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Petitioner's Reply to Patent Owner's Response

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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. IPR2023-00341
Patent 9,483,448 B2

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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1001	U.S. Patent No. 9,483,448
1002	File History of U.S. Patent No. 9,483,448
1003	Declaration of Henry Lieberman
1004	Curriculum Vitae of Henry Lieberman
1005	International Patent Pub. No. WO 00/48110 to Lebrun et al. ("Lebrun")
1006	U.S. Patent Pub. No. 2005/0033656 to Wang et al. ("Wang")
1007	U.S. Patent Pub. No. 2005/0021626 to Prajapat et al. ("Prajapat")
1008	"NCSA Mosaic, Project Profile," University of Illinois, National Center for Supercomputing Applications (available at: https://www.ncsa.illinois.edu/research/project-highlights/ncsa-mosaic/)
1009	"Netscape Communications Corp.," Henry R. Norr, August 28, 2017, Encyclopedia Britannica, Inc. (available at: https://www.britannica.com/topic/Netscape-Communications-Corp)
1010	"50 Years of Email," cloudHQ, April 6, 2021 (available at: https://www.prnewswire.com/news-releases/50-years-of-email-301262676.html)
1011	"The History of Email: Major Milestones from 50 Years," Kasey Steinbrinck, January 28, 2021, Email on Acid Ina Fried, (available at: https://www.emailonacid.com/blog/article/email-marketing/history-of-email/)
1012	"10 Instant Messaging Services that Used to Be Popular," Elise Moreau, May 3, 2021, Lifewire Tech for Humans (available at: https://www.lifewire.com/once-popular-old-instant-messaging-services-3486135)

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1013	"Timeline of Social Media," Wikipedia (available at: https://en.wikipedia.org/wiki/Timeline_of_social_media)
1014	"Hyperlink," Wikipedia (available at: https://en.wikipedia.org/wiki/Hyperlink)
1015	U.S. Patent No. 5,708,780 to Levergood, et al.
1016	"Session Identification URI," W3C Working Draft WD-session-id-960221, w3 Org (available at: https://www.w3.org/TR/WD-session-id.html)
1017	"Giving Web a Memory Cost Its Users Privacy," John Schartz, September 4, 2001, New York Times (available at: https://www.nytimes.com/2001/09/04/business/giving-web-a-memory-cost-its-users-privacy.html)
1018	"GroupWeb: A WWW Browser as Real Time Groupware," Saul Greenberg and Mark Roseman, CHI '96 ACM Conference on Human Factors in Computing Systems, April 13-18, 1996 (available at: https://dl.acm.org/doi/pdf/10.1145/257089.257317)
1019	"Let's Browse: A Collaborative Web Browsing Agent," IUI '99: ACM Proceedings of the 4th International Conference on Intelligent User Interfaces, December 1998 (available at: https://dl.acm.org/doi/10.1145/291080.291092)
1020	"Letizia: An Agent that Assists Web Browsing," Henry Lieberman, <i>International Joint Conference on Artificial Intelligence</i> , 1995 (available at: https://web.media.mit.edu/~lieber/Lieberary/Letizia/Letizia-AAAI/Letizia.html)
1021	U.S. Patent No. 6,353,822 to Lieberman
1022	"Google Docs," Wikipedia (available at: https://en.wikipedia.org/wiki/Google_Docs)

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1023	"Google Announces Google Docs & Spreadsheets," October 11, 2006, Google Press Release, (available at: http://googlepress.blogspot.com/2006/10/google-announces-google-docs_11.html)
1024	"The History of JavaScript: Everything You Need to Know," T.J. DeGroat, August 19, 2019, Springboard (available at: https://www.springboard.com/blog/data-science/history-of-javascript/)
1025	"Adobe Flash," Wikipedia (available at: https://en.wikipedia.org/wiki/Adobe_Flash)
1026	"What Does AJAX Even Stand For?," Jay Hoffman, March 4, 2019, The History of The Web (available at: https://thehistoryoftheweb.com/what-does-ajax-even-stand-for/)
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1031	"Microsoft Computer Dictionary 5th Edition," May 01, 2002, Microsoft Press
1032	Claim 1 from each patent (as relied on during Friedman deposition)
1033	Transcript of Deposition of Stacy Friedman, taken November 15, 2023
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I. INTRODUCTION

Samesurf ("PO"), in its Patent Owner's Response ("POR"), cannot dispute that the claim limitations are rendered obvious by the prior art. In a desperate attempt to avoid a finding of unpatentability, they attempt to re-write the claims under an improper and unsupported claim construction, distort the plain teachings of the specification, concoct an attorney-argument irrelevant theory about a "middleman" server, and apply the wrong obviousness standard. The Board should disregard these arguments and find the challenged claims unpatentable.

