

FENWICK

Intuit Inc. v. Samesurf, Inc.

IPR2023-00339 (Patent 9,185,145)

IPR2023-00341 (Patent 9,483,448)

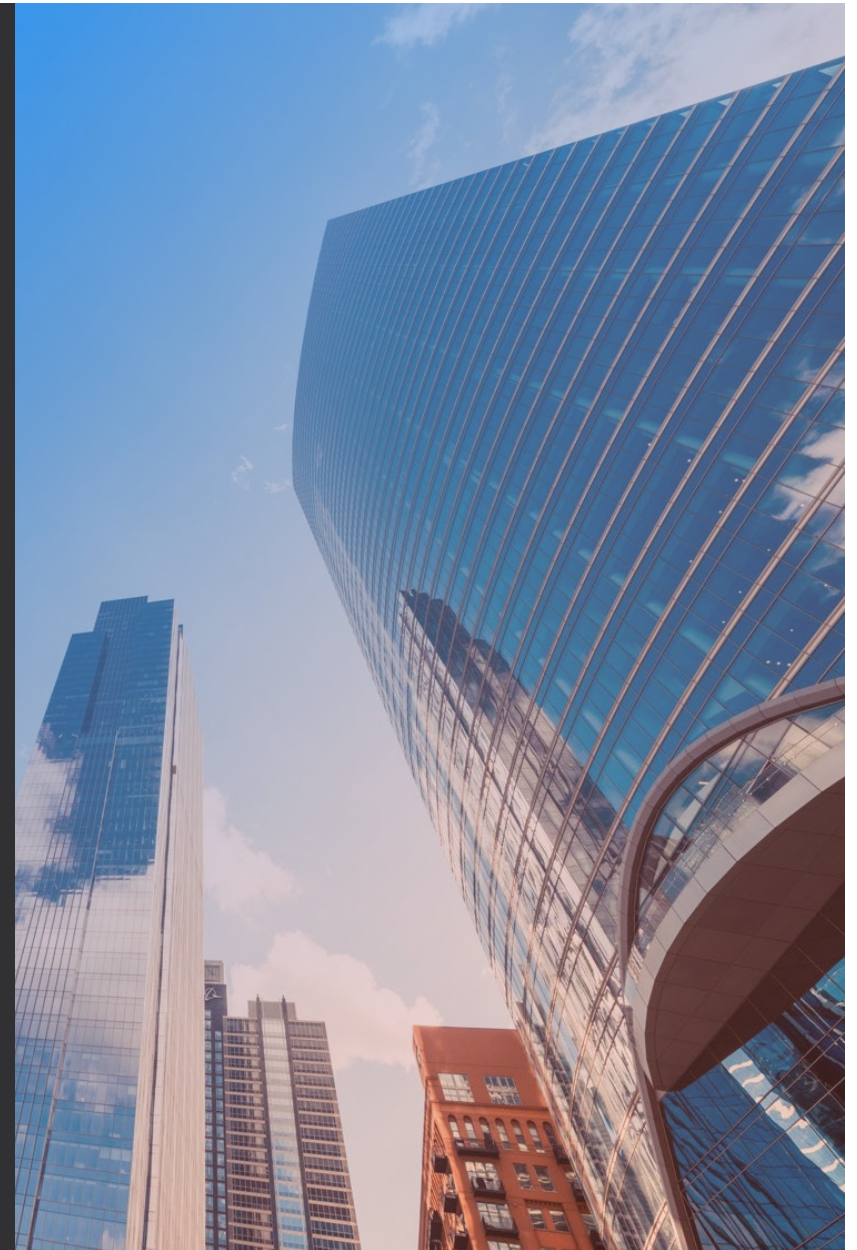
IPR2023-00342 (Patent 8,527,591)

March 27, 2024

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DEMONSTRATIVE EXHIBIT - NOT EVIDENCE

USP 8,527,591, 9,185,145, & 9,483,448 Claims are Invalid

Overview

- Specification and claims of '591, '145, '448 patents
- Limitations in dispute
- Overview of Lebrun, Prajapat, Wang

Grounds

- Lebrun and Wang renders the claims obvious; Prajapat and Wang renders the claims obvious
- Dependent claims

Motion to Amend:

- '591 proposed amended claims lack written description support
- Lebrun and Wang renders the amended claims obvious; Prajapat and Wang renders the amended claims obvious; Birnbaum, with Lebrun, Prajapat, and/or Wang

Motions to Strike

Motions to Exclude

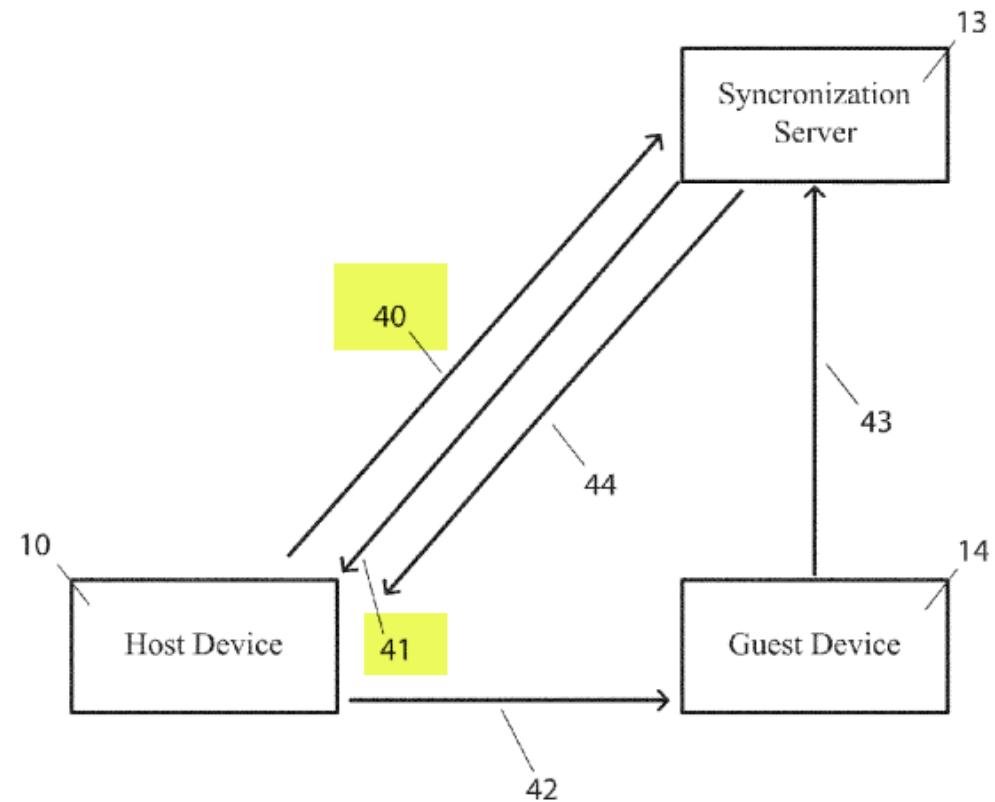
USP 8,527,591, 9,185,145, & 9,483,448 Claims are Invalid under §103

- **Petitioner showed reasonable likelihood of obviousness of claims at institution**
 - Ground 1: Lebrun and Wang
 - Ground 2: Prajapat and Wang
- **PO has done nothing in its papers to upset the Board's initial findings that:**
 - the issued claims of all three patents are obvious over the prior art
 - Not all limitations disputed by Patent Owner
 - the proposed substitute claims of the '591 patent lack written description support
 - the proposed substitute claims of the '591 patent are obvious over the prior art

'591 DI (Paper 12), 26, 28, 40; '145 DI (Paper 12), 30, 32, 42; '448 DI (Paper 13), 23, 27, 33; '591 PG (Paper 32), 7, 11-16

USP 8,527,591, 9,185,145, & 9,483,448 Specification

FIG. 2 shows the architecture of a synchronized browsing session at a high level



USP 8,527,591, 9,185,145, & 9,483,448 Claims

- Each recites a “synchronized browsing session”
- Guest versus host device perspectives

(12) United States Patent
Pinazar

(10) Patent No.: US 9,483,448 B2
(45) Date of Patent: Nov. 1, 2016

(54) METHOD AND APPARATUS FOR THE IMPLEMENTATION OF A REAL-TIME, SHARABLE BROWSING EXPERIENCE ON A HOST DEVICE

(58) Field of Classification Search
See application file for complete search history.

(71) Applicant: Samsung

(72) Inventor: Kamble, CA (US)

(73) Assignee: SAMSUNG

(*) Notice: Subject is prior art under U.S.C. 102(b). This patent claims the benefit of U.S. Pat. No. 8,527,591.

(21) Appl. No. 14/830,727

(22) Filed: Aug. 19, 2015

(65) Prior Publication Data
US 2015/035308 A1
May 20, 2015

(60) Continuation of application May 20, 2015

(51) Int. Cl. G06F 15/172
G06F 15/22
H04L 29/08
H04L 29/06
H04L 29/08

(52) U.S. Cl. CPC: G06F 15/172 (2013.01); H04L 29/08 (2013.01); H04L 29/06 (2013.01)

(12) United States Patent
Pinazar

(10) Patent No.: US 9,185,145 B2
(45) Date of Patent: Nov. 18, 2015

(54) METHOD AND APPARATUS FOR THE IMPLEMENTATION OF A REAL-TIME, SHARABLE BROWSING EXPERIENCE ON A GUEST DEVICE

(58) Field of Classification Search
CPC: H04L 29/08 (2013.01); H04L 29/06 (2013.01); H04L 29/08 (2013.01); H04L 29/06 (2013.01)

(71) Applicant: A

(72) Inventor: Kamble, CA (US)

(73) Assignee: Samsung

(*) Notice: Subject is prior art under U.S.C. 102(b). This patent claims the benefit of U.S. Pat. No. 8,527,591.

(21) Appl. No. 14/830,727

(22) Filed: Aug. 19, 2015

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US 2015/035308 A1
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(52) U.S. Cl. CPC: G06F 15/172 (2013.01); H04L 29/08 (2013.01); H04L 29/06 (2013.01); H04L 29/08 (2013.01); H04L 29/06 (2013.01)

(12) United States Patent
Pinazar

(10) Patent No.: US 8,527,591 B2
(45) Date of Patent: Sep. 3, 2013

(54) METHOD AND APPARATUS FOR THE IMPLEMENTATION OF A REAL-TIME, SHARABLE BROWSING EXPERIENCE ON A GUEST DEVICE

(58) Field of Classification Search
CPC: H04L 29/08 (2013.01); H04L 29/06 (2013.01); H04L 29/08 (2013.01); H04L 29/06 (2013.01)

(71) Applicant: A

(72) Inventor: Kamble, CA (US)

(73) Assignee: Samsung

(*) Notice: Subject is prior art under U.S.C. 102(b). This patent claims the benefit of U.S. Pat. No. 8,527,591.

(21) Appl. No. 12/783,743

(22) Filed: May 20, 2010

(65) Prior Publication Data
US 2011/0201157 A1
Nov. 24, 2011

(51) Int. Cl. G06F 15/172
G06F 15/22
H04L 29/08
H04L 29/06
H04L 29/08

(52) U.S. Cl. CPC: G06F 15/172 (2013.01); H04L 29/08 (2013.01); H04L 29/06 (2013.01); H04L 29/08 (2013.01); H04L 29/06 (2013.01)

(56) References Cited
U.S. PATENT DOCUMENTS
6,035,312 A 2/2000 Inagaki et al.
6,411,489 B1 8/2001 Roberts et al.
6,414,471 B1 8/2001 Roberts et al.
6,426,276 B1 8/2001 Roberts et al.
7,287,054 B2 10/2007 Lee et al.

