

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

DROPBOX, INC.,  
Petitioner,

v.

MOTION OFFENSE, LLC,  
Patent Owner.

---

IPR2024-00286  
Patent 11,611,520 B1

---

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

BEAMER, *Administrative Patent Judge*.

DECISION  
Granting Institution of *Inter Partes* Review  
35 U.S.C. § 314

## 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 1–8 and 17–21 of U.S. Patent No. 11,611,520 B1 (“the ’520 patent”). Paper 1. On April 30, 2024, Motion Offense, LLC (“Patent Owner”) responded by filing a Disclaimer In Patent Under 37 C.F.R. 1.321(a), disclaiming claims 1–8, and a Preliminary Response (“Prelim. Resp.”), pursuant to 35 U.S.C. § 313, defending only claims 17–21. Ex. 2045; Paper 10.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and any preliminary response shows that “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons explained below, we determine that Petitioner has established a reasonable likelihood that it would prevail with respect to at least one challenged claim. Accordingly, we institute an *inter partes* review as to challenged claims 17–21 and the grounds raised in the Petition. *See* 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.”).

## 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. 1001, code (54). The ’520 patent is a continuation-in-part of, *inter alia*, U.S. Patent Application Nos. 13/624,906 and 13/626,635 (“the ’906 application” (Ex. 2003) and “the ’635 application” (Ex. 2004), respectively). Ex. 1001, 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 “Folder Share” embodiment primarily disclosed in the ’635 application.<sup>1</sup> *See* Prelim. Resp. 6.

In particular, a pertinent example process is broadly summarized by the steps of Figures 2A and 2B of the ’635 application. Ex. 2004, Figs. 2A, 2B, ¶¶ 16–17. A first part of the process creates and transmits a message including a “mount descriptor.” *Id.* at Figs. 2B, 8A, ¶¶ 120, 124, 132, 135. A second communications agent represents a second user and, in a first step 212, receives data object information identifying a data object in a second data store of a second execution environment that includes the second communications agent. *Id.* at Fig. 2B, ¶ 120. In the next step 214, the mount descriptor is created and configured for accessing the data object by a first data store in a first execution environment that includes a first communications agent that represents a first user. *Id.* ¶ 124. In the next step 216, the second communications agent places the mount descriptor in a first message addressed to the first user. *Id.* ¶ 132. In the next step 218, the

---

<sup>1</sup> 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.

second communications agent sends the first message to the first communications agent.<sup>2</sup> *Id.* ¶ 135.

A second part of the process uses the mount descriptor to create a representation of the data object in the first data storage and provide access to the data object (from the second data store). Ex. 2004, Fig. 2A, ¶¶ 93, 97, 100, 109. In the first step 202, the first communications agent receives the first message (which includes the mount descriptor) from the second communications agent. *Id.* ¶ 93. In the next step 204, the first communications agent detects the mount descriptor. *Id.* ¶ 97. In the next step 206, the first communications agent determines a “first” location of the data object in the first data store. *Id.* ¶ 100. In the next step 208, the first communications agent creates, based on the mount descriptor, the representation of the data object in the first data storage. *Id.* ¶ 109.

An example method for creating the first message addressed to the first user is illustrated in Figure 6D, reproduced below.

---

<sup>2</sup> We adhere to the '635 application's designations of “first” and “second” communications agent, user, data store, and execution environment.

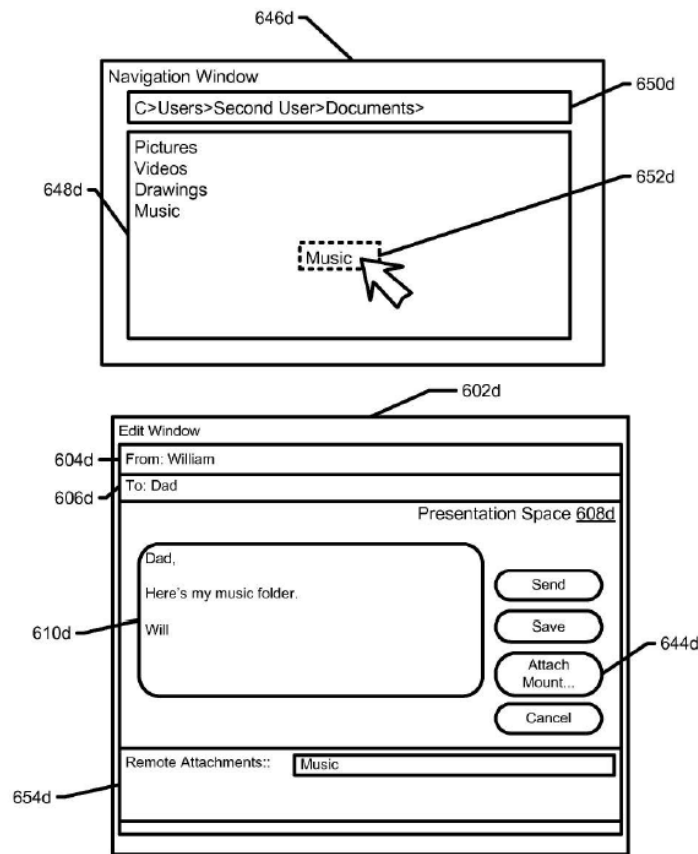


FIG. 6D

Figure 6D is a user interface including Edit Window 602d and Navigation Window 646d. Ex. 2004 ¶¶ 25, 122.

Edit window 602d is presented in response to a user input to create a new email, allowing input of contactor UI element 604d (“William”), contactee UI element 606d (“Dad”), and user message UI element 610d in presentation space 608d. Ex. 2004 ¶¶ 82, 102, 122. Selection of attach mount UI element 644d presents navigation window UI element 646d, containing folder content pane UI element 648d listing folders in path UI element 650d. *Id.* ¶¶ 122, 123. Pointer UI element 652d illustrates a drag and drop operation of a “Music” folder represented in contents pane UI element 648d, dropped on edit window UI element 602d. *Id.* ¶ 123. This causes creation

of a “mount descriptor,” included in the email, for accessing the Music folder from the second data store by a first data store. *Id.* This is depicted in Figure 8A reproduced below.

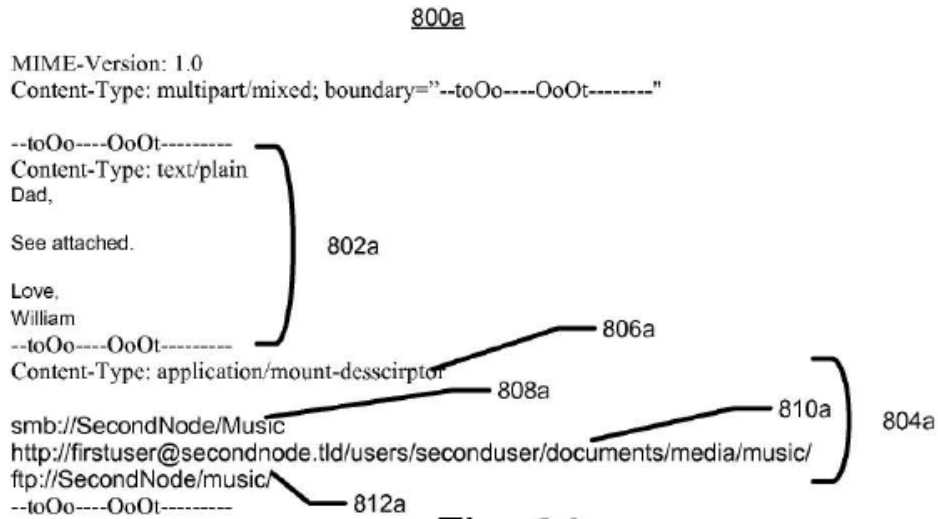


Figure 8A includes an exemplary content portion 800a of an email message, including user readable message portion 802a and mount descriptor portion 804a, which identifies alternative URLs for accessing the “Music” folder. Ex. 2004 ¶¶ 30, 96, 112, 130.

Upon receipt of the email, the contactee (“Dad”) can select a “mount UI element” to display a navigation window for identifying a location in a data store to mount the remote “Music” folder identified in the mount descriptor. Ex. 2004 ¶¶ 102–104. In one example, there is created, based on the mount descriptor, a representation of the folder at the selected location, wherein accessing the representation includes accessing the data object from the data store of the contactor (“William”). *Id.* ¶¶ 8, 109. 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 folder. *Id.* ¶¶ 49–52, 69.

*B. Illustrative Claim*

Independent claim 17 is representative, and is reproduced below.<sup>3</sup>

17. A method, comprising:

- [a]: causing, at a first node, display of: a first user interface element, for collecting information associated with at least one folder,
- [b]: a second 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
- [c]: a third user interface element, for detecting an indication of a selection thereof to cause an initiation of a sharing of the at least one folder;
- [d]: causing generation of at least one email, based on the information associated with the at least one folder, the at least one object associated with the at least one email address, and the detection of the indication of the selection of the third user interface element to cause the initiation of the sharing of the at least one folder, where the at least one email: identifies the information associated with the at least one folder, includes an Hypertext Transfer Protocol (HTTP) link, does not include a file attachment, for permitting avoidance of at least one file from being communicated to and stored at the second node until an initiation of the communication of the at

---

<sup>3</sup> The bracketed letters and paragraph arrangement are taken from the Petition but do not impact our analysis. Pet. 84–85.

least one file by a user of the second node is detected and the communication commences via at least one server that stores the at least one file, is at least partially pre-written, and is automatically caused to be received without requiring user involvement after the detection of the indication of the selection of the third user interface element to cause the initiation of the sharing of the at least one folder;

[e]: receiving, from the second node and at [*sic*] least one server, a signal for causing creation of a first representation of the at least one folder, 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;

[f]: causing, at the second node, receipt of the at least one web page, that results in display, at the second node and via the at least one web page, the first representation of the at least one folder that is stored at the at least one server; and

[g]: causing, at the second node, receipt of code for storage at the second node and cooperation with a file explorer interface of a client-based file explorer application, for being utilized to: cause creation of a second representation of the at least one folder, in a location among one or more folders, that is stored at the second node and that is displayable via the file explorer interface of the client-based file explorer application.

