 150. Results pane UI element 670g displays representation of the located data objects (“FamilyHistory.docx” and “XmasLetter-2012.pdf”), and UI elements 672g-674g allow original contactor (Dad) to request the retrieval of one or more data objects identified in the data object identification response. *Id.*

B. Illustrative Claim

Independent claims 9 and 22 are representative and are reproduced below.²

9. An apparatus, comprising: at least one non-transitory memory storing instructions; and one or more processors in communication with the at least one non-transitory memory, wherein the one or more processors execute the instructions to:

- [a]: cause, at a first node, display of a first interface with a first user interface element and a second user interface element, the first interface for use in creating a file request requesting at least one file;
- [b]: receive, from the first node via at least one network, a file description via the first user interface element that includes a textbox, utilizing the first interface, the file description describing the at least one file in connection with the file request;
- [c]: receive, from the first node via the at least one network, an indication of at least one of a date or a time via the second user interface element, utilizing the first interface;
- [d]: cause, at the first node, display of a second interface with a third user interface element and a fourth user interface element, the second interface for use in causing the file request to be sent;
- [e]: receive, from the first node via the at least one network, indicia associated with at least one email address via the third user interface element, utilizing the second interface, the at least one email address for being used to send the file request;
- [f]: receive, from the first node via the at least one network, an indication of a selection of the fourth user

² The bracketed letters and paragraph arrangement are taken from the Petition but do not impact our analysis. Pet. 84–87.

interface element, utilizing the second interface, where the receipt of the indication of the selection of the fourth user interface element indicates that the file request is to be caused to be sent;

- [g]: in response to the receipt of the indication of the selection of the fourth user interface element and based on the file description, the indication of the at least one of the date or the time, and the indicia associated with the at least one email address; generate a first message addressed to the at least one email address and including the file request, the first message indicating the at least one of the date or the time on which the file request is based, and further including a fifth user interface element and at least one sentence including the file description describing the at least one file in connection with the file request;
- [h]: send, to a second node via the at least one network, the first message;
- [i]: receive, from the second node via the at least one network, an indication of a selection of the fifth user interface element of the first message, where the receipt of the indication of the selection of the fifth user interface element indicates that the at least one file is to be uploaded in response to the file request;
- [j]: in response to the receipt of the indication of the selection of the fifth user interface element, cause, at the second node, display of a third interface with a sixth user interface element and a seventh user interface element, the third interface for use in uploading the at least one file in response to the file request;
- [k]: receive, from the second node via the at least one network, an indication of a selection of the seventh user interface element, utilizing the third interface;
- [l]: in response to the receipt of the indication of the selection of the seventh user interface element,

generate a second message that includes an eighth user interface element, and that does not include a file attachment with the second message, the second message indicating that the file request has been responded to;

[m]: send, to the first node via the at least one network, the second message;

[n]: receive, from the first node via the at least one network, an indication of a selection of the eighth user interface element of the second message;

[o]: in response to the receipt of the indication of the selection of the eighth user interface element of the second message, cause, at the first node, display of at least one fourth interface with a reference to the at least one file for allowing access to the at least one file at the first node.

Ex. 1101, 51:21–52:37.

22. A method, comprising:

22[a]: causing, at a first node, display of: a first user interface element that includes a textbox, for collecting a file request description for at least one file,

22[b]: a second user interface element, for enabling collection of an indication of at least one of a date or a time,

22[c]: a third user interface element, for collecting at least one object associated with at least one email address, the at least one object associated with at least one email address being the at least one email address or an alias associated with the at least one email address, and

22[d]: a fourth user interface element, for detecting an indication of a selection thereof to cause an initiation of a request for the at least one file;

22[e]: causing generation of a first email, based on the file request description for the at least one file, the at least

one object associated with the at least one email address, and the detection of the indication of the selection of the fourth user interface element to cause the initiation of the request for the at least one file, where the first email includes: at least one sentence including the file request description for the at least one file, and a fifth user interface element for detecting an indication of a selection thereof;

22[f]: based on the detection of the indication of the selection of the fifth user interface element of the first email, causing, at the second node, display of: a sixth user interface element, for collecting an indication of at least one file, and

22[g]: a seventh user interface element, for detecting an indication of a selection thereof;

22[h]: receiving, from the second node and at at *[sic]* least one server, a signal for causing creation of a first representation of the at least one file, in a location among one or more folders, that is stored at the at least one server and that is displayable via at least one web page;

22[i]: causing generation of a second email, based on the detection of the indication of the selection of the seventh user interface element, where the second email: includes an eighth user interface element for detecting an indication of a selection thereof, does not include a file attachment, for permitting avoidance of the at least one file from being communicated to and stored at the first node via the second email, is at least partially pre-written, and is automatically caused to be received without requiring further user involvement after the detection of the indication of the selection of the seventh user interface element;

22[j]: causing, at the first node, receipt of the at least one web page, that results in display, at the first node and via the at least one web page, of a file structure that

permits access to the first representation of the at least one file that is stored at the at least one server;

22[k]: causing, at the first node, receipt of code for storage at the first node and cooperation with a file explorer interface of a client-based file explorer application, for being utilized to: based on the detection of the indication of the selection of the seventh [*sic* — eighth] user interface element, cause creation of a second representation of the at least one file, in a location among one or more folders, that is stored at the first node and that is displayable via the file explorer interface of the client-based file explorer application.

Ex. 1101, 56:9–57:11.

C. Asserted Grounds

Petitioner asserts that claims 9–16 and 22–24 are unpatentable based on the following grounds.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
9, 10, 14, 15	103(a)	Riepling ³
11–13, 16, 22–24	103(a)	Riepling, Manzano ⁴
9, 10, 14, 15	103(a)	Riepling, Meisels ⁵
11–13, 16, 22–24	103(a)	Riepling, Manzano, Meisels

³ U.S. Patent Application Publication 2013/0046833 A1 (Ex. 1107) (“Riepling”).

⁴ U. S. Patent Application Publication No. 2010/0005138 A1 (Ex. 1105) (“Manzano”).

⁵ U.S. Patent Application Publication No. 2012/0278404 A1 (Ex. 1108) (“Meisels”).

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
11–13, 16, 22–24	103(a)	Riepling, Manzano, Garcia, ⁶
11–13, 16, 22–24	103(a)	Riepling, Manzano, Meisels, Garcia

Pet. 6.⁷ In support of its patentability challenge, Petitioner relies on, *inter alia*, the Declaration of Todd Mowry, Ph.D. and the Second Declaration of Todd Mowry, Ph.D. Ex. 1102 (“Mowry Decl.”); Ex. 1127 (“Mowry 2nd Decl.”).

D. Real Parties in Interest

The parties identify themselves as the real parties-in-interest. Pet. 2; Paper 7, 2.

E. Related Proceedings

The parties identify *Motion Offense, LLC v. Dropbox, Inc.*, No. 6:20-cv-00251 (W.D. Tex.); *Motion Offense, LLC v. Dropbox, Inc.*, No. 6:23-cv-0303 (W.D. Tex.); and *Dropbox, Inc. v. Motion Offense, LLC*, IPR2024-00286 (PTAB) as related proceedings. Pet. 2; Paper 7, 2.

⁶ U.S. Patent No. 9,633,125 B1 (Ex. 1104) (“Garcia”).

⁷ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included amendments to 35 U.S.C. §§ 102 and 103 that became effective after the filing of the ’906 and ’635 applications. Petitioner relies only on prior art predating these applications, although it reserves the right to argue that the ’520 patent is not entitled to the filing dates of those applications. Pet. 5, n.1; Paper 45, 13:24–14:2. We apply the pre-AIA version of Section 103, although application of the AIA version would not alter our analysis.

III. ANALYSIS OF PETITIONER'S GROUNDS

A. *Legal Standards*

To prevail in its grounds for unpatentability, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (2012) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to the patent owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective indicia of non-obviousness (also called secondary considerations), such as

commercial success, long-felt but unsolved needs, and failure of others.⁸ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). We analyze the grounds based on obviousness in accordance with the above-stated principles.