10 Claims, 20 Drawing Sheets

'591 1. A method for a guest device performing a synchronized browsing session administered by a synchronization server, comprising:

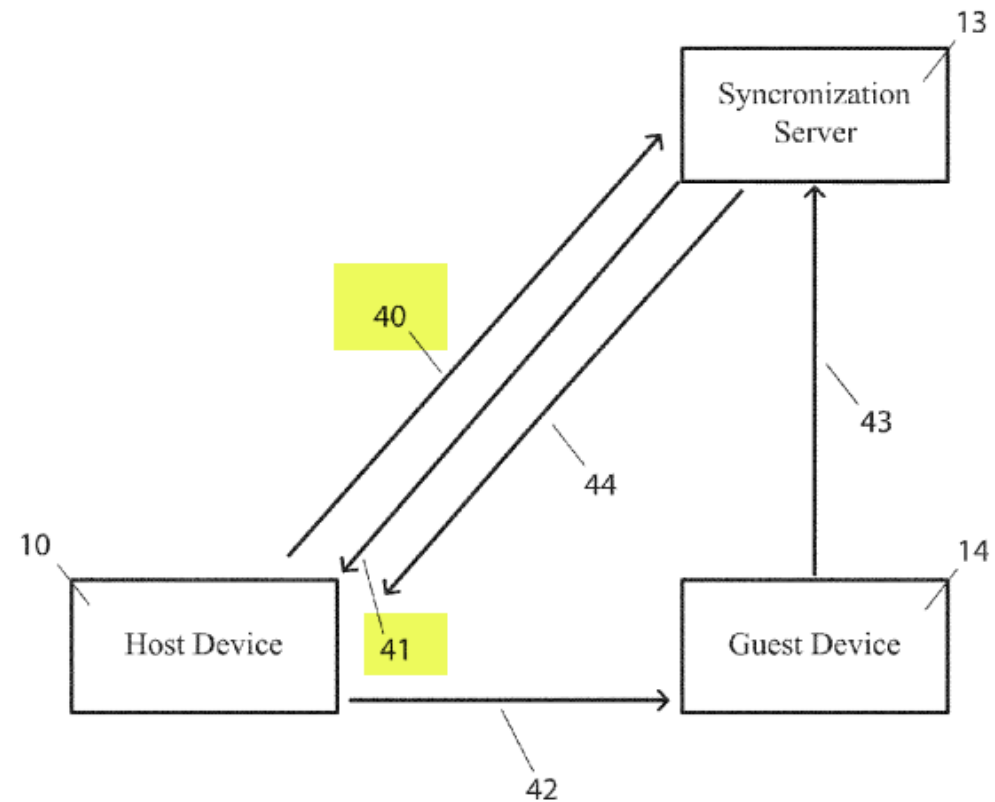
'145 1. A method performed by a guest device for joining a synchronized browsing session administered by a synchronization server, comprising:

'448 1. A method performed by a host device for establishing a synchronized browsing session between the host device and an invitee device, comprising:

591, Claim 1; '145, Claim 1; '448, Claim 1

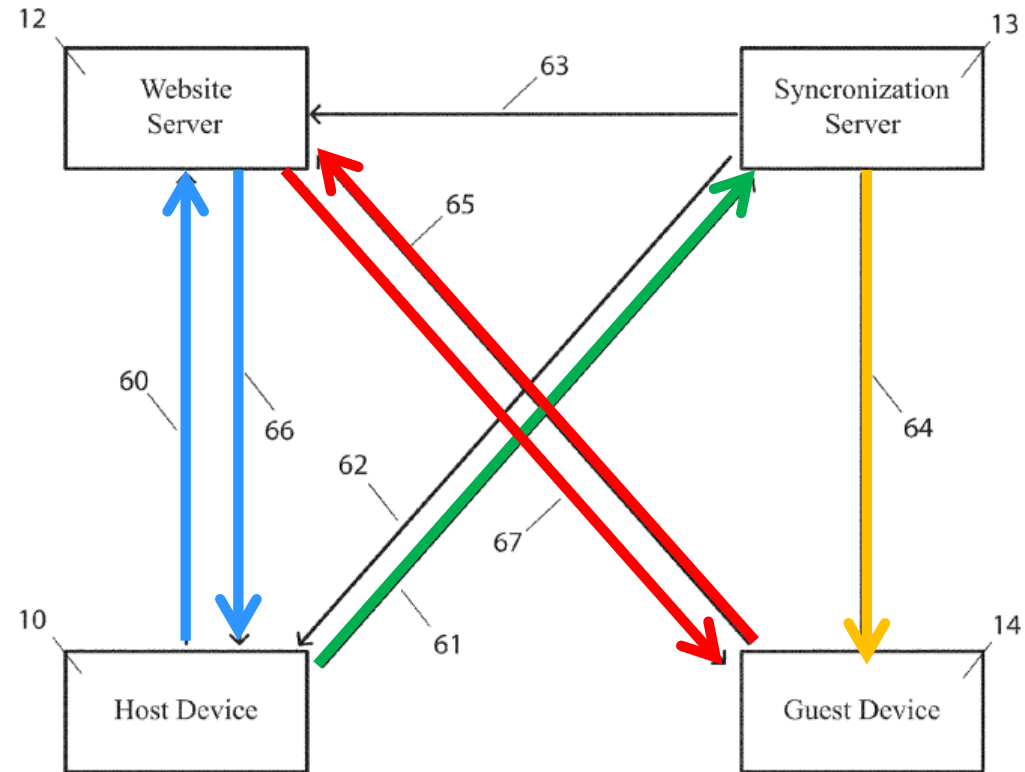
USP 8,527,591, 9,185,145, & 9,483,448 Specification

FIG. 2 shows the architecture of a synchronized browsing session at a high level



USP 8,527,591, 9,185,145, & 9,483,448 Specification

FIG. 5a shows the information exchanged between the entities



PO Argues the Specification, Which Should Not Be Read into the Claims

Claims recite “synchronized browsing session” in only a few limitations

- Only those establishing the synchronized browsing session
- “Synchronized browsing session” does not require synchronized data transmission

Claims do NOT recite:

- Synchronized transmission or synchronously share/ing
- Simultaneously or nearly simultaneously
- Temporally coordinated
- Real-time (except ‘591)

‘591 Reply, 1-9

The Board Preliminarily Found the Grounds Rendered the Claims Obvious

Claims

'591 Claim 1

1. A method for a **guest device** performing a synchronized browsing session administered by a synchronization server, comprising:
 - [1a] detecting an activation of a hyperlink associated with the synchronized browsing session by a guest device;
 - [1b] sending a request by the guest device to join the synchronized browsing session to the synchronization server in response to the activation of the hyperlink;
 - [1c] receiving from the synchronization server a notification that guest device has joined the synchronized browsing session;
 - [1d] receiving data from the synchronization server, where the data relates to a website being accessed in real-time by a host device; and wherein the data comprises a URL of the website and cookie information associated with the website and the host device; and**
 - [1e] operating a browser by the guest device based on the data received from the synchronization server.**

'591 Ex. 1001, Claim 1

'145 Claim 1

1. A method performed by a **guest device** for joining a synchronized browsing session administered by a synchronization server, comprising:

[1a] receiving from the synchronization server a session invitation including a session identifier associated with a host device;

[1b] activating the session invitation to send a request to join said synchronized browsing session to said synchronization server;

[1c] **receiving web browsing interaction data from said synchronization server, wherein said web browsing interaction data is associated with:**
a website server that is independent of the synchronization server, and
the host device that has initiated the session invitation; and

[1d] **operating an application based on said web browsing interaction data received from said synchronization server to access a website server independent of the synchronization server**
subsequent to the activation of the session invitation.

'145 Ex. 1001, Claim 1

'448 Claim 1

1. A method performed by a **host device** for establishing a synchronized browsing session between the host device and an invitee device, comprising:

[1a] sending a request to establish the synchronized browsing session to a synchronization server;

[1b] receiving a confirmation message from the synchronization server including a session identifier generated by the synchronization server, wherein the session identifier is associated with the host device and the established synchronized browsing session;

[1c] sending an invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier;

[1d] recording a shared web browsing interaction responsive to determining that a web browsing interaction of the host device within a web browsing window is a sharable web browsing interaction;

[1e] sending a request for webpage content to a website server independent of the synchronization server;

[1f] subsequent to sending the request for webpage content to the website server, transmitting information related to the shared web browsing interaction to the synchronization server,

[1fi] wherein the information related to the shared web browsing interaction is to be processed by a browser of the invitee device and enables the invitee device to generate a request to retrieve a substantially the same webpage content as the request for the webpage content from the host device;

[1fii] wherein the synchronization server transmits the information related to the shared web browsing interaction to the invitee device in response to receiving the information related to the shared web browsing interaction from the host device, and

[1fiii] wherein the invitee device retrieves data from the website server in response to receiving the information related to the shared web browsing interaction from the synchronization server, the data associated with the webpage content requested by the host device and the information related to the shared web browsing interaction; and

[1g] receiving, responsive to sending the request for webpage content to the website server and after transmitting the information related to the shared web browsing interaction to the synchronization server, the requested webpage content from the website server.

Not All Limitations Disputed

- The Petition established that all of the limitations are rendered obvious by the prior art in each ground; the Board preliminarily agreed in the Institution Decision
 - Arguments about limitations undisputed by PO are **waived**:
 - ‘591: [1.pre], [1.a], [1.b], [1.c]
 - ‘145: [1.pre], [1.a], [1.b]
 - ‘448: [1.pre], [1.a], [1.b]
- Patent Owner is cautioned that any arguments not raised in the response may be deemed waived.
- PO’s Sur-reply: “all of the limitations...are in dispute”
 - Sur-reply does not argue all limitations

‘591 DI (Paper 12), 16-29, 36-41; ‘145 DI (Paper 12), 18-32, 39-44; ‘448 DI (Paper 13), 17-39, 47-56; ‘591 Scheduling Order (Paper 13), 10; ‘591 Sur-reply (Paper 33), 12

PO Argues the Specification, Which Should Not Be Read into the Claims

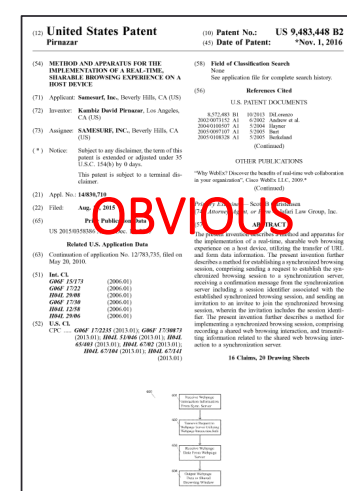
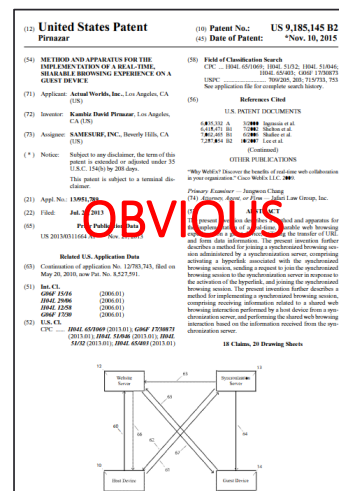
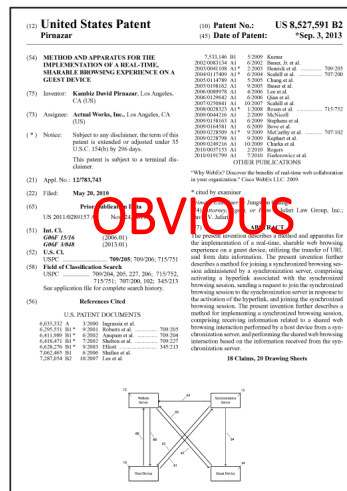
PO's Sur-replies:

- Argue that preamble is limiting – **NEW ARGUMENT**
- Argue that Petitioner argument is contrary to District Court “contentions” – **NEW ARGUMENT**
 - Petitioner’s statements of the “abstract idea” that the claims are “directed to” for determining patentable subject matter **are not “contentions...regarding claim scope”** or claim construction
 - Petitioner’s argument that the claims do not recite the terms “synchronized” or “simultaneously” **is not inconsistent** with this abstract idea statement
 - PO cannot read the term “simultaneous interactions” into the claims when they do not recite it

‘591 Sur-reply (Paper 33), 6-8; ‘145 Sur-reply (Paper 27), 6-9; ‘448 Sur-reply (Paper 28), 7-9; ‘591 Reply to MTE (Paper 44), 1-2

The Board Preliminarily Found the Grounds Rendered the Claims Obvious

- The Board analyzed the claims of each of the ‘591, ‘145, and ‘448 Patents
- The Board found that both grounds render the claims of each patent obvious
 - Obvious in view of Lebrun & Wang (Ground 1)
 - Obvious in view of Prajapat and Wang (Ground 2)



