

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.
Petitioner

v.

SAMESURF, INC.
Patent Owner

Case IPR2023-00339
U.S. Patent No. 9,185,145

PATENT OWNER'S SUR-REPLY

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2002	Saif Askar's Biography
2003	Declaration of David S. Howell
2004	Declaration of Stacy Friedman
2005	Order Denying Defendant's Motion to Dismiss Pursuant to 35 U.S.C. § 101 (Case No. 3:22-cv-00412-LL-KSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)
2006	Defendant Intuit Inc.'s Memorandum of Points and Authorities in Support of Motion to Dismiss Pursuant to Fed.R.Civ.P. 12(b)(6) (Case No. 3:22-cv-00412-LL-KSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)
2007	Defendant Intuit Inc.'s Reply in Support of Motion to Dismiss Pursuant to Fed.R.Civ.P. 12(b)(6) (Case No. 3:22-cv-00412-LL-KSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)

I. INTRODUCTION

Petitioner has ***not*** met its burden of proving that claims 1-18 of the '145 Patent would have been obvious to a POSITA at the time of invention over Lebrun (Ex. 1005) in view of Wang (Ex. 1006) (Ground 1) or over Prajapat (Ex. 1007) in view of Wang (Ground 2).

First, the '145 Patent claims require a “synchronization server,” which as shown by PO throughout its submissions herein, is vastly different in terms of form, function, and purpose than Lebrun’s “Group Surfing Server,” Prajapat’s “Web Media Server” and Wang’s “Server Apparatus.” Session participants in Lebrun, Prajapat and Wang engage in a resource intensive “page sharing” process that requires that a “middleman” server continuously request, receive, reassemble, and deliver *webpage content* to the participants via the middleman server’s interactions with the web server. In the '145 Patent claims, the guest devices in PO’s system engage in a resource efficient “synchronized browsing session” wherein each receives “*web browsing interaction data*” from the “synchronization server,” thereby allowing the guest device to make its own request to the web server to thereby independently replicate the host’s web browsing interactions in real time. These fundamental differences in components, topology, and flows would not have been obvious to a POSITA at the time of the '145 Patent, and Petitioner has not met its burden of proving otherwise.

Second, Petitioner incorrectly contends that the ordinary meaning to a POSITA of “web browsing interaction data” is “data relating to web browsing interactions,” but Petitioner reaches this conclusion *without* ever considering the specification, which is *forbidden* under *Phillips*.

Third, Petitioner incorrectly contends that the claims do not require “two browsers [that] are simultaneously, or nearly simultaneously, sharing internet browsing of the same webpage in real time” by *ignoring its own contentions* before the District Court that the Asserted Claims (including the ’145 Patent) “make clear that sending and receiving information for simultaneous interactions is the focus of the Asserted Claims.” Exs. 2006, 7:11-12 and 2007. The District Court adopted Petitioner’s characterization of the claims. Ex. 2005, 10:4-21.

Fourth, Petitioner fails to prove that Lebrun and Prajapat disclose at least limitations [1.c] and [1.d] and that a POSITA would have been motivated to combine either reference with Wang. Petitioner cannot prove that Lebrun or Prajapat disclose limitations [1.c] and [1.d] because both require a “middleman” server, which, contrary to limitations [1.c] and [1.d], sends web content that the “middleman” server received from a website and then transmits to the session participants. Thus, Lebrun and Prajapat fail to provide “synchronized browsing sessions” that do not “materially impos[e] more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods.” Ex. 1001, 5:33-36.

II. SUR-REPLY ARGUMENTS

A. **Petitioner Has Not Met its Burden of Proving that a POSITA Would Have Understood the Phrase “Web Browsing Interaction Data” to Mean “Data Related to Web Browsing Interactions”**

Petitioner wrongly contends that “web browsing interaction data” “is clear on its face and no additional definition or limitation is required.” Pet. Reply, 5. As support, Petitioner relies on Petitioner’s expert declaration in which Petitioner’s expert improperly states that “[n]o additional limitation or limitation is required in my opinion, nor is there any special or specific meaning given to the term in the specification of the ’145 Patent.” Ex. 1034, ¶13. The methodology used by Petitioner and Petitioner’s expert to determine the ordinary and customary meaning of “web browsing interaction data” is incorrect as a matter of law.