B. Level of Skill in the Art

In determining whether an invention would have been obvious at the time it was made, 35 U.S.C. § 103(a) requires us to resolve the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). Factors that may be considered in determining the level of ordinary skill in the art include, but are not limited to, the types of problems encountered in the art, the sophistication of the technology, and educational level of active workers in the field. *Id.* In a given case, one or more factors may predominate. *Id.*

Petitioner asserts that a person of ordinary skill in the art at the time of the earliest claimed priority date of the '520 patent (September 22, 2012):

would have had at least the equivalent of a Bachelor's degree in electrical engineering, computer science, or a related field and two or more years of experience in a related field such as networked computer systems using Internet protocols. Less work experience may be compensated by a higher level of education, such as a Master's Degree, and vice versa.

Pet. 3–4 (citing Mowry Decl. ¶ 29). Patent Owner does not

⁸ No evidence of objective indicia of non-obviousness is of record concerning the challenged claims.

dispute Petitioner's definition. PO Resp. 7.

Petitioner's proposal is consistent with the level of ordinary skill in the art as reflected by the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *GPAC*, 57 F.3d at 1579. We apply Petitioner's articulation.

C. Claim Construction

The Petition was accorded a filing date of January 22, 2024. Paper 5, 1. In an *inter partes* review for a petition filed on or after November 13, 2018, a claim "shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b)." 37 C.F.R. § 42.100(b). We apply the claim construction standard from *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (*en banc*). Claim terms need only be construed to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Petitioner submits that no claim construction is necessary. Pet. 13. However, Patent Owner asserts that the phrase, "representation of the at least one file," in various claims should be construed as:

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.

PO Resp. 15. Thus, argues Patent Owner:

[E]ach representation of a file is different than an ordinary file for two reasons: (1) the representation's file contents are stored not at the user's node but instead remotely, despite the representation being displayed at the user's node; and (2) the

representation's file contents are not communicated to the user till the user initiates a request for them.

Id. at 15–16 (citing Smith Decl. ¶ 59).⁹ Patent Owner argues that a representation of a file is itself a file because claim 22 requires the representation to be stored “in a location among one or more folders,” either on a “server” or at a “node.” *Id.* at 17 (citing Smith Decl. ¶ 63). Patent Owner also argues that the “representation[s] of the at least one file” do not contain the contents of the files when the representations are first created, based on the claim 22[i] requirement that the second email “does not include a file attachment, for permitting avoidance of the at least one file from being communicated to and stored at the first node via the second email.” *Id.* at 18–19 (citing Smith Decl. ¶ 66). Patent Owner argues that this claim requirement means that the file contents corresponding to a representation are not stored at the requesting user's location when the representation is created. *Id.*

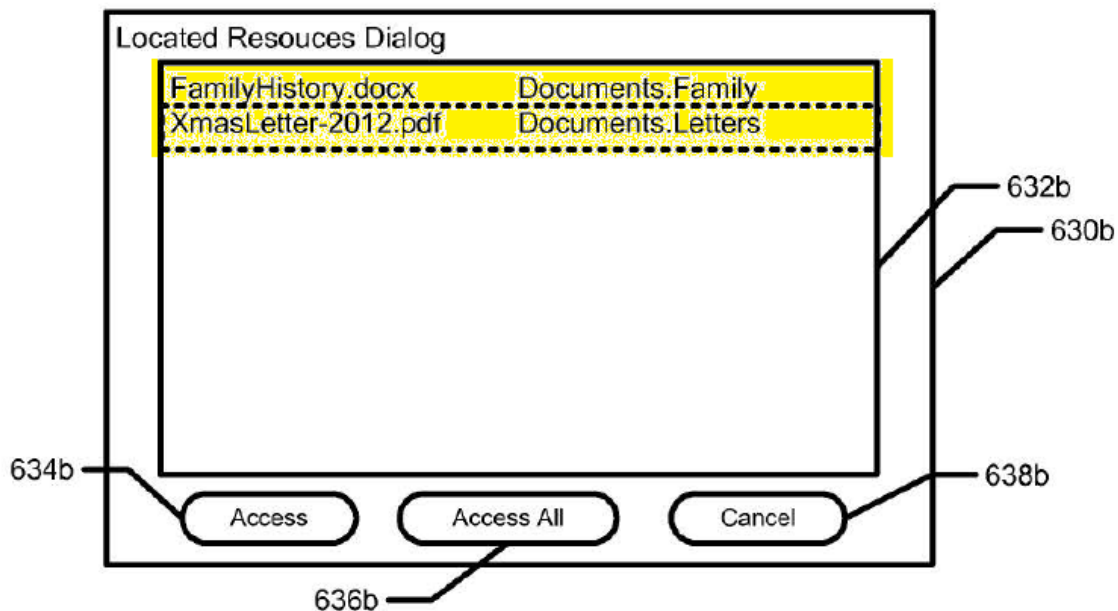
Patent Owner further argues that its construction is supported by dependent claim 16, which specifically requires that the first node does not store the file when its representation is created, but only when it requested by the user. PO Resp. 19–21 (citing Smith Decl. ¶ 68). Patent Owner similarly relies on dependent claim 12, with commensurate requirements, in support of its construction. *Id.* at 21 (citing Smith Decl. ¶ 70). In addition, Patent Owner relies on portions of the '635 priority application which claim or describe “creating . . . a representation of the data object at the location

⁹ “Smith Decl.” refers to Exhibit 2005, the Declaration Of Dr. Michael Smith, submitted by Patent Owner in support of its Response.

[in a first data store], wherein accessing the representation includes accessing the data object from the second data store.” *Id.* at 22–24 (citing Ex. 2002, cl. 1, ¶¶ 8–13, 109, 135; Smith Decl. ¶¶ 71–74). Patent Owner argues that this means that “the contents of the file representation are stored remotely (i.e., ‘in a second data store’) rather than at the user’s node and are not accessed by the user till the user accesses the representation.” *Id.* at 23.

In reply, Petitioner argues that Patent Owner’s construction is unnecessary to resolve the issues, that a representation of a file is simply a “sign or symbol that stands in the place of” a file, that it makes no sense to equate a representation of a file with the file itself, that the additional wording that Patent Owner would include in its construction is already explicitly recited in some of the claims, and that disclosures in the ’635 priority application do not preclude communication of data objects separate from the “accessing” referred to. Reply 2–5 (citing Mowry 2nd Decl. ¶¶ 13–23).

We conclude that there is no basis for Patent Owner’s proposed construction of “representation of the at least one file.” Petitioner is correct that a representation of a file is not the file itself, but (in keeping with the ordinary meaning of “representation”) is rather some sign or symbol that stands for the folder. Reply 2. This is confirmed by the explicit example of a representation of a folder in the ’906 application, illustrated in the portion of Figure 6B reproduced below (highlighted here for purposes of explanation).



This portion of Figure 6B depicts representations of two files: “FamilyHistory.docx” and “XmasLetter-2012.pdf.” The ’906 application specifically states:

[A] located data resources dialog UI element 630b . . . includes a presentation space 632b for presenting a user detectable **representation** of some or all of the data objects identified in the received data object identification response from . . . second node 504.

Ex. 2004 ¶ 147 (emphasis added). The entries in the above figure are representations of the files, not the files themselves. The actual files are stored in the file system storage associated with the user’s node, and only retrieved if the user selects the “Access” or “Access All” elements. *Id.* ¶ 148.

Patent Owner misconstrues the claim 22 language, “a first representation of the at least one file, in a location among one or more folders, that is stored at the at least one server” and “a second representation of the at least one file, in a location among one or more folders, that is stored

at the first node.” Patent Owner infers from this language that the representation is itself a file that is “in a location among one or more folders” and is stored on a server or at a node. PO Resp. 17. Not so — the representation of a file, such as “FamilyHistory.docx” in the above figure, is not stored at a server or node, but rather is simply displayed on a screen. As the ’906 application states:

A representation of a program entity may be stored and/or otherwise maintained in a presentation space. As used in this document, the term “presentation space” refers to a storage region allocated and/or otherwise provided for storing presentation information A screen of a display, for example, is a presentation space.

Ex. 2004 ¶ 51. Thus, we find that the language, “representation of the at least one file, in a location among one or more folders, that is stored at the at least one server [or node],” is properly read to mean that it is the file, not its representation, that is “in a location among one or more folders” and that is stored on a server or node.

Patent Owner’s reliance on claim language that provides that file content is stored remotely and is not communicated to the user till the user initiates the communication is not persuasive. Given that the claims explicitly impose this requirement, there is no need to further construe “representation of the at least one file” to also impose that requirement.