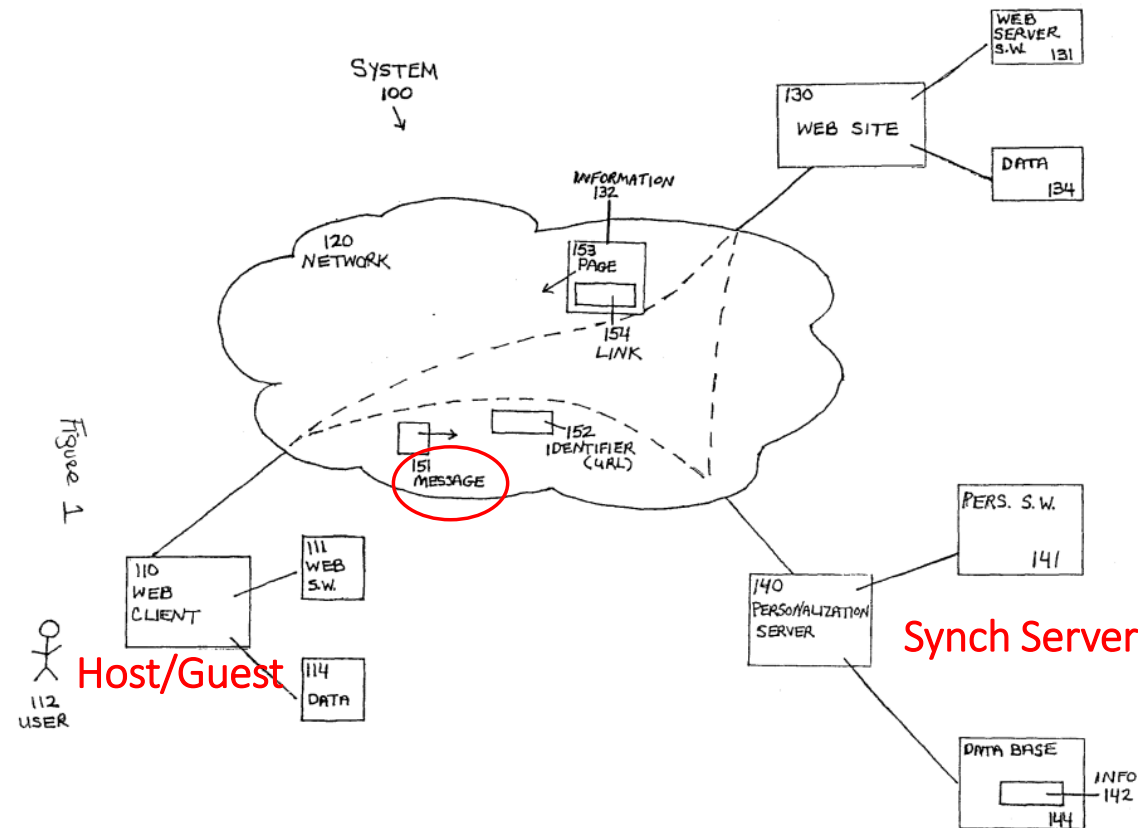
The Board Preliminarily Found the Grounds Rendered the Claims Obvious

Lebrun: International Patent Pub. No. WO 00/48110, “Personalized Access to Web Sites”

The invention provides an improved technique for group access to web sites. Multiple related users can simultaneously access a sequence of web sites, such that each of the related users has substantially the same content presented at the same times. In a first embodiment, a selected one of the related users controls the web surfing process. In a second embodiment, a selected plurality of the users collectively control the web surfing process. In a first aspect of the invention, the group surfing process can be used in conjunction with a communication technique between and among groups of users involved in the web surfing process, such as telephone communication, voice over IP, or Internet chat. In a second aspect of the invention, the group surfing process can be used in conjunction with other network functions, such as electronic commerce, on-line or otherwise remote training, virtual displays or tours, telemedicine or other process telecontrol, or consulting (such as in the fields of finance, advertising or marketing). More generally, the group surfing process can be used in conjunction with functions that could otherwise occur on display before an in-person audience.

The Board Preliminarily Found the Grounds Rendered the Claims Obvious

Lebrun: International Patent Pub. No. WO 00/48110, “Personalized Access to Web Sites”



The Board Preliminarily Found the Grounds Rendered the Claims Obvious

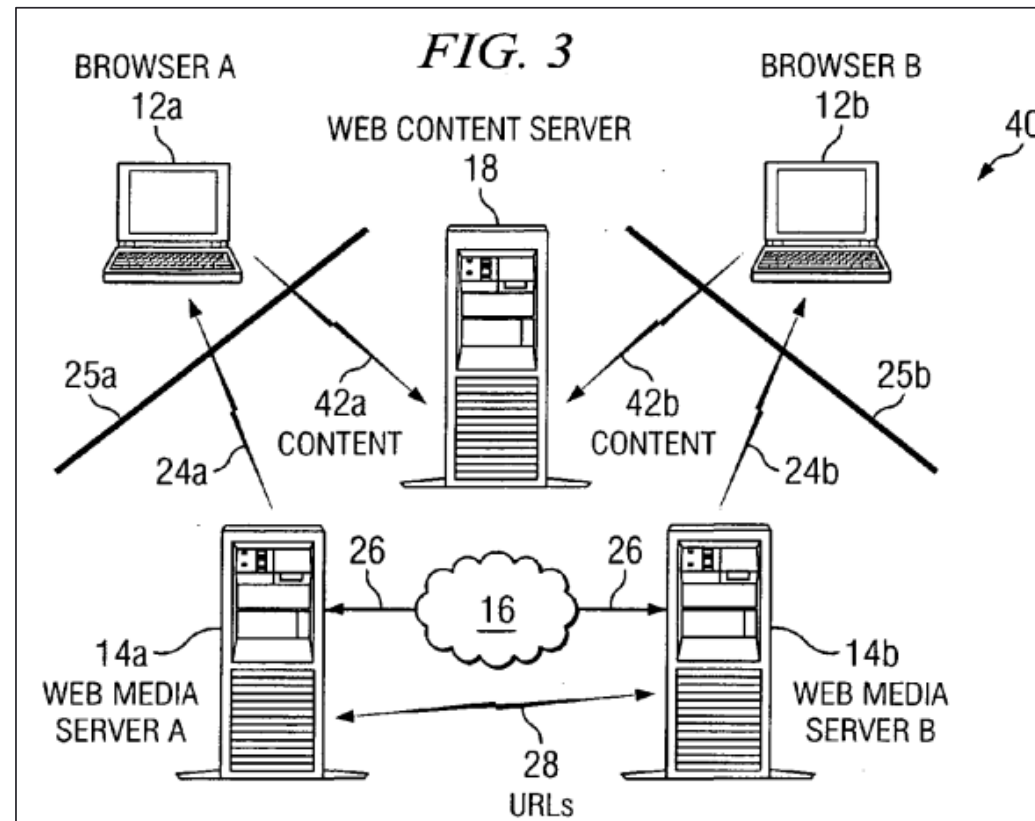
Prajapat: U.S. Patent Pub. No. 2005/0021626, “Peer-to-Peer Dynamic Web Page Sharing”

[0012] FIG. 1 illustrates an example communication system 10 operable to provide peer-to-peer dynamic web page sharing. Communication system 10 includes browsers 12, web media servers 14a and 14b coupled via network 16, and web content server 18 coupled to web media server 14a via link 20. In general, web media servers 14 allow browser 12a to co-browse one or more web pages with browser 12b. The term “co-browse” may include one or more of the following situations: browser 12a and browser 12b display the same web pages at substantially the same time; browser 12a may alter web pages and browser 12b may view those alterations; browser 12b may alter web pages and browser 12a may view those alterations; or any other suitable situations.

As the content tree in an associated browser 12 changes, changes to the content tree may be propagated back to the web media server 14 associated with the browser 12 to facilitate maintenance of an accurate reflection of the content tree of the browser 12. As an example, changes to the content tree in browser 12a may then be synchronized with other browsers 12 in a web page sharing session. As a content tree associated with a browser 12 is updated on the web media server 14 associated with the browser 12, multiple page load events may be generated from the web media server 14 to the browser 12 to cause full content synchronization.

The Board Preliminarily Found the Grounds Rendered the Claims Obvious

Prajapat: U.S. Patent Pub. No. 2005/0021626, “Peer-to-Peer Dynamic Web Page Sharing”



Ex. 1007, FIG. 3

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The Board Preliminarily Found the Grounds Rendered the Claims Obvious

Wang: U.S. Patent Pub. No. 2005/0033656, “Collaboration System Suitable for Online Shopping”

A collaboration system includes a plurality of client devices individually connected to a network, and a server apparatus for receiving requests from the client devices, responding to the client devices, and providing a common collaboration environment among the client devices. The server includes means for providing a group session formed by integrating communication sessions of the plurality of client devices, and means for synchronizing the client devices in the collaboration environment. Each of the client devices includes means for synchronizing displays on the plurality of client devices.

The Board Preliminarily Found the Grounds Rendered the Claims Obvious

Challenged Limitations of the Claims

Both Grounds Disclose the Challenged Limitations of '591/'145

'591

[1d] receiving data from the synchronization server, where the data relates to a website being accessed in real-time by a host device; and wherein the data comprises a URL of the website and cookie information associated with the website and the host device; and

[1e] operating a browser by the guest device based on the data received from the synchronization server.

'448

[1fii] wherein the synchronization server transmits the information related to the shared web browsing interaction to the invitee device in response to receiving the information related to the shared web browsing interaction from the host device, and

[1fiii] wherein the invitee device retrieves data from the website server in response to receiving the information related to the shared web browsing interaction from the synchronization server, the data associated with the webpage content requested by the host device and the information related to the shared web browsing interaction; and

'145

[1c] receiving web browsing interaction data from said synchronization server, wherein said web browsing interaction data is associated with:

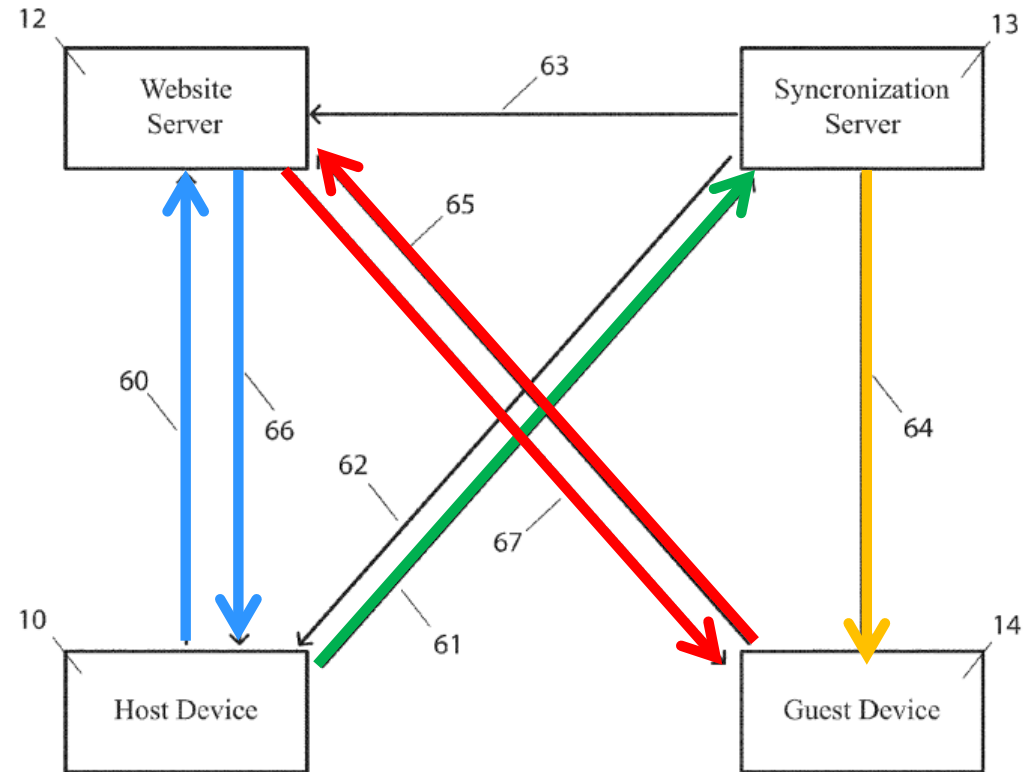
a website server that is independent of the synchronization server, and the host device that has initiated the session invitation; and

[1d] operating an application based on said web browsing interaction data received from said synchronization server to access a website server independent of the synchronization server subsequent to the activation of the session invitation.

'591, Claim 1; '145, Claim 1; '448. Claim 1

USP 8,527,591, 9,185,145, & 9,483,448 Specification

FIG. 5a shows the information exchanged between the entities



'591 Both Grounds Disclose the Only Challenged Limitations

Lebrun Ground 1 Discloses '591 [1.d], [1.e]

PO's Wrong Arguments for Ground 1

PO's Arguments to be Rebutted:

- Lebrun does not have an embodiment disclosing a guest device receiving from a synch server both a URL and cookies
- Lebrun does not have an embodiment disclosing operating a browser “based on” the data received from the synch server
- Lebrun's embodiments should not be combined
- There is no motivation to combine Lebrun and Wang

'591 Both Grounds Disclose the Only Challenged Limitations

'591 [1.d], [1.e]

- Board re: Ground 1: “On this preliminary record, therefore, we find Petitioner’s showing as to limitation [1d] sufficient for institution.”
- Board re: Ground 1: “Accordingly, Petitioner’s showing for the operating a browser limitation is sufficient for purposes of institution.”
- Board re: Ground 2: “At this preliminary juncture, we find Petitioner’s showing as to limitation [1d] sufficient for institution.”
- Board: “Petitioner further contends Lebrun contemplates combining embodiments” “Petitioner further contends Prajapat contemplates combining embodiments.” “On this record, we agree.”
- Moreover, the Federal Circuit has held that “[c]ombining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness.” *Boston Scientific v. Cordis*, 554 F.3d 982, 991 (Fed. Cir. 2009)

PO has provided no credible rationale or evidence to refute these findings

Ground 1: Lebrun Discloses '591 [1.d], [1.e]

Lebrun's multiple group-surfing session alternative embodiment discloses the data received at the guest device including both URLs and cookies

Lebrun also details that “[i]n alternative embodiments, the second web client 110 can receive only a list of pointers (such as URLs) to those pages presented during the group-surfing session, dynamically updated when a new page is added.” *Id.* at 43:20–22. Unlike the alternative, “no cookies” embodiment discussed above, Lebrun does not provide any indication that this alternative embodiment is used only in the absence of cookies. *See id.* (making no mention of the presence or absence of cookies).