II. PO'S INCORRECT & UNSUPPORTED CLAIM CONSTRUCTION**A. Synchronized Browsing Session**

Neither the claims nor the specification requires any synchronous sharing, despite PO's contrary arguments. The POR repeatedly relies on the term "synchronized browsing session" ("SBS") as the basis to assert that the claims require "the 'host device' and the 'invitee device' [be] synchronously sharing the same web browsing experiences and in real time." POR, 1-2. Not so.

The claims do not require "synchronously sharing the same web browsing experiences." As admitted by PO's expert Stacy Friedman, independent claims 1 and 11 only recite the SBS in the initial elements establishing the session and notifying the guest device of joining (1[pre]-1[c] and 11[pre]-11[e]). Ex. 1033, 238:24-239:5. The Board preliminarily found that both grounds rendered these claim limitations obvious; the POR did not refute that finding. DI, 17-20, 47-49.

Nor did PO argue that the preamble is limiting. The challenged limitations, aside from 1[c], do not recite the SBS, as Petitioner's expert concedes. Ex. 1033, 238:24-239:5. In deposition Mr. Friedman admitted he had not evaluated whether "synchronized browsing session" and "real-time" were co-extensive and provided no claim construction of either. *Id.*, 139:7-22, 197:9-198:19, 206:10-208:15.

According to the specification, "establishing" a SBS requires only (1) the host device to transmit a request to the synchronization server ("SS") and (2) the SS to respond with a confirmation and session identifier. Ex. 1001, 10:10-14. Establishing a SBS does not even require that the guest device has joined - once *established*, the host can transmit session invitations. *Id.*, 10:19-28 (emphasis added); FIG. 2(a). No synchronized transmission of data between the host and guest(s) is required. Ex. 1033, 229:23-230:8; *see also* Ex. 1003, ¶¶27-28; Ex. 1034, ¶7-9. Mr. Friedman agreed that "in order to understand what claim terms mean, looking at the specification is an important source of information." Ex. 1033, 115:18-20.

B. "Synchronized"

There is no requirement in the claims that any content be "synchronized" as between the host and guest devices, viewed "simultaneously" (or near simultaneously), nor "coordinated" in any manner, as PO's expert admitted. *See* Ex. 1033, 239:6-13, 240:2-24. Indeed, while admitting that the internet is "laggy," Mr. Friedman could not answer how a POSITA would be able to tell whether

communications would be too laggy to be considered “synchronized.” *Id.*, 216:12-217:7, 220:14-19, 221:6-11.

Yet PO repeatedly criticizes the applied references as *not disclosing* synchronized browsing. The POR attempts to distinguish Prajapat as having “no teaching or suggestion [] that the two browsers are *simultaneously*, or even *nearly simultaneously*, sharing internet browsing on the same web page *in real time*.” POR, 63-64 (emphasis added). These arguments are a distraction; the claims recite *none of* these terms.

Even if the claims required content to be synchronized – which they do not – the plain and ordinary meaning of that term is “occurring at the same time,” a definition supported by both Dr. Lieberman’s testimony and The Microsoft Computer Dictionary, 5th Edition. *See* Ex. 1031, 506; Ex. 1034, ¶¶10-12. Despite the term “synchronized” being the basis for PO’s argument, PO’s expert admitted he did not construe the term. Ex. 1033, 61:22-62:4. Indeed, Mr. Friedman refused to define “synchronized” when questioned or to provide an opinion whether the dictionary definition was reasonable. *Id.*, 36:11-21, 56:9-60:12, discussing Ex. 1031, 506. His deposition position was only that a POSITA would understand the term’s meaning. Ex. 1033, 36:11-21.

PO provides no reason that a POSITA would construe the term “synchronized” in Prajapat differently from the term’s meaning in the ’448 patent.

Ex. 1034, ¶10. Nevertheless, Mr. Friedman would not take a position on whether the meaning of the term would be the same as between the two. Ex. 1033, 125:6-126:23; *see also id.*, 210:24-211:1.

Notably, the dictionary definition of “synchronized” as “occurring at the same time” is very similar to that of the term “dynamic” as “occurring immediately and concurrently.” *See* Ex. 1031, 181. This similarity is important because the term “dynamic” appears throughout both the Lebrun and Prajapat references. Ex. 1034, ¶10.

C. “Information related to the shared web browsing interaction”

PO's proffered construction of this term is both incorrect and contrary to the Board's position upon institution. The POR argues the correct construction of “information related to the shared web browsing interaction” (“IRTTSWBI”) is “data describing interactions performed on a website by a host device,” and it excludes “webpage data.” POR, 34-36. PO's expert testified that he “did not proffer a formal construction” of the term and refused to do so during his deposition but asserted that “it doesn't include web pages or snapshot data.” Ex. 1033, 187:7-184:15. PO's construction is incorrect.