By simply moving the word “data” from the last word in the phrase to the first word in the phrase and adding the words “relating to,” neither Petitioner nor its expert *ever* consults the specification or even considers what the meaning of the term would have been to a POSITA after reading the entire patent at the time of the ’145 Patent. Petitioner thus *errs* as a matter of law. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2004).

B. “Web Browsing Interaction Data” Is “Data Describing Interactions Performed on a Website by a Host Device,” Which Does not Include Webpage Data Received in Response to a Web Request

PO contends that a POSITA reading the claims in light of the specification would have understood that the term “web browsing interaction data” refers to “data describing interactions performed on a website by a host device,” which does not include webpage data received in response to a web request. Patent Owner Response (“POR”), 16-23; 28-41. Petitioner contends that PO’s construction incorrectly imports limitations from exemplary embodiments into the claim term. Pet. Reply, 6-8. PO is not importing a limitation.

PO’s construction recognizes the distinction in the specification between “webpage interaction information” (*i.e.*, “web browsing interaction data” (Ex. 2004, ¶40)), which is sent from the synchronization server to the guest device, and “webpage data,” which is sent from the website server to the guest device in response to the webpage interaction information. POR, 33-39; Ex. 2004, ¶¶37; 42; 45.

Petitioner contends that Figures 5(a), 5(c), and 5(d), and their respective descriptions in the specification, are merely exemplary and therefore there is no “single embodiment” or “clear intention” to limit the claims to the embodiments of Figures 5(a), 5(c), and 5(d). Pet. Reply, 6-7. There is no written description in the

specification to support a claim scope for “web browsing interaction data” that includes webpage data sent in a response from a web server. Ex. 2004, ¶45.

Further, unlike the known methods that allow users to view the same content but require high levels of bandwidth and computer processing power (Ex. 1001, 2:25-43), “utilization of *the present invention* does not materially impose more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods.” Ex. 1001, 5:33-36.¹ See *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) (“When a patent thus describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.”).

This requirement—“not materially imposing more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods”—is necessarily met by the claims, because the “web browsing interaction data” sent from the synchronization server to the guest device (on which the application of the guest device operates) does not include any “webpage data.” Therefore, as no webpage data is included with the “web browsing interaction data,” only conventional web requests are used, and thus no more bandwidth or processing power requirements are necessary than simply browsing the internet using standard,

¹ All emphasis added unless otherwise noted.

conventional methods. This is the typical and long-known method for how web browsers interact with web servers. Ex. 2004, ¶37.

But under Petitioner’s contention, if the “web browsing interaction data” includes webpage data, then, pursuant to limitation [1.c] of claim 1 of the ’145 Patent, this webpage data would be sent by the synchronization server to the guest device *and*, pursuant to limitation [1.d], the application on the guest device would operate based on the “web browsing interaction data,” including the webpage data, to access a website server. This scenario, which includes an extra transmission of webpage data from the synchronization server to the guest devices and includes the use of webpage data by the application on the guest devices to access a website server, would impose materially more bandwidth and processing power requirements than simply browsing the internet using standard, conventional methods, and therefore would be *inconsistent* with the “present invention.”

C. The District Court Adopted Petitioner’s Contention That the Claims Require “Synchronized Sessions”

Petitioner contends that the claims of the ’145 Patent do not require “two browsers [that] are simultaneously, or nearly simultaneously, sharing internet browsing of the same webpage in real time,” *i.e.*, “[t]here is no limitation that requires such ‘simultaneous’ or ‘real time sharing’ of the same webpage in real time.” Pet. Reply at 15-16. Petitioner’s citation to Ex. 1033, 222:2-14 does not

support its contention, as, on the prior page of his deposition transcript, Mr. Friedman testified that “synchronized browsing session” is recited in the preamble and in limitation [1.b] Ex. 1033, 221:21-23. Similarly, Petitioner’s citation to Ex. 1034, ¶¶12-14 is of no support, as this merely constitutes declaration statements by Petitioner’s expert regarding a communication message and the meaning of “web browsing interaction data.”