Ex. 1001, 55:1–56.

### *C. Asserted Grounds*

Petitioner asserts that claims 17–21 are unpatentable based on the following grounds.



<b>Claim(s) Challenged</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>
17–21	103(a)	Houston <sup>4</sup> , Garcia <sup>5</sup>
17–21	103(a)	Houston, Garcia, Manzano <sup>6</sup>
17–21	103(a)	Houston, Garcia, Wu <sup>7</sup>
17–21	103(a)	Houston, Garcia, Manzano, Wu

Pet. 6.<sup>8</sup> In support of its patentability challenge, Petitioner relies on, *inter alia*, the Declaration of Todd Mowry, Ph.D. Ex. 1002 (“Mowry 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.*, C.A. No. 6:20-cv-00251 (W.D. Tex.); *Motion Offense, LLC v. Dropbox, Inc.*, C.A.

---

<sup>4</sup> U.S. Patent No. 8,825,597 B1 (Ex. 1003) (“Houston”).

<sup>5</sup> U.S. Patent No. 9,633,125 B1 (Ex. 1004) (“Garcia”).

<sup>6</sup> U. S. Patent Application Publication No. 2010/0005138 A1 (Ex. 1005) (“Manzano”).

<sup>7</sup> U.S. Patent Application Publication No. 2007/0011246 A1 (Ex. 1006) (“Wu”).

<sup>8</sup> 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. For present purposes, we apply the pre-AIA version of Section 103, although application of the AIA version would not alter our analysis.

No. 6:23-cv-0303 (W.D. Tex.); and *Dropbox, Inc. v. Motion Offense, LLC*, IPR2024-00287 (PTAB) as related proceedings. Pet. 1–2; Paper 7, 2

### III. ANALYSIS OF PETITIONER’S GROUNDS

#### A. *Legal Standards*

To prevail in its grounds for unpatentability during trial, 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 nonobviousness (also called secondary considerations), such as

commercial success, long-felt but unsolved needs, and failure of others. *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 dispute Petitioner's definition for purposes of its Preliminary Response. Prelim. Resp. 17.

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. For purposes of this Decision, 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. 13–14. Patent Owner does not specifically raise any claim construction issues. *See generally* Prelim. Resp.

However, in our analysis of Petitioner’s challenges below, we consider the scope of the claim terms “representation of [a] folder” and “signal for causing creation of a . . . representation of [a] folder.”

### D. *Discretionary Denial Pursuant To 35 U.S.C. § 325(d)*

As a threshold matter, Patent Owner argues that institution should be denied pursuant to 35 U.S.C. § 325(d) because Houston, Garcia, and Wu were of record in the ’520 patent’s prosecution, and the examiner was also

provided the petitions in three IPR proceedings filed by Google LLC against predecessors of the '520 patent, which petitions relied on Houston and Garcia using substantially similar unpatentability arguments as Petitioner makes here. Prelim. Resp. 25–26 (citing Ex. 2002, 46–48; Ex. 2005, 3; Ex. 2006, 3; Ex. 2007, 3). Patent Owner points out that the Examiner identified and indicated consideration of the references in signed Information Disclosure Statements. *Id.* at 26 (citing Ex. 2002, 21–24).

Patent Owner argues that Petitioner has failed to demonstrate that the Examiner made a material error in allowing the issued claims over this art, given that the Examiner indicated consideration of arguments made by Google as to the references, which arguments were substantially similar to what Petitioner now advances, and that Petitioner failed to discuss the prosecution history in detail, the examination of the IPR proceedings as to related patents, or how the Office erred in considering the prior art of record. Prelim. Resp. 27–29.

Under 35 U.S.C. § 325(d), the Board may exercise discretion to deny a petition that presents the same or substantially the same art or arguments as were previously presented to the Office. *See* 35 U.S.C. § 325(d); 37 C.F.R. § 42.4(a) (providing that the Board institutes on behalf of the Director). The Board has outlined factors it considers in determining whether to exercise discretion to deny institution under § 325(d):

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in

which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

*Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton Dickinson*”). The *Becton Dickinson* factors apply when a petition relies on art or arguments previously presented to the Office during any proceeding pertaining to the challenged patent, including reexamination, reissue, and AIA post-grant proceedings. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8–10 (PTAB Feb. 13, 2020) (precedential). *Advanced Bionics* explains how the *Becton Dickinson* factors fit into a two-part framework that examines:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.

*Id.* at 8.

Here, the same art (Houston, Garcia, and Wu) previously was presented to the Office, including submission of three IPR petitions challenging related patents in the same family as the ’520 patent and

applying Houston and Garcia. For example, on September 10, 2022, the Examiner indicated consideration of the Houston and Garcia patents by signing an Information Disclosure Statement that included citations to those patents. Ex. 1014, 712, 809, 811, 826. This was in connection with a September 19, 2022 Notice of Allowance, and subsequently an Issue Notification setting November 29, 2022 as the issue date of the patent. *Id.* at 706–713, 837. Before that scheduled issue date, Applicant withdrew the patent from issuance and filed an Information Disclosure Statement that included citations to the Wu patent and the three IPR petitions that Applicant submitted, which Statement the Examiner signed on January 28, 2023. *Id.* at 838–850, 880–881. The ’520 patent ultimately issued March 21, 2023. *Id.* at 891.

Thus, Patent Owner has shown that the first part of the *Advanced Bionics* framework is satisfied. Turning to the second part of the *Advanced Bionics* framework, we determine that Petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims. As Petitioner argues, there is no evidence that the references in question were meaningfully addressed during the prosecution of the ’520 patent — there was no evaluation of the art or articulation regarding any arguments applying that art. Pet. 11. We note that the IPR petitions were submitted only after the prosecution came to a purported end with an Issue Notification — submission of the petitions briefly postponed issuance, but resulted in no further substantive actions other than a later issuance.

In connection with the second part of the *Advanced Bionics* framework, “The Board frequently holds that a reference that was neither applied against the claims nor discussed by the Examiner does not weigh in

favor of exercising the Board’s discretion under § 325(d) to deny a petition.” *Amazon.com, Inc. v. M2M Sols. LLC*, IPR2019-01205, Paper 14, 16 (PTAB Jan. 27, 2020) (quotation omitted); *Fasteners for Retail, Inc. v. RTC Indus., Inc.*, IPR2019-00994, Paper 9, 7–11 (PTAB Nov. 5, 2019); *Mylan Pharm. Inc., v. Merck Sharp & Dohme Corp.*, IPR2020-00040, Paper 21, 18 (PTAB May 12, 2020); *Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01615, Paper 12, 12–13 (PTAB Apr. 17, 2020); *Adv. Energy Indus. Inc. v. Reno Tech. Inc.*, IPR2021-01397, Paper 7, 7 (PTAB Feb. 16, 2022).

In addition, all three of the IPRs associated with the petitions that were submitted resulted in the Board instituting the proceedings. *Google LLC v. Motion Offense, LLC*, IPR2022-01311, Paper 17 (PTAB March 2, 2023); *Google LLC v. Motion Offense, LLC*, IPR2022-01312, Paper 17 (PTAB March 6, 2023); *Google LLC v. Motion Offense, LLC*, IPR2022-01313, Paper 17 (PTAB March 6, 2023). Those Decisions to Institute were not before the Examiner. Furthermore, as set forth herein, our analysis demonstrates that, if the Examiner did in fact substantively find that this art was insufficient with respect to the challenged claims, we determine that the Examiner erred, given the Board’s determinations in the three previous IPRs, and on our determination here. Accordingly, we do not exercise our discretion under § 325(d) to deny the Petition.

#### *E. Secondary Considerations*

In response to Petitioner’s grounds for unpatentability of the ’520 patent, in addition to its arguments directed to the relied-on references analyzed below, Patent Owner argues that evidence of commercial success, industry praise, long-felt but unsolved needs, industry skepticism and failure



of others, and unexpected results provide additional factual evidence that the challenged claims would not have been obvious. Prelim. Resp. 42–50.

Patent Owner relies on Petitioner’s “Smart Sync” feature incorporated in its products, which keeps a user’s files and folders synchronized between their local filesystem and Petitioner’s servers. *Id.* at 43. An aspect of Smart Sync that Patent Owner focuses on is that the synchronized files “take[] up virtually no local disk space until [they’re] needed,” and that “whenever they need to access files stored in the cloud, users can download them with a quick double click.” *Id.* at 43–44 (citing Exs. 2012, 2014). Patent Owner argues that the widespread adoption and commercial success of Smart Sync demonstrates the commercial success of the claimed inventions of the ’520 patent. *Id.* at 45. Patent Owner alleges that there is a nexus between Smart Sync and the claimed inventions given the ability to make available shared folders (and the files within them) to recipients simply as “representations” without needing to download the contents of any files to each such user’s local drive until they are needed. *Id.*

Patent Owner submits evidence that Smart Sync’s ability to save local storage space while providing access to files in the cloud received industry praise. Prelim. Resp. 46–47 (citing Exs. 2012, 2014, 2019–2020, 2025). Patent Owner argues that the ability of Smart Sync to avoid storing files locally until needed satisfied a long-felt need to solve the problem of locally storing large files like photos and videos on local storage with limited capacity. *Id.* at 47–48 (citing Exs. 2013, 2017, 2021–2025). Patent Owner further argues that, after the invention of the ’520 patent subject matter, “companies such as Amazon, Microsoft, Google, Box and others began implementing the specific features covered by the challenged claims.” *Id.*

at 48 (citing Exs. 2027–2044). Patent Owner also submits evidence that it asserts shows industry skepticism, failure of others, and unexpected results related to the Smart Sync features. *Id.* at 48–50 (citing Exs. 2017–2018, 2022).

