

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.
Petitioner

v.

SAMESURF, INC.
Patent Owner

Case IPR2023-00341
U.S. Patent No. 9,483,448

PATENT OWNER'S SUR-REPLY

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Patent Trial and Appeal Board
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2003	Declaration of David S. Howell
2004	Declaration of Stacy Friedman
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2006	Defendant Intuit Inc.'s Memorandum of Points and Authorities in Support of Motion to Dismiss Pursuant to Fed.R.Civ.P. 12(b)(6) (Case No. 3:22-cv-00412-LL-KSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)
2007	Defendant Intuit Inc.'s Reply in Support of Motion to Dismiss Pursuant to Fed.R.Civ.P. 12(b)(6) (Case No. 3:22-cv-00412-LL-KSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)
2008	Corrected Notice of Allowability for Application No. 14/830,710 (U.S. Patent No. 9,483,448)

I. INTRODUCTION

Petitioner has ***not*** met its burden of proving that claims 1-16 of the '448 Patent would have been obvious to a POSITA at the time of invention over Lebrun (Ex. 1005) in view of Wang (Ex. 1006) (Ground 1) or over Prajapat (Ex. 1007) in view of Wang (Ground 2).

First, the '448 Patent claims require a “synchronization server,” which as shown by PO throughout its submissions herein, is vastly different in terms of form, function, and purpose than Lebrun’s “Group Surfing Server,” Prajapat’s “Web Media Server” and Wang’s “Server Apparatus.” Session participants in Lebrun, Prajapat and Wang engage in a resource intensive “page sharing” process that requires that a “middleman” server continuously request, receive, reassemble, and deliver *webpage content* to the participants via the middleman server’s interactions with the web server. In the '448 Patent claims, the invitee devices in PO’s system engage in a resource efficient “synchronized browsing session” wherein each receives “information related to the shared web browsing interaction” (“IRTTSWBI”) from the “synchronization server,” thereby allowing the invitee device to make its own request to the web server to thereby independently replicate the host’s web browsing interactions in real time. These fundamental differences in components, topology, and flows would not have been obvious to a POSITA at the time of the '448 Patent, and Petitioner has not met its burden of proving otherwise.

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

Third, Petitioner incorrectly contends that the claims do not require “two browsers [that] are simultaneously, or nearly simultaneously, sharing internet browsing of the same webpage in real time” by *ignoring its own contentions* before the District Court that the Asserted Claims (including the ’448 Patent) “make clear that sending and receiving information for simultaneous interactions is the focus of the Asserted Claims.” Exs. 2006, 7:11-12 and 2007. The District Court adopted a more detailed description of the claims, finding that the claims are “directed to performing a synchronized browsing session between two electronic devices (a host device and a guest/invitee device) via a synchronization server.” Ex. 2005, 10:4-21; and

Fourth, Petitioner fails to prove that Lebrun and Prajapat disclose at least limitations [1.c]-[1.g] and that a POSITA would have been motivated to combine either reference with Wang. Petitioner cannot prove that Lebrun or Prajapat disclose limitations [1.c]-[1.g] because both require a “middleman” server, which, contrary to limitations [1.c]-[1.g], sends web content that the “middleman” server received from a website and then transmits to the session participants. Thus, Lebrun and

Prajapat fail to provide “synchronized browsing sessions” that do not “materially impos[e] more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods.” Ex. 1001, 5:34-37.

II. SUR-REPLY ARGUMENTS

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

Petitioner wrongly contends that the plain meaning of IRTTSWBI is “any information related to the shared web browsing interaction.” Ex. 1034, ¶13; Pet. Reply, 4-5. The methodology used by Petitioner and its expert to determine the ordinary and customary meaning of IRTTSWBI is incorrect as a matter of law.

By simply adding the word “any” to the beginning of the claim term, Petitioner *never* consults the specification or even considers what the meaning of the term would have been to a POSITA after reading the entire patent at the time of the ’448 Patent. Petitioner thus *errs* by viewing the claim term in the abstract, rather than within the context of the patent or in view of the POSITA. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2004) (*en banc*) (“The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent. Properly viewed, the ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent.”).

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

Patent Owner (“PO”) contends that a POSITA reading the claims in light of the specification would have understood that the term IRTTSWBI refers to “data describing interactions performed on a website by a host device,” which does not include “webpage data” (the claimed “data from the website server”) retrieved in response to a web request. Patent Owner’s Response (“POR”), 15-22; 25-37. Petitioner contends that PO’s construction incorrectly imports limitations from exemplary embodiments into the claim term. Pet. Reply, 4-6. PO is not importing a limitation.