Upon institution, the Board made several findings regarding the term. The Board indicated that [1.e] merely required that it was “information” “related” in some way “to the shared web browsing interaction.” DI, 23; *accord id.*, 27. This

statement correctly reflects the breadth of the term, whereas PO's construction seeks to improperly narrow the interpretation that the information is "related to" interactions to "describing" interactions. Neither the claim language nor the specification supports such a narrowing. Ex. 1034, ¶¶13-14; *see also* Ex. 1003, ¶¶163-164.

Nor does support exist for further narrowing the interactions "describ[ed]" to those "performed on a website *by a host device*." POR, 34-35 (emphasis added). Here, PO contradicts itself later in the POR, when it argues that IRTTSWBI must comprise "web browsing interactions" to be "performed *by the guest device*." POR, 49. PO's proffered construction fails for even its own arguments. Ex. 1034, ¶15.

Upon institution, the Board correctly disagreed with PO's assertion that the term "cannot encompass web pages that are shared across the browsers engaged in the co-browsing or sharing session." DI, 54. PO repeats its argument without explaining why the Board should reverse its preliminary position. POR, 36. PO's position also is at odds with statements made by PO's expert that "the primary way that a user interacts with a web page is through a web browser." Ex. 2004, ¶45; *accord* Ex. 1033, 171:24-172:18, 177:16-178:6. It is unclear how, if a web browser is the "primary way" that a user *interacts with a web page*, that the web page would not be part of the "information *related to* the shared web browsing interaction."

Indeed, it would be difficult to describe a web browsing interaction without describing the web page interacted with. Ex. 1034, ¶16.

D. Limitation [1.f] Subparts [1.f.i]-[1.f.iii]

Limitations [1.f.i]-[1.f.iii] were renumbered and designated “subparts” of [1.f] by the Board (DI, 23, 24, 26, 37, 50) and recite “wherein” clauses that modify limitation [1.f] and describe the intended use of the information related to the shared web browsing interaction. A clause in a method claim “is not given weight when it simply expresses the intended result of a process step positively recited.” *Minton v. Nat’l Ass’n of Sec. Dealers, Inc.*, 336 F.3d 1373, 1381 (Fed. Cir. 2003); *see also Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1376 (Fed. Cir. 2001). Claim 1 recites a method that is performed by a host device, while subparts [1.f.i]-[1.f.iii] recite limitations not performed by the claim actor, i.e., the host device. Thus, these “wherein” clauses indicate the intended use of the IRTTSWBI and should not be given weight.

III. LEBRUN AND WANG RENDER THE CLAIMS OBVIOUS (GROUND 1)

A. That Ground 1 Discloses Limitations [1.pre]-[1.b] Is Not In Dispute

Only limitations [1.c]-[1.g] are in dispute.¹ PO did not challenge Petitioner's arguments for any other claim limitations, which thus should be deemed waived. Paper 14, 10; *see also* Ex. 1033, 70:22-71:9.

B. Ground 1 Discloses Limitation [1.c]

Lebrun and Wang disclose “sending an invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier.”

PO has done nothing to disturb Petitioner's showing that Lebrun's session-creation message 151, which includes an identifier for the group-surfing session, discloses this limitation, with which the Board preliminarily agreed upon institution. DI, 19-20; *see* Pet., 25. Indeed, PO's entire argument is based on an incorrect premise – that the host must send the invitation to the invitee device *directly*. POR, 41-42. The claims do not recite such a requirement; PO may not write one in. Ex. 1003, ¶37.

¹ With respect to independent claim 11, the POR says only that “[t]he arguments presented regarding independent claim 1 also apply to independent claim 11.” POR, 12.

PO's own arguments confirm that Lebrun discloses [1.c]. PO admits that in Lebrun, (1) the controlling web client (host) sends the session-creation message, which includes identifiers for web clients 110 participating in the session (invitees), and (2) the group-surfing server (SS) then informs the participants (invitees) that they are invited to join the session. POR, 41-42. The host sends the message that is forwarded to the invitee, which meets the limitation. Ex. 1003, ¶¶37, 149.

PO makes a similar admission regarding Wang: "the *invitation message* from the first client device (T5) is sent to the server apparatus (T6) ... [which] then "transmits *an invitation notice*...to a second client device." POR, 42 (emphasis added), citing Ex. 1007, ¶¶47-48. Despite PO's assertions to the contrary, the Petition explicitly teaches the motivation for combining Lebrun and Wang. Although PO incorrectly argues that "[t]here is no evidence that Lebrun's group-surfing session is in any way compatible with Wang's 'communication means,'" the Petition identifies such evidence: "both Lebrun and Wang describe a process in which a first user initiates a collaborative browsing session by sending a request to a server to create a group browsing session and to send invitations to other users to join the session." Pet., 19 (VII.D., cited at Pet., 25). As noted in the Petition, this "is a combination of prior art elements according to known methods yielding predictable results." *Id.*

C. Ground 1 Discloses Limitation [1.d]

Lebrun discloses “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.” PO has done nothing to disturb the Board’s preliminary finding that Petitioner’s position is a “reasonable reading” of “*unambiguous passages* in Lebrun.” DI, 21 (emphasis added). In particular, Petitioner demonstrated that (1) Lebrun’s selection of pages to be viewed in the session determines at the controlling web client (host) whether pages are appropriate for the web clients (invitees) participating in the session, which indicates whether the web browsing interaction is shareable; and (2) Lebrun’s program fragment at the controlling web client (host) records the selection and transmits it to the group-surfing server (SS). Pet., 25-26; DI, 20-21. Indeed, the POR did not acknowledge the Board’s preliminary finding or provide any basis for challenging it. *See* POR, 43-44.