Notwithstanding what the teachings of the prior art would have suggested to one skilled in the art, objective evidence of nonobviousness (so called “secondary considerations”) may lead to a conclusion that the challenged claims would not have been obvious. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). Objective evidence of nonobviousness “may often be the most probative and cogent evidence in the record” and “may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012) (quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983)). Objective evidence may include long-felt but unsolved need, failure of others, unexpected results, commercial success, copying, licensing, and praise. *See Graham*, 383 U.S. at 17–18; *Leapfrog Enters., Inc. v. Fisher–Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Commercial success is typically shown with evidence of “significant sales in a relevant market.” *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006) (citation omitted). “When a patentee can demonstrate commercial success, usually shown by significant sales in a relevant market, and that the successful product is the invention disclosed and claimed in the patent, it is presumed that the commercial success is due to the patented invention.” *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997).

To give substantial weight to objective indicia of nonobviousness such as commercial success, a proponent must establish a nexus between the evidence and the merits of the claimed invention. *ClassCo, Inc. v. Apple, Inc.*, 838 F.3d 1214, 1220 (Fed. Cir. 2016). Nexus is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). “[T]here is no nexus unless the evidence presented is ‘reasonably commensurate with the scope of the claims.’” *ClassCo*, 838 F.3d at 1220 (quoting *Rambus Inc. v. Rea*, 731 F.3d 1248, 1257 (Fed. Cir. 2013)). A patentee is entitled to a presumption of nexus “when the patentee shows that the asserted objective evidence is tied to a specific product and that product ‘embodies the claimed features, and is coextensive with them.’” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019) (quoting *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018)). “[T]he patentee retains the burden of proving the degree to which evidence of secondary considerations tied to a product is attributable to a particular claimed invention.” *Fox Factory*, 944 F.3d at 1378. The Federal Circuit has held that “if the marketed product embodies the claimed features, and is coextensive with them, then a nexus is presumed and the burden shifts to the party asserting obviousness to present evidence to rebut the presumed nexus.” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000).

“A finding that a presumption of nexus is inappropriate does not end the inquiry into secondary considerations”; rather, “the patent owner is still afforded an opportunity to prove nexus by showing that the evidence of

secondary considerations is the ‘direct result of the unique characteristics of the claimed invention.’” *Fox Factory*, 994 F.3d at 1374 (quoting *In re Huang*, 100 F.3d 125, 140 (Fed. Cir. 1996)). “Ultimately, the fact finder must weigh the [objective indicia] evidence presented in the context of whether the claimed invention as a whole would have been obvious to a skilled artisan.” *See Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 33, 33 (PTAB Jan. 24, 2020) (precedential) (citing *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1331–32 (Fed. Cir. 2016)).

As evidence of commercial success and other objective evidence of nonobviousness, Patent Owner relies on publicly available marketing literature and news articles related to Petitioner’s “Smart Sync” synchronization engine incorporated in Petitioner’s desktop applications. Prelim. Resp. 42–50 (citing Exs. 2012–2025). In arguing nexus, Patent Owner relies on descriptions of Smart Sync as:

[A] “feature that makes all the content in a user’s Dropbox account seamlessly accessible from their desktop file system — and the content takes up virtually no local disk space until it’s needed,” such that “Team members gain full visibility and unprecedented access to their entire Dropbox right from their desktop file system, no matter how large.”

Prelim. Resp. 43 (quoting Ex. 2012). Key to Patent Owner’s theory of nexus is the fact that Smart Sync provides that “whenever they need to access files stored in the cloud, users can download them with a quick double click,” and “[t]he upstream files look like any other item in your Dropbox. . . click on one and it will quickly download and open, as if it were there on your disk the whole time.” *Id.* at 44 (citing Exs. 2014–2015). Patent Owner does not

provide a detailed comparison of Smart Sync with the challenged claims in its Preliminary Response. But Patent Owner argues:

[T]here is a direct nexus between Smart Sync and the claimed inventions. For example, as set forth above, a key benefit of the claimed inventions is the ability to make available shared folders (and the files within them) to recipients simply as “representations” without needing to download the contents of any files to each such user’s local drive until they are needed. Thus, not only does the shared folder overwhelm the recipient’s drive space, but each recipient has the ability to selectively download only those files they need to access. Moreover, because no files are automatically downloaded to the recipient’s computer at the time of sharing, for each such file that a recipient wishes to download, the recipient is guaranteed to access the most up-to-date version of the file.

Prelim. Resp. 45–46.

The problem with Patent Owner’s nexus arguments is that, as discussed further below, the challenged claims do not pertain to the above-quoted features—rather, those features at most pertain to disclaimed independent claims 1 and 7. *See* note 12 and pages 35 and 43 below. In addition, we note that, in the related case, *Motion Offense, LLC v. Dropbox, Inc.*, WDTX-6:20-cv-00251 (W.D. Tex.), after a jury trial in May 2023, all asserted claims of a related patent were found not infringed and invalid. *See* Ex. 1013. Patent Owner has stated that the claims of the ’520 patent and of that case are “substantially similar.” Ex. 1018 ¶ 31.

In sum, our review of the record does not support a finding of nexus to support Patent Owner’s assertions of objective indicia of nonobviousness.

*F. Alleged Obviousness of Claims 17–21 over Houston and Garcia*

Petitioner challenges claims 17–21 as obvious over the combination of Houston and Garcia. Pet. 15–64.<sup>9</sup>

*1. Houston*

Houston, titled “Network Folder Synchronization,” issued September 2, 2014, from an application filed August 13, 2010. Ex. 1003, codes (54), (45), (22). Houston “relates generally to sharing of data over a network” and “is directed to synchronization of a folder and its contents shared between multiple clients.” *Id.* at 1:14–18. Houston Figure 1 is reproduced below.

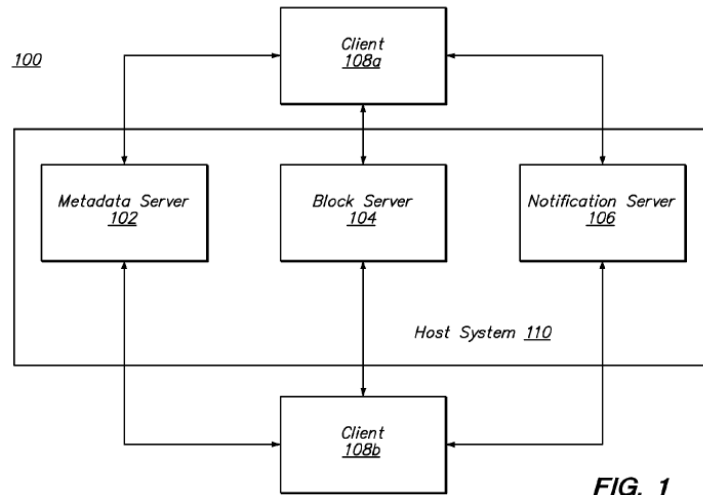


Figure 1 “is a block diagram of a host system and clients for maintaining synchronized shared folders.” Ex. 1003, 2:22–23.

---

<sup>9</sup> Petitioner also challenges claims 1–8 over Houston and Garcia, but because Patent Owner has disclaimed those claims, we do not consider that portion of Petitioner’s challenge, except to the extent that Petitioner relies on its analysis of those claims in its analysis of claims 17–21.

System 100 includes clients 108a, 108b and a host system 110, and further includes a metadata server 102, block server 104, and notification server 106. Ex. 1003, 2:59–62. Client 108 enables a user to create, modify and delete files on the client’s local file system, and for those actions to be synchronized with versions of the same files on host system 110 and on one or more other client computers. *Id.* at 3:25–28. A user creates a folder and designates it as one that should be synchronized, and its contents are then managed by client 108 to maintain that synchronization. *Id.* at 3:29–31. A user can create a shared synchronized folder either through a user interface portion of client 108, or via a web server. *Id.* at 3:31–34.

Block server 104 receives, stores, and serves blocks of data constituting synchronized files. Ex. 1003, 2:66–67. Metadata server 102 receives requests from clients to update block server 104’s copy of synchronized folders and provides clients with a list of metadata for files being synchronized. *Id.* at 2:63–65. Notification server 106 provides updates to clients when a synchronized folder has been updated on block server 104. *Id.* at 2:67–3:3.

Houston Figures 2, 3 and 4 are reproduced below.