PO’s construction recognizes the distinction in the specification between “webpage interaction information” (*i.e.*, “information related to a [] web browsing interaction” (Ex. 2004, ¶41)), which is sent from the synchronization server to the invitee device, and webpage data, which is retrieved by the invitee device from the website server in response to the webpage interaction information. POR, 29-36; Ex. 2004, ¶¶37-39, 44-45. Importantly, PO’s construction matches precisely with the understanding of the Examiner who allowed the claims in the first place:

*“Further, the claims present[] that it is actually determined that **the web browsing interaction is a shareable web browsing interaction, which is an active step that must be performed**, meaning that the system could also determine that a web browsing interaction*

within the web browsing window is not a shareable interaction. These changes together are not considered to be fairly taught or suggested by the prior art of record in view of claims 1 and 13, as a whole.”

Ex. 2008, 10.¹

There is no written description in the specification to support a claim scope for IRTTSWBI that includes webpage data retrieved in response to a web request. Therefore, such a broad reading would not be in accordance with the ordinary meaning of IRTTSWBI in view of the specification. Ex. 2004, ¶¶37-39, 40-46.

Petitioner ignores the fact that, unlike the known methods that allow users to view the same webpages while requiring high levels of bandwidth and computer processing power (Ex. 1001, 2:26-44), “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, 5:34-37. *See Netcraft Corp. v. eBay, Inc.*, 549 F.3d 1394, 1398 (Fed. Cir. 2008) (“[T]he common specification’s repeated use of the phrase ‘the present invention’ describes the invention as a whole”); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) (“When a patent thus describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.”).

¹ All emphasis added unless otherwise noted.

This requirement—“not materially imposing more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods”—is met by the claims, because the IRTTSWBI sent from the synchronization server to the invitee device does not include webpage data retrieved in response to a web request. Therefore, as this webpage data is not included with the IRTTSWBI, only conventional web requests are used and no more bandwidth or processing power requirements are necessary than “simply browsing the internet using standard, conventional methods.” Ex. 1001, 5:34-37. This is the typical and long-known method for how web browsers interact with web servers. Ex. 2004, ¶38.

However, under Petitioner’s contention, if the IRTTSWBI includes webpage data retrieved in response to a web request, then, pursuant to limitation [1.f] of claim 1 of the ’448 Patent, this webpage data would be transmitted by the synchronization server to the invitee device *and*, pursuant to steps [1.f.i] and [1.f.iii], the invitee device would process the IRTTSWBI, including this webpage data, to generate a request to retrieve substantially the same webpage content as the request for the webpage content from the host device. This scenario, which includes an extra transmission of webpage data (from the synchronization server to the invitee device) and the use of webpage data by the browser on the invitee device to retrieve webpage content, would impose materially more bandwidth and processing power requirements than simply browsing the internet using standard, conventional

methods. Therefore, this scenario would be *inconsistent* with the “present invention,” as described in the specification and as claimed.

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

Petitioner contends that the claims of the ’448 Patent do not require “any synchronous sharing” (Pet. Reply, 1) or that “any content be ‘synchronized’ as between the host and invitee devices, viewed ‘simultaneously’ (or near simultaneously), nor ‘coordinated’ in any manner” (Pet. Reply, 2).² Petitioner’s citations to Mr. Friedman’s declaration do not support its contention, as Mr. Friedman testified that “synchronized browsing session” is recited in the preamble and in limitation [1.b]. Ex. 1033, 221:21-23. Moreover, Petitioner’s arguments that Mr. Friedman did not construe the terms “synchronized” and/or “synchronized browsing session” are a distraction. Pet. Reply, 1-4. Mr. Friedman repeatedly asserted that these terms were given their plain and ordinary meaning. *See, e.g.*, Ex. 1003, 32:3-8; 33:9-25; 36:11-21; 203:14-204:6. Similarly, Petitioner’s citation to Ex. 1034, ¶¶12-14 is of no support, since this is merely its expert’s declaration statement regarding a communication message and the meaning of “web browsing interaction data.”

² The Board should give no weight to Petitioner’s newly-offered construction of the term “synchronous” or its definition for “dynamic,” as Petitioner simply cherry-picked definitions from a dictionary without providing any evaluation of the intrinsic evidence. Pet. Reply, 3.

Regardless, the Board should disregard Petitioner’s current contentions, as they are *contrary* to Petitioner’s own prior contentions before the District Court in its Motion to Dismiss. Exs. 2006 and 2007. In that Motion, Petitioner contended that the claims of the ’448 Patent “make clear that sending and receiving information for *simultaneous interactions* is the focus of the Asserted Claims,” which includes the ’448 Patent. Ex. 2006, 7:11-12; *see also* 2:16-21; 3:26-4:3; 6:12-14; Ex. 2007, 1:20-25; 3:16-17; 4:2-6; 5:2-4.