DI (Paper 12), 25-26; Reply (Paper 29), 9-14; Ex. 1005 (Lebrun), 43:20-22,

Ground 1: Lebrun Discloses '591 [1.d], [1.e]

Lebrun's multiple group-surfing session alternative embodiment discloses the data received at the guest device including both URLs and cookies

Each such web client 110 can have its own personalized group-surfing session, which a second web client 110 can view and view the history thereof. If the second web client 110 is already participating in that group-surfing session, the page would be presented to the second web client 110 when it is sent by the first web client 110 to the group-surfing server 140. In alternative embodiments, the second web client 110 can receive only a list of pointers (such as URLs) to those pages presented during the group-surfing session, dynamically updated when a new page is added.

Ex. 1005, 43: 16-22; '591 Reply (Paper 29), 7-9

Ground 1: Lebrun Discloses '591 [1.d], [1.e]

The Board specifically addressed cookies upon institution, distinguishing this embodiment from the “no cookies” embodiment of Lebrun

Patent Owner maintains that “Lebrun explains that this embodiment is only to be used *without cookies*.” Prelim. Resp. 41 (citing Ex. 1005, 35:17–19). This argument conflates two different embodiments in Lebrun.

Nor are we aware of any statement in Lebrun indicating that *all* alternative embodiments must be implemented without cookies.

DI (Paper 12), 25-26; Reply (Paper 29), 7-9

Ground 1: Lebrun Discloses '591 [1.d], [1.e]

Lebrun's embodiments disclose the guest device receiving both URLs and cookies & Lebrun contemplates combining embodiments

Thus, Patent Owner is correct that Lebrun's primary embodiment, although it sends cookie information to the participating clients

Lebrun also details that "[i]n alternative embodiments, the second web client 110 can receive only a list of pointers (such as URLs) to those pages presented during the group-surfing session, dynamically updated when a new page is added." *Id.* at 43:20–22.

Petitioner further contends Lebrun contemplates combining embodiments. *See* Opp. 14–15. On this record, we agree with Petitioner

'591 DI (Paper 12), 24-25; '591 PG (Paper 32), 12; Reply (Paper 29), 7-9.

Ground 1: Lebrun Discloses '591 [1.d], [1.e]

Patent Owner's arguments for [1.e] are contingent on their arguments for [1.d]

- “Patent Owner does not appear to dispute that Lebrun teaches operating a browser based on data received from the synchronization server.”

Lebrun discloses multiple web clients (host and guest) sharing web pages

The group-surfing server 140 then re-sends that page 153 to those web clients 110 participating in the session. This allows usage of a single set of “cookies,” or other data related to identity or session, sent by the web site 130 and stored by the group-surfing server 140 at each participating web client 110.

In alternative embodiments, the second web client 110 can receive only a list of pointers (such as URLs) to those pages presented during the group-surfing session, dynamically updated when a new page is added.

'591 DI (Paper 12), 27; Ex. 1005, 35:13–15; 43:13–22; '591 Pet. 31; Reply (Paper 29). 7-9

Ground 1: Lebrun Discloses '591 [1.d], [1.e]

PO's Sur-reply:

- Revisits its “only pointers” argument
- Acknowledges FIG. 4 shows group-surfing server receiving website cookies but argues “Lebrun does not disclose that any web client ever *receives* cookie information associated with the website and host device.”

At a step 291, the controlling web client 110 sends an import-export message 151 to the group-surfing server 140, directing import or export of information relating to web sites (such as bookmarks, “cookies,” or user registrations at participating web sites 130)

At a step 292, the group-surfing server 140 receives the import-export message 151. The group-surfing server 140 imports or exports the designated information to selected databases at web clients 110 participating in the session that indicate their willingness to participate in the import or export operation.

'591 Sur-reply (Paper 29), 13-14; Ex.. 1005, 49:1-8

Ground 1: Lebrun Discloses '591 [1.d], [1.e]

PO's Sur-reply:

- Argues simple substitution of the term thus requires that “the data received” is both the URL and the cookie information received from the synchronization server, and that the guest device must operate a browser “based on” the URL and the cookie information received from the synchronization server.

[1.d]: “receiving data from the synchronization server, where the data relates to a website being accessed in real-time by a host device; and wherein the data comprises a URL of the website and cookie information associated with the website and the host device”

[1e] operating a browser by the guest device based on the data received from the synchronization server.

Sur-reply (Paper 33), 17; Ex.. 1005, 49:1-8, Claim 1

Ground 1: A POSITA Would Combine Lebrun and Wang

Lebrun does not “teach away” from Wang as PO argues

- “Teaching away” refers to criticizing or generally discouraging an approach.
In re Chaganti, 554 F. App’x 917, 921 (Fed. Cir. 2014)
- Teaching away is not describing or teaching different approaches in the same field
 - E.g., embodiment of Lebrun sends a webpage **without multimedia features**, whereas Wang purportedly is “designed to store a **snapshot** of page data locally” (media)

Board finding Motivation to Combine:

- Utilizing Wang’s designated URL address to activate a session join invitation would enable Lebrun’s group-surfing server to coordinate and manage the group-surfing session and further Lebrun’s goal of providing improved group access to web sites.

‘591 Reply (Paper 29), 14-15; ‘591 POR, 70, 77; DI (Paper 12), 18, ‘591 Pet., 25

‘145 Both Grounds Disclose the Only Challenged Limitations

Lebrun Ground 1 Discloses ‘145 [1.c], [1.d]

'145 Both Grounds Disclose the Only Challenged Limitations

'145 [1.c], [1.d]:

- Board re: Ground 1: “Accordingly, based on this preliminary record, Petitioner’s showing for the “receiving web browsing interaction data from said synchronization server” is sufficient for institution.”
- Board re: Ground 1: “Petitioner’s showing for the “operating the application” limitation is sufficient for institution..”
- Board re: Ground 2: “For the reasons explained above, however, we are persuaded that at least Petitioner’s Prajapat showing is sufficient for institution.”

PO has provided no credible rationale or evidence to refute these findings

'145 DI (Paper 12), 30, 32, 42

‘145 Both Grounds Disclose the Only Challenged Limitations

‘145 [1.c]: “receiving **web browsing interaction data** from said synchronization server...”

- **Board preliminarily found “web browsing interaction data” “encompasses web pages or portions thereof related to a browsing interaction”**
- Sur-reply: “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.
- ...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.... and therefore would be inconsistent with the “present invention.”

‘145 DI (Paper 12), 27; ‘145 Sur-reply (Paper 27), 5-6; ‘145 Ex. 1001, 5:33-36

Ground 1: Lebrun Discloses '145 [1.c], [1.d]

Lebrun discloses the group-surfing server delivering pages to the guest device

The group-surfing server 140 receives the session-creation message 151, and responds by (1) creating a group-surfing session, and (2) informing the participants in the group-surfing session. When the session-creation message 151 includes an identifier 152 for an initial page 153, the group-surfing server 140 proceeds to begin operation of the group-surfing session, as described below, causing the web site 130 to deliver the initial page 153 to the web clients 110 participating in the session.

The webpage is sent “without any multimedia elements (such as embedded sound, images, or program fragments),” which are later populated directly from the website.

'145 Reply (26), 10; Ex. 1005, 32:26-31

Ground 1: Lebrun Discloses '145 [1.c], [1.d]

Lebrun discloses the host device causing the synchronization server to send a webpage to the guest device without any multimedia elements, which is later populated by **direct interaction** between the web client and the web page server

In a preferred embodiment, in order to reduce load on the group-serving server 140, the group-serving server 140 sends only the page 153 itself without any multimedia elements (such as embedded sound, images, or program fragments). Each participating web client 110 requests those multimedia elements directly from the web site 130.

'145 Reply (Paper 26), 13; Ex. 1005, 45:31-46:2

Ground 1: Lebrun Discloses '145 [1.c], [1.d]

Sur-reply: “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”).”

In a preferred embodiment, in order to reduce load on the group-serving server 140, the group-serving server 140 sends only the page 153 itself without any multimedia elements (such as embedded sound, images, or program fragments). Each participating web client 110 requests those multimedia elements directly from the web site 130.

Sur-reply (Paper 27), 14; 145 Reply (Paper 26), 13; Ex. 1005, 45:31-46:2

Ground 1: Lebrun Discloses '145 [1.c], [1.d]

Sur-reply: “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.”

- **Board preliminarily disagreed:**

As explained above, based on this preliminary record, “web browsing interaction data” encompasses web pages or portions thereof related to a browsing interaction and is not limited to data related to enabling a host interaction being replicated by the guest device.

'145 Sur-reply (Paper 27), 14; '145 DI (Paper 12), 27; '145 Reply (Paper 26), 13;

Ground 1: Wang Discloses '145 [1.d]

Alternatively, Wang's page navigation discloses [1.d]

The page navigation means **22** includes initiative transfer means **28**, and allows the client device **12a** to access the server apparatus **14** directly and to acquire a web page when the client device **12a** has ownership of the initiative of web page operation.

'145 Pet., 59; Ex. 1006 ¶¶ 21, 41; '145 DI (Paper 12), 42

'448 Both Grounds Disclose the Challenged Limitations

Lebrun Ground 1 Discloses '448 [1.f.ii], [1.f.iii]

Ground 1: Lebrun Discloses '448 [1.f.ii], [1.f.iii]

'448 [1.f.ii], [1.f.iii]

[1fii] wherein the synchronization server transmits the **information related to the shared web browsing interaction to the invitee device** in response to receiving the information related to the shared web browsing interaction from the host device;

[1.f.iii] wherein the invitee device **retrieves data from the website server** in response to receiving the information related to the shared web browsing interaction from the synchronization server, the data associated with the webpage content requested by the host device and the information related to the shared web browsing interaction;

'448, Claim 1; '448 DI (Paper 13), 8

Both Grounds Disclose the Challenged Limitations of '591/'145

'591

[1d] receiving data from the synchronization server, where the data relates to a website being accessed in real-time by a host device; and wherein the data comprises a URL of the website and cookie information associated with the website and the host device; and

[1e] operating a browser by the guest device based on the data received from the synchronization server.

'448

[1fii] wherein the synchronization server transmits the information related to the shared web browsing interaction to the invitee device in response to receiving the information related to the shared web browsing interaction from the host device, and

[1fiii] wherein the invitee device retrieves data from the website server in response to receiving the information related to the shared web browsing interaction from the synchronization server, the data associated with the webpage content requested by the host device and the information related to the shared web browsing interaction; and

'145

[1c] receiving web browsing interaction data from said synchronization server, wherein said web browsing interaction data is associated with:

a website server that is independent of the synchronization server, and the host device that has initiated the session invitation; and

[1d] operating an application based on said web browsing interaction data received from said synchronization server to access a website server independent of the synchronization server subsequent to the activation of the session invitation.

'591, Claim 1; '145, Claim 1; '448. Claim 1

Ground 1: Lebrun Discloses '448 [1.f.ii], [1.f.iii]

'448 [1.f.ii] “wherein the synchronization server transmits the information related to the shared web browsing interaction...”

- Board preliminarily found “information related to the shared web browsing interaction” merely required that it was “**information**” “**related**” in some way “**to the shared web browsing interaction.**”
- Sur-reply: “Information Related to the Shared Web Browsing Interaction” [is not shown] to Mean “**Any** Information Related to the Shared Web Browsing Interaction”
- Board preliminarily found that “Petitioner correctly relies on **Lebrun’s unambiguous description** to show that it meets this limitation.”

'448 DI (Paper 13), 23 ,27, 33; '448 Sur-reply (Paper 28), 3; '448 Reply (Paper 27), 16

Ground 1: Lebrun Discloses '448 [1.f.ii], [1.f.iii]

[1.f.ii] wherein the synchronization server transmits the information related to the shared web browsing interaction to the invitee device in response to receiving the information related to the shared web browsing interaction from the host device

Lebrun's page 153 discloses this limitation

At a step 234, the group-surfing server 140 receives the next-page message 151. The group-surfing server 140 (1) contacts the web site 130 having that next page 153 after adding proper cookie or other identity information, and directs that target web site 130 to deliver that next page 153 to the group-surfing server 140 itself. The group-surfing server 140 then re-sends that page 153 to those web clients 110 participating in the session.

Ground 1: Lebrun Discloses '448 [1.f.ii], [1.f.iii]

Sur-reply: “Petitioner relies upon the same disclosure that was relied upon for limitation [1.c] above to disclose the “transmitting” subpart of this limitation.”

Lebrun’s next-page message 151 discloses this limitation

At a step 234, the group-surfing server 140 receives the next-page message 151. The group-surfing server 140 (1) contacts the web site 130 having that next page 153 after adding proper cookie or other identity information, and directs that target web site 130 to deliver that next page 153 to the group-surfing server 140 itself. The group-surfing server 140 then re-sends that page 153 to those web clients 110 participating in the session.