The Board should disregard Petitioner’s current contentions, as they are *contrary* to Petitioner’s own prior contentions before the District Court in its Motion to Dismiss. In that Motion, Petitioner contended that the claims of the ’145 Patent “make clear that sending and receiving information for simultaneous interactions is the focus of the Asserted Claims,” which includes the ’145 Patent. Ex. 2006, 7:11-12; *see also* 2:16-21; 3:26-4:3; 6:12-14; Ex. 2007, 1:20-25; 3:16-17; 4:2-6; 5:2-4.

The District Court denied Petitioner’s Motion, and, in so doing, held that the claims, as supported by the specification, are “directed to performing a synchronized browsing session between two electronic devices (a host device and a guest/invitee device) via a synchronization server.” Ex. 2005, 10:4-11:21. The Court thus concluded that “the claims are directed to a specific solution that is rooted in computer technology to overcome a problem specifically arising in the realm of computer networks—using a synchronization server to administer synchronized

browsing sessions in order to overcome the bandwidth and processing issues of the prior art.” Ex. 2005, 11:23-27.²

Petitioner further contends that “[n]othing in the claim recites *how* the synchronized browsing session is administered by the synchronization server” Pet. Reply, 16. Petitioner ignores the District Court’s findings that (1) the claims “are specifically directed to performing a synchronized browsing session between two electronic devices (a host device and a guest/invitee device) via a synchronization server;” (2) that the preamble provides that “the [representative] claim is directed to a method for ‘performing a synchronized browsing session administered by a synchronization server;” and (3) that the body of the claim provides the method steps for performing the “synchronized browsing session via a synchronization server, a host device, and a guest device.” Ex. 2005, 10:5-15.

Since Petitioner and the District Court relied on the preamble of claim 1 of the representative claim, which states that the method is directed to a “synchronized browsing session” in their Section 101 analysis, the recitation of the “synchronized

² The Board should give no weight to Petitioner’s expert’s opinion that “[n]one of the claim limitations requires any synchronous sharing of the same web browsing experiences, despite PO trying to read this limitation” (Ex. 1034, ¶7), because that alleged opinion *contradicts* Petitioner’s own prior contentions before the District Court and Petitioner’s expert never states that he considered Petitioner’s prior Motion to Dismiss contentions or the District Court’s findings. Ex. 2006, 7:11-12; Ex. 2005, 11:23-27.

browsing session” in the preamble is *limiting*. See *Data Engine Techs. LLC v. Google LLC*, 10 F.4th 1375, 1381 (Fed. Cir. 2021). Further, the reference to a “synchronized browsing session” and “synchronization server” in the preamble provide antecedent basis for the same terms in steps [1.a] and [1.b] of the claims and therefore, for this reason as well, the preamble is limiting, thereby limiting the claims to “synchronized browsing session administered by a synchronization server.” *In re Fought*, 941 F.3d 1175, 1178 (Fed. Cir. 2019).

A “synchronized browsing session” requires shared internet browsing “in real time” and in a “simultaneous fashion from different devices and/or locations” (POR, 14-15). Therefore the claims, being limited to “synchronized browsing sessions,” similarly require shared internet browsing “in real time” and in a “simultaneous fashion from different devices and/or locations.” See POR, 14-28.

D. “Page Sharing” is Distinguished from the Claimed Inventions and Lebrun and Prajapat Are Examples of “Page Sharing”

Petitioner’s objections to PO’s discussion of “page sharing” are meritless. Pet. Reply, 1-2.

First, Petitioner contends that PO asserted that “the ’145 specification disparages ‘page sharing’ as too ‘resource intensive.’” Petitioner’s Reply, 1. PO *never* stated that the ’145 Patent mentions “page sharing.” POR, 1-11. Instead, PO

explained that “page sharing” was a technique for sharing webpages that was known in May 2010. POR, 6-8; Ex. 2004, ¶50.