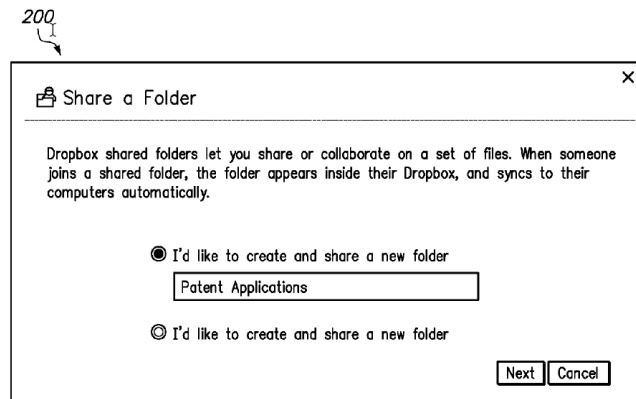
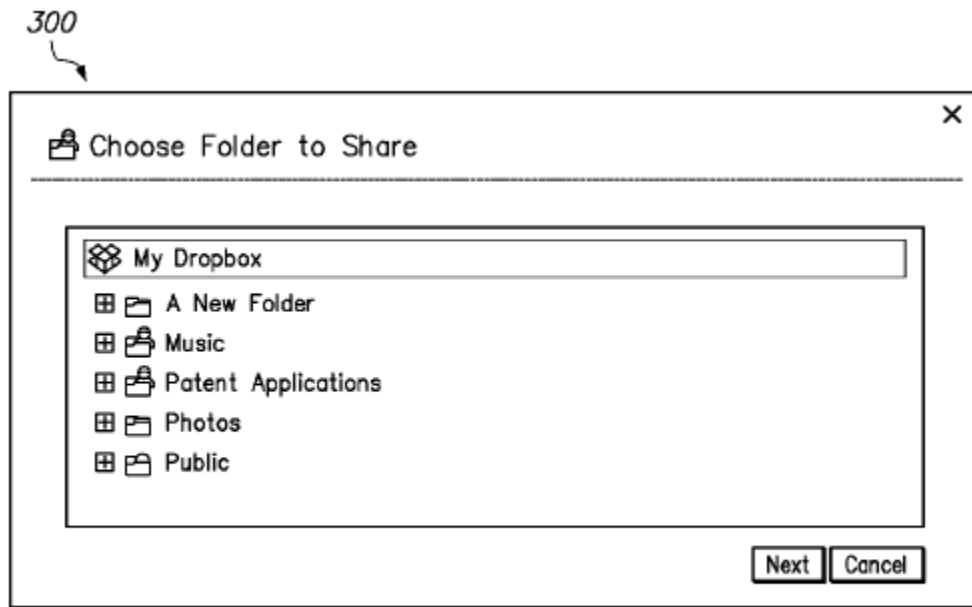
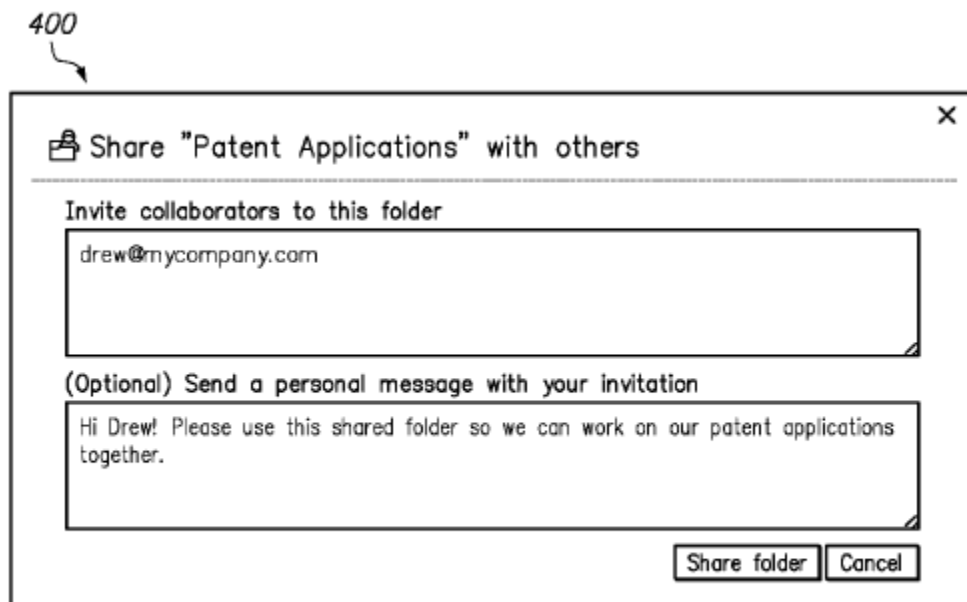


FIG. 2



**FIG. 3**



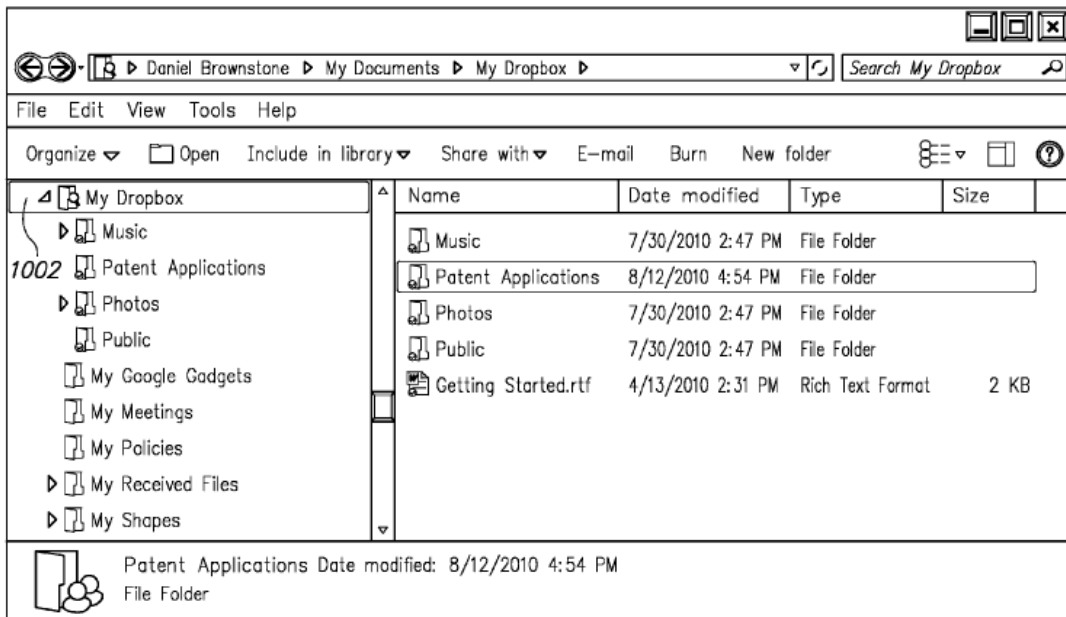
**FIG. 4**

Figures 2 and 3 each “illustrate[] a user interface window for creating a shared synchronized folder,” *i.e.*, of existing folders to be shared. Figure 4 “illustrates a user interface window for sharing a folder.” Ex. 1003, 2:25–33.



Figure 2 illustrates a user interface window accessed via a web interface, and Figure 3 illustrates a user interface portion of a client, either of which can be used to designate a folder to be synchronized and shared — in the illustrated examples, a “Patent Applications” folder is so designated. Ex. 1003, 3:29–40. Once the user has chosen or created the folder to be shared, Figure 4 illustrates a user interface window 400 via which the user can invite other users to share the folder. *Id.* at 3:40–43.

Houston Figure 10 is reproduced below.



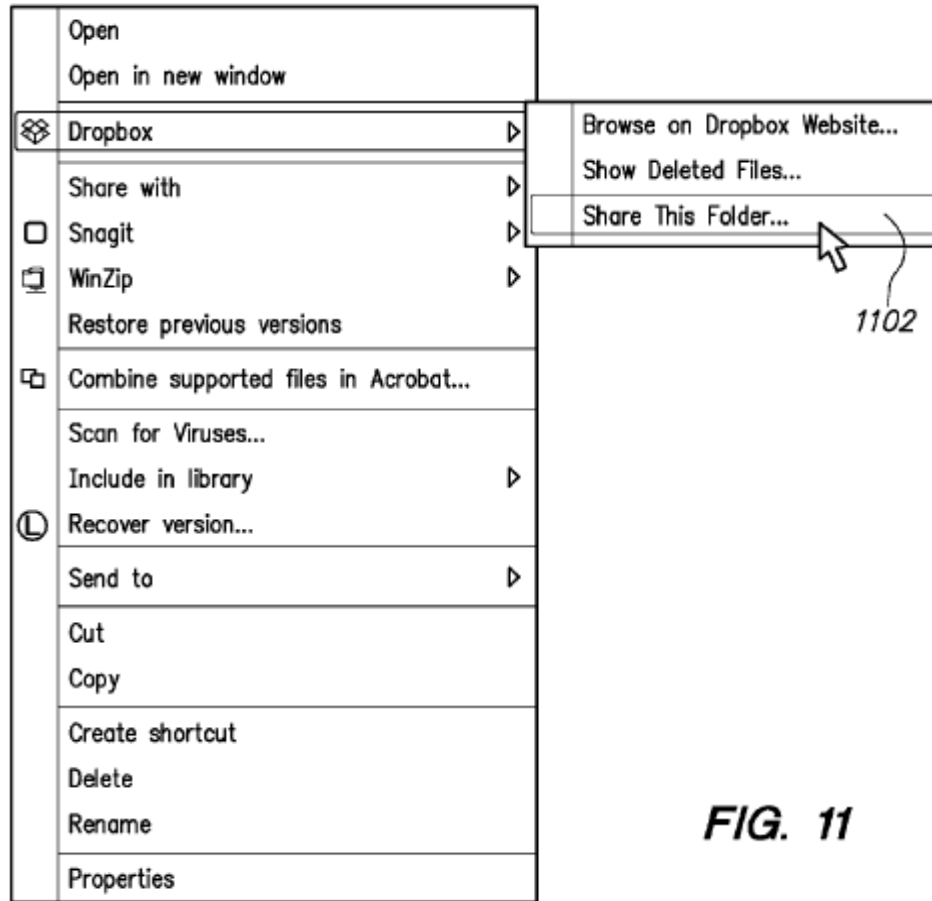
**FIG. 10**

Figure 10, reproduced above, “illustrates an interface for interacting with shared folders.” Ex. 1003, 2:48–49.

The user interface shown in Figure 10 allows users to interact with shared folders, which in this example is the “My Dropbox” folder 1002, which is synchronized with the host system. Ex. 1003, 7:18–23. That folder includes the folders Music, Patent Applications, Photos, and Public, and the

document Getting Started.rtf, stored on the user's system. *Id.* at 7:26–28.

Figure 11 is reproduced below.



**FIG. 11**

Figure 11, reproduced above, “illustrates a selection menu for sharing a folder.” Ex. 1003, 2:51–52.

By right-clicking on the folder name and selecting “Share This Folder . . .” option 1102, a user can share the “Patent Applications” folder.

Ex. 1003, 7:32–36. Alternatively, the user can use a web interface to communicate the share instructions to host system 110. *Id.* at 7:37–38. In either event, the user also specifies the account identifier of the user(s) with whom the folder is to be shared. *Id.* at 7:38–40. If an invited user accepts the invitation to share the folder, metadata server 102 creates a link in the

user's storage that points to the folder, and notification server 106 provides change notifications to the invited user's client, and the invited user's client obtains the latest version of the synchronized file. Ex. 1003, 7:49–58.