[1.c] Relies on **session-creation message 151**

‘448 Sur-reply, (Paper 28) 18; ‘448 Pet., 24-25, 29-30; Ex. 1005, 45:25-29, 35:17-19

Ground 1: Lebrun Discloses '448 [1.f.ii], [1.f.iii]

[1.f.iii] wherein the invitee device retrieves data from the website server in response to receiving the information related to the shared web browsing interaction from the synchronization server...

- Board preliminarily found “Petitioner relies on an unambiguous description in Lebrun that the web client in some embodiments can receive the next web page directly from the web site.”
- Lebrun:

In alternative embodiments, where no “cookies” or other data related to identity are involved, each web client 110 can receive the next page 153 directly from the web site 130.

'448 DI (Paper 13), 26; '448 Pet., 30; Ex. 1005, 35:17-19

Ground 1: Lebrun Discloses '448 [1.f.ii], [1.f.iii]

Sur-reply: “it is Petitioner’s burden to describe why “retrieving” and “receiving” are the same despite these different terms being used separately in the claim language, which Petitioner fails to do.”

- **Board at institution:**

For the reasons explained above, we do not agree with Patent Owner. Petitioner’s position is that Lebrun describes or at least suggests that the web client retrieves, not merely receives, the next page directly from the website in some embodiments. Pet. 30, 32–33. We understand Petitioner’s argument to be that the recited “data” is the web page retrieved from the web site. *See* Pet. 33–34.

‘448 Sur-reply (Paper 28), 19; ‘448 DI (Paper 13), 37; ‘448 Pet., 33-34

'591 Both Grounds Disclose the Only Challenged Limitations

Ground 2

PO's Wrong Arguments for Ground 2

PO's Arguments to be Rebutted:

- Prajapat does not show a guest device receiving from a synch server both a URL and cookies
- Prajapat does not disclose that browser 12a and browser 12b simultaneously, or nearly simultaneously, share internet browsing on the same webpage
- Prajapat's embodiments should not be combined
- There is no motivation to combine Prajapat and Wang

'591 Both Grounds Disclose the Only Challenged Limitations

Prajapat Ground 2 Discloses '591 [1.d]

Ground 2: Prajapat Discloses '591 [1.d]

Prajapat teaches the guest device receiving both URL and cookie information

[0043] Browser 12a may submit a request to web content server 18 for one or more web pages using link 42a, for example. Links 42 may include an HTTP link or any other suitable type of link. The request may be submitted in any suitable format such as HTTP. Web content server 18 may return the requested web page to browser 12a. Browser 12a may communicate the URL or other suitable information regarding the requested web page to web media server 14a.

The request for a web page may specify the web page to retrieve and display, as well as any other suitable information. For example, the request for the web page may include information that may be required to properly render the web page on browser 12a, such as session information, cookies, parameters to send to web content server 18, and any other suitable information.

Reply (Paper 29) 17-18; Ex. 1007 (Prajapat) 17, 43; DI (Paper 12), 39-40

Ground 2: Prajapat Discloses '591 [1.d]

Sur-reply: “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”

- **PO’s expert:**

24	Q. Nothing in Claim 1 of the '591 Patent
25	recites anything happening either simultaneously or
1	nearly simultaneously, correct?
2	MR. MCBETH: Objection to form.
3	THE WITNESS: <u>Well, the word</u>
4	<u>"simultaneous" does not appear in Claim 1.</u>
5	BY MR. SACKSTEDER:
6	Q. Nor do the words "nearly simultaneous,"
7	correct?
8	A. That's correct.

Ground 2: Prajapat Discloses '591 [1.d]

Sur-reply: “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...”

Prajapat:

As a content tree associated with a browser 12 is updated on the web media server 14 associated with the browser 12, multiple page load events may be generated from the web media server 14 to the browser 12 to cause full content synchronization.

Sur-reply (Paper 33), 19; Reply (Paper 29) 7-8; Ex. 1007 (Prajapat), 30

Ground 2: Prajapat Discloses '591 [1.d]

PO's Sur-reply:

- **Argues: Petitioner acknowledges that Prajapat discloses multiple, distinct embodiments but contends that “similar processes can be used among the various embodiments.”**
- **Lebrun:**

Variations on the Group-Surfing Session

There are many variations of techniques by which individual web clients 110 can access information from web sites 130. There are similarly many variations of techniques by which the controlling web client 110 can access information from web sites 130 and cause that information to be presented to those web clients 110 participating in the session. These can include one or more of, or some combination of, the following:

Board:

On this record, we agree with Petitioner and observe that Lebrun 37:21–25 teaches variations of techniques in the context of web page automatic form completion described on pages 38 and 39. See Lebrun 37:24–25 (“[t]hese can include one or more of, or some combination of, the following”).

'591 Sur-reply (Paper 33), 19-20; Ex.. 1005, 37:21-25; '591 PG (Paper 32), 12

Ground 2: A POSITA Would Combine Prajapat and Wang

- A POSITA would have been motivated to combine Wang's URL-based session invitation with Prajapat co-browsing request because doing so would allow Prajapat's guest device to perform collaborative browsing and would further provide control over the time that other browser could join a co-browsing session.
- Mr. Friedman admitted that he did not dispute in his declaration that Prajapat in combination with Wang discloses all of the claim elements.

8	Q. You do not dispute in your declaration
9	that Prajapat plus Wang discloses all limitations in
10	Claim 1, correct?
11	MR. MCBETH: Objection to form.
12	THE WITNESS: I think I just answered that
13	question. But other than what the petition argued,
14	I did not -- I did not address that point generally,
15	but again with the caveat that my declaration speaks
16	for itself.

‘145 Both Grounds Disclose the Only Challenged Limitations

Prajapat Ground 2 Discloses ‘145 [1.c], [1.d]

Ground 2: Prajapat Discloses '145 [1.c], [1.d]

[1c] receiving web browsing interaction data from said synchronization server, wherein said web browsing interaction data is associated with: a website server that is independent of the synchronization server, and the host device that has initiated the session invitation

- Board re: Prajapat:

Petitioner identifies web pages, content trees, or relayed information to update web page form content that browser 12b (corresponding to the guest device) receives from the web media servers as web browsing interaction data received from the synchronization server, as required by claim 1. Pet. 55–56 (citing Ex. 1007 ¶¶ 12, 23, 28–32, Fig. 1).

DI (Paper 12) , 41, 43; '145 Pet, 53-54.; Ex. 1007 (Prajapat) 12, 23, 28-32

Ground 2: Prajapat Discloses '145 [1.c], [1.d]

Sur-reply: “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.**”

[1c] **receiving web browsing interaction data from said synchronization server,** wherein said web browsing interaction data is associated with: a website server that is independent of the synchronization server, and the host device that has initiated the session invitation

'145 Sur-reply (Paper 27), 23; '145 Ex. 1001, claim 1

Ground 2: Prajapat Discloses '145 [1.c], [1.d]

[1d] operating an application based on said web browsing interaction data received from said synchronization server to access a website server independent of the synchronization server subsequent to the activation of the session invitation

- Prajapat:

Web media server 14b may communicate the URL and any other suitable information to browser 12b. Browser 12b may use the URL and any other suitable information to request from web content server 18 the web page that browser 12a requested.

Ex. 1007 (Prajapat) 43; '145 DI (Paper 12) , 43; '145 Pet, 53-54; '145 Reply (Paper 26), 17-19

Ground 2: Prajapat Discloses '145 [1.c], [1.d]

Sur-reply: “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].”

- **Board:**

On this record, we agree with Petitioner that Prajapat contemplates combining embodiments. See Dec. 40–41; Prajapat ¶¶ 41 (in the context of Figure 3, referring to aspects of the Figures 1 and 2 embodiments), 45 (collectively referring to aspects of Figures 1, 2, and 3), 47 (in the context of Figure 3, referring to aspects of the Figures 1 and 2 embodiments).

- **Prajapat:**

[0041] **FIG. 3** illustrates an example communication system 40 operable to provide peer-to-peer simple web page sharing. System 40 includes browsers 12, web media servers 14, and web content server 18. In certain embodiments, system 40 includes firewalls or other security measures 25. In operation of system 40, browser 12a may request a web page sharing session with one or more other browsers 12 (in this example, browser 12b) and may submit this request to web media server 14a. Web media server 14a may locate the web media server associated with browser 12b in a substantially similar manner to that described above with reference to **FIGS. 1 and 2**.

For purposes of web page sharing, UA and media controller 54a may locate UA and media controller 54b in substantially the same manner as described above with reference to **FIGS. 1, 2, and 3**.

[0047] Although the illustrated embodiment depicts browsers 12 retrieving web pages from web content server 18, system 48 may be constructed such that UA and web media controller 54a is operable to retrieve web pages from web content server 18. In this example, web pages may be shared in a substantially similar manner to that described above with reference to **FIGS. 1 and 2**.

'448 Both Grounds Disclose the Challenged Limitations

Prajapat Ground 2 Discloses '448 [1.f.ii], [1.f.iii]

Ground 2: Prajapat Discloses '448 [1.f.ii], [1.f.iii]

[1.f.ii] wherein the synchronization server transmits the information related to the shared web browsing interaction to the invitee device in response to receiving the information related to the shared web browsing interaction from the host device;

[1.f.iii] wherein the invitee device retrieves data from the website server in response to receiving the information related to the shared web browsing interaction from the synchronization server...

- Prajapat:

Web media server 14b may communicate the URL and any other suitable information to browser 12b. Browser 12b may use the URL and any other suitable information to request from web content server 18 the web page that browser 12a requested.

'448 DI (Paper 13) , 51-56, '448 Pet, 56-57.; Ex. 1007 (Prajapat), 43

'448 Both Grounds Disclose the Challenged Limitations

**Lebrun Ground 2 Discloses '448 remaining disputed
limitations**

[1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

‘448 Both Grounds Disclose Challenged Limitations [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

[1c] sending an invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier;

[1d] recording a shared web browsing interaction responsive to determining that a web browsing interaction of the host device within a web browsing window is a sharable web browsing interaction;

[1e] sending a request for webpage content to a website server independent of the synchronization server;

[1f] subsequent to sending the request for webpage content to the website server, transmitting information related to the shared web browsing interaction to the synchronization server,

[1fi] wherein the information related to the shared web browsing interaction is to be processed by a browser of the invitee device and enables the invitee device to generate a request to retrieve a substantially the same webpage content as the request for the webpage content from the host device;

...

[1g] receiving, responsive to sending the request for webpage content to the website server and after transmitting the information related to the shared web browsing interaction to the synchronization server, the requested webpage content from the website server.

‘448 Both Grounds Disclose Challenged Limitations [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

Board re: Ground 1: “In sum, as discussed above, Petitioner’s showing regarding the limitations recited in claim 1 and at least Lebrun’s disclosures are sufficient for institution. “ [38]

Board re: Ground 2: “Petitioner’s showing here maps the claim elements to straightforward descriptions in Prajapat as described above.” [50]

PO has provided no credible rationale or evidence to refute these findings

DI (Paper 13), 51-56, ‘448 Pet, 56-57; Ex. 1007 (Prajapat), 43

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

[1c] sending an invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier

Lebrun's session creation message discloses this limitation

A first web client 110 sends a session-creation message 151 to the group-surfing server 140, to request the group-surfing server 140 to create or set up a group-surfing session. In a preferred embodiment, the message 151 includes an identifier for the group-surfing session, so that other web clients 110 can add themselves to that session.

DI (Paper 13), 19-20; '448 Pet, 25; Ex. 1005 (Lebrun), 32:9-12

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

Sur-reply: “Petitioner does not address the fact that the “session creation message” is sent only to the group-surfing server and terminates after arriving at the group-surfing server.”

A first web client 110 sends a session-creation message 151 to the group-surfing server 140, to request the group-surfing server 140 to create or set up a group-surfing session. In a preferred embodiment, the message 151 includes an identifier for the group-surfing session, so that other web clients 110 can add themselves to that session.

'448 Sur-reply (Paper 28), 11; DI (Paper 13), 19-20; '448 Pet, 25; Ex. 1005 (Lebrun), 32:9-12

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

[1d] recording a shared web browsing interaction responsive to determining that a web browsing interaction of the host device within a web browsing window is a sharable web browsing interaction

Lebrun:

When the controlling web client 110 selects a link 152 on the page 153, the selection is caught by the program fragment, which sends the selection to the group-surfing server 140 as described below (preferably using a protocol operating on top of TCP/IP).

The controlling web client 110 can select web pages 153 for “look ahead” before designating those web pages 153 as next pages 153 in the progression of pages 153 in the session.