Second, Petitioner contends that “[t]he ’145 Patent does not identify or describe any ‘middleman’ server or disparage the use of a server to relay webpage information to or from a webpage server.” Petitioner Reply, 3. The use of a “middleman” server was a known method, like “desktop or screen sharing,” that “allow[s] users to simply view the same internet content.” Ex. 2004, ¶50. However like “desktop or screen sharing,” page sharing does not “coordinate users’ browsing activity in any meaningful way” while also adding “additional resource usage.” *Id.* Methods that use a “middleman” server are therefore distinguished from the claims of the ’145 Patent, because they transmit webpage data between a “middleman” server and a web browser, *i.e.*, methods using a “middleman server” do not disclose sending “web browsing interaction data” from a “synchronization server” to a “guest device” in a manner that enables each guest device to access “a website server that is independent of the synchronization server.” Therefore, contrary to the invention of the ’145 Patent invention, the “middleman” server utilizes materially “more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods.” Ex. 1001, 2:31-38. The Lebrun and Prajapat references each rely on the use of a “middleman” server. POR, 2-6.

Third, Petitioner contends that “[t]he claims do not recite any architecture that would solve any problems purportedly caused by ‘middleman’ servers.” Pet. Reply, 3. This is incorrect. The specification expressly states that “[t]he present invention allows two or more persons browsing the internet to share their internet browsing experience and have all users simultaneously browse and fully interact with web sites, games, virtual worlds, or other online applications in real time,” **without** “materially impos[ing] more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods” by “utiliz[ing] the passing of certain data such as URL information, form data, scripts (including java script), cookies, or other types of data information between browser clients” via instruction from the synchronization server. Ex. 1001, 5:22-36.

Consistent with this description in the specification, claim 1 of the ’145 Patent describes how, in a “synchronized browsing session,” the “guest device” receives, from the “synchronization server,” “web browsing interaction data” that is associated with (1) “a website server that is independent of the synchronization server;” and (2) “the host device that has initiated the session invitation.” It also requires that an application on the “guest device” be operated “based on said web browsing interaction data” to access the website server. As discussed, the “web browsing interaction data” is “data describing interactions performed on a website

by a host device,” which ***does not*** include responsive webpage data from a webpage server, that are the ***result*** of interacting with the website. POR, 16-23; 28-41.

E. Petitioner Has Not Met its Burden of Proving that Lebrun in Combination with Wang Renders Obvious Any Claim of the '145 Patent (Ground 1)

1. All of the Limitations of the Claims of the '145 Patent Are in Dispute

Petitioner contends that “PO Does Not Dispute that Lebrun and Wang Render Obvious Limitations [1.pre], [1.c.i] or [1.c.ii]” and therefore “[o]nly limitations [1.a], [1.b], [1.c], and [1.d] are in dispute.” Pet. Reply, 9. Petitioner is wrong. A determination of obviousness pursuant to Section 103 requires an examination of the claims “as a whole” and therefore ***all*** claim limitations are always in dispute. *GE v. Raytheon Techs. Corp.*, 983 F.3d 1334, 1352 (Fed. Cir. 2020).

Further, pursuant to 35 U.S.C. § 316(e), Petitioner bears the burden of proving invalidity throughout the entire IPR proceeding, *i.e.*, that the claims of the '145 Patent, ***as a whole***, would have been obvious to a POSITA. *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1342 (Fed. Cir. 2020). Indeed, “[a] patentee technically has no ‘burden’ to do anything to defend the validity of its patent other than hold the patent challenger to its own burden of persuasion.” *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1008 (Fed. Cir. 2018); 37 C.F.R. §§ 42.107(a)

Petitioner further contends that “PO did not challenge any claim limitation under any construction of ‘web browsing interaction data’ other than its proposed construction.” Pet. Reply, 9. PO has no obligation to show validity under Petitioner’s alleged construction and the Board is not required to accept any of Petitioner’s arguments. Therefore, the Board could correctly find that Petitioner has not met its burden of proving obviousness, even under Petitioner’s (incorrect) construction.

2. Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.c]

Petitioner has not met its burden of proving that Lebrun discloses limitation [1.c], *i.e.*, that the “guest device” “receives web browsing interaction data from said synchronization server.”

