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 OPPOSITION TO PETITIONER'S MOTION TO STRIKE EXHIBITS 2006 AND 2007

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I. INTRODUCTION

The Board should deny Petitioner's Motion to Strike Exhibits 2006 and 2007 ("Motion") in its entirety, because Petitioner has failed to satisfy its "burden of proof to establish that it is entitled to the requested relief." 37 C.F.R. § 42.20(c).

Exhibits 2006 and 2007 are Petitioner's briefs from its Motion to Dismiss in the co-pending District Court litigation. In both briefs, Petitioner characterized the scope of the challenged claims as requiring "simultaneous interactions." Ex. 2006, 2:16-21; 3:26-4:3; 6:12-14; 7:11-12; Ex. 2007, 1:20-25; 3:16-17; 4:2-6; 5:2-4. This contrasts with Petitioner's current contention in this IPR that the challenged claims do not require simultaneous interactions. Petitioner Reply ("Reply"), 15-16.

Petitioner has not met its burden of proving that Exs. 2006 and 2007, being its own briefs, are "new exhibits" to Petitioner, and good cause exists for their entry.

II. RELEVANT BACKGROUND FACTS

The parties dispute the scope of the challenged claims. Petitioner contends "[t]here is no [claim] limitation that requires [] 'simultaneous' or 'real time sharing' of 'the same webpage in real time.'" Reply, 15-16; *see also* Ex. 1034, ¶7-12.

Patent Owner ("PO") contends that the claims are directed to a "synchronized browsing session" in which browsing occurs "in real time" and in a "simultaneous fashion from different devices and/locations." POR, 14-28; PO's Sur-Reply, 8-9.

In its Sur-Reply, PO demonstrated the inconsistencies between Petitioner's

current IPR contentions and its District Court contentions, pointing to, among other things, Petitioner's Motion to Dismiss briefs (Exs. 2006 and 2007) and the District Court's findings in its Order denying the Motion to Dismiss (Ex. 2005). *See* PO's Sur-Reply, 7-8. Petitioner does not move to strike PO's Sur-Reply or Ex. 2005 (submitted with PO's POR); Petitioner moves to strike only Exs. 2006 and 2007.

PO did not submit Exs. 2006 and 2007 earlier with its POR because Petitioner did not argue in its Petition that the claims do not require "simultaneous interactions," and PO did not anticipate that Petitioner would proffer a position in its Reply that was inconsistent with one it had previously taken in District Court. Petitioner first raised its inconsistent argument in its Reply, forcing PO to submit Exs. 2006 and 2007 at its first opportunity with its Sur-Reply.

III. THE BOARD SHOULD DENY PETITIONER'S MOTION

A. Petitioner Has Not Met its Burden of Demonstrating that Exs. 2006 and 2007 Are "New Evidence"

Petitioner has not met its burden of establishing that Exs. 2006 and 2006 are "new evidence" to Petitioner. 37 C.F.R. § 42.20(c).

The present case is similar to *Popsockets LLC v. Flygrip, Inc.*, IPR2022-00937, Paper 29 at 8-9 (PTAB Oct. 30, 2023). In *Popsockets*, the petitioner moved to strike certain exhibits from the sur-reply related to priority documents of the challenged patent. The Board denied the motion, finding that "Petitioner does not

explain adequately why these exhibits constitute 'new evidence' to Petitioner, when they are, or should have been, the bases of its analysis regarding the asserted priority date of the challenged claims." *Popsockets*, Paper 29 at 9; *see also Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 34 at 3-4 (PTAB Jun. 3, 2021) (denying Petitioner's request to file a motion to strike where Petitioner raised arguments for the first time in the reply: "[PO] did not have an earlier opportunity, nor a reason, to present arguments and supporting evidence to show entitlement [] to the earlier [] filing date.")

Here, Petitioner moves to strike its own Motion to Dismiss briefs (Exs. 2006 and 2007) in which Petitioner characterized the scope of the '145 patent's claims as including "simultaneous interactions." Ex. 2006, 2:16-21; 3:26-4:3; 6:12-14; 7:11-12; Ex. 2007, 1:20-25; 3:16-17; 4:2-6; 5:2-4. Petitioner now contends, however, that the challenged claims do not require "simultaneous interactions." Pet. Reply, 15-16. Plainly, Petitioner considered, or should have considered, its own District Court briefs characterizing the scope of the claims when preparing its contentions in this IPR proceeding, and therefore Petitioner's briefs are not "new evidence" to Petitioner, as the Board found in *Popsocket.*

Like the petitioner in *Popsocket*, Petitioner here has not explained why its own district court briefs constitute "new evidence" to it. Instead, Petitioner argues that the exhibits "are not deposition transcripts or exhibits raised during deposition."

Motion, 3. Simply stating that the exhibits are not from a deposition cannot meet Petitioner's burden to show they are "new evidence" to Petitioner.

Further, Petitioner's prior contention that the claims require "simultaneous interactions" is not even "new" to the record. PO submitted the District Court's Order as Ex. 2005 to its POR. In its Order, the District Court described Petitioner's contention that the claims require "simultaneous interactions":

> In its motion to dismiss, ***Intuit*** contends that the asserted claims are directed to the abstract idea of 'organizing human activity,' specifically 'sending and receiving information for ***simultaneous interactions***.' ECF No. 16-1 **[what is now Ex. 2006]** at 6-7; *see* ECF No. 22 **[what is now Ex. 2007]** at 3.

Ex. 2005, 9:24-26 (emphasis and bracketed language added).

The facts of this case are thus distinguished from those in *Satco Products, Inc. v. Seoul Semiconductor Co., Ltd.*, IPR2020-00836, Paper 45 at 75-77 (PTAB October 22, 2021), relied on by Petitioner. In *Satco*, unlike this case, the exhibits at issue were not the Petitioner's own pleadings and the record did not already include the information contained in the exhibits at issue.

B. Striking Exs. 2006 and 2007 Would Ignore the Inconsistencies in Petitioners Arguments to the PTAB and the District Court

When considering Petitioner's Motion to Strike, the Board should be mindful of the parties' duty to disclose inconsistent arguments made in other proceedings. 37 C.F.R. § 42.11(a).

Here, Petitioner's prior, inconsistent arguments regarding claim scope are plainly relevant to the issue of obviousness to be decided by the Board. Thus, PO believes it is obligated by § 42.11 to submit Petitioner's briefs containing such inconsistent arguments. Specifically, Petitioner has taken positions in this proceeding regarding claim scope that are inconsistent with those it made in District Court, while simultaneously moving to strike the evidence of its own inconsistent contentions set forth in its District Court briefs.

C. Should the Board Consider Granting Petitioner's Motion, PO Requests that the Board take Official Notice of Petitioner's Inconsistent Statements

In the alternative to granting the Motion, the Board should, at a minimum, take official notice of Petitioner's inconsistent statements made in its District Court filings. 37 C.F.R. § 42.62(a) and (c); Fed. R. Evid. 201; *see also, e.g.*, *Assa Abloy AB et al v. CPC Patent Technologies Pty Ltd*, IPR2022-01045, Paper 42 at 13-14, FN20 (PTAB Dec. 23, 2023). Petitioner's statements in its district court filings are plainly facts that "can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned." Fed. R. Evid. 201(d).

IV. CONCLUSION

The Board should deny Petitioner's Motion to Strike in its entirety.

Date: February 22, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE EXHIBITS 2006 AND 2007** is being served on counsel for petitioner via electronic mail on, in its entirety on the following counsel of record for Petitioner on this 2nd day of February 2024:

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