## 2. *Garcia*

*Garcia*, titled “System, Method, And Computer Program For Enabling A User To Synchronize, Manage, And Share Folders Across A Plurality Of Client Devices And A Synchronization Server,” issued April 25, 2017, from an application filed August 10, 2012. Ex. 1004, codes (54), (45), (22).

*Garcia* “relates generally to a synchronization system and, more particularly, to a system and method for enabling a user to synchronize, manage, and share folders across a plurality of client devices and a synchronization server.” *Id.* at 1:11–15.

*Garcia* Figure 20a is reproduced below.

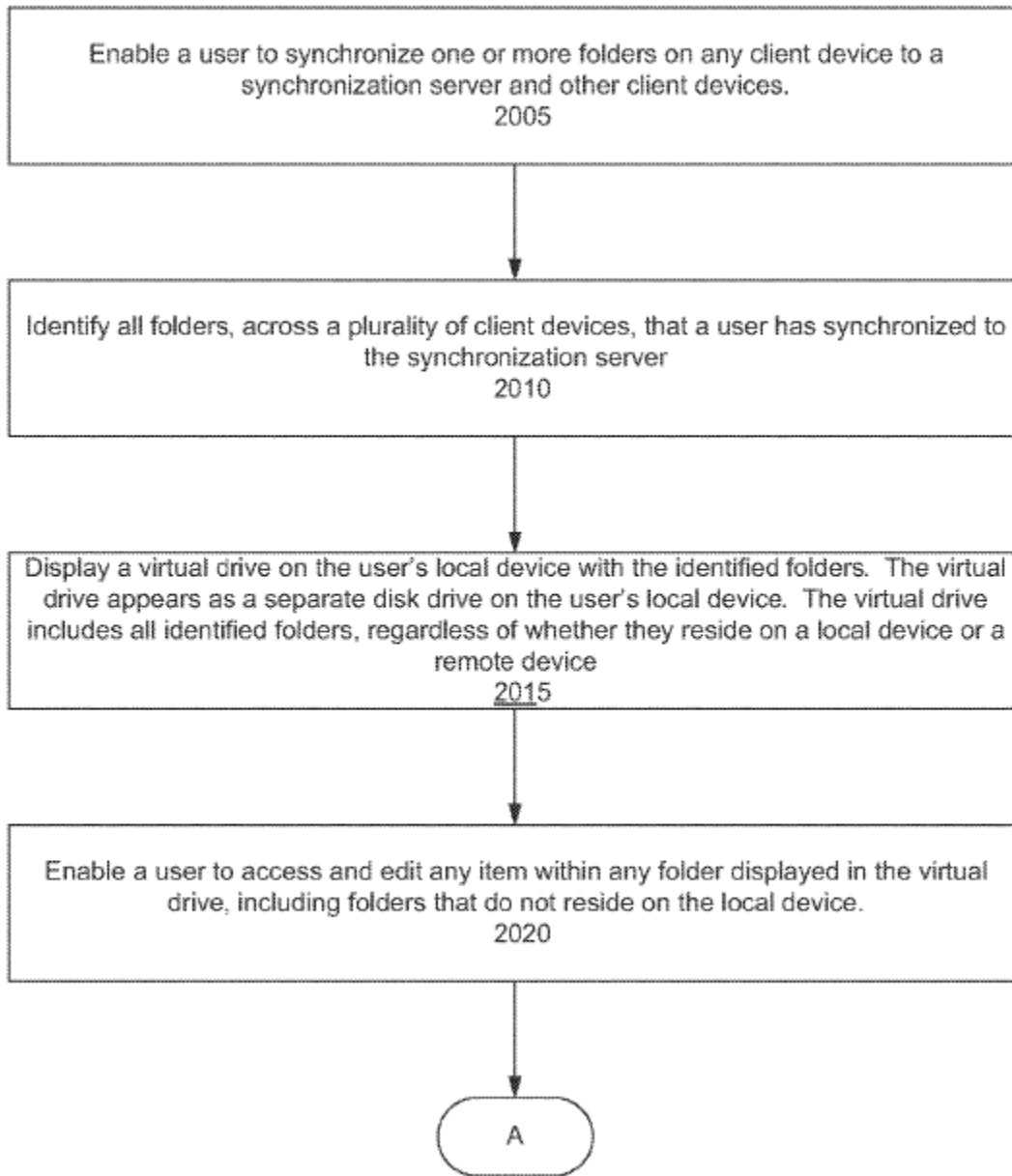


Figure 20a is “a flowchart that illustrates a method . . . for enabling a user to access and edit, via a virtual drive, local and remote objects, including objects synchronized to a plurality of synchronization software clients.” Ex. 1004, 2:66–3:1.

In step 2005, a user is enabled to synchronize one or more folders on any synchronization client to the synchronization server and other

synchronization clients. Ex. 1004, 5:14–17. When a user synchronizes an object to the synchronization server, the synchronization server stores a copy of the object. *Id.* at 8:29–31. In step 2010, all folders, across a plurality of synchronization clients that a user has backed up or synchronized to the synchronization server, are identified, as well as any folders that the user shares with other users. *Id.* at 5:17–20. Each of the synchronization clients stores metadata with information on all folders shared with or by the user and all folders that the user has backed up or synced to the synchronization server (including the contents of the folder). *Id.* at 5:20–24. The synchronization client on the client device uses this metadata to generate the virtual drive and the user interface. *Id.* at 5:24–26.

In step 2015, a virtual drive is displayed on the user's local client device with the identified folders. Ex. 1004, 5:27–28. The virtual drive appears as a separate disk drive on the user's local client device. *Id.* at 5:28–30. The virtual drive includes all of the user's synced folders, regardless of whether a folder resides on the local client or only on a remote client. *Id.* at 5:30–32.

In step 2020, a user is enabled to access and edit any item within any folder displayed in the virtual drive, including folders that do not reside on the local client. Ex. 1004, 5:32–35. When a user double clicks on a file or item in a remote folder in the virtual drive, the server downloads its copy of the file/item to the local synchronization software client (i.e., the client currently being used by the user). *Id.* at 5:35–39. The user can then edit the file/item as desired. *Id.* at 5:39–40. In one embodiment, when a user double clicks on a local folder, the user is taken to the folder in the local file system view. *Id.* at 5:40–42. In another embodiment, the server downloads its copy

of the item/file in the local computer. *Id.* at 5:42–43.

Garcia Figures 3–14 “are screenshots of an exemplary user interface in a synchronization system.” Ex. 1004, 2:60–61. Figure 10 is reproduced below.



Figure 10 illustrates how a user accesses files in a folder displayed in the client sync application. Ex. 1004, 10:52–55.

Any file in folders 1005 in the synchronization system may be accessed through a virtual drive 1010, including folders located only on a remote device or folders located only on the synchronization server.

Ex. 1004, 10:60–64. A virtual drive is a file representation view of non-file system data, such that folders 1005 may be viewed as if they resided on the hard drive of the local device (e.g., a home computer) and the user may open, add, edit, delete, and move files within these folders, including files that reside on a remote device. *Id.* at 10:64–11:2. Changes made via the

virtual drive are automatically synchronized with the synchronization server and applicable client devices. *Id.* at 11:2–4. When a user double clicks on a folder in the user interface of the client sync application, the virtual drive is displayed. *Id.* at 11:4–7. Not only are all of the user’s folders that have been synchronized to or stored on the server accessible through the virtual drive, but also all of the folders 1015 shared with the user by other users. *Id.* at 11:7–10.

Garcia Figures 11–12 illustrate the functionality of a “sharing view.” Ex. 1004, 11:11–12. Figure 11 is reproduced below.

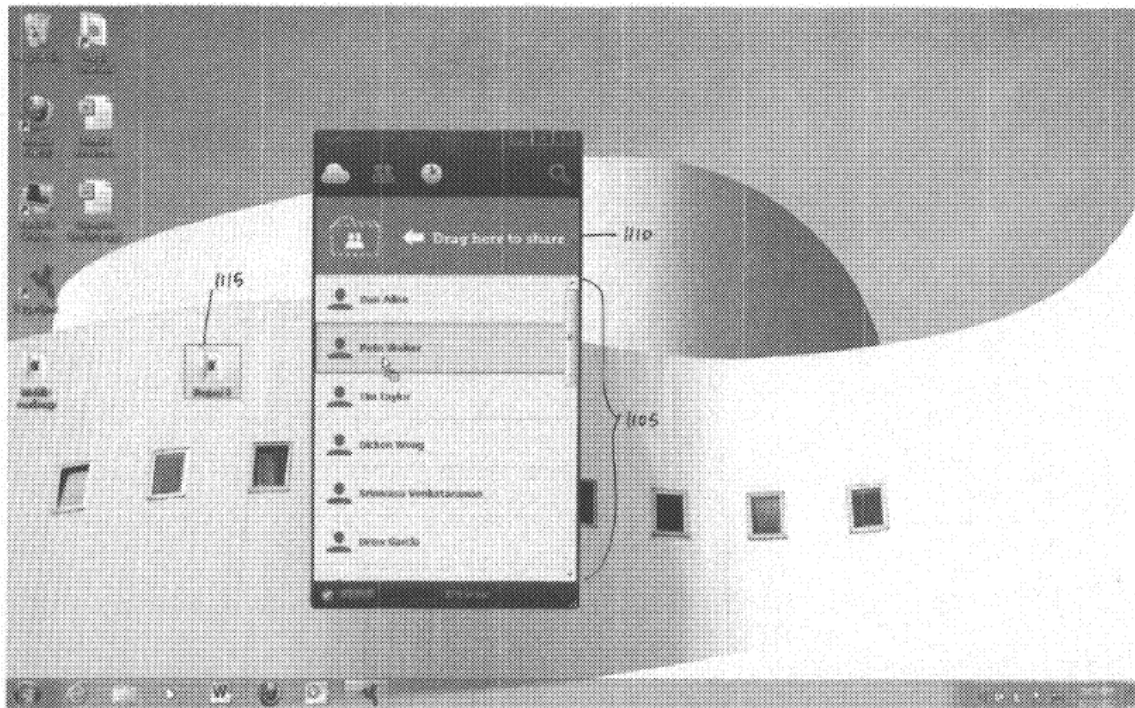


Figure 11 shows a list of contacts 1105, each of which is a drop target zone, and a separate dedicated drop target zone 1110. Ex. 1004, 11:12–14.