DI (Paper 13), 20-21; '448 Pet, 26; Ex. 1005 (Lebrun), 36:21-23, 37:30-31 45:14-17

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

Sur-reply: Petitioner must explain why “catching/intercepting” is different from “recording”

Petitioner then contends that “when a ‘controlling web client’ chooses the next page, as opposed to designating a web page for ‘look ahead’ or ‘special access,’ the user is determining to share a web page to others participating in the session.” Pet. 26 (citing Ex. 1005, 37:27–38:27). As such, according to Petitioner, Lebrun’s program fragment recording the information about a web page to be shared occurs after such a determination and meets the limitation: “recording a shared web browsing interaction responsive to determining that a web browsing interaction of the host device within a web browsing window is a sharable web browsing interaction.” *See* Pet. 25–26.

Petitioner’s contention is based on a reasonable reading of unambiguous passages in Lebrun and is sufficient for institution.

‘448 Sur-reply (Paper 28), 14; DI (Paper 13) , 21; ‘448 Pet, 26; Ex. 1005 (Lebrun), 36:21-23, 37:30-31 45:14-17

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

[1e] sending a request for webpage content to a website server independent of the synchronization server

Lebrun:

A first web client 110 sends a session-creation message 151 to the group-surfing server 140, to request the group-surfing server 140 to create or set up a group-surfing session. In a preferred embodiment, the message 151 includes an identifier for the group-surfing session, so that other web clients 110 can add themselves to that session.

In a preferred embodiment, the message 151 can also include **an identifier 152 for an initial page 153** for the group-surfing session. For example, the initial page 153 can include a home page for a selected web site 130 or a welcome page for a selected service available at the selected web site 130.

In alternative embodiments, where no “cookies” or other data related to identity are involved, **each web client 110 can receive the next page 153 directly from the web site 130.**

'448 DI (Paper 13) , 22; '448 Pet, 27; Ex. 1005 (Lebrun), 32:9-24, 35:17-19

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

[1g] **receiving**, responsive to sending the request for webpage content to the website server and after transmitting the information related to the shared web browsing interaction to the synchronization server, **the requested webpage content from the website server.**

Lebrun:

In a preferred embodiment, the web site 130 includes a processor operating under control of web server software 131, and disposed for **delivering information 132 to the web clients 110** or the group-surfing server 140 **in response to requests** made using the communication protocol.

'448 DI (Paper 13), 37; Ex. 1005 (Lebrun), 31:27-30

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

Sur-reply: “Petitioner describes Figure 1 by relying on disclosures that Lebrun makes with regard to Figure 3, but never provides any reason why a POSITA would be motivated to combine these two different systems.”

- Board: “Petitioner further contends Lebrun contemplates combining embodiments” “On this record, we agree.”

'448 Sur-reply (Paper 28), 15-16; DI (Paper 13) , 22; '448 Pet, 27; Ex. 1005 (Lebrun), 32:9-2, 21-24, 35:17-19; '591 PG (Paper 32), 12

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

Sur-reply: This disclosure does not refute PO's assertion that "Lebrun fails to disclose the host device 'sending the request for webpage content to the website server.'"

In a preferred embodiment, the web site 130 includes a processor operating under control of web server software 131, and disposed for delivering information 132 to the web clients 110 or the group-surfing server 140 in response to requests made using the communication protocol.

'448 Sur-reply, (Paper 28) 20; DI (Paper 13), 37; Ex. 1005 (Lebrun), 31:27-30

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

[1f] subsequent to sending the request for webpage content to the website server, transmitting information related to the shared web browsing interaction to the synchronization server, [1fi] wherein the information related to the shared web browsing interaction is to be processed by a browser of the invitee device and enables the invitee device to generate a request to retrieve a substantially the same webpage content as the request for the webpage content from the host device

Lebrun:

At a step 233, the controlling web client 110 sends a next-page message 151 to the group-surfing server 140, indicating the next page 153 in the progression of pages 153 in the session.

In a preferred embodiment, in order to reduce load on the group-serving server 140, the group-serving server 140 sends only the page 153 itself without any multimedia elements (such as embedded sound, images, or program fragments). Each participating web client 110 requests those multimedia elements directly from the web site 130.

'448 DI (Paper 13), 25; '448 Pet, 28-30; Ex. 1005 (Lebrun), 45:21-23, 45:31-46:2

Ground 1: Lebrun Discloses '448 [1.c], [1.d], [1.e], [1.f], [1.f.i], [1.g]

Sur-reply: “Lebrun 46:1-2 is also inapt since a “request” for multimedia elements does not sufficiently explain whether the request is one to “retrieve” or “receive.”

Lebrun:

In a preferred embodiment, in order to reduce load on the group-serving server 140, the group-serving server 140 sends only the page 153 itself without any multimedia elements (such as embedded sound, images, or program fragments). Each participating web client 110 requests those multimedia elements directly from the web site 130.

'448 Sur-reply (Paper 28), 18; DI (Paper 13), 25; '448 Pet, 28-30; Ex. 1005 (Lebrun), 45:31-46:2

Ground 1: Wang Discloses ‘448 [1.c], [1.f.i]

For [1.c] Wang’s “communication means for enabling the client devices to display a message for other client devices” discloses this limitation

[0020] The present invention also includes a client device for use in a system that enables computer devices to collaborate with one another through a network. The client device comprises: browser means for allowing the client device to display data received through the network; page navigation means for communicating, through the network, a request for changing ownership of the initiative to operate the web page displayed among a plurality of the client devices; synchronization control means for enabling the plurality of client devices to share the web page; and communication means for enabling the client device to display a message for other client devices. The synchronization control means may issue a request for making an inquiry about an identification value of previously compiled data of the web page through the network in response to ownership of the initiative of the operation of the web page.

For the [1.f.i] the Board preliminarily found that “a web page or the snapshot data of Wang can[] constitute ‘information related to the shared web browsing interaction’ as recited in claim 1.”

‘448 DI (Paper 13), 48-51, 54, 56; ‘448 Pet, 50; Ex. 1006 (Wang), 20

'448 Both Grounds Disclose the Challenged Limitations

Prajapat Ground 2 Discloses '448 remaining disputed limitations [1.f], [1.g]

Ground 2: Prajapat Discloses '448 [1.f], [1.g]

[1f] subsequent to sending the request for webpage content to the website server, transmitting information related to the shared web browsing interaction to the synchronization server...

[1g] receiving, responsive to sending the request for webpage content to the website server and after transmitting the information related to the shared web browsing interaction to the synchronization server, the requested webpage content from the website server

Board:

For the transmitting information to the synchronization server limitation [1.f], Petitioner again relies on Prajapat's unambiguous disclosure that browser 12a may communicate requests to the web media server for web pages. Pet. 53 (citing Ex. 1007 ¶ 22).

'448 DI (Paper 13), 50, '448 Pet, 53; Ex. 1007 (Prajapat), 22

Ground 2: Prajapat Discloses '448 [1.f], [1.g]

[1f] subsequent to sending the request for webpage content to the website server, transmitting information related to the shared web browsing interaction to the synchronization server...

[1g] receiving, responsive to sending the request for webpage content to the website server and after transmitting the information related to the shared web browsing interaction to the synchronization server, the requested webpage content from the website server

Prajapat:

[0022] Via outgoing channel 30a or in any other suitable manner, web media server 14a may receive requests from browser 12a for one or more web pages. For example, browser 12a may submit requests for one or more web pages by communicating a request to web media server 14a for a particular web site using the uniform resource locator (URL) of the web site. As discussed above, the request for a web page may specify the web page to retrieve and display, as well as any other suitable information. For example, the request for the web page may include information that may be required to properly render the web page such as session information, cookies, parameters to send to the web content server 18 associated with the requested web page, or any other suitable information. In one embodiment, web media server 14a may retrieve any suitable information from browser 12a using a signed Applet, plugin, or by other suitable means. Web media server 14a may derive any suitable information regarding browser 12a during a session with web content server 18.

'448 DI (Paper 13), 50, '448 Pet, 53; Ex. 1007 (Prajapat), 22

Wang Discloses Dependent Claims

PO waived argument for most of the dependent claims

‘591 Claims 2-5, 12: Wang’s discloses use of the myURL address to provide an invitation to join a session, sending it via email

‘145 Claims 2, 3, 11: Wang’s discloses use of the myURL address to provide an invitation to join a session, sending it via email

‘448 Claims 3-6, 10, 12, 16: Wang’s discloses use of the myURL address to provide an invitation to join a session, sending it via email

‘591 Reply, (Paper 29) 19-20; ‘591 DI (Paper 12), 30-33; ‘145, DI (Paper 12), 33, 50; ‘448 DI (Paper 13), 40, 43-44, 56; ‘591 Pet, 35-38, 43; ‘145 Pet., 37-40, 63-74; ‘448 Pet., 41-45; Ex. 1006 (Wang), 47-49, 66

'591 Motion to Amend

'591 Motion to Amend

The proposed amended claims also are invalid

Board's Preliminary Guidance findings :

- the proposed substitute claims of the '591 patent **lack written description** support
- the proposed substitute claims of the '591 patent **are obvious** over each combination of the prior art
 - Lebrun and Wang
 - Prajapat and Wang
 - Birnbaum in view of Lebrun, Prajapat, and/or Wang

PO has provided no credible rationale or evidence to refute these findings

- No expert declaration supporting the MTA

'591 PG (Paper 32), 6, 11-16; Pet. Sur-reply to MTA (40), 1-2, 7

The proposed amended claims are invalid

Amended claim 19

Appendix A - Substitute Claims

19. (Proposed substitute for claim 1, if claim 1 found unpatentable) A method for a guest device performing a synchronized browsing session administered by a synchronization server, comprising:

detecting an activation of a hyperlink associated with the synchronized browsing session by a guest device;

sending a request by the guest device to join the synchronized browsing session to the synchronization server in response to the activation of the hyperlink;

receiving from the synchronization server a notification that guest device has joined the synchronized browsing session;

receiving first data from the synchronization server, where the first data relates to a website being accessed in real-time by a host device; and

wherein the first data comprises a URL of the website, ~~and~~ cookie information associated with the website and the host device, and information related to a shared user input web browsing interaction that includes second data indicating at least one direct host device interaction with content of the website performed by the host device; and

operating a browser by the guest device based on at least the second data received from the synchronization server to independently replicate the host device interaction with the content of the website, obtained by the guest device from a website server based on at least the first data.

wherein the first data comprises a URL of the website, ~~and~~ cookie information associated with the website and the host device, and information related to a shared user input web browsing interaction that includes second data indicating at least one direct host device interaction with content of the website performed by the host device; and

operating a browser by the guest device based on at least the second data received from the synchronization server to independently replicate the host device interaction with the content of the website, obtained by the guest device from a website server based on at least the first data.

PO Did Not Refute that its MTA Analysis is Not Supported by Expert Testimony

- All of PO's arguments in the MTA and Reply to MTA are undermined by a lack of expert support or other evidence
 - PO did not submit a declaration supporting its MTA or MTA Reply
 - PO opted not to cross-examine Petitioner's expert on his Opposition declaration
- Mere conclusory statements in the form of attorney argument cannot take the place of evidence in the record. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016)
- To the extent that PO's arguments are contrary to those supported by Dr. Lieberman's testimony, there is **no substantial evidence to support them**, and thus they must fail

Opp. to MTA (30), 25; Sur-reply to MTA (40), 1

Lack of Written Description

Lack of written description support is fatal to PO's motion to amend

PO's MTA fails 37 C.F.R. § 42.121(b)(1) for absence of showing "support in the original disclosure"

- The MTA Reply includes **eight new citations** to Ex. 1001 without corresponding cites to the *application as filed* and absent from the cites in the MTA

between browser clients." (*Id.*, 5:15-19.) Specifically, "form data" input by a host may be "relayed" by the synch-server to the guest device. (*Id.*, 6:65-7:1, 7:56-59.) The data passed to the synchronization server is sent to the guest device. (*Id.*, 16:51-56.) The guest device then *uses* this information, which can include the claimed "second data," to replicate an action of the host device, including, for example, "formulating" an "identical" request. (*Id.*, 16:56-63, 19:12-16.)

As noted above, this may include relay and usage of "form data" that is "information inputted by a user in pre-defined fields." (*Id.*, 16:63-64, 19:15-16.) The guest device "formulation" is an example of the guest device using the forwarded "form data" to "replicate" a host device interaction. All of the preceding can be done using software that includes, for example, standard browsers, plug-ins and/or software that operates the browser or includes browser capability, any of which constitute "operating a browser." (*Id.*, 7:32-55, 19:21-28.)

The '591 Patent also lists other examples of replication that include host input being "formatted, forwarded and inputted into other devices." (*Id.*, 5:26-35.) This enables "all" session attendees to "view[]" and fully interact in a shared browsing experience" and "with the same internet content." (*Id.*, 5:41-47.) "Fully interact" includes "filling in form data" as well as activities such as "drawing on the screen," both of which are examples of content interaction that can be "inputted" into the other devices. (*Id.*, 5:48-50.) Ultimately, "webpage interactions

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of the host ... are relayed to following devices," which allows for "identical" "visual output of shared browsing window ..." (*Id.*, 7:56-62.)