PO cannot cure this deficiency by arguing that the program fragment “intercepting” the link selection means the controlling web client (host) does not access the webpage from the website server. POR, 44; Ex. 1003, ¶¶169, 173. As described above, the controlling web client’s (host’s) *selection of pages* to be shared in the session occurs *before* the program fragment *records* that information. Pet., 25-26; DI, 21. For the controlling web client (host) to make that selection, it “looks

ahead” (accesses) the pages to be able to decide which should be shared. Ex. 1005, 37:27-38:13; Pet., 25-26. The controlling web client (host) thus accesses the webpage directly as an initial step. Indeed, the program fragment is described as *residing at the web client*, after being sent to it by the personalization server. Ex. 1005, 26:13-22; *see also id.*, 36:22, 36:27-29, 65:1-3.

The POR also fails with its weak attempt to distinguish the program fragment's catching/intercepting from recording. POR, 43-44. The POR provides no rationale as to why catching/intercepting is different from recording. The cited portion of PO's expert declaration (Ex. 2004, ¶74) fails to address this topic.² *Id.* Lebrun discloses that the program fragment can manage databases; a POSITA would understand that it is capable of “recording” such information. Ex. 1005, 49:13-14; Ex. 1003, ¶¶162-163. Moreover, Lebrun says repeatedly that the program fragment “is disposed for *recognizing a post command* from” the web client about the webpage, which discloses the host determining that the web browsing interaction is sharable. Ex. 1005, 83:16-23; *see also id.*, 37:8-10.

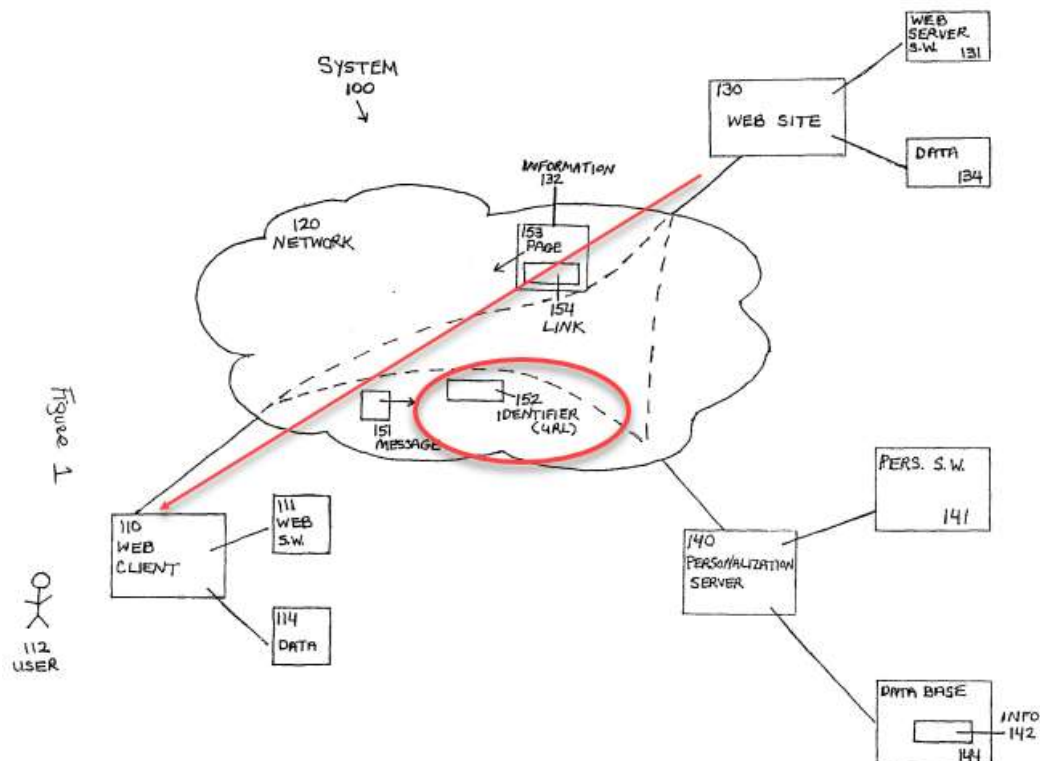
D. Ground 1 Discloses Limitation [1.e]

Lebrun discloses “sending a request for webpage content to a website server independent of the synchronization server.”