The list of contacts 1105 may be compiled from the user’s MICROSOFT OUTLOOK contacts, mobile device contacts, or any other contacts.

Ex. 1004, 11:14–16. When a user drags a folder, such as folder 1115 in the figure, to a particular contact, the folder or a link to the folder is automatically sent (via email, text, or other means) to the contact. *Id.* at 11:16–19. Dragging the folder automatically displays a dialog box that provides a user with options for sharing the folder with the contact. *Id.* at 11:19–23.

An example of such a dialog box is shown in Figure 12, reproduced below.

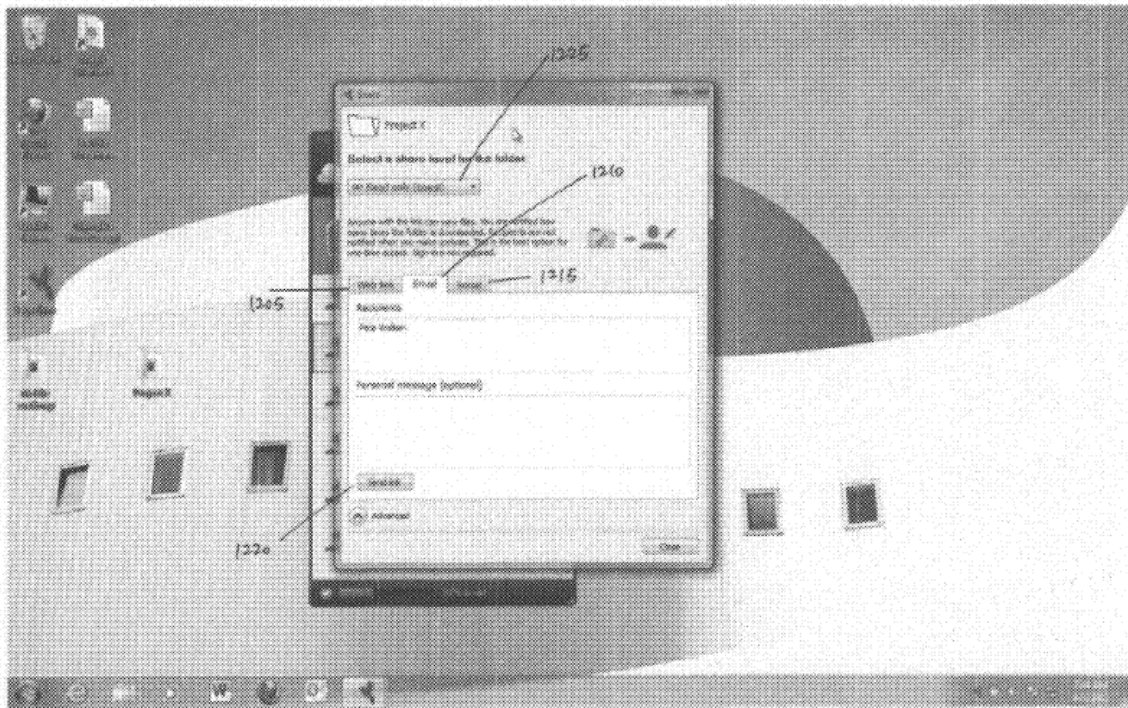


Figure 12 illustrates that sharing folder 1115 may be by web link 1205, by email 1210, or by social networking 1215. Ex. 1004, 11:23–26.

The user contact information is automatically populated into the “Recipients” field. Ex. 1004, 11:26–27. When the user clicks on send link button 1220, a link to folder 1115 is sent to the contact. *Id.* at 11:27–29. When the contact clicks on the link to folder 1115, the contents of the folder



are shared with the contact. *Id.* at 11:29–31.

Garcia Figure 13 is reproduced below.



Figure 13 illustrates web interface 1305 for the synchronization system. Ex. 1004, 11:44–45.

The web interface 1305 has a content view 1310, sharing view 1315, activity view 1320, and search field 1325. *Id.* at 11:46–48. In a My Cloud tab 1330 (of the content view 1310) is a list of folders 1345 from all synchronized client devices. *Id.* at 11:50–52.

### 3. Motivation To Combine

For some of the requirements of claims 17–21, elaborated below, Petitioner argues that one of ordinary skill in the art would have been motivated to combine Houston and Garcia because (i) Houston and Garcia are from the same field of endeavor, directed to synchronizing and sharing

folders; (ii) the combination would have yielded expected, predictable results, using known and routine computer programming principles; (iii) the combination would have been obvious to try given that sending an email with a link was one of only a few common and predictable methods for sharing folders; (iv) the combination would have been readily implemented given that it used information already received by Houston's system; (v) and the combination was suggested because Garcia expressly disclosed a benefit of sending an email message with a link to a shared folder (as required by requirement 17[d] discussed below). Pet. 27–31 (citing Ex. 1003, code (57), Figs. 1–4, 1:41–45, 1:53–54, 3:31–43; Ex. 1004, code (57), Figs. 2, 11–12, 10:32–34, 10:40–43, 11:39–43, cl. 3; Mowry Decl. ¶¶ 87–92). 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 31–32 (citing Ex. 1003, code (57), 1:53–54; Ex. 1004, code (57); Mowry Decl. ¶ 93).

Patent Owner argues that a person of ordinary skill in the art, in light of Garcia, would not have been “motivated to modify Houston's system such that, when an icon for a shared folder is created in Houston's Figure 10 interface at an invited user's client, the client does not store a file in the shared folder.” Prelim. Resp. 30. Patent Owner addresses Petitioner's argument that “Garcia's teaching of a ‘virtual drive’ that ‘appears as a separate disk drive on the user's local client device’ teaches [this modification of Houston] because [in Garcia] ‘when a user double clicks on a file or item in a remote folder in the virtual drive, the server downloads its copy of the file/item to the local synchronization software client.’” *Id.* at 30–31 (citing Pet. 38–40). Patent Owner disputes this, arguing that the

modification of Houston that Petitioner argues “would be contrary to the fundamental goal of Houston and eliminate its key function, which is ensuring the availability of synchronized local copies of files at each user.” *Id.* at 33. Patent Owner argues that storing copies of files locally at each user is critical to Houston’s system, and that Houston repeatedly criticizes systems that store documents remotely, such as in Garcia. *Id.* at 18, 33.

In particular, Patent Owner argues that numerous technical adjustments would have had to be made to modify Houston so that when an icon for a shared folder is created, the client does not store a file in the shared folder, thus teaching away from making the combination. Prelim. Resp. 31. Patent Owner argues that Houston is based on immediately updating changes to files stored locally at each client, which would be rendered inoperable if Houston is modified to delay downloading files in the manner of Garcia. *Id.* at 31–32. Patent Owner also argues Petitioner fails to explain how the technical details regarding change notifications and block list requests would be redesigned for any Houston/Garcia combination. *Id.* at 32–33.

Patent Owner’s arguments are not pertinent to Petitioner’s proffered combination of Houston with Garcia as applied to the remaining challenged claims 17–21. As discussed further below, Petitioner relies on Garcia as supplementing Houston for details regarding the requirements of generating and sending an email with a link to a folder but without a file attachment, and for synchronizing folders and providing interfaces for display of shared folders. Pet. 26–27, 36–39, 57–60. For the challenged claims, Petitioner does *not* rely on the combination to modify Houston’s system such that, when an icon for a shared folder is created in Houston’s interface at an

invited user's client, the client does not store a file in the shared folder — that aspect of the Houston/Garcia combination is only relevant to claims 1–8, which have been disclaimed. Pet. 40–41; Ex. 2045.

Thus, Patent Owner's argument, that Houston teaches away from combining with Garcia to delay storing a file when a folder is shared, is not applicable to Petitioner's challenges of claim 17–21. The fact that the Houston system ensures the availability of synchronized local copies of files at each user and criticizes systems that store documents remotely, such as in Garcia, is irrelevant to those claims. On this record, nothing about that particular difference in the approaches of Houston and Garcia would have discouraged one of ordinary skill in the art from adopting Houston to take advantage of the teachings in Garcia regarding use of email and folder interfaces.

In sum, Patent Owner focuses on a specific irrelevant detail of Houston regarding local storage of files, whereas Petitioner relies on other features of the combination of Houston and Garcia. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). “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.” *In re Keller*, 642 F.2d at 425; *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012). “Combining the *teachings* of references does not involve an ability to combine their specific structures.” *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973). At this stage, we are persuaded by Petitioner's declarant's testimony that one of ordinary skill would have been motivated to apply the email and

folder interface teachings of Garcia to modify Houston. Mowry Decl. ¶¶ 84–93, 102–104, 148, 151–152.

Accordingly, for purposes of this Decision, we determine that Petitioner has provided sufficiently articulated reasoning with rational underpinnings for the proffered combined teachings of Houston and Garcia.

#### 4. *Independent Claim 17*

##### a) *Preamble and Requirements 17[a]–17[c] and 17[g]*

For the “method” preamble of independent claim 17, Petitioner generally relies on the disclosure in Houston of “[a] method for synchronizing a shared folder over a network.” Pet. 15–16, 56 (citing Ex. 1003, Fig. 1, Cl. 1; Mowry Decl. ¶ 144).<sup>10</sup>

For claim requirement 17[a] of a first user interface for collecting folder information,<sup>11</sup> Petitioner relies on the disclosure in Houston of Figure 2, a web interface allowing a user to enter the name of a folder to share, and also Figure 3, a user interface window, which allows the user to select a folder to share. Pet. 17–21, 56 (citing Ex. 1003, Figs. 2, 3, 3:31–40; Mowry Decl. ¶¶ 64–71, 145).