The preceding examples show possession of a guest device receiving information including the "second data" as claimed. (*Id.*, 6:65-7:1, 16:31-40.) The information is relayed from the synchronization server. (*Id.*) The information is *independently used* by software of the guest device, as claimed, to replicate the host interaction. (*Id.*, 5:26-35, 16:51-17:11, 17:31-34, 7:56-62.) The software of the guest device may be a standard browser, plugin, or standalone software that can operate a browser or that includes browser capabilities. (*Id.*, 7:32-55, 19:21-28.)

B. Claims 25, 33 and 35

Intuit contends that the application does not show display of "the host device's interaction." That is not what is claimed. With regards to displaying the *replicated* interaction, PO notes that the host data input may be "forwarded and inputted into the other devices ..." and that forwarding of webpage interactions of the host device allows for identical visual output. (*Id.*, 5:32-36, 7:56-62.)

III. Claims 19 and 28 are definite

The Board correctly found that the claims are not indefinite. (PG, 7-8.) Relayed messages may include URLs, cookies or form data. (Ex.1001, 16:4-7.)

IV. Unaddressed limitations and claims

In its Opposition (hereinafter "OPP") Intuit failed to address the first three

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Pet. Sur-reply to MTA (40), 2-3;
Reply (34) to MTA, 2-3

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Lack of written description support is fatal to PO's motion to amend

PO also misapplies the doctrine of claim differentiation

The “second data” is distinct from URL or cookie data by dint of claim differentiation and “indicates” a “direct host interaction with content of the website.”

- The doctrine of claim differentiation requires that “the presence of a **dependent** claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the **independent** claim.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc).
- The URL/cookie data and the “second data” are both within the same limitation of claim 19

Pet. Sur-reply to MTA (Paper 40), 4; Reply ISO MTA (Paper 34), 1

No written description support for “second data”

PO’s MTA Reply fails to explicitly state where specification allegedly supports the terms “second data” and “operating a browser” based on the second data

- singular “non-limiting example” of “second data” as “**form data**” that can be part of the “**other user inputted information**” sent from the host device to synch server to guest device

During an exemplary synchronized browsing session, after host device **10** transmits website request **60** to website server **12**, host device **10** transmits communication message **61** to synchronization server **13**. Communication message **61** may comprise the URL address of website server **12**, cookie information, form data, java script, **or other user inputted information**, or attached files.

A following device, such as guest device **14**, may be defined as any device that receives relayed webpage interactions from synchronization server **13**. In exemplary embodiments, relayed webpage interactions may include data such as URL, form data, scripts, advertising codes, **or other information**. A following device that does not possess leading device

To share their internet browsing experience, the present invention utilizes 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.

No written description support for “operating a browser” based on “second data”

PO’s MTA Reply fails to explicitly state where specification allegedly supports the terms “second data” and “operating a browser” based on the second data

- PO alleges “guest device then uses this information, which can include the claimed “second data,” to replicate an action of the host device”

Communication message 64 may be used by guest device 14 to formulate website request 65 to be sent from guest device 14 to website server 12. Website request 65 is a data communication message transmitted by guest device 14 to website server 12. In exemplary embodiments, website request 65 should be similar or identical to website request 60.

A following device, such as guest device 14, may be defined as any device that receives relayed webpage interactions from synchronization server 13. In exemplary embodiments, relayed webpage interactions may include data such as URL, form data, scripts, advertising codes, or other information.

Guest device 14 formulates website request 65 by processing communication message 64. In exemplary embodiments, information in communication message 64, including URL, form data, cookies or other data, is transmitted in website request 65.

Shared browsing window 17 is an element of synchronized browsing software 16 wherein the webpage interactions of host device 10, or other leading device, are relayed to following devices in the synchronized browsing session, such as guest device 14. In exemplary embodiments, the audio and visual output of shared browsing window 17 may be similar or identical on both leading and following devices.

No written description support for “operating a browser” step

- Form data is not disclosed as indicating **an interaction** with the content of the website by host device that is independently replicated by guest device

Form data may be defined as information inputted by a user in pre-defined fields on a webpage that may be transmitted to a website server. Website request 60 may include form data inputted by the user of host device 10. For **example**, should the user of host device 10 search a website for hotel vacancies in New York City on a specified date, website request 60 would include form data for data fields such as location, data of travel, number of nights, number of guests, and other query fields.

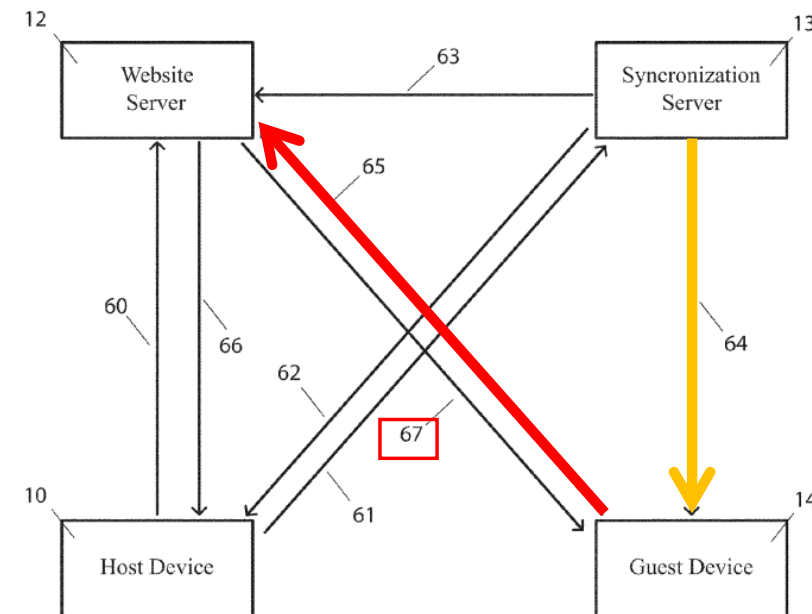
Pet. Sur-reply to MTA (Paper 40), 5-6; '591 Ex. 1001,16:63-17:4

No written description support for “operating a browser” step

- If form data is received by the guest device and included in the website request 65
 - It would be sent **before** any “content” is received by the guest device (67) that it could possibly “interact” with

A following device, such as guest device 14, may be defined as any device that receives relayed webpage interactions from synchronization server 13. In exemplary embodiments, relayed webpage interactions may include data such as URL, form data, scripts, advertising codes, or other information.

Communication message 64 may be used by guest device 14 to formulate website request 65 to be sent from guest device 14 to website server 12. Website request 65 is a data communication message transmitted by guest device 14 to website server 12. In exemplary embodiments, website request 65 should be similar or identical to website request 60.



Pet. Sur-reply to MTA (Paper 40), 5-6; '591 Ex. 1001, 6:64-7:2, 16:56-62; FIG. 5a

'591 Amended Claims Are Obvious

The amended claims are obvious over the asserted references

PO has done nothing to refute the Board's preliminary findings that Petitioner's obviousness contentions were "sufficiently persuasive"

In the Opposition, Petitioner advances the following grounds (*see* Opp. 10, 15, 19):

- (1) proposed substitute claims 19 and 28 remain obvious over Lebrun in view of Wang;
- (2) proposed substitute claims 19 and 28 remain obvious over Prajapat in view of Wang; and
- (3) proposed substitute claims 19 and 28 are also obvious over Birnbaum in view of Wang and Lebrun and/or Prajapat.

For the reasons below, on this record, Petitioner's contentions based on grounds (1), (2), and (3) are sufficiently persuasive.

The amended claims are obvious over the asserted references

Only the “operating a browser” limitation is in dispute

- PO did not challenge Petitioner’s Opposition arguments or the Board’s preliminary findings regarding the “first data received” limitation
- It is undisputed that the references disclose the “first data received” limitation

PO’s MTA Reply arguments largely disregard the Preliminary Guidance

- Limited discussion on the Board-discussed portions of the references
- Reiterates arguments contrary to the Board’s conclusions without explaining why
- Does not even address the Board’s preliminary findings regarding Birnbaum

Pet. Sur-reply to MTA (Paper 40), 7-8; MTA Reply (Paper 34), 7-12 (no citations to PG)

Lebrun renders obvious the amended claims

- The Board relied primarily on Ex. 1005 at 39:1-4 (form completion) and 43:20-22 (guest device receiving URLs)

In alternative embodiments, the second web client 110 can receive only a list of pointers (such as URLs) to those pages presented during the group-surfing session, dynamically updated when a new page is added.

In alternative embodiments, when the controlling web client 110 enters information to complete the HTML form, and sends that information to the group-surfing server 140, the group-surfing server 140 may present that information on the HTML form at each participating web client 110, so that each participating web client 110 can see the HTML form being filled in. The group-surfing server 140 may present that information on the HTML form as each field of the form is completed, or when the entire form is completed, or at other times.

Pet. Sur-reply to MTA (Paper 40) 7-8; '591 PG (Paper 32), 11-12; '591 Ex. 1001, 39:1-4, 43:20-22

Lebrun renders obvious the amended claims

PO repeats arguments

- “only” pointers argument
 - Board cited to:

In alternative embodiments, the second web client 110 can receive **only a list of pointers (such as URLs)** to those pages presented during the group-surfing session, dynamically updated when a new page is added.

- argument against combining Lebrun’s embodiments
 - Board explicitly addressed:

Petitioner further contends **Lebrun contemplates combining embodiments.** See Opp. 14–15. On this record, **we agree with Petitioner** and observe that Lebrun 37:21–25 teaches variations of techniques in the context of web page automatic form completion described on pages 38 and 39. See Lebrun 37:24–25 (“[t]hese can include one or more of, or some combination of, the following”).

Prajapat renders obvious the amended claims

- The Board relied on Prajapat ¶¶30, 31, and 43

[0043] Browser 12a may submit a request to web content server 18 for one or more web pages using link 42a, for example. Links 42 may include an HTTP link or any other suitable type of link. The request may be submitted in any suitable format such as HTTP. Web content server 18 may return the requested web page to browser 12a. Browser 12a may communicate the URL or other suitable information regarding the requested web page to web media server 14a. Web media server 14a may communicate the URL and any other suitable information to web media server 14b, using media session 28 for example. Web media server 14b may communicate the URL and any other suitable information to browser 12b. Browser 12b may use the URL and any other suitable information to request from web content server 18 the web page that browser 12a requested.

[0031] In certain embodiments, web page form content, such as fields in web page forms for example, are kept in sync on web pages in browsers 12 involved in a web page sharing session by using JavaScript or other suitable events. As an example, at appropriate times when data in a web page form field changes, a JavaScript or other suitable event may be triggered to send a command to the appropriate web media server 14. If web media server 14b receives the command, for example, it may then be forwarded to web media server 14a. Web media server 14a may then send the updated metadata to web media server 14b, and events may be generated to the browsers 12 to update the web page form content if necessary (i.e. the originating browser 12 may not need the event).

As the content tree in an associated browser 12 changes, changes to the content tree may be propagated back to the web media server 14 associated with the browser 12 to facilitate maintenance of an accurate reflection of the content tree of the browser 12. As an example, changes to the content tree in browser 12a may then be synchronized with other browsers 12 in a web page sharing session. As a content tree associated with a browser 12 is updated on the web media server 14 associated with the browser 12, multiple page load events may be generated from the web media server 14 to the browser 12 to cause full content synchronization.

Pet. Sur-reply to MTA (Paper 40), 9; '591 PG (Paper 32), 13-14; Ex. 1007 (Prajapat), 30, 31, 43

Prajapat renders obvious the amended claims

PO's arguments:

- repeats argument against combining Prajapat's embodiments
 - Board explicitly addressed:

Petitioner further contends Prajapat contemplates combining embodiments. See Opp. 18. On this record, we agree with Petitioner that Prajapat contemplates combining embodiments. See Dec. 40–41; Prajapat ¶¶ 41 (in the context of Figure 3, referring to aspects of the Figures 1 and 2 embodiments), 45 (collectively referring to aspects of Figures 1, 2, and 3), 47 (in the context of Figure 3, referring to aspects of the Figures 1 and 2

- Repeats wrong “claim differentiation” argument

A URL or cookie is not “the second data” due to claim differentiation. (§V, *supra*.)

Pet. Sur-reply to MTA (Paper 40), 9; '591 PG (Paper 32), 13-14; Ex. 1007 (Prajapat), 30, 31, 43; Reply ISO MTA (Paper 34), 11

Prajapat renders obvious the amended claims

PO's arguments:

- Attorney argument regarding “any other suitable information” of Prajapat

Petitioner combines these teachings with the Fig. 3/4 embodiments under the logic that the teaching of “any other suitable information” will cover the claimed “second data.” (OPP, 18.)

- Mere attorney argument cannot take the place of evidence in the record.