Accordingly, we do not adopt Patent Owner’s proposed claim construction.

D. Alleged Obviousness of Claims 9, 10, 14, and 15 over Riepling and Meisels

Petitioner challenges claims 9, 10, 14, and 15 as obvious Riepling alone, and in the alternative over the combination of Riepling and Meisels. Pet. 14–49, 65–71. We need only consider the alternative ground based on the combination Riepling and Meisels.

1. Riepling

Riepling, titled “Method And System For Sending A Digital Invitation Requesting A Data Upload,” is an application published February 21, 2013, and filed August 16, 2011.¹⁰ Ex. 1107, codes (54), (43), (22). Riepling is directed to a content sharing service including sending, to a contact, a digital invitation requesting a data upload. *Id.* at Abstr., ¶ 7. Riepling Figure 2 is reproduced below.

¹⁰ Patent Owner argued in its response that the Riepling application was not prior art because it was abandoned and thus not entitled to its filing date. PO Resp. 31–36. However, in light of *Lynk Labs, Inc. v. Samsung Elecs. Co., Ltd.*, 125 F.4th 1120 (Fed. Cir. 2025), which rejects the theory that Patent Owner relied on, Patent Owner has withdrawn that argument for this Proceeding. Sur-Reply 9; Paper 45, 24:19–22.

Fig. 2

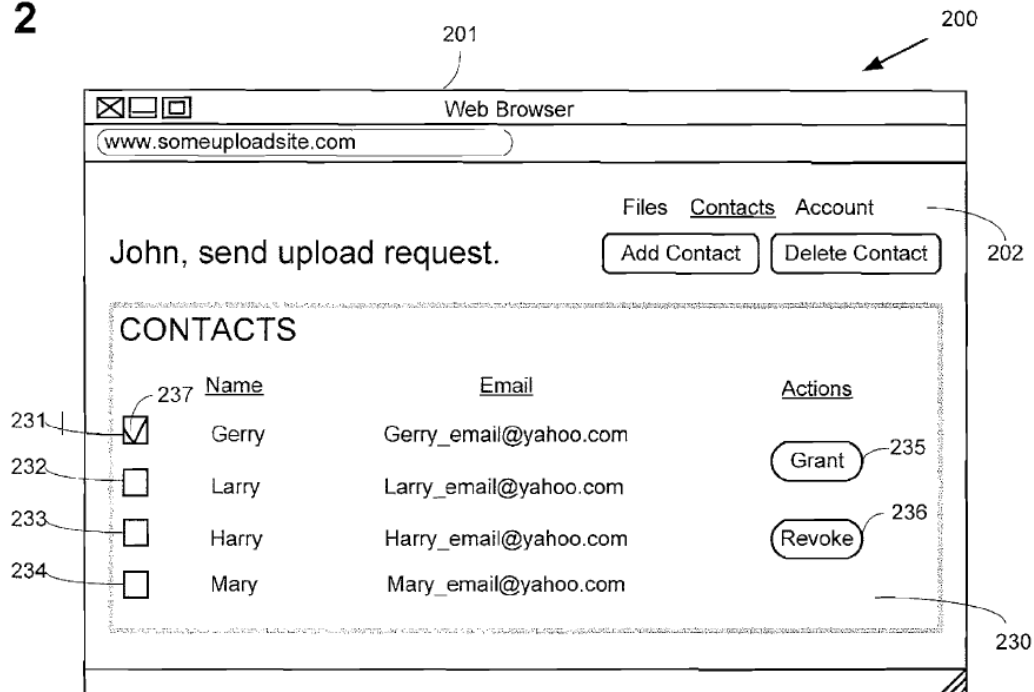


Figure 2 depicts a web browser request interface 201 for selecting a contact to receive a digital invitation requesting a data upload. Ex. 1107 ¶¶ 11, 24.

In this example, by selecting email address box 231 and grant access button 235, user John grants user Gerry access to a server, and designates Gerry's email to receive an invitation to upload files to the server. Ex. 1107 ¶¶ 24, 26.

Riepling Figure 3 is reproduced below.

Fig. 3

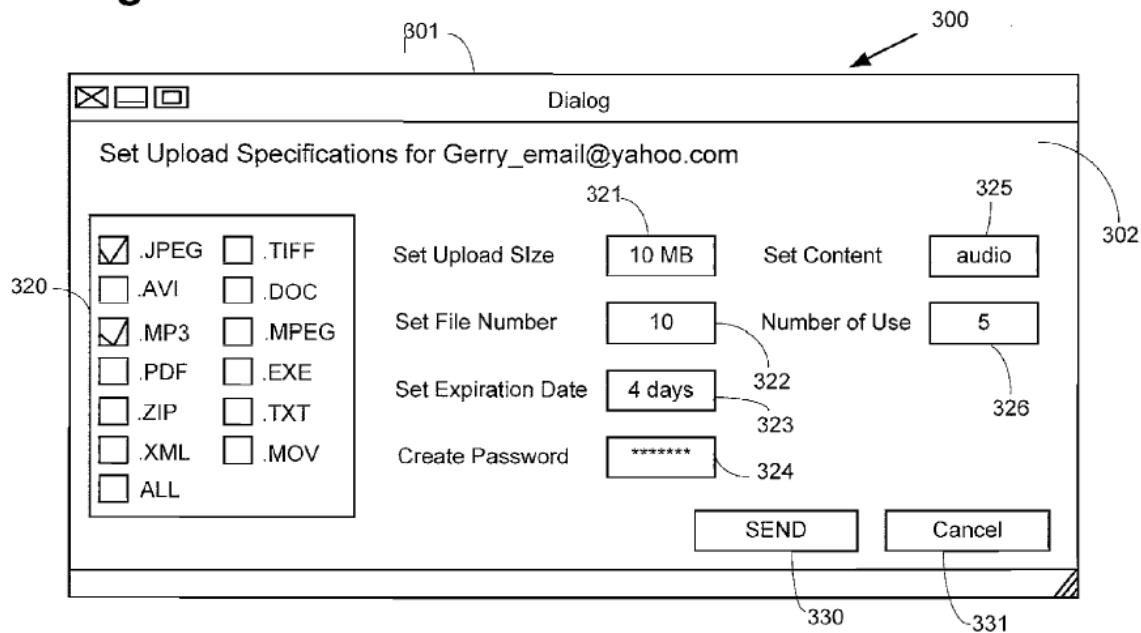


Figure 3 depicts an upload parameter dialog for specifying upload parameters. Ex. 1107 ¶¶ 12, 28.

Upload parameter dialog 301 is presented in response to the above selection of email contacts, and allows specifying upload parameters including file format check boxes 320, size limit field 321, file number field 322, invitation expiration field 323, invitation password field 324, set content field 325, and number of uses field 326. Ex. 1107 ¶ 28–29. These fields may be text fields. *Id.* ¶¶ 31, 33. Although not shown in the figure, other upload parameters restricting the data upload based upon data composition may be specified from upload parameter dialog 301. *Id.* ¶ 31. Send button 330 is used to send a digital invitation restricted by the one or more upload parameters specified in upload parameter dialog 301. *Id.* ¶ 34.

Riepling Figure 4 is reproduced below.