² Ex. 2004, ¶74 is focused on the relationship between [1.d] and [1.e].

The POR does not mention the Board's preliminary finding that the Petition's proffered evidence meets this limitation. DI, 20-21; *see* POR, 44-46.

Consistent with the Board's preliminary determination, Lebrun discloses in one of the cited portions that "[i]n a preferred embodiment, the message 151 can also include an *identifier 152* for an initial page 153 for the group-surfing session." Ex. 1005, 32:21-24 (emphasis added). As shown in FIG. 1, annotated below, "identifier 152" is a URL, and the web site 130 sends the initial page 153 *directly* to the web client 110, as indicated by the arrow at "Page 153." Ex. 1005, FIG. 1.



Indeed, in the text immediately preceding, Lebrun explains this step: "[i]n 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.” Ex. 1005, 31:27-30 (emphases added). Thus, the “Page 153” delivered is in response to *a request from the web client*.

PO does not address the fact that the message 151 includes an identifier 152 (URL), despite the Board's specifically listing this evidence as Petitioner's proffered rationale. DI, 22. Nor does the POR rely on any contrary expert testimony to refute Dr. Lieberman's supporting the Petition. Ex. 1003, ¶165, cited at Pet., 27. Conclusory attorney argument [is] insufficient in response to expert testimony. *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, IPR2016-00393, Paper 62, 36-37 (P.T.A.B. June 23, 2017), *citing In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

PO's final argument is a return to the failed capture/intercept argument from [1.d]. POR, 45. There is no temporal requirement in the claim that [1.e] must occur subsequent to [1.d], as the POR implies. *Id.*; *see also* Ex. 1033, 242:10-243:12 (temporal requirements).

E. Ground 1 Discloses Limitation [1.f]

Lebrun discloses “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.”

PO has done nothing to disturb the Board's preliminary finding that Petitioner's proffered evidence satisfies this limitation. DI, 37. The Board emphasized multiple times that the language of the terms recited in limitation [1.f] and its subparts is "broad" and does not support the narrower reading argued by PO. *Id.*, 23-24. In particular, for IRTTSWBI, the Board considered that information as being "information" "related" in some way "to the shared web browsing interaction," and found that the scope of IRTTSWBI encompasses Petitioner's application of Lebrun sufficiently for institution. *Id.*, 23, 33; *see also supra* Section II.C.

As discussed *supra* in conjunction with limitation [1.d], Lebrun's program fragment, after recording the selection, ***transmits it to the group-surfing server*** (synchronization server). Pet., 25-26. PO appears not to dispute this, since PO itself argues that the program fragment at the web client "sends [the] selection to the group-surfing server." POR, 43.

F. Ground 1 Discloses [1.f.i]-[1.f.iii]

As discussed *supra* in the claim construction section, limitation [1.f] subparts [1.f.i]-[1.f.iii] recite intended use of IRTTSWBI, as performed by entities other than the claim actor (host), such as by the invitee device ([1.f.i], [1.f.iii]) and the SS ([1.f.ii]). *See supra* Section II.D. Nonetheless, Ground 1 discloses limitation [1.f] including all of its subparts, as the Board preliminarily recognized. DI, 37.

1. Ground 1 Discloses [1.f.i]

Lebrun discloses “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 substantially the same webpage content as the request for the webpage content from the host device.”

Upon institution, the Board noted that the claim language of limitation [1.f.i] broadly recites the invitee device being enabled to generate a request to retrieve substantially the same webpage content, but *does not require a particular manner of doing so*. DI, 29. Indeed, the language of the claim recites only that the information “*enables* the invitee device to generate a request.” The Board explicitly disagreed with PO that the IRTTSWBI must necessarily enable the invitee device to generate the request to retrieve the webpage content “on its own.” DI, 28. Limitation [1.f.i] recites no such language and does not even positively recite that the invitee device needs to make the request, only that it is *enabled* to do so. PO's attempt to distinguish between “retrieving” and “receiving” (POR, 50-51) fails for a similar reason. The claim recites only that the IRTTSWBI “*enables* the invitee device to generate a request to retrieve substantially the same webpage content”; neither “retrieving” nor “receiving” are required.

Moreover, even if the claim had required the invitee device to retrieve the webpage content on its own – which it does not – Lebrun discloses doing so. As the

Board preliminarily agreed, Lebrun describes that each web client can receive the next web page *directly from the web site*. DI, 32, citing Ex. 1005, 35:17–19. Indeed, Lebrun further describes or suggests that the web client *retrieves* the webpage content directly from the website in some embodiments. Pet. 20, 32-33; Ex. 1005, 35:17-19, 46:1-2; Ex. 1003, ¶¶165, 173, 180; *see* DI, 37.