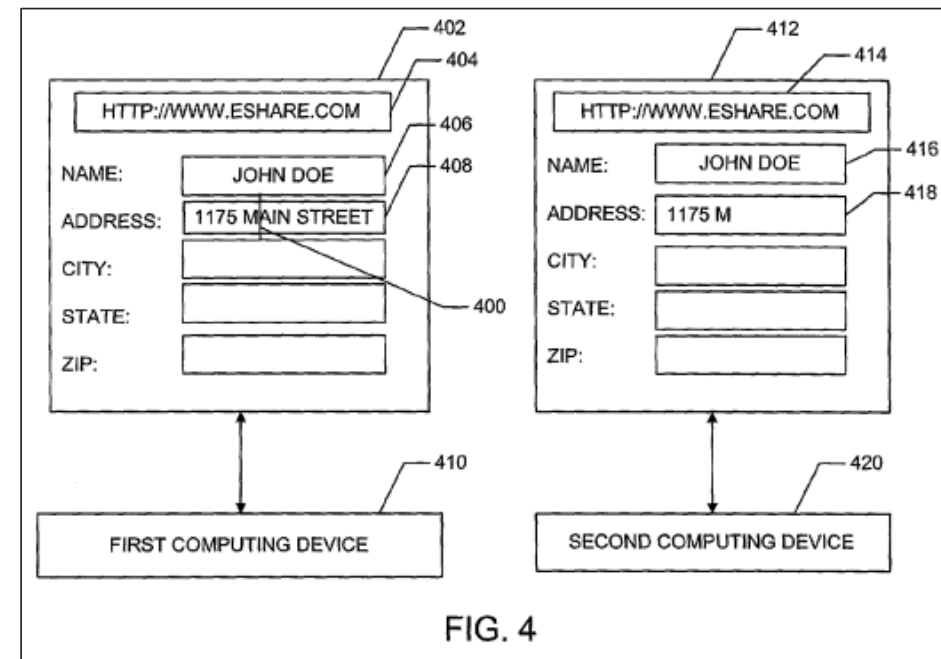
In re Schulze, 346 F.2d 600, 602 (CCPA 1965)

Pet. Sur-reply to MTA (Paper 40), 9; ‘591 PG (Paper 32), 13-14; Ex. 1007 (Prajapat), 30, 31, 43

Birnbaum renders obvious the amended claims

Birnbaum: U.S. Patent Publication No. 2002/0143878, “Collaboration Between Two Computing Devices” (Ex. 1036)

A first computing device and a second computing device establish (101) a connection and the first computing device downloads (102) a mini-application which monitors for changed information on the first computing device, such as a new web page address or information entered into the field of a form displayed on the browser of the first computing device. Once the mini-application detects (103) such a change it sends (104) the information regarding the change to the second computing device. The second computing device then implements (105) that information by acting on or displaying that information, such as by going to the new web page address if the change was a new website, or by displaying the information in the appropriate field on the form displayed on the second computing device. The mini-application continues (106) to monitor for change on the first computing device until web collaboration is disabled (107).



Ex. 1036 (Birnbaum), Abstract, FIG. 4

Birnbaum renders obvious the amended claims

- Board’s preliminary findings:

Petitioner further contends Birnbaum discloses the “operating a browser” limitation of claims 19 and 28. *See* Opp. 23. We agree with Petitioner that Birnbaum’s process, discussed *supra*, describes usage of the second data “to independently replicate the host device interaction.” For example, in Figure 4, the name in field 406 is independently replicated in field 416. Birnbaum Fig. 4, ¶¶ 80, 88, 89. Birnbaum discloses “[i]f the information [from the device 410] is a new web address, the browser on the agent's computing device [420] will go to that new web address.” Birnbaum ¶ 80; *see also* Birnbaum ¶ 72. On this record, we agree with Petitioner that at least this portion of Birnbaum teaches “the content of the website [is] obtained by the guest device from a website server based on at least the first data.”

- PO does not refute – or even address – the Board’s preliminary findings Birnbaum

Birnbaum renders obvious the amended claims

- Birnbaum's collaborative web browsing process allows "the agent and customer to independently ... receive[] the same information from the connected server."
- "[A]ny change occurring at the customer's browser will also occur at the agent's browser, so the agent's browser will be synchronized to the customer's browser."

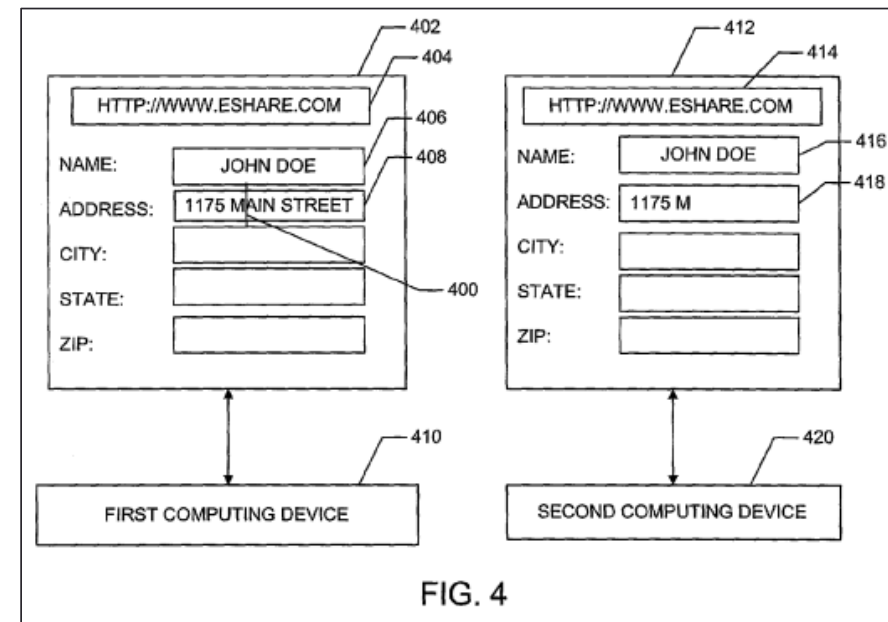
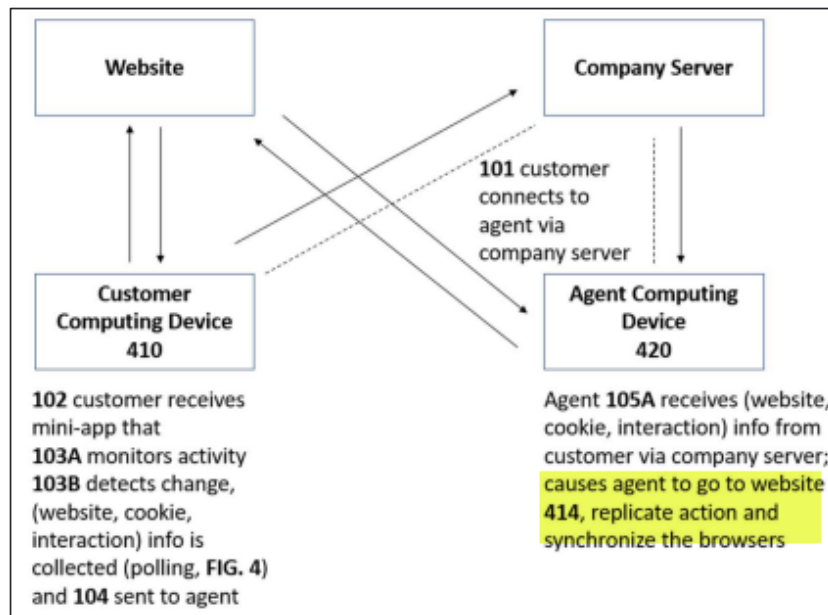


FIG. 4

The amended claims are obvious over the asserted references

PO's challenges to the art combinations fail

- PO did not challenge combining Lebrun or Prajapat with Wang, either in its Motion or the MTA Reply
- PO did not address the Board's preliminary finding that a POSITA would have combined the references.
- Petitioner showed why the amended claims are obvious over Birnbaum:
 - "Birnbaum ... ***discloses the newly added limitations***"
 - PO did not dispute
 - "Birnbaum in view of Wang and Lebrun or Wang and Prajapat also render claims 19 and 28 obvious."
 - Birnbaum combinations only rely upon the other references for showing that the remaining, ***unamended*** claim limitations are obvious over those combinations

Pet. Sur-reply to MTA (Paper 40), 10-11; MTA, (Paper 23) 15-23; MTA Reply (Paper 29), 7-12; '591 PG (Paper 32), 10; '591 DI (Paper 12), 28, 41; Opp. to MTA (Paper 30), 19-24

The amended claims are obvious over the asserted references

PO's arguments mischaracterize the law

- PO misrepresents 37 C.F.R. § 42.121(d)(2)
 - Correct: places the burden on Petitioner to show the proposed claims as amended are unpatentable
 - PO points to no requirement for Petitioner to **repeat arguments** from the Petition about the unamended claim limitations
- The Board commonly grants MTAs based on Petitioners' addressing only the amended limitations. *See, e.g., Unified Patents Inc., v. KCG Technologies LLC*, IPR2019-01536, Paper 28 (FWD) at 42 (P.T.A.B. Feb. 10, 2021)
- The Board determines whether substitute claims are unpatentable “based on the entirety of the record, including any opposition made by the petitioner.”

TPG, 68 (emphasis added), citing *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, -01130, Paper 15 at 3-4 (P.T.A.B. Feb. 25, 2019) (precedential)

Pet. Sur-reply to MTA (Paper 40), 11-12

Motions to Strike and Exclude

Petitioner's Motion to Strike

The Board should strike Exhibits 2006, 2007, and 2008 ('448/-341 only) because they were filed contrary to the Board's rules and TPG

- PO filed Exhibits 2006, 2007, & 2008 **with its Sur-reply** in each case
- USPTO Rule 42.23(b): "A sur-reply may only respond to arguments raised in the corresponding reply and **may not be accompanied by new evidence other than deposition transcripts** of the cross-examination of any reply witness."
- TPG, 73: a "sur-reply may **not be accompanied by new evidence other than deposition transcripts** of the cross-examination of any reply witness."
- The Board routinely strikes such improper new evidence.
 - *Satco Products, Inc. v. Seoul Semiconductor Co., Ltd.*, IPR2020-00836, Paper 45 at 75-77 (P.T.A.B. Oct. 22, 2021)
 - *Lenovo Holding Co., Inc. v. Dodots Licensing Solutions LLC*, IPR2019-01278, Paper 37 at 31-33 (P.T.A.B. Jan. 19, 2021)
 - *Clearone, Inc. v. Shure Acquisition Holdings, Inc.*, IPR2019-00683, Paper 66 at 3-5 (P.T.A.B. April 20, 2020)

'591 Pet. Motion to Strike (Paper 37), 1-2; '145 Pet. Motion to Strike (Paper 30), 1-2;
Pet. Motion to Strike (Paper 31), 1-2; '591 Sur-reply (Paper 33), 2, 6, 7

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Petitioner's Motion to Strike

The Board should strike Exhibits 2006, 2007, and 2008 ('448/-341 only) because they were filed contrary to the Board's rules and TPG

The exhibits are:

- Petitioner's Notice of Motion and Motion to Dismiss Pursuant to Rule 12(b)(6) from SDCA Case No. 22-cv-00412-LL-KSC (Ex. 2006)
- Reply in Support of Its Motion to Dismiss (Ex. 2007) from same
- Corrected Notice of Allowability for Application No. 14/830,710 (US Patent 9,483,448)(Ex. 2008)
- **New evidence** because they were not previously of record in this IPR proceeding
- **Not** "deposition transcripts of the cross-examination of any reply witness"

Petitioner's Motion to Strike

PO's Opposition to MTS:

- Relies on *Popsockets LLC v. Flygrip, Inc.*, IPR2022-00937, Paper 29 at 8-9 (PTAB Oct. 30, 2023)
- “Petitioner here has not explained why its own district court briefs constitute “new evidence” to it.”
- “The facts of this case are thus distinguished from those in *Satco Products, Inc.*,” in which “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.”
- “Petitioner has taken positions in this proceeding regarding claim scope that are inconsistent with those it made in District Court”

Petitioner's Motion to Exclude

Exhibits 2005-2007 should be excluded as irrelevant and/or unfairly prejudicial or confusing

- Petitioner objected to Exhibits 2005-2007 as irrelevant
- Each of these papers relates to a district court Motion to Dismiss Pursuant to 35 U.S.C. § 101
 - Patentable subject matter is not a ground that can be raised in an IPR
- The term argued in PO's Sur-reply ("simultaneous interactions") is **not present** in the claims

Exhibits 2006-2008 should be excluded as beyond the scope of a proper Sur-reply

- FRE 403: prejudicial, misleading, confusing, and/or a waste of time under
- 37 C.F.R. § 42.23(b): improper under new evidence (if not stricken)

'591 Pet. Motion to Exclude (Paper 41); Pet. Motion to Exclude (Paper 33); '448 Pet. Motion to Exclude (Paper 34);
Pet. Objections to Evidence (Papers 25, 35)

Reply ISO Petitioner's Motion to Exclude

- Petitioner's statements of the "abstract idea" that the claims are "directed to" for determining patentable subject matter **are not "contentions...regarding claim scope"** or claim construction
- Petitioner's argument that the claims do not recite the terms "synchronized" or "simultaneously" **is not inconsistent** with this abstract idea statement
- PO cannot read the term "simultaneous interactions" into the claims when they do not recite it