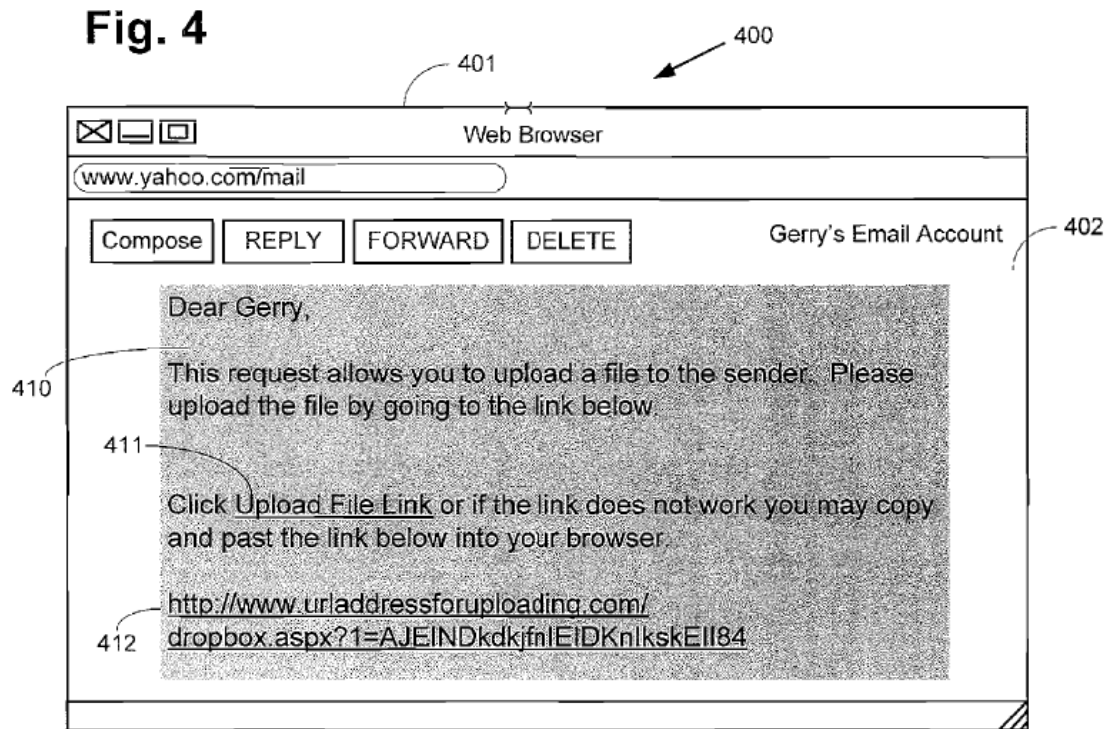


Figure 4 depicts a digital invitation containing a unique location identifier. Ex. 1107 ¶¶ 13, 35.

Web browser 401 includes email interface 402, which includes digital invitation 410 with unique location identifiers 411 and 412. Ex. 1107 ¶ 35. In this example Gerry is receiving the email invitation. *Id.* ¶ 36. Clicking on either of the unique location identifiers launches a dialog associated with the content sharing service. *Id.* ¶ 37.

Riepling Figure 5 is reproduced below.

Fig. 5

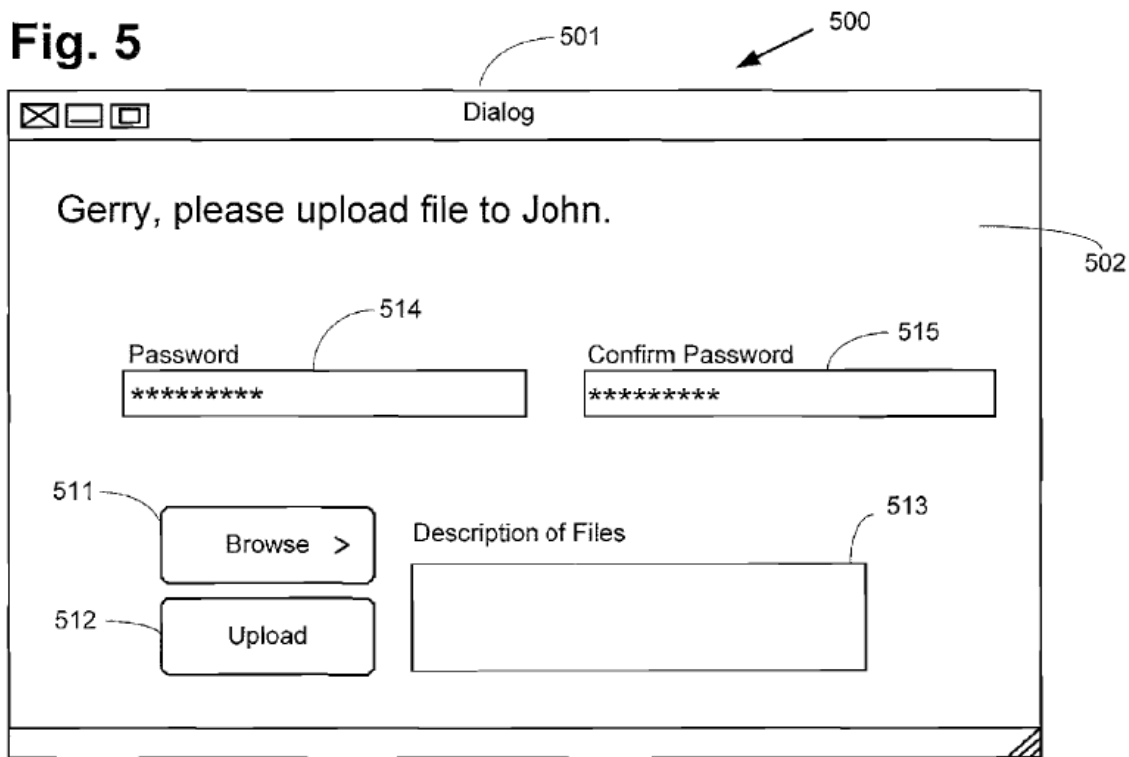


Figure 5 depicts a file upload dialog for selecting data files for uploading. Ex. 1107 ¶¶ 14, 41.

File upload dialog 501 is presented when the recipient of invitation 410 (“Gerry”) clicks on location identifier 411 or 412. Ex. 1107 ¶ 42. Browse button 511 is used to select one or more data files for uploading, file description text field 513 receives a textual description of the data files chosen for uploading, and upload button 512 is used to upload the selected files to the content sharing service. *Id.* ¶ 43. The sender of the digital invitation (“John”) can receive an alert message notification of the upload, permitting downloading the uploaded data. *Id.* ¶ 45.

Riepling Figure 7 is reproduced below.

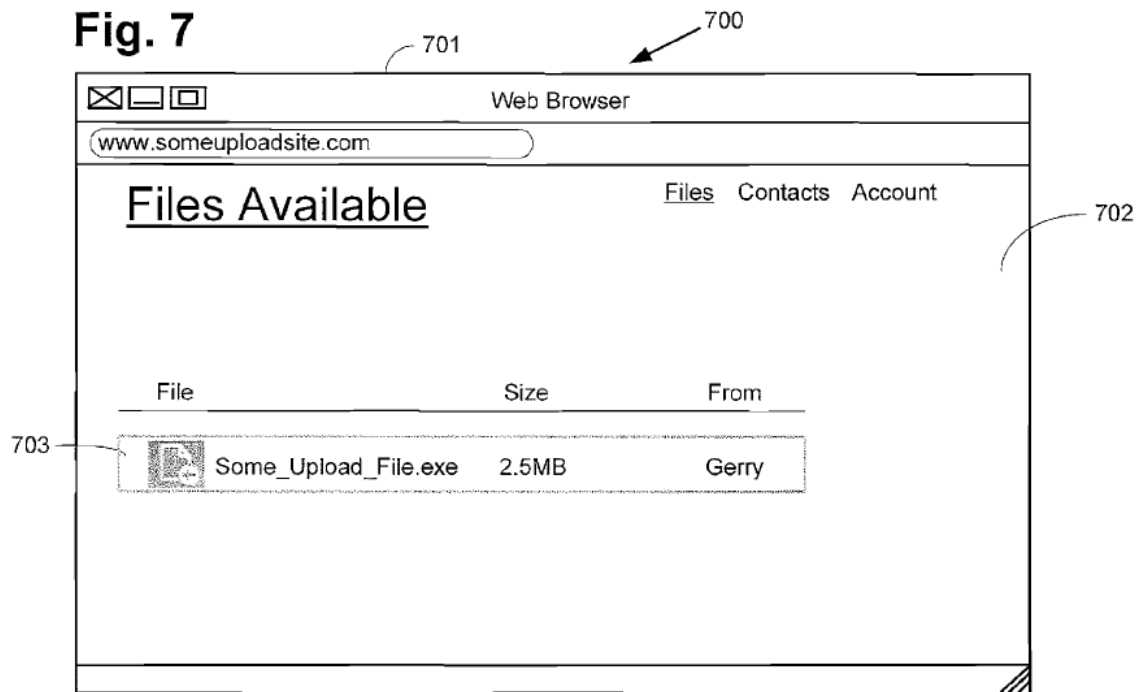


Figure 7 depicts a data availability interface.
Ex. 1107 ¶¶ 16, 48.