Next, PO repeats its failed “result” argument from the POPR that the IRTTSWBI “must comprise “web browsing interactions” *to be performed* by the guest device.” POR, 49; Ex. 1034, ¶15. The Board noted upon institution that the claim language merely indicates that the information request would “*result in* the retrieval of substantially the same web page content”; it does not require an identical request. DI, 30. Indeed, the Board noted that PO failed to identify any claim language requiring the invitee device *to independently replicate* actions performed by the host device to access the same web content. DI, 29. PO does not explain why the Board should reverse its preliminary stance on this topic.

With respect to Wang, PO incorrectly relies on its construction of IRTTSBI as not including web pages or snapshot data. POR, 52. As discussed *supra*, this language is not so limiting. *See supra* Section II.C. Here again the POR did not cite to any expert support for its position. *See In re Schulze*, 346 F.2d 600, 602 (CCPA 1965); *In re Geisler*, 116 F.3d 1465 (Fed. Cir. 2016).

2. Ground 1 Discloses [1.f.ii]

Lebrun discloses “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.”

PO has done nothing to disturb the Board's preliminary finding that Petitioner correctly relies on Lebrun's *unambiguous description* to show that it meets this limitation. DI, 33; Pet. 30 (citing Ex. 1005, 35:17-19). PO also appears again to rely on its mistaken construction of IRTTSWBI. DI, 32-33.

As discussed regarding limitation [1.c], PO *acknowledges* that Lebrun's group-surfing server (SS) informs the participants (invitees) that they are invited to join the session. *See supra* Section III.B. This action is the recited “transmitting” of this limitation subpart.

Likewise, PO *admits* that in Wang “the invitation message from the first client device (T5) is sent to the server apparatus (T6) [synchronization server] ... [which] then “transmits an invitation notice...to a second client device [invitee].” POR, 42. Thus, Wang also discloses this “transmitting” limitation subpart.

PO makes a final failed strawman argument that “there is no *synchronization* between the client devices” in Wang. POR, 54. But the claim has no such

requirement, as admitted by PO's own expert. *See* Ex. 1033, 238:24-239:5.

Petitioner need not show an unrecited limitation.

3. Ground 1 Discloses [1.f.iii]

Lebrun discloses “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.”

The POR again does nothing to refute the Board's preliminary finding that “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*.” DI, 36 (emphasis added), citing Ex. 1005, 35:17-19; Pet. 30. And PO again attempts to distinguish between “retrieving” and “receiving,” without citing to any expert or other support for its position. POR, 54-55; *see supra* Section II.C. As discussed *supra* regarding [1.e], Lebrun explains that 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.” Ex. 1005, 31:27-30 (emphases added). Thus, Lebrun discloses that content sent from the web site to the

web clients is the result of requests from the web clients. *See supra* Section III.D; Ex. 1003, ¶183.

PO mischaracterizes the Petition's motivation to combine Wang's "server apparatus" having integration and synchronization functionality with Lebrun's "group-surfing server." POR, 55. Contrary to PO's statement, the Petition provided ample rationale for the combination, including that it is a combination of prior art elements according to known methods yielding predictable results. Pet., 35; *see also id.*, 18-19, Ex. 1003, ¶184. Following this mischaracterization, PO provides no discernable reasoning challenging it. POR, 55. A POSITA would have been motivated to combine Wang's "server apparatus" having synchronization functionality with Lebrun's "group-surfing server." Ex. 1003, ¶184.

G. Ground 1 Discloses Limitation [1.g]

Lebrun discloses "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."

As discussed regarding limitation [1.e], Lebrun discloses that "[i]n a preferred embodiment, the web site 130 includes a processor ... 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." Ex. 1005, 31:27-30

(emphases added); *see also supra* Section III.D; Ex. 1034, ¶17. The Board preliminarily found that the Petition's proffered evidence met this limitation. DI, 37; *see* POR, 55-56.

H. Lebrun Contemplates Combining Embodiments

Contrary to PO's argument that Lebrun's embodiments should not be combined, Lebrun explicitly contemplates considering variations of its embodiments. PO does not address that it made this argument in its POPR, but the Board found Petitioner's showing sufficient for institution. DI, 17-18, 38.

In the Summary section, Lebrun contemplates "an improved technique for group access to web sites," before delving into the various embodiments. Ex. 1005, 7:3-16; *see also* Ex. 1003, ¶277 (p. 107). Lebrun explicitly notes that "[a]lthough preferred embodiments are disclosed herein, many variations are possible which remain within the concept, scope, and spirit of the invention, and ***these variations would become clear to those skilled in the art after perusal of this application.***" Ex. 1005, 75:18-20 (emphasis added); *see also id.* 37:21-25, 44:1-3. Indeed, the "multiple group surfing channels" (Ex. 1005, 43:5) that PO calls out as a discrete embodiment is actually a sub-heading under the heading "***variations on*** the group-surfing session." Ex. 1005, 37:19 (emphasis added); Ex. 1034, ¶18. 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 Corp., 554 F.3d 982, 991 (Fed. Cir. 2009). Thus, PO has provided no reason why a POSITA would not consider all of the various embodiments in Lebrun, nor any rationale for why the Board should reconsider its preliminary finding that did the same. Ex. 1034, ¶18.