First, Petitioner contends that Lebrun’s “group-surfing server” is the claimed “synchronization server” (Petition, 23) and contends that operation of the “group-surfing server” that “caus[es] the web site 130 to ***deliver the initial page 153 to the web clients***” is disclosure of limitation [1.c]. Pet. Reply, 10. An operation that causes ***the web site*** to deliver an initial page to the web clients via the group-surfing server cannot be limitation [1.c]. This is because limitation [1.c] requires that the “web browsing interaction data” be sent to the guest device ***from the “synchronization server,”*** *i.e.*, the purported “group-surfing server” of Lebrun, not from the website.

Second, Petitioner now contends that limitation [1.c] is also met because Lebrun's disclosure "includes the webpage 'without any multimedia elements (such as embedded sound, images, or program fragments),' which is later populated directly from the website." Pet. Reply, 10. Petitioner did **not** include this disclosure in its Petition or its expert's declaration, and therefore it is waived. Petition, 28-30; Ex. 1003, ¶¶185-189. Instead, Petitioner relied on this disclosure of Lebrun only for the portion of limitation [1.d] that requires that the website server is "independent of the synchronization server." Petition, 33-34; Ex. 1003, ¶204. Regardless of the omission, these webpages are still not "web browsing interaction data" as they are merely the result of an interaction performed on a website.

Third, Petitioner contends that Lebrun discloses that "each web client receives web browsing interaction information . . . via a 'program fragment' that 'intercept[s] selection of a link 152 at the web client 110 and direct[s] that selection **to the group surfing server** 140 for processing.'" Pet. Reply, 10-11. There is no disclosure in Lebrun that shows that any information was sent **from** the "group-surfing server" (*i.e.*, the "synchronization server") **to** the web client (*i.e.*, the "guest device"). Instead, this disclosure describes receiving information "via 'program fragment'" and describes sending a "selection" **to** the "group-surfing server." Neither can be limitation [1.c].

Petitioner's other arguments fare no better. Petitioner addresses PO's contention that a partial webpage is not "web browsing interaction data," as construed by PO and contends that a partial webpage is not the result of interacting with the website. Pet. Reply, 11. This is incorrect. In Lebrun, the "group-surfing server" obtains the partial webpage which includes webpage content, *i.e.*, the non-multimedia elements, by interacting directly with the website server. Ex. 1005, 35:10-12. The "group-surfing server" then sends this webpage content to the web clients (*i.e.* "guest devices"), as shown in the Modified and Annotated Figure 3 of Lebrun. POR, 49-50 (the red arrows identified with "1").

Petitioner further contends that the "partial" webpage is "data describing interactions performed on a website by a host device." Pet. Reply, 12. This is incorrect. A "partial" webpage, *i.e.*, a webpage without any multimedia elements, is the **result** of an interaction performed on a website by a host device. For example, the click on a link by the host device is "data describing interactions performed on a website by a host device," but the webpage (whether "partial" or full) that is sent by the website server in response to that click (interaction) is the **result** of the interaction (clicking the link). The partial webpage is thus not the interaction itself. POR, 51; Ex. 2004, ¶68.

Petitioner next addresses its contention that "the 'links' intercepted and used by the program fragment residing on the guest device are 'web browsing interaction

data.” Pet. Reply, 12. Petitioner appears to be referring to Lebrun’s disclosure that the “program fragment” intercepts “links” or “‘submit’ selections” at the web client 110, which it then sends to the “group-surfing server” “for processing.” Ex. 1005, 37:5-10. The “processing” then performed by the “group-surfing server” is: (1) the determination of the next page in the progression of pages; (2) the contacting of the web site having that page; (3) the direction to the website to deliver the next page to the group-surfing server; and (4) the re-sending of the webpage to the participating web clients. Ex. 1005, 35:5-12.

Limitation [1.c] requires that the “guest device” receive “web browsing interaction data” from the “synchronization server.” The “links” intercepted at a web client by a program fragment and sent from the web client *to* the “group-surfing server” (*i.e.*, the “synchronization server”) for further processing by the “group-surfing server” is plainly *not* “web browsing interaction data” sent *from* the “synchronization server” to the “guest device.”