Data availability interface 702 allows the sender of the digital invitation (“John”) to view uploaded data, and file entry link 703 may be used to open or download the actual data file associated with the link. Ex. 1107 ¶ 49.

2. *Meisels*

Meisels, titled “Upload Of Attachment And Insertion Of Link Into Electronic Messages,” is an application published February 21, 2013, and filed August 16, 2011. Ex. 1108, codes (54), (43), (22). Meisels discloses an electronic message with an automatically inserted link to a document in place of the document attachment itself. *Id.* at Abstr., ¶¶ 3, 23.

A portion of Figure 4 is reproduced below.

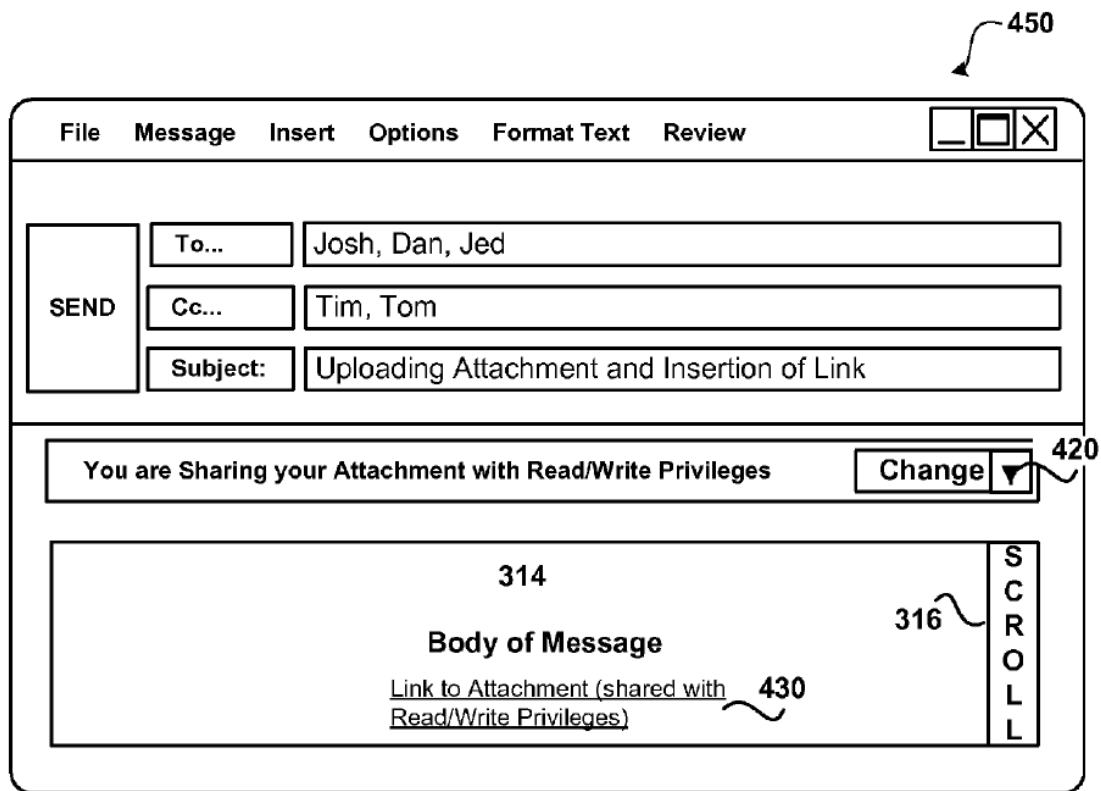


FIG.4

This portion of Figure 4 depicts an electronic message after a user action is received to upload an attachment. Ex. 1108 ¶¶ 7, 43.

Electronic message 450 includes a link to attachment 430, rather than the attachment itself. Ex. 1108 ¶¶ 43, 45. A link may be in the form of a Uniform Resource Locator (URL) that specifies a network location of where the content is stored. Id. ¶ 23.

3. Motivation To Combine

Petitioner argues that one of ordinary skill in the art would have been motivated to use the teaching of Meisels to include a link to an uploaded document, rather than the document attachment itself, in the above-described alert message notification of Riepling, as discussed further below in

connection with claim limitation 9[1]. Pet. 66–67 (citing Ex. 1108, Figs. 4, 7, ¶¶ 23, 41–45, 54, 56; Mowry Decl. ¶¶ 192–193).

Petitioner argues that this combination would have been motivated because (i) Riepling and Meisels are from the same field of endeavor, directed to sharing files over a network; (ii) the combination would have yielded expected, predictable results, using known and routine computer programming principles, to modify Riepling’s system to generate an electronic message that includes a link pointing to an uploaded file; (iii) the combination would have been readily implemented given Meisels’ teachings of inserting, in an electronic message, a link to a shared location where a file is uploaded; and (iv) the combination was suggested because Meisels expressly disclosed a benefit of sending an email message with a link, to avoid multiple copies of a file from existing at multiple locations, and sending links to one file to multiple recipients and managing permissions on an individual recipient basis. Pet. 67–70 (citing Ex. 1107, Fig. 1, ¶¶ 2, 4, 19; Ex. 1108, Fig. 4, ¶¶ 1, 3, 41–45, 56; Mowry Decl. ¶¶ 194–198). In addition, for reasons similar to the motivation basis, Petitioner argues that a person of ordinary skill in the art would have had a reasonable expectation of success in making the combination. *Id.* at 70–71 (citing Mowry Decl. ¶¶ 199–200).

Other than its arguments directed to ’520 claim requirement 9[1], discussed below in Section III.D.4.d), Patent Owner does not further address Petitioner’s arguments regarding the combination of Riepling and Meisels. As discussed in that section, we are persuaded by Petitioner’s expert’s testimony that one of ordinary skill would have applied the document link teachings of Meisels to modify Riepling. Accordingly, we determine that Petitioner has proved by a preponderance of the evidence that one of

ordinary skill in the art would have been motivated to combine Riepling and Meisels in the manner argued by Petitioner.

4. Independent Claim 9

a) Preamble and Requirements 9[a], 9[c]–9[f], 9[h]–9[k], and 9[m]–9[o]

For the apparatus preamble of independent claim 9, Petitioner generally relies on the disclosure in Riepling of a system sending a digital invitation requesting a data upload, including a server, processor, and storage database. Pet. 14–15 (citing Ex. 1107, Fig. 1, ¶¶ 19, 63; Mowry Decl. ¶¶ 64–65).¹¹

For claim requirement 9[a] of causing a display of a first interface for creating a file request,¹² Petitioner relies on the disclosure in Riepling of upload parameter dialog 301, which includes invitation expiration field 323 and set content field 325. Pet. 15–17 (citing Ex. 1107, Figs. 1, 3, ¶¶ 18, 21, 22, 29, 33; Mowry Decl. ¶¶ 66–69).

For claim requirement 9[c] of receiving an indication of at least one of a date or a time, Petitioner relies on the disclosure in Riepling of invitation expiration field 323 which, for example, may contain text such as “4 days” or “from Jun. 1, 2011, 8:00 am PST until Jun. 5, 2011, 8:00 am PST.” Pet. 19–20 (citing Ex. 1107, Figs. 1, 3, ¶ 33; Mowry Decl. ¶¶ 73–75).

¹¹ We make no determination that the preamble of claim 9, or of claims 14 or 22, is limiting.

¹² For economy of presentation, we refer to the portions of claim 9 identified by bracketed letters at Section II.B above, and paraphrase the referenced claim requirement, although the complete language of each claim requirement is the subject of our analysis.

For claim requirement 9[d] of causing a display of a second interface for use in causing the file request to be sent, Petitioner relies on the disclosure in Riepling of web browser request interface 201, which includes list of contact information 230. Pet. 20–21 (citing Ex. 1107, Fig. 2, ¶¶ 4, 24–26; Mowry Decl. ¶¶ 76–78). Petitioner also relies on send button 330, which in the Riepling disclosure appears on Figure 3, which Petitioner associates with the claimed first interface. *Id.* at 22. But Petitioner’s expert testifies that including that interface element on Figure 2 (the proposed second interface) would have been an obvious alternative, given that the order of entering information in Figures 2 and 3 was arbitrary. *Id.* at 22–25 (citing Ex. 1107, Fig. 3, ¶¶ 7, 34, 57; Mowry Decl. ¶¶ 79–82). We note that the ’906 application embodiment that most closely corresponds to the ’520 patent claims discloses a single interface that serves as both the first and second claimed interfaces. Ex. 2004, Fig. 6A.