IV. PRAJAPAT AND WANG RENDER THE CLAIMS OBVIOUS (GROUND 2)

A. Prajapat Contemplates Combining Embodiments

Prajapat *explicitly contemplates* combining its embodiments. The POR's primary argument regarding Ground 2 appears to be that Prajapat's embodiments should not be combined, but the Board correctly rejected this argument upon institution. POR, 71; *see* DI, 55-56. In addition, the POR does not provide any limitation-by-limitation analysis for Ground 2.

The Board addressed and preliminarily disagreed with PO's position that Petitioner provided no evidence for its citations to the different varieties of peer-to-peer web page sharing, as well as noting that the cited passages from the "dynamic" sharing portions "on their face *seem applicable to web page sharing generally* and cover activities not discussed with specificity" in the "simple" sharing system. DI, 55-56 (emphasis added). The POR cites no support whatsoever for its argument that the Board's conclusion does "not amount to a sufficient rationale." POR, 72.

PO also incorrectly argues that the premise that the architectures of the different web sharing systems are combinable is "unsupported by the specification."

POR, 71. Not so. The “dynamic” sharing section of the Prajapat specification repeatedly indicates its broad applicability beyond the specifics described. For example: “system 10 may be implemented *in any suitable environment* where co-browsing may be desired” (Ex. 1007, [0012] (emphasis added)); “[w]hile system 10 is illustrated as including particular elements in a specific configuration, *the functionalities of these elements may be combined, separated, and/or rearranged as appropriate*” (*id.*, [0013] (emphasis added)); “*functionality described* in connection with browser 12a, web media server 14a, and web content server 18 *may be provided using a single computer system or other device*, which in a particular embodiment might include a single server system” (*id.*, [0014] (emphasis added)).

Moreover, the Board, in related case IPR2022-00342, recognized upon institution that Prajapat related the embodiments: “Prajapat expressly indicates that the web page sharing of Figure 3 is the same as that described in the dynamic web page sharing embodiment of Figures 1 and 2.” IPR2022-00342, Paper 12 at 40 (citing Ex. 1007, [0047]); *see also* Ex. 1007, [0041] (relating FIG. 3 to FIGS. 1 and 2); [0045] (relating FIG. 4 to FIGS. 1, 2, and 3). Thus, Prajapat *explicitly connects* the various embodiments. *See also Boston Scientific*, 554 F.3d at 991. The case law PO cited – finding that a motivation is required to combine embodiments within a single reference – is rendered moot since *Prajapat itself* provides that motivation. *See* POR, 71-74; DI, 55-56; *see also* Ex. 1034, ¶¶19-20.

B. Prajapat Discloses “information related to the shared web browsing interaction” as recited in [1.f]-[1.g]

PO's broad argument that Prajapat does not disclose “information related to the shared web browsing interaction” fails for several reasons. First, as discussed *supra*, PO's construction of IRTTSWBI is incorrect. *See supra* Section II.C. Upon institution, the Board considered the term as including “information” that is “related” in some way “to the shared web browsing interaction.” DI, 23.

PO's additional attempt at a red herring argument for Ground 2 again fails. The language upon which PO relies does not reflect the actual claim language. PO argues that “in neither of Prajapat's embodiments does Prajapat teach or suggest the use of information related to the shared web browsing interaction that a “guest device” receives from a “synchronization server” and *uses to request web content from a website server.*” POR, 57-58 (emphasis added). But claim 1 does not require the invitee device to “use” the information related to the shared web browsing interaction. Rather, the claim merely recites the “invitee device retriev[ing] data from the website server *in response to* receiving” the information.

As discussed *supra*, the limitations recited in [1f.i]-[1f.iii] recite an intended use. *See supra* Section II.D. All that is required of the host with respect to the IRTTSWBI is to transmit it to the synchronization server after sending the request for webpage content to the website server (1[f]) and receive the requested webpage content after that transmitting (1[g]).

V. THE DEPENDENT CLAIMS ARE RENDERED OBVIOUS

As a preliminary matter, the POR does not refute any of Petitioner's arguments regarding dependent claims 2-3, 7, 10, 12, or 16 of either ground, nor for claim 6 of Ground 2. Thus, these dependent claims are not in dispute.

For claims 4-6, PO relies on its failed arguments for independent claim 1. *See supra* Sections III.B., III.E., IV.A; *see also* DI, 39-44, 56-57; Ex. 1034, ¶¶13-16.

For claims 8-9 and 14-15, the POR again relies on its failed arguments for claim 1. In particular, for claims 8 and 14, PO falls back on its incorrect position that web pages are not web browsing interactions. POR, 77. However, as discussed in conjunction with the construction of "information related to the shared web browsing interaction," a web browsing interaction is *with the web page*. *See supra* Section II.C.; *see also* Pet., 43, 69; Ex. 1034, ¶¶16, 21. Likewise, for claims 9 and 15, PO repeats its failed arguments; Petitioner demonstrated that Lebrun's selection of pages indicates whether the web browsing interaction is shareable. *See supra* Section III.C.; *see also* Pet., 25-26, citing Ex. 1003, ¶¶209-210, 218-219; DI, 20-21; Ex. 1034, ¶21.