For claim requirement 17[b] of a second user interface for collecting email address information, Petitioner relies on the disclosure in Houston of Figure 4, a user interface window, which allows the user to enter an email

---

<sup>10</sup> Based on the present record, we make no determination at this stage of the proceeding that the preamble of claim 17 is limiting.

<sup>11</sup> For economy of presentation, we refer to the portions of claim 17 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.

address. Pet. 21–23, 56 (citing Ex. 1003, Fig. 4, 3:40–43; Mowry Decl. ¶¶ 72–76, 146).

For claim requirement 17[c] of a third user interface for initiating sharing the folder, Petitioner again relies on the disclosure in Houston of Figure 4, in which selection of the “Share folder” button allows the user to invite another user to share the folder. Pet. 23–24, 56 (citing Ex. 1003, Fig. 4; Mowry Decl. ¶¶ 77–78, 147).

Claim requirement 17[g] requires:

causing, at the second node, receipt of code for storage at the second node and cooperation with a file explorer interface of a client-based file explorer application, for being utilized to: cause creation of a second representation of the at least one folder, in a location among one or more folders, that is stored at the second node and that is displayable via the file explorer interface of the client-based file explorer application.

Ex. 1001, 55:48–56. For this requirement, Petitioner relies on Figure 10 of Houston, depicting a file-explorer-type interface for interacting with shared folders. Pet. 33–35, 60 (citing Ex. 1003, Figs. 2, 10, 2:48–50, 7:18–31, 7:49–58; Mowry Decl. ¶¶ 96–99). Petitioner argues that one of skill in the art would have understood that code that allows such access to the host system would be stored on the invited collaborator’s client device. *Id.* at 33 (citing Ex. 1003, 3:43–45, 8:64–9:4; Mowry Decl. ¶ 97). Petitioner also relies on Figure 10 of Garcia, also depicting a file-explorer-type interface for interacting with shared, synchronized folders stored on a synchronization server. *Id.* at 36–39, 60 (citing Ex. 1004, Figs. 10, 21, 2:37–41, 5:27–30, 6:36–67, 7:14, 7:22–29, 10:59–63, 11:7–10; Mowry Decl. ¶¶ 102–104). Petitioner cites the fact that Garcia further discloses local client

synchronization software that functions to synchronize client devices with the synchronization server. *Id.* at 36–37 (citing Ex. 1003, Fig. 21, 7:1–3; Mowry Decl. ¶ 102).<sup>12</sup>

Other than its arguments discussed above generally relating to all of Petitioner’s grounds, Patent Owner does not specifically respond to Petitioner’s arguments regarding requirements 17[a]–17[c] and 17[g]. *See generally* Prelim. Resp. Accordingly, we are persuaded, for purposes of this Decision, that the record supports Petitioner’s arguments regarding these claim requirements.

*b) Requirement 17[d]*

For the claim requirement 17[d] of generating an email with various specified requirements, Petitioner relies on the combination of Houston and Garcia. Pet. 24–32, 57. For the general requirement of generating an email, and the further specific requirements of identifying in the email the information associated with the at least one folder, and not including a file attachment in the email, Petitioner first relies on Houston alone, based on the disclosures that clients may share folders with one another via a host system over a network, that a client can provide the folder information and an email to the server and invite others to share the folder, and that “attaching files [to emails is] cumbersome for many computer users.” *Id.* at 24–26 (citing

---

<sup>12</sup> Petitioner also relies on the combination of Houston and Garcia to modify Houston’s system such that, when an icon for a shared folder is created in Houston’s Figure 10 interface at an invited user’s client, the client does not store a file in the shared folder, as taught by Garcia. Pet. 40–41 (citing Mowry Decl. ¶¶ 105–106). However, this aspect of Petitioner’s challenge relates to a requirement of claims 1 and 7, which claims are no longer a subject of this proceeding. *See* Ex. 2045.

Ex. 1003, Fig. 1, 1:41–42, 1:53–54, 2:67–3:3, 3:5–10, 3:22–24, 3:40–43, 7:18–51; Mowry Decl. ¶¶ 80–83). Petitioner argues that, based on these disclosures, it would have been obvious that an invitation to notify the collaborator about the folder being shared and how to access the folder would be in the form of an email message to the provided email address. *Id.* at 25–26 (citing Mowry Decl. ¶ 82).

In the alternative, Petitioner argues that one of ordinary skill would have known to use, in the Houston system, an email to invite a user to share a folder based on the disclosure in Garcia that a client can share a folder with another client by generating and sending an email with a link to, and identification of, the shared folder, instead of an attachment. Pet. 26–27, 57 (citing Ex. 1004, Figs. 2, 9, 11–12, 8:8–26, 10:32–34, 10:38–40, 11:39–43, Cl. 3; Mowry Decl. ¶¶ 84–86). For the 17[d] requirement of including a Hypertext Transfer Protocol (HTTP) link in the email, and the requirement that the email is at least partially pre-written, Petitioner argues that an HTTP link was known as the conventional type of link to be inserted in an email, and that at least the “From” and “To” fields in the email of Garcia would be pre-written. *Id.* at 57 (citing Mowry Decl. ¶ 148). For the requirement of automatically causing the email to be received without requiring user involvement after the action of requirement 17[c], Petitioner argues that because neither Houston nor Garcia expressly requires a user’s approval for an email to be sent or received, a person of ordinary skill would have understood the email to be automatically received by the person to which the email is addressed, without any user involvement, as was the norm. *Id.*

As discussed above in Section III.F.3, Patent Owner challenges Petitioner’s reliance on the Houston/Garcia combination for requirement



17[d], in addition to its arguments discussed above generally relating to all of Petitioner’s grounds. However, for the reasons discussed above, for purposes of this Decision, we are persuaded that the record supports Petitioner’s arguments regarding this claim requirement.

*c) Requirements 17[e] and 17[f]*

Claim requirements 17[e] and 17[f] require:

receiving, from the second node and at [*sic*] least one server, a signal for causing creation of a first representation of the at least one folder, 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;

causing, at the second node, receipt of the at least one web page, that results in display, at the second node and via the at least one web page, the first representation of the at least one folder that is stored at the at least one server.

Ex. 1001, 55:38–47. For these requirements, Petitioner relies on the disclosure in Houston of host servers that synchronize and store folders, that receive requests from clients to update the server’s copy of synchronized folders and provide clients with a list of metadata for files being synchronized, and that provide a web interface that allows access to shared folders. Pet. 57–58 (citing Ex. 1003, 2:10–12, 2:63–66; Mowry Decl. ¶ 150). Petitioner also relies on the disclosure in Garcia of the ability of a user to synchronize a folder to a synchronization server, which provides a web interface to users that displays shared folders. Pet. 58–60 (citing Ex. 1004, Figs. 2, 10, 13, 5:9–11, 8:29–31, 10:60–61, 11:7–10, 11:44–50; Mowry Decl. ¶¶ 151–152).

Patent Owner argues that Petitioner fails to identify, in a Houston/Garcia combination, any creation of a “representation” of a shared

folder at the receiving second node as required by element [e] of claim 17. Prelim. Resp. 33–34. Patent Owner argues that the claimed creation of a “representation” means that “when a folder is shared with a second node, a special version of the shared folder is created at the second node that appears to the user to exist locally at the second node, but whose contents (and the contents of files within the folder) exist on the cloud and are not downloaded till the user wishes to interact with them.” *Id.* at 34. Patent Owner argues that the Houston/Garcia combination does not teach this aspect of the claims. *Id.* at 34–35.

In arguing that Petitioner has not identified, in the Houston/Garcia combination, any creation of a “representation” of a shared folder at the receiving second node as required by the claims, Patent Owner argues that the claimed creation of a “representation” means that:

[W]hen a folder is shared with a second node, a *special version* of the shared folder is created at the second node that appears to the user to exist locally at the second node, but whose contents (and the contents of files within the folder) exist on the cloud and are not downloaded till the user wishes to interact with them.

Prelim. Resp. 33–34 (emphasis added). However, there is no such requirement of a “special version of the shared folder” in claim 17. Patent Owner’s assertions otherwise are based on unsupported attorney argument that has no basis in the record.

There is no explicit definition of “representation” in the ’520 patent. One example of a representation of a folder is described in the incorporated by reference ’635 application as a window or other visual interface element displayed on a screen of a display presenting information representing a

program entity such as a folder. Ex. 2004 ¶¶ 49–52, 69. Another example, also in the '635 application, states that “a representation of a data object may include and/or may otherwise be based on a replica of at least a portion of the data object” — the opposite of Patent Owner’s asserted “special version” definition. It is also true that disclaimed claim 1 includes the requirement that, when a representation of a folder is created, such creation “does not store the at least one file when the creation of the representation of the at least one folder is caused.” Ex. 1001, 49:44–49. But this specific requirement for claim 1 does not apply to claim 17, or support the sweeping interpretation of “representation” that Patent Owner asserts.

Patent Owner further argues that Petitioner does not identify any teachings in Houston or Garcia of the claimed “signal” in the claim requirement 17[e]: “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 folder.” Prelim. Resp. 35–36 (emphasis added). Patent Owner notes Petitioner’s reliance on the web interfaces disclosed in both Houston and Garcia, but argues that there is no citation by Petitioner to a teaching of the “signal” requirement. *Id.*

Patent Owner’s argument that Petitioner does not identify any teachings in Houston or Garcia of the claimed “signal” in the claim 17[e] is also unsupported. Claim 17[e] requires, “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 folder.” Ex. 1001, 55:38–40. Nowhere in the '520 patent is there any specific reference to such a signal, let alone a definition of that term. However, at one point in the prosecution history of the '520 patent, a proposed dependent claim (which was allowed but later

withdrawn by the applicant) specified that the signal requirement “includes an HTTP request.” Ex. 1014, 32, 411, 493. This is consistent with disclosures in the incorporated by reference ’635 application that the email sent to the recipient of a shared folder includes a “mount descriptor” with an HTTP link to the folder, which the recipient can then use to request the folder. Ex. 2004, Figs. 6A, 8A (item 810a), ¶¶ 102–103, 112, 130. Accordingly, on this record, we determine that at least one example of the signal that is referred to in claim 17[e] is an HTTP request.