Lastly, Petitioner contends that the information to complete an HTML form is “web browsing interaction data.” Pet. Reply, 12-13. Lebrun, however, discloses that the “program fragment” intercepts form data only the when the “submit” button is pressed, and that the “group-surfing server” only presents HTML form information “as each field is completed, or when the entire form is completed, or at other times.” Ex. 1005, 37:8-10; 39:8-10. That is, there is no requirement in Lebrun that the

HTML form data is shared among web clients in “real time” or “in simultaneous fashion,” *e.g.*, as each character is inputted. Although Lebrun may disclose HTML form data, it does not disclose that such data is shared in a “synchronized browsing session.” In addition, the element that Petitioner analogizes to the “guest devices” in Lebrun *never* performs limitation [1.d] with the HTML form information “to access a website server independent of the synchronization server” because in Lebrun only the “group-surfing” server retrieves the webpages using the HTML form data. Ex. 1005, 37:8-10. Petitioner ignores the importance of limitation [1.d] with regards to the invention. It is this step, and the requirement that the guest devices “access a website server independent of the synchronization server” that ultimately achieves a synchronized browsing system that “does not materially impose more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods.” Ex. 1001, 5:33-36. Thus, there is no need for a centralized “middleman” server, such as is described in the cited references, which relays web content to the guest devices in a resource intensive fashion.

3. Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.d]

Petitioner has not met its burden of proving that Lebrun discloses limitation [1.d], *i.e.*, “operating an application *based on said web browsing interaction data* received from said synchronization server to access a website server.”

Petitioner contends that, in this embodiment of Lebrun, the “partial webpage,” *i.e.*, the webpage without any multimedia elements, is the “web browsing interaction data.” Pet. Reply, at 13. As discussed, the “partial webpage” only contains webpage content and therefore it is **not** “web browsing interaction data” pursuant to PO’s understanding of the ordinary meaning. Further, **webpage data** contained in a “partial webpage” is not “data describing interactions performed on a website by a host device.” Ex. 2004, ¶69. In other words, **webpage data** does not “inform the guest device what information **to request or access** directly from the webpage server.” Ex. 2004, ¶¶69-71. Instead and in line with the way HTML and webpages have always worked, the partial webpage merely contains links to the multimedia elements which inform the guest device as to what to request from the webpage server. *Id.*

Even if one assumes arguendo that the “partial webpage” is “web browsing interaction data,” Petitioner cannot show that Lebrun discloses that the application is operated **based on** the partial webpage, as required by limitation [1.d]. Lebrun states that “[e]ach participating web client 110 requests those multimedia elements directly from the web site 130.” Ex. 1005, 46:1-2. There is no disclosure in Lebrun that the web client operates an application based on the “partial webpage,” *i.e.*, the webpage content (non-multimedia elements) **and** the multimedia elements. A POSITA would have understood that the links in the partial webpage are used to

retrieve the multimedia elements from the webpage server *rather than* the non-multimedia webpage data. Ex. 2004, ¶¶69-70.

4. Petitioner Has Not Met its Burden of Proving that a POSITA Would Have Been Motivated to Combine Lebrun with Wang

Petitioner has not met its burden of showing that a POSITA would have been motivated at the time of the '145 Patent (*i.e.*, without hindsight) to combine Lebrun with Wang to arrive at the inventions claimed in the '145 Patent. *Endo Pharms., Inc. v. Actavis LLC*, 922 F.3d 1365, 1373 (Fed. Cir. 2019).

Petitioner *ignores* PO's contention that Petitioner failed to "discuss what obviousness-related modifications to Lebrun . . . should be made with the disclosure of Wang" (POR, 76). Instead, Petitioner only criticizes PO's expert for using the term "teaches away" as part of his multi-paragraph testimony. Pet. Reply, 20-21. In so doing, Petitioner misstates the meaning of teaching away: "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Chaganti*, 554 F. App'x 917, 921 (Fed. Cir. 2014). Indeed, the obviousness analysis must account for "reasons not to combine," which are facts relevant to the overall consideration of obviousness. *Teva Pharms. Int'l GmbH v. Eli Lilly & Co.*, 8 F.4th 1349, 1358 (Fed. Cir. 2021).