VI. PO'S EXHIBIT 2005

PO's unexplained reference to a district court denial of Intuit's motion to dismiss under 35 U.S.C. §101 (POR, 36-37) is irrelevant because that order pertained to a different issue (abstract idea as opposed to obviousness), with different evidence (a question of law on the pleadings as opposed to a factual inquiry on prior art),

under a different standard (clear and convincing as opposed to preponderance of the evidence).

VII. PO HAS WAIVED ISSUES NOT ADDRESSED IN THE POR

Per the Scheduling Order, "Patent Owner is cautioned that any arguments not raised in the response may be deemed waived." Paper 13, 10. Nor can arguments from the POPR be incorporated by reference into the POR. *See* 37 CFR §42.6(a)(3). As a result, any arguments not presented or maintained in the POR are considered waived."³

VIII. PO'S ATTEMPTS TO INCORPORATE BY REFERENCE ARE IMPROPER

PO repeatedly violates the rules by citing to swathes of its expert declaration to support conclusory statements made in the POR, which is a violation for at least two reasons. First, PO should not ask Petitioner and the Board "to play archeologist with the record"; "a brief must make all arguments accessible to the judges." *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 10 (P.T.A.B. Aug. 29, 2014), quoting *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999). Second, papers in an IPR also should not attempt to incorporate by reference

³ This includes arguments about whether Dr. Lieberman qualifies as a POSITA not maintained from the POPR. Mr. Friedman verified during his deposition that he did not address this topic. Ex. 1033, 29:8-25.

arguments made in an expert report. 37 CFR §42.6(a)(3); *Blackberry Corp. v. Mobilemedia Ideas LLC*, IPR2013-00016, Paper 32 at 21 (P.T.A.B. Feb. 25, 2014) (attempt to incorporate by reference expert testimony was prohibited); *Cisco Sys.*, IPR2014-00454, Paper 12 at 9-10 (arguments not made in papers but only by reference to expert declaration not considered by Board).

The POR repeatedly cites to six to 10 paragraphs of expert testimony as allegedly supporting an argument made in the POR, the most egregious examples of which cite to the entire section of the expert report corresponding to a reference. *See, e.g.*, POR, 57 (citing to ¶¶57-66, which is the entirety of the Prajapat “overview”; ¶¶75-81, which is the entirety of the Prajapat “discussion”; and ¶¶82-89, which is the entirety of the Wang “discussion”), and 71 (citing to ¶¶75-81, which is the entirety of the Prajapat “discussion”). These citations force the reader “to play archeologist with the record” to understand what in these large swaths of cited expert testimony pertain to the arguments in the POR for which they are cited. *Cisco Sys.*, IPR2014-00454, Paper 12 at 10. Moreover, such incorporation by reference “amounts to a self-help increase in the length of the [] brief[.]” *Id.* Thus, arguments not made in the papers should not be considered by Board. *Id.*

IX. PO'S EXPERT TESTIMONY IS LIMITED AND NOT SUPPORTED BY EVIDENCE

As called out in the analysis above, portions of the analysis in the POR are not supported by Mr. Friedman's expert testimony or other evidence. Mere attorney

argument cannot take the place of evidence in the record, nor can it rebut contrary expert testimony. *In re Schulze*, 346 F.2d at 602; *In re Geisler*, 116 F.3d at 1465.

Of the expert testimony relied upon in the POR, the vast majority of Mr. Friedman's opinions consist of only ***conclusory assertions*** without underlying factual support, and thus they should be given little weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 at 5 (P.T.A.B. Feb. 10, 2023). Indeed, aside from a patent describing cookies at Ex. 1003 ¶37, the relied upon testimony ***cites to no authority or exhibits*** and on the whole lacks evidentiary support. As a result, Mr. Friedman's testimony should be given little weight.

X. CONCLUSION

For the reasons discussed herein, the Board should find the challenged claims unpatentable.

Dated: December 20, 2023

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**CERTIFICATE OF COMPLIANCE
WITH TYPE-VOLUME LIMITATION**

Pursuant to 37 C.F.R. § 42.24 *et seq.*, the undersigned certifies that this **Petitioner's Reply to Patent Owner's Response** complies with the 5,600 word type-volume limitation. The Petition contains 5,592 words, excluding the parts of the Reply exempted from the type-volume limitation.

Dated: December 20, 2023

Respectfully submitted,

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on December 20, 2023, I caused a true and correct copy of the foregoing PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE and Exhibits 1031 – 1034 to be electronically served on Petitioner's lead and backup counsel at the following addresses:

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