For claim requirement 9[e] of receiving indicia associated with at least one email address, Petitioner relies on the disclosure in Riepling of list of contact information 230, with the associated selection boxes 231–234. Pet. 25–27 (citing Ex. 1107, Fig. 2, ¶¶ 25–26, 34; Mowry Decl. ¶¶ 83–85).

For claim requirement 9[f] of receiving indication of a selection of a user interface element that indicates that the file request is to be caused to be sent, Petitioner relies on the disclosure in Riepling of send button 330, which when selected causes digital invitation 410 to be sent to the indicated email addresses. Pet. 27–28 (citing Ex. 1107, Fig. 3, ¶ 34; Mowry Decl. ¶¶ 86–88).

For claim requirement 9[h] of sending the first message (digital invitation 410, discussed below in connection with claim requirement 9[g]),

Petitioner relies on the disclosure in Riepling of the above-described operation of send button 330, which causes the message to be sent. Pet. 28–29, 31–32 (citing Ex. 1107, Figs. 1, 2, 4, ¶¶ 34–35; Mowry Decl. ¶¶ 90, 92, 97).

For claim requirement 9[i] of receiving indication of a selection of a user interface element that indicates that a file is to be uploaded in response to the file request, Petitioner relies on the disclosure in Riepling of the ability of a user to click on either of unique location identifiers 411 and 412 in digital invitation 410. Pet. 32–33 (citing Ex. 1107 ¶¶ 37, 42; Mowry Decl. ¶¶ 99–100).

For claim requirement 9[j] of, in response to the receipt of the indication of the selection of the user interface element of claim requirement 9[i], causing display of a third interface for use in uploading the file in response to the file request, Petitioner relies on the disclosure in Riepling of file upload dialog 501, including upload interface 502 with browse button 511, which is used to select files for uploading, and upload button 512, used to perform data upload. Pet. 33–34 (citing Ex. 1107, Fig. 5, ¶¶ 37, 42–43; Mowry Decl. ¶¶ 101–103).

For claim requirement 9[k] of receiving indication of a selection of a user interface element of the third interface, Petitioner relies on the disclosure in Riepling of using upload button 512 to upload files. Pet. 35 (citing Ex. 1107 ¶ 43; Mowry Decl. ¶¶ 104–105).

For claim requirement 9[m] of sending the second message, Petitioner relies on the disclosure in Riepling of sending the alert message, discussed below in connection with claim requirement 9[g]. Pet. 36–37 (citing Ex. 1107, Fig. 1, ¶ 45; Mowry Decl. ¶¶ 111–112).

For claim requirement 9[n] of receiving an indication of selection of a user interface element in the second message, Petitioner relies on the disclosure in Riepling that the notification message permits downloading of uploaded data, together with the use of a link to the data as taught by Meisels. Pet. 37–38, 65–67 (citing Ex. 1107 ¶ 45; Mowry Decl. ¶¶ 113–114, 192–193).

For claim requirement 9[o] of, in response to the receipt of the indication of the selection of the user interface element of claim requirement 9[n], causing display of a fourth interface with a reference to the file for allowing access the file, Petitioner relies on the disclosure in Riepling of data availability interface 702 with file entry link 703. Pet. 38–39 (citing Ex. 1107, Fig. 7, ¶ 49; Mowry Decl. ¶¶ 115–117).

Patent Owner does not specifically address claim requirements 9[a], 9[c]–9[f], 9[h]–9[k], and 9[m]–9[o]. *See generally* PO Resp. We are persuaded that the record supports Petitioner’s arguments regarding these claim requirements.

b) Requirement 9[b]

For the claim 9[b] requirement of receiving a file description of a file in connection with the file request via an interface that includes a textbox, Petitioner relies on the disclosure in Riepling of set content field 325 containing the text, “audio,” in Figure 3, reproduced *supra*. Pet. 17–19 (citing Ex. 1107, Figs. 1, 3, ¶¶ 31–34; Mowry Decl. ¶¶ 70–72). Petitioner’s expert testifies that, based on the description in Riepling of size limit field 321, file number field 322, invitation expiration field 323, invitation password field 324, and number of use field 326 as text fields, one of

ordinary skill would have understood that set content field 325 was a text field. *Id.*

Patent Owner argues that Petitioner’s reliance on set content field 325 is in error on the grounds that this field is not described in the specification, other than its appearance in Figure 3, that the word “audio” appearing in the field is only associated with the MP3 audio format in the specification, that the fact that “JPEG” is checked in the file format check box 320 is inconsistent with the appearance of “audio” in field 325, and that that there is no indication in the specification that field 325 is a textbox. PO Resp. 37–39 (citing Ex. 1107 ¶¶ 30–32; Smith Decl. ¶¶ 87–90). Patent Owner also argues that Figure 5 of Riepling includes textbox 513, labeled “Description of Files,” which is part of the response to a file request from the file-request recipient, instead of part of the file request itself, which therefore is not received from the first node as required by the claim, and which, argues Patent Owner, “is the opposite of the ’520 patent’s teaching.” *Id.* at 39–40 (citing Ex. 1101, 2:1–10; Ex. 1107, Fig. 5, ¶¶ 41–43; Smith Decl. ¶ 91).

We agree with Petitioner that set content field 325 of Riepling teaches or suggests claim requirement 9[b]. As Petitioner’s expert explains, the fact that field 325 has an appearance identical to that of fields 321–324 in Figure 3, which fields are specifically stated to be “text field[s],” strongly suggests that field 325 is also a text field. Mowry Decl. ¶ 70; *see also* Reply 10–11. Patent Owner’s suggestion that field 325 could be a dropdown list or other type of field is contradicted by the fact that it does not show the typical dropdown arrow associated with a dropdown box, or other typical non-textbox appearance such as the checkbox appearance of field 320.

Moreover, in the example of Figure 3, the “Set Content” entry is “audio,” which is a file description. Reply 10. The fact that “JPEG” is checked in field 320 is not inconsistent with the “audio” entry in field 325, given that, as 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.” *Id.* at 11 (citing Ex. 1107 ¶ 32; Mowry 2nd Decl. ¶¶ 101–104). Also, there is no reason why the Figure 5 response that gives the uploader the ability to provide additional description of the file being uploaded is inconsistent with the ability of the requester first describing what type of file is being requested via field 325 in Figure 3. *Id.* at 11–12.

Accordingly, for the reasons discussed above, we are persuaded that the record supports Petitioner’s arguments regarding claim requirement 9[b].

c) Requirement 9[g]

For claim requirement 9[g] of, in response to the receipt of the indication of the selection of the user interface element of claim requirement 9[f], generating a first message addressed to the email address and including the file request, indicating the date or time, including a user interface element (used in claim requirement 9[i]), and including at least one sentence including the file description describing the at least one file in connection with the file request, Petitioner relies on the disclosure in Riepling of digital invitation 410, sent in response to send button 330, and which includes unique location identifiers 411 and 412 as the required user interface element. Pet. 28–32 (citing Ex. 1107, Figs. 1–4, ¶¶ 34–36; Mowry Decl. ¶¶ 90–94, 97–98). Petitioner’s expert testifies that, based on the disclosure in Riepling that the digital invitation may be “restricted by the one or more

upload parameters specified in upload parameter dialog 301,” it would have been obvious to include other restrictive parameters in the digital invitation, including content field 325 (e.g., “audio”) and invitation expiration field 323 (e.g., “4 days” or “Jun. 1, 2011, 8:00 am PST until Jun. 5, 2011, 8:00 am PST”). *Id.* at 30–31 (citing Ex. 1107 ¶ 34; Mowry Decl. ¶¶ 95–96).

Patent Owner argues that neither content field 325 nor invitation expiration field 323 would be included in the claimed message, because Riepling states that “[o]nce grant access button 235 [on Figure 2] has been used, content sharing service 105, using processor 102, may begin creating a digital invitation for transmission to the contact.” PO Resp. 44 (citing Ex. 1107 ¶ 26). From this, Patent Owner argues that digital invitation 410 is sent before the information in Figure 3 is entered, and therefore neither the content field nor the invitation expiration field would be included on invitation. *Id.* at 43–45 (citing Smith Decl. ¶ 96). Patent Owner apparently argues that, once the system begins creating the invitation, nothing more can be added to it. *Id.* at 45 (citing Smith Decl. ¶¶ 97, 101).