Further, Petitioner’s statement—“to the extent Lebrun and Wang teach different methods of storing data, that does not show ‘teaching away’ nor any reason a POSITA would not be motivated to combine their disclosures” (Pet. Reply, 21; Ex. 1034, ¶23)—is only based on the testimony of Petitioner’s expert and is thus insufficient to meet Petitioner’s burden of showing a motivation to combine Lebrun and Wang. *See TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1357-1361 (Fed. Cir. 2019) (rejecting obviousness determinations based on conclusory and unsupported expert testimony).

F. Petitioner Has Not Met its Burden of Proving that Prajapat in Combination with Wang Renders Obvious Any Claim of the ’145 Patent (Ground 2)

As it did with respect to Ground 1, Petitioner contends that only limitations [1.c] and [1.d] are in dispute. Again, a determination of obviousness pursuant to Section 103 requires an examination of the claims “as a whole” and therefore *all* claim limitations are always in dispute. *GE*, 983 F.3d at 1352.

Petitioner further contends that “PO did not challenge any claim limitation under a construction of ‘web browsing interaction data’ other than its proposed construction,” and therefore “any arguments about the other limitations should be deemed waived” and “if the Board rejects PO’s construction, PO will have presented no other challenges to Petitioner’s analysis of Ground [2].” Pet. Reply, 15. This is incorrect. PO addressed numerous other deficiencies of Prajapat with respect to

limitation [1.d]. For example, PO set forth that (1) in Prajapat, browsers 12a and 12b do not communicate with a website server, but rather communicate with web media servers 14a or 14b (POR, 66-67); and (2) in Prajapat's "peer-to-peer simple web sharing embodiment," there is no teaching or suggestion that browser 12a and browser 12b simultaneously, or nearly simultaneously, and in real time share internet browsing on the same webpage. POR, 70.

1. Petitioner Has Not Met its Burden of Proving that Any of Prajapat's Three Embodiments May be Combined With Each Other

Petitioner acknowledges that Prajapat discloses multiple distinct embodiments but contends that "similar processes can be used among the various embodiments" and therefore a POSITA would have combined disclosures from the various embodiments. Pet. Reply, 19. This is incorrect.

Prajapat discloses a first, "peer-to-peer dynamic web page sharing" embodiment at Ex. 1007, [0012]-[0040]. However, Prajapat does not state anywhere that the description of that embodiment applies to any other embodiment.

Prajapat discloses a second, "peer-to-peer simple web page sharing" embodiment at Ex. 1007, [0041]-[0043]. In this description, Prajapat states that the web media server 14a locates the web media server associated with browser 12b to operate in a substantially similar manner to the first embodiment. Ex. 1007, [0041].

Prajapat does ***not*** state that any other feature of this second embodiment operates in a similar fashion to a feature in the first embodiment.

Prajapat discloses a third, “peer-to-peer web sharing using at least two phones” embodiment at Ex. 1007, [0044]-[0048]. With regard to this embodiment, Prajapat states that UA and media controller 54a can locate UA and media controller 54b to operate in a substantially similar manner to that in the first and second embodiments. Ex. 1007, [0045].

The implication of these single, limited, and explicit disclosures is that all ***other*** aspects of these second and third embodiments operate differently from the first embodiment.

2. Prajapat’s “Peer-to-Peer Simple Web Page Sharing” Embodiment Does Not Disclose a “Synchronized Browsing Session”

As discussed at Section II.C., *supra*, the claims require the existence of “synchronized browsing sessions,” *i.e.*, shared internet browsing that occurs “in real time” and in a “simultaneous fashion from different devices and/or locations.” Petitioner contends that in Prajapat’s “peer-to-peer dynamic web page sharing” embodiment, Prajapat discloses that browser 12a and 12b display the same web pages at substantially the same time, citing Ex. 1007, [0012] and Ex. 1003, ¶286. Pet. Reply, 16.