Petitioner identifies such an HTTP request in Garcia — Garcia discloses sending an email with a link, which Petitioner argues would have been known to be an HTTP link. Pet. 27, 57 (citing Ex. 1004, Figs. 9, 11–12, 10:32–34, 10:38–40, 11:39–43, Cl. 3; Mowry Decl. ¶¶ 86, 148). Petitioner explains that “[w]hen a user synchronizes an object to the synchronization server, the synchronization server stores a copy of the object.” Pet. 58 (citing Ex. 1004, Fig. 13, 5:9–11, 8:29–31, 11:44–50; Mowry Decl. ¶ 151). Although Petitioner does not explicitly state, the reference to “when a user synchronizes an object” is to the user selecting the HTTP link to the folder in the email — *i.e.*, generating a signal in the form of an HTTP request. As stated in Garcia, “[i]f the user elects to synchronize the remote object to the local device, a copy of the remotely located object is downloaded to the local device,” and such election is performed via selecting a link in an email sent to the user — “[w]hen the contact clicks on the link to folder, the contents of the folder are shared with the contact.” Ex. 1004, Figs. 9, 11–12, 4:32–35, 10:32–43, 11:11–43. For purposes of this Decision, we find that Petitioner has sufficiently supported this aspect of its challenge to claim requirement 17[e].

Accordingly, notwithstanding Patent Owner's specific arguments directed to claim requirement 17[e], and its arguments discussed above generally relating to all of Petitioner's grounds, for the reasons discussed above, for purposes of this Decision, we are persuaded that the record sufficiently supports Petitioner's arguments regarding claim requirements 17[e] and 17[f].

*d) Conclusion Regarding Claim 17*

Based on our analysis set forth above, including our analysis of Patent Owner's arguments regarding secondary considerations of nonobviousness, we determine, on the current record and for purposes of this Decision, that the information presented in the Petition demonstrates a reasonable likelihood that Petitioner will prevail in establishing that claim 17 is unpatentable under 35 U.S.C. § 103(a) over the combination of Houston and Garcia.

*5. Dependent Claim 18*

Claim 18 adds to claim 17 the requirement, "wherein the email and the file explorer interface are displayed via separate interfaces for permitting access to the at least one folder via multiple different interfaces based on a detection of an indication that the HTTP link has been selected." Ex. 1001, 55:57–61. For this requirement, Petitioner relies on the above-discussed teachings of the Houston/Garcia combination of an email including an HTTP link and a client-based file explorer interface, together with the understanding of one of ordinary skill that clicking the HTTP link would have opened a web page in a web browser that is separate from a file explorer interface of a client-based file explorer application and that the user

would be able to access the shared folder from the web page or the file explorer interface. Pet. 60–61 (citing Ex. 1004, Fig. 10; Mowry Decl. ¶¶ 156–157).

Patent Owner argues that Petitioner errs in asserting that one of ordinary skill would have known that clicking on the HTTP link sent in Garcia’s email would have opened a web page in a web browser distinct from a file explorer interface. Prelim. Resp. 37. Based on a reference to “SugarSync” in some of the Garcia drawings, Patent Owner relies on a “SugarSync User Guide,” which Patent Owner characterizes as explaining that receiving a link to a shared folder via email will cause the shared folder to sync automatically to the recipient’s computer via the virtual drive, not via a web page. *Id.* at 37–38 (citing Ex. 2010, 78; Ex. 2011, 75–76). Patent Owner also argues that Petitioner has not shown that the requirements that “the email and the file explorer interface are displayed via separate interfaces,” or that folder access is “via multiple different interfaces based on a detection of an indication that the HTTP link has been selected,” are satisfied. *Id.* at 38–39.

At this stage, we are persuaded by Petitioner’s arguments regarding claim 18. The fact that arguably related SugarSync documents indicate use of an interface other than a web page does not alter the disclosures in Garcia of using a web page. “Combining the *teachings* of references does not involve an ability to combine their specific structures.” *In re Niveelt*, 482 F.2d at 968. Based on our analysis set forth above, including our analysis of Patent Owner’s arguments regarding secondary considerations of nonobviousness, we determine, on the current record and for purposes of this Decision, that the information presented in the Petition demonstrates a

reasonable likelihood that Petitioner will prevail in establishing that claim 18 is unpatentable under 35 U.S.C. § 103(a) over the combination of Houston and Garcia.

*6. Dependent Claims 19–21*

Claim 19 adds to claim 17 the requirement, “wherein the file explorer interface of the client-based file explorer application is displayed via an interface that does not include a web page displayed via a web browser.” Ex. 1001, 55:62–65. Claim 20 adds to claim 17 the requirement, “wherein the file explorer interface is part of an operating system of the second node.” *Id.* at 55:66–67. For these requirements, Petitioner relies on the above-discussed Figure 10 disclosure of Garcia. Pet. 51, 61–63 (citing Ex. 1004, Fig. 10, 7:25–29; Mowry Decl. ¶¶ 130, 159, 161).

Claim 21 adds to claim 17 the requirement, “wherein at least one of: the first user interface element, the second user interface element, and the third user interface element are caused by sending a first communication; the receipt of the at least one web page is caused by sending a second communication; or the receipt of the code is caused by sending a third communication.” Ex. 1001, 56:1–8. For this requirement, Petitioner relies on the disclosure in Garcia of a synchronization server sending a web interface to a client device, which Petitioner argues satisfies the “second communication” alternative of claim 21. Pet. 63–64 (citing Ex. 1004, Fig. 2; Mowry Decl. ¶¶ 163–164).

Other than its arguments discussed above relating to claims 17 and 18, which we have considered, and its arguments discussed above generally relating to all of Petitioner’s grounds, Patent Owner does not specifically

respond to Petitioner's arguments regarding dependent claims 19–21. *See generally* Prelim. Resp. Based on our analysis set forth above, including our analysis of Patent Owner's arguments regarding secondary considerations of nonobviousness, we determine, on the current record and for purposes of this Decision, that the information presented in the Petition demonstrates a reasonable likelihood that Petitioner will prevail in establishing that claims 19–21 are unpatentable under 35 U.S.C. § 103(a) over the combination of Houston and Garcia.

*G. Alleged Obviousness of Claims 17–21 over Houston, Garcia, and Manzano*

Petitioner alternatively challenges claims 17–21 as obvious over the combination of Houston, Garcia, and Manzano. Pet. 64–73. Manzano, titled “Electronic File Sharing,” was published January 7, 2010, from an application filed April 21, 2009. Ex. 1005, codes (54), (43), (22). Manzano is directed to sharing of electronic files among electronic devices. *Id.* ¶ 2. Petitioner's reliance on Manzano as an additional reference, in combination with Houston and Garcia, is not applicable to this proceeding to the extent that it is primarily directed to several requirements of claims 1, 3, and 7, which have been disclaimed. Pet. 64–65. Petitioner also relies on Manzano regarding claim requirement 17[g] “to the extent [Patent Owner] further contends that a representation of a folder in a file explorer interface implies that at least one file in the folder is not downloaded when the representation of the folder is caused.” *Id.* at 65. Patent Owner does make this contention regarding “representation.” Prelim. Resp. 33–35. However, as discussed above at note 12 and pages 35 and 43, there is no such requirement in claim



17. Therefore, for purposes of this decision, we need not address this argument.

*H. Alleged Obviousness of Claims 17–21 over Houston, Garcia, and Wu, and of Claims 17–21 over Houston, Garcia, Manzano, and Wu*

Petitioner alternatively challenges claims 17–21 as obvious over the combination of Houston, Garcia, and Wu, and claims 17–21 over Houston, Garcia, Manzano, and Wu. Pet. 73–77. Other than its arguments discussed above relating to claims 17 and 18, which we have considered, and its arguments discussed above generally relating to all of Petitioner’s grounds, Patent Owner does not specifically address these challenges. *See generally* Prelim. Resp.

Wu is titled “System And Method Of Producing E-Mail.” Ex. 1006, code (54). Wu “relates to a system and method of producing E-mail, and more particularly to a system and method for producing the contents of an E-mail.” *Id.* ¶2. Wu teaches, for its solely applied feature, producing emails using “predetermined subject templates” and “predetermined content templates” stored in databases. Pet. 73–74 (citing Ex. 1006 ¶¶ 5–9, 17–32). Petitioner relies on Wu as teaching or suggesting the portion of claim 17[d] that requires the subject email to be “at least partially pre-written.” *Id.* at 73. However, as discussed above, for purposes of this decision, we find that the combination of Houston and Garcia sufficiently teaches or suggests this requirement, and therefore we do not consider this alternative argument at this stage.

#### IV. CONCLUSION

After considering the evidence and arguments presented in the Petition and the Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that at least one claim of the '520 patent is unpatentable. Accordingly, we institute an *inter partes* review of challenged claims 17–21 and all of the grounds presented in the Petition. *See* 37 C.F.R. § 42.108(a); *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *AC Techs. S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1364 (Fed. Cir. 2019) (“[I]f the Board institutes an IPR, it must . . . address all grounds of unpatentability raised by the petitioner.”). At this stage of the proceeding, we have not made a final determination as to the patentability of these challenged claims.

#### V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314, *inter partes* review is instituted as to challenged claims 17–21 of the '520 patent with respect to all grounds of unpatentability presented in the Petition; and

FURTHER ORDERED that *inter partes* review is commenced on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

IPR2024-00286  
Patent 11,611,520 B1

For PETITIONER:

Scott Bertulli  
Trishan Efram  
WILMER CUTLER PICKERING HALE ANDORR LLP  
scott.bertulli@wilmerhale.com  
trishan.esram@wilmerhale.com

For PATENT OWNER:

George Gordon  
ANDREW GORDON LAW FIRM PLLC  
andrew@agordonlawfirm.com