Patent Owner further argues that Petitioner has not provided any motivation for adding the content field and the invitation expiration field to the invitation. PO Resp. 46 (citing Smith Decl. ¶ 98). Patent Owner argues that Petitioner’s reliance on the disclosure in Riepling that the digital invitation may be “restricted by the one or more upload parameters specified in upload parameter dialog 301” is insufficient because Riepling separately provides for a “revoked digital invitation” dialog that takes into account these additional upload parameter restrictions. *Id.* at 46–47 (citing Ex. 1107, Fig. 6, ¶ 47; Smith Decl. ¶¶ 99).

We agree with Petitioner that it would have been obvious to include the information in content field 325 and invitation expiration field 323 in the digital invitation, given the disclosure in Riepling that the digital invitation may be “restricted by the one or more upload parameters specified in upload parameter dialog 301.” Ex. 1107 ¶ 34; Reply 13–14. The fact that Riepling discloses provisions for revoking a digital invitation based on such parameter restrictions does not undercut the motivation to also include that information in the invitation.

In addition, Patent Owner has shown no basis to assume that the information provided by the user when filling out the “Upload Specifications for Gerry_email@yahoo.com” in Figure 3 could not be included in the email to “Gerry” that is sent after the user selects “Send” in that figure. Although selecting “Grant” in Figure 2 “begin[s] creating a digital invitation for transmission to the contact,” it is only after “Send” is selected in Figure 3 that “a digital invitation restricted by the one or more upload parameters specified in upload parameter dialog 301” is sent. Ex. 1107 ¶¶ 26, 34; Reply 14–16.

Accordingly, for the reasons discussed above, we are persuaded that the record supports Petitioner’s arguments regarding claim requirement 9[g].

d) Requirement 9[l]

For claim requirement 9[l] of, in response to the receipt of the indication of the selection of the user interface element of claim requirement 9[k], generating a second message that does not include a file attachment, indicating that the file request has been responded to, Petitioner relies on the disclosure in Riepling that, when a file is uploaded, an alert message is sent

to user accounts, which message permits the downloading of the uploaded data. Pet. 35–36 (citing Ex. 1107 ¶ 45; Mowry Decl. ¶¶ 107–110). As discussed above, Petitioner further relies on Meisels in combination with Riepling as teaching or suggesting that the alert message would include a link to the uploaded file rather than the file attachment. *Id.* at 65–67 (citing Ex. 1108, Figs. 4, 7, ¶¶ 3, 23, 41–45, 54, 56; Mowry Decl. ¶¶ 192–193).

Patent Owner argues that there is no disclosure in Riepling that the notification message that Petitioner relies on includes “an eighth user interface element” and “does not include a file attachment” as required. PO Resp. 48–49 (citing Smith Decl. ¶ 102). Patent Owner argues that Petitioner’s reliance on the fact that location identifier 411 of digital invitation 410 may be a clickable link is unjustified, because the invitation is sent to the sender, whereas the notification is sent to the requester during a different stage of the process. *Id.* at 49–51 (citing Ex. 1107 ¶¶ 21, 29, 30, 45; Smith Decl. ¶¶ 103–107). Patent Owner points out that the only relevant disclosure in Riepling allowing the requester to access uploaded files is data availability interface 702, which is not disclosed as related to the notification message. *Id.* at 49 (citing Ex. 1107 ¶ 49; Smith Decl. ¶ 104).

In regard to Meisels, Patent Owner argues that this reference only discloses “manually creat[ing] an email, manually confirm[ing] to upload an attachment to insert a link to the attachment, and manually send[ing] the email to its recipient,” but does not disclose the various claim 9[l] requirements of generating a message in response to user interface elements or including an interface element that allows file access. PO Resp. 53–55 (citing Smith Decl. ¶¶ 115–118).

Patent Owner unpersuasively argues Riepling and Meisels individually, whereas Petitioner relies on the combination. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d at 425; *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012). We are persuaded by Petitioner's expert's testimony that one of ordinary skill would have been motivated to apply the email teachings of Meisels to the disclosed alert message of Riepling, to arrive at a second message in accord with claim requirement 9[1]. Mowry Decl. ¶¶ 109, 192–193; Reply 22–23 (citing Mowry 2nd Decl. ¶¶ 111–113).

e) Conclusion re Claim 9

Based on our analysis set forth above, we determine, having considered and weighed the entirety of the evidence, that Petitioner has proved by a preponderance of the evidence that independent claim 9 is unpatentable under 35 U.S.C. § 103(a) over the combination of Riepling and Meisels.

5. Claims 10, 14, and 15

For claim 10's requirement of basing the file indication on the received date or time of claim requirement 9[c], Petitioner relies on the disclosure in Riepling that invitation expiration field 323 is used to specify a time window of a data upload associated with the digital invitation. Pet. 39–40 (citing Ex. 1107, ¶ 33; Mowry Decl. ¶¶ 118–119).

Independent claim 14 includes requirements commensurate with independent claim 9, and Petitioner’s arguments with respect to claim 14 are substantially similar to those regarding claim 9. Pet. 40–47.

Claim 15 depends from claim 14 and further requires:

- the first message and the second message are email messages;
- the object includes the at least one email address or an alias associated with the at least one email address;
- the second message is at least partially pre-written and is automatically generated without user involvement after the receipt of the message associated with the selection of the fifth user interface element; and
- the message associated with the at least one file is conditionally received based on whether a date-related criterion or a time-related criterion is met.

Ex. 1101, 54:37–49. For claim 15, Petitioner relies on its analysis of claim 14, including its argument for claim requirement 14[j], which in turn relies on its analysis of claim requirement 9[l], arguing that the combination of Riepling and Meisels teaches or suggests that the second message is an email. Pet. 35–36, 46, 47, 65–67 (citing Mowry Decl. ¶¶ 107–110, 138, 133, 192–193). In addition, Petitioner relies on the disclosure in Riepling that digital invitation 410 (“the first message”) “may be a textual email message,” and argues that it would have been obvious that the alert message (“the second message”) would also be an email. *Id.* at 47 (citing Ex. 1107, ¶¶ 36, 45; Mowry Decl. ¶¶ 138–139). Petitioner further relies on the email addresses associated with selection boxes 231–234 in list of contact information 230. *Id.* at 47–48 (citing Ex. 1107, ¶¶ 25–26; Mowry Decl. ¶¶ 140–141). Also, Petitioner argues that one of ordinary skill would have

known that the alert message would have been automatically generated by the content sharing service and would have been at least partially pre-written. *Id.* at 48 (citing Ex. 1107, ¶ 45; Mowry Decl. ¶¶ 142–143). Finally, Petitioner relies on its analysis of claim 10 for date/time condition of claim 15. *Id.* at 48.

For these claims, Patent Owner refers to its arguments discussed above relating to claim 9, which we have considered. PO Resp. 51–53. For claim 15, Patent Owner also argues that Riepling does not teach or suggest that the “second message” is an email, because the alert message of Riepling is sent only “within [Riepling’s] content sharing service,” not via email. *Id.* at 52 (citing Ex. 1107 ¶¶ 21, 29–30, 45, 56; Smith Decl. ¶ 113). However, as discussed above in connection with claim requirement 9[1], we are persuaded by Petitioner’s reliance on the combination of Riepling and Meisels, which teaches or suggests using email for the notification message. Although Riepling uses its content sharing service to generate the notification message, it also states that “one or more user accounts may receive an alert message or any other type of notification message.” Reply 20 (citing Ex. 1107 ¶ 45). Moreover, Petitioner’s reliance on the combination of Riepling and Meisels further supports an email implementation — “[c]ombining the teachings of references does not involve an ability to combine their specific structures.” *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973); *to like effect*, *In re Keller*, 642 F.2d at 425 (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.”).

Accordingly, based on our analysis set forth above, we determine, having considered and weighed the entirety of the evidence, that Petitioner has proved by a preponderance of the evidence that claims 10, 14, and 15 are unpatentable under 35 U.S.C. § 103(a) over the combination of Riepling and Meisels.