Petitioner's reliance on Prajapat's "dynamic web page sharing" embodiment of Paragraph [0012] is misplaced and irrelevant since in Section II.F.1., *supra*, Prajapat's "dynamic web page sharing" embodiment is **not** descriptive of Prajapat's other "peer-to-peer simple web page sharing" embodiment of Paragraphs [0041-0043]. As PO discussed in its POR at 64-65, as it relates to the "simple web page sharing embodiment," Prajapat teaches the direct transmission through the "peer-to-peer" web media servers of a URL (or other suitable information regarding the requested webpage) from one browser to another browser, in an "any time" sequence, without any suggestion that the transmission is "simultaneous," in "real-time," or temporally coordinated whatsoever.

3. Petitioner Has Not Met its Burden of Proving that Prajapat Alone or in Combination with Wang Renders Obvious Limitations [1.c] and [1.d]

By relying solely on Prajapat's "dynamic web page sharing" embodiment, Petitioner contends that Prajapat discloses limitations [1.c] and [1.d]. Pet. Reply, 17. Petitioner admits that in this embodiment, Prajapat discloses that the web browsers communicate with the web media servers and that the web media servers communicate with the web content servers. *Id.*

Limitation [1.d] requires the step of a "guest device" "operating an application based on said web browsing interaction data received from said synchronization server **to access a website server.**" Ex. 1001, 23:11-13. Plainly, Prajapat's disclosure

of the web browsers communicating with the *web media servers* is *not* the disclosure of a guest device accessing a *website* server.

Petitioner argues that PO is re-writing the claim by adding the term “directly” before the term “accessing.” Pet. Reply, 17-18; Ex. 1034, ¶19. Petitioner misunderstands the claim—the claim requires “accessing a website server.” Accessing a web media server is *not* accessing “a website server,” even if accessing the web media server provides access to content that it previously obtained from a website server.

Petitioner further argues that “Prajapat in view of Wang renders [limitation [1.d]] obvious,” contending that “[a] POSITA would have been motivated to combine Wang’s teachings with Prajapat.” Pet. Reply, 18; Ex. 1003, ¶300. Petitioner relies only on its expert’s unsupported conclusion that a POSITA would have been motivated to incorporate Wang’s “page navigation control” software into Prajapat’s “browser” to “allow Prajapat to perform the functions described in Prajapat’s disclosure.” Ex. 1003, ¶300. This conclusion proffered by Petitioner’s expert does not prove that the combination of Prajapat with Wang results in limitation [1.d] or that a POSITA would have been motivated to so modify Prajapat, because Wang, like Prajapat, does not disclose a browser that accesses a website server. Instead, the devices in Wang access a “server apparatus 14,” which, like the “web media server” of Prajapat, is *not* a website server. See Ex. 1006, ¶ [0039] (describing how the

“server apparatus” “retrieves the applicable web pages” after receiving HTTP requests from the client devices). Accordingly, neither Wang nor Prajapat disclose the accessing of a website server and therefore neither disclose [1.d].

Petitioner next argues that Prajapat discloses [1.b] via the URL described in Paragraph [0043] and discloses [1.d] via “new action requests” as described in Paragraph [0028]. Pet. Reply, 18-19. Here, Petitioner is improperly combining a disclosure from Prajapat’s “simple web page sharing” embodiment in Paragraph [0043] with a disclosure from Prajapat’s “dynamic web page sharing” embodiment at Paragraph [0028]. As discussed in Section II.F.1., *supra*, Petitioner offers no evidence that a POSITA would have been motivated to make such a combination.

4. Petitioner Has Not Met Its Burden of Proving that a POSITA Would Have Been Motivated to Combine Prajapat with Wang

For the reasons discussed in Section II.E.4., *supra*, Petitioner has not met its burden of proving that a POSITA would have been motivated to combine Prajapat with Wang. Pet. Reply, 20-21.

III. CONCLUSION

Claims 1-18 are patentable over Lebrun in view of Wang (Ground 1) and over Prajapat in view of Wang (Ground 2).

Date: January 31, 2024

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S SUR-REPLY** specified in 37 C.F.R. § 42.24 have 5597 words, in compliance with the 5,600 word limit set forth in 37 C.F.R. § 42.24(c). This word count was prepared using Microsoft Word.

Date: January 31, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S SUR-REPLY** is being served on counsel for petitioner via electronic mail on, in its entirety on the following counsel of record for Petitioner on this 31st day of January 2024:

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