Filed on behalf of Intuit Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner

v.

SAMESURF, INC.,
Patent Owner.

Inter Partes Review No. IPR2023-00339
Patent 9,185,145 B2

PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE EXHIBITS 2005–2007

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c), Petitioner Intuit Inc. ("Petitioner") respectfully submits this Reply in accordance with Due Date 7 of the Scheduling Order (Paper 13), and hereby continues to request exclusion of Exhibits 2005-2007.

I. EXHIBITS 2005-2007 SHOULD BE EXCLUDED AS IRRELEVANT AND/OR UNFAIRLY PREJUDICIAL OR CONFUSING

Petitioner's Motion to Exclude requested that the Board exclude of Exhibits 2005-2007 as irrelevant and/or unfairly prejudicial or confusing. Motion (Paper 33), 3-4. Patent Owner's Opposition to the Motion ("Opposition") only serves to amplify these issues.

First, Patent Owner ("PO") misleadingly attempts to characterize these exhibits, which each relate to a Motion to Dismiss Pursuant to 35 U.S.C. § 101 ("101 MTD") that was filed in the corresponding district court case, as including "contentions…regarding claim scope." Opp., 2-5. This characterization is incorrect. Petitioner's statements as to the "abstract idea" that the claims are "directed to" for determining patentable subject matter are not contentions regarding claim scope or claim construction. Thus they are irrelevant. PO appears to be using its Opposition to attempt to supplement its substantive argument about to the scope of the claims. This is improper.

Second, PO wrongly argues that Petitioner's "contentions" in the 101 MTD are "inconsistent" with Petitioner's positions about the claims in this IPR. They are

not. These misstatements by PO only add to why allowing these is exhibits would only exacerbate the confusion surrounding them. The 101 MTD argued the abstract idea as "sending and receiving information ***for*** simultaneous interactions" – which explains that the claims cover communications ***for the purpose of*** simultaneous interactions. PO conflates this statement of purpose with Petitioner's arguments in this IPR about what the claim language actually recites. Petitioner's argument that the claims do not recite the terms "synchronized" or "simultaneously" is ***not*** inconsistent with the abstract idea/statement of purpose. That these statements are ***not*** inconsistent undercuts PO's assertion that they must be disclosed. Opp., 5. Regardless, PO cannot read the term "simultaneous interactions" into the claims when they do not recite it, so the exhibit is irrelevant to construction of the claims.

For the reasons above, Exhibits 2005-2007 do not have "any tendency to make a fact more or less probable than it would be without the evidence" and are of no "consequence in determining the action." FRE 401.

II. EXHIBITS 2006AND 2007 ARE NEW EVIDENCE AND SHOULD BE EXCLUDED

PO wrongly argues that Petitioner has not "met its burden" to show Exhibits 2006 and 2007 are "new" evidence. PO attempts to misrepresent the record by referring to these exhibits as Petitioner's "own briefs" or "own pleadings," but the fact remains that these exhibits were ***not of record in this case*** prior to being filed with the Sur-reply, which is improper. *Satco Products, Inc. v. Seoul Semiconductor*

Co., Ltd., IPR2020- 00836, Paper 45 at 76 (P.T.A.B. Oct. 22, 2021) (exhibits considered new evidence because they were not of record prior to Patent Owner filing them with its Sur-reply); 37 C.F.R. § 42.23(b). That they are of record in the corresponding district court case is not relevant to this analysis. PO also does not explain why it delayed in filing Exhibits 2006-2008; for example, why it did not file them when it filed Exhibit 2005, which pertains to the same 101 MTD.

Popsockets LLC v. Flygrip, Inc., cited by PO, is inapposite. In that case, the Motion to Strike (not exclude) exhibits was denied because the exhibits filed with PO's Sur-reply were the basis for Petitioner's priority date arguments and were actually or substantively previously of record. *Popsockets LLC v. Flygrip, Inc*., IPR2022-00937, Paper 29 at 8-9 (P.T.A.B. Oct. 30, 2023). The facts in this case are different, as the exhibits at issue were not previously or record or discussed, and thus are new evidence.

New arguments or evidence introduced in Sur-reply are inadmissible under 37 C.F.R. § 42.23(b) and thus subject to exclusion. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1366, 1369-70 (Fed. Cir. 2016). Nor may PO use judicial notice under FRE 201 as a backdoor to making this improper new evidence of record.

III. CONCLUSION

For the reasons presented above, Exhibits 2005-2007 fail to comply with the Federal Rules of Evidence and 37 C.F.R. § 42.23(b) and should be excluded.

Dated: March 20, 2024

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on March 6, 2024, I caused a true and correct copy of the foregoing PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO MOTION TO EXCLUDE EXHIBITS 2005-2007 to be electronically served on Petitioner's lead and backup counsel at the following addresses:

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