E. Alleged Obviousness of Claims 11, 12, 16, and 22–24 over Riepling, Manzano, and Meisels

Petitioner alternatively challenges claims 11, 12, 16, and 22–24 as obvious over the combination of (i) Riepling and Manzano; (ii) Riepling, Manzano, and Meisels; (iii) Riepling, Manzano, and Garcia; and (iv) Riepling, Manzano, Meisels, and Garcia.¹³ Pet. 49—83. We need only consider the combination of Riepling, Manzano, and Meisels.

Manzano, titled “Electronic File Sharing,” is an application published January 7, 2010, and filed April 21, 2009. Ex. 1105, codes (54), (43), (22). Manzano is directed to sharing of electronic files among electronic devices. *Id.* ¶ 2. Manzano provides for user interfaces displayed on the displays of electronic devices that correspond to respective electronic folders or windows into which files may be placed. *Id.* ¶ 32. File icons are displayed to visually indicate whether a file has been downloaded locally or is being shared but located on a remote device — if remote, the icon can be “ghosted” (*i.e.*, rendered semi-transparent). *Id.* ¶ 50. A user may right-click on the icon to download the associated file, at which time the icon will become unghosted. *Id.* ¶ 51.

¹³ As stated above, claim 13 was subject to Petitioner’s challenge but was subsequently disclaimed. Sur-Reply 5, n. 5

Petitioner argues that one of ordinary skill in the art would have been motivated to use the teaching of Manzano to allow creation of electronic folders or windows on displays of the Riepling user devices (modified to include links to files as taught by Meisels) into which uploaded files may be placed, with displayed file icons that serve as representations of the transferred files. Pet. 49–53, 65–66 (citing Ex. 1105, Figs. 2, 3, 6, ¶¶ 2, 29–30, 32–38, 41, 50–52; Ex. 1108, Figs. 4, 7, ¶¶ 23, 41–45, 54, 56; Mowry Decl. ¶¶ 146–154, 192–193).

Petitioner argues that this combination would have been motivated because (i) Riepling, Meisels, and Manzano are from the same field of endeavor, directed to sharing files over a network; (ii) that the combination would have yielded expected, predictable results, using known and routine computer programming principles, to modify Riepling’s system to have a file-transfer application that would display a ghosted icon of the uploaded file until the file is requested to be downloaded; (iii) that the combination would have been readily implemented using basic computer programming principles to modify Riepling’s system to include Manzano’s teachings of using a ghosted icon; (iv) and that the combination was suggested because one of ordinary skill would have recognized the benefit of not storing a file at a node until a user requests the file be downloaded. Pet. 53–55, 67–70 (citing Ex. 1105, Fig. 2, ¶¶ 2, 29, 32–38, 41, 50–52; Ex. 1107, Fig. 1, ¶¶ 2, 4, 19; Ex. 1108, Fig. 4, ¶¶ 1, 3, 41–45, 56; Mowry Decl. ¶¶ 155–159, 194–198). In addition, for reasons similar to the motivation basis, Petitioner argues that a person of ordinary skill in the art would have had a reasonable expectation of success in making the combination. *Id.* at 55–57, 70–71 (citing Mowry Decl. ¶¶ 160, 199–200).

Patent Owner does not specifically address Petitioner's arguments regarding the combination of Riepling, Manzano, and Meisels. We are persuaded by Petitioner's expert's testimony that one of ordinary skill would have applied the ghosted icon teachings of Manzano to modify the Riepling/Meisels combination. Accordingly, we determine that Petitioner has proved by a preponderance of the evidence that one of ordinary skill in the art would have been motivated to combine Riepling, Meisels, and Manzano in the manner argued by Petitioner.

For most of the requirements of claims 11, 12, 16, and 22–24, Petitioner relies on disclosures in Riepling, and on the use of emailed links to files in Meisels, which are discussed above in connection with claims 9, 10, 14, and 15. Pet. 49–67. The above-discussed disclosure in Manzano, including ghosting of file icons, is relied on for the following additional claim requirements regarding displaying representations of transferred files:

Claim 11: “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 that is not a web page and utilizes a client-based file explorer application, such that the at least one file is accessible via . . . the file explorer interface.” Ex. 1101, 52:43–51; Pet. 49–53.

Claim 12: “a storage at the first node does not store the at least one file when the creation of the representation of the at least one file is caused.” Ex. 1101, 52:52–60; Pet. 57.

Claim 16: Commensurate with claims 11 and 12. Pet. 59.

Claim 22: “cause creation of a second representation of the at least one file, in a location among one or more folders, that is stored at the first

node and that is displayable via the file explorer interface of the client-based file explorer application.” Ex. 1101, 57:5–11; Pet. 63–64.

Patent Owner argues that Manzano “does not disclose a representation of a file being created in a location among one or more folders on a file explorer interface as recited in claims 11–13, 16 and 22–24.” PO Resp. 59 (citing Smith Decl. ¶ 126). Patent Owner argues that Manzano only discloses transferring files into folders, rather than creation of representations. *Id.* (citing Ex. 1105 ¶¶ 41, 52). However, as Petitioner argues, Manzano’s ghosted icon 600 corresponds to “a representation of the at least one file” created in a folder in a file explorer interface, and the presence of a ghosted file in a folder itself implies that the representation of the file is among at least one folder. Reply 24–25.

Accordingly, based on our analysis set forth above, we determine, having considered and weighed the entirety of the evidence, that Petitioner has proved by a preponderance of the evidence that claims 11, 12, 16, and 22–24 are unpatentable under 35 U.S.C. § 103(a) over the combination of Riepling, Manzano, and Meisels.

IV. PETITIONER’S MOTION TO EXCLUDE

Petitioner moves to exclude portions of Patent Owner’s Sur-Reply, directed to allegations that Petitioner failed to provide routine discovery pursuant to 37 C.F.R. § 42.5(b)(1)(iii), concerning statements about Garcia, and patent applications “directed to file request functionality,” allegedly inconsistent with positions that Petitioner is taking in this proceeding. Paper 40; Ex. 1137.

We have not relied on the portions of the Sur-Reply relating to Garcia because we do not reach the grounds based on that reference. In addition, we agree with Petitioner that the statement in the Sur-Reply regarding unspecified statements in unrelated prosecutions is not probative. Therefore, Petitioner's Motion To Exclude is dismissed as moot.

V. CONCLUSION¹⁴

For the foregoing reasons, we are persuaded that Petitioner establishes by a preponderance of the evidence that claims 9–12, 14–16 and 22–24 of the '520 patent are unpatentable.

¹⁴ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. §§ 42.8(a)(3), (b)(2).

In summary:

Claims	35 U.S.C. §	References/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
9, 10, 14, 15	103(a)	Riepling ¹⁵		
11, 12, 16, 22–24	103(a)	Riepling, Manzano ¹⁵		
9, 10, 14, 15	103(a)	Riepling, Meisels	9, 10, 14, 15	
11, 12, 16, 22–24	103(a)	Riepling, Manzano, Meisels	11, 12, 16, 22–24 ¹⁶	
11, 12, 16, 22–24	103(a)	Riepling, Manzano, Garcia ¹⁵		
11, 12, 16, 22–24	103(a)	Riepling, Manzano, Meisels, Garcia ¹⁵		
Overall Outcome			9–12, 14–16, 22–24 ¹⁶	

¹⁵ We do not reach these grounds because we have determined that claims 9, 10, 14, and 15 have been shown to be unpatentable over the combination of Riepling and Meisels, and claims 11–12, 16, and 22–24 have been shown to be unpatentable over the combination of Riepling, Manzano, and Meisels.

¹⁶ As noted, claim 13 was subject to Petitioner’s challenge but was subsequently disclaimed. Sur-Reply 5, n. 5.

VI. ORDER

In consideration of the foregoing, it is hereby
ORDERED that claims 9–12, 14–16 and 22–24 of US Patent
11,611,520 B1 have been shown to be unpatentable under 35 U.S.C. § 103;
and

FURTHER ORDERED that Petitioner’s Motion to Exclude is
dismissed as moot; and

FURTHER ORDERED that, because this is a final written decision,
parties to this proceeding seeking judicial review of our Decision must
comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2024-00287
Patent 11,611,520 B1

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