The District Court denied Petitioner’s Motion, and, in doing so, held that the claims, as supported by the specification, are “directed to performing *a synchronized browsing session* between two electronic devices (a host device and a guest/invitee device) via a synchronization server,” Ex. 2005, 10:4-11:21. The Court thus concluded that “the claims are directed to a specific solution that is rooted in computer technology to overcome a problem specifically arising in the realm of computer networks—using a synchronization server to administer *synchronized browsing sessions* in order to overcome the bandwidth and processing issues of the prior art.” Ex. 2005, 11:23-27.³

³ The Board should give no weight to Petitioner’s expert’s opinion that “[n]one of the claim limitations requires any synchronous sharing of the same web browsing experiences, despite PO trying to read this limitation” (Ex. 1034, ¶7), because that alleged opinion *contradicts* Petitioner’s own prior contentions before the District Court and Petitioner’s expert never states that he considered Petitioner’s prior

Since Petitioner and the District Court relied on the preamble of claim 1 of the representative claim in their Section 101 analysis which states that the method is directed to a “synchronized browsing session,” the recitation of the “synchronized browsing session” in the preamble is **limiting**. See *Data Engine Techs. LLC v. Google LLC*, 10 F.4th 1375, 1381 (Fed. Cir. 2021) (holding that reliance on the preamble as a limitation to show patentable subject matter under Section 101 renders the preamble limiting for purposes of infringement and validity). Furthermore, the reference to a “synchronized browsing session” in the preamble provides antecedent basis for the same term in limitation [1.b] of the claims and therefore the preamble limits the claims to “synchronized browsing sessions.” *In re Fought*, 941 F.3d 1175, 1178 (Fed. Cir. 2019).

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

Motion to Dismiss contentions or the District Court’s findings. Ex. 2006, 7:11-12; Ex. 2005, 11:23-27.

D. All of the Limitations of the Claims of the '448 Patent Are in Dispute

Petitioner contends that “PO did not challenge Petitioner’s arguments for any other claim limitations, which thus should be deemed waived” and therefore “[o]nly limitations [1.c]-[1.g] are in dispute.” Pet. Reply, 7. Petitioner is wrong. A determination of obviousness pursuant to Section 103 requires an examination of the claims “as a whole” and therefore *all* claim limitations are always in dispute. *GE v. Raytheon Techs. Corp.*, 983 F.3d 1334, 1352 (Fed. Cir. 2020) (“[t]he claimed invention and an invention in the prior art must both be analyzed as a whole for the same reason: an invention is more than the sum of its individual elements.”)

Further, pursuant to 35 U.S.C. § 316(e), Petitioner bears the burden of proving invalidity throughout the entire IPR proceeding, *i.e.*, that the claims of the '448 Patent, *as a whole*, would have obvious to a POSITA. *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1342 (Fed. Cir. 2020). Indeed, “[a] patentee technically has no ‘burden’ to do anything to defend the validity of its patent other than hold the patent challenger to its own burden of persuasion.” *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1008 (Fed. Cir. 2018); 37 C.F.R. §§ 42.107(a)

E. Petitioner Has Not Met its Burden of Proving, Pursuant to Section 103, that LeBrun in Combination with Wang Renders Obvious to a POSITA Any Claim of the '448 Patent (Ground 1)

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

Ignoring the arguments in the POR, Petitioner repeats its argument from the petition that “Lebrun’s session creation message 151, which includes an identifier for the group-surfing session, discloses this limitation.” Pet. Reply, 7. 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. *Id.*, 7-8; POR, 40-41. Petitioner also ignores that Lebrun does not describe the “session creation message” as an “invitation to an invitee device to join the synchronized browsing session.” *Id.*; POR, 41. The “session-creation message,” “includes *identifiers* for a set of web clients 110 *participating in, permitted to participate in, or forbidden from participating in*, that session” (Ex. 1005, 32:14-16) and the group-surfing server “responds by... *informing the participants in the group-surfing session* [(i.e. web clients *participating in* not invitees *permitted to participate in*)]” (*Id.*, 32:26-28). Accordingly, Petitioner is incorrect that “the group-surfing server (SS) then *informs the participants (invitees) that they are invited to join the session.*” Pet. Reply, 8. Thus, neither the “session-creation message” nor the “identifiers” are “an invitation to an invitee device to join the synchronized browsing session” and Petitioner provides no citations to the contrary.

Petitioner also incorrectly states that Lebrun discloses that “[t]he host sends the message [(i.e. “session-creation message”)] that is forwarded to the invitee, which meets the limitation.” Pet. Reply, 8. However, Lebrun does not describe *forwarding* the “session-creation message” to the invitee and Petitioner does not cite to anywhere in Lebrun that states otherwise. *Id.*

With regard to Wang, Figure 3 illustrates that the invitation message is sent to the “server apparatus.” However, only an *acknowledgement or notice of the invitation* (not the invitation itself) is sent by the “server apparatus” to the invitee device. Indeed, Wang’s “communication means” merely “enabl[e] the client device to display a message for other client devices” (Ex. 1006, ¶20) and this is not an “invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier.”

Furthermore, Petitioner’s simple assertion that “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” does not describe why a POSITA would have been motivated to combine the prior art references with a reasonable expectation of success. *See ParkerVision, Inc. v. Qualcomm Inc.*, 903 F.3d 1354, 1363 (Fed. Cir. 2018) *quoting InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1346-47 (Fed. Cir. 2014) (“a party seeking to invalidate method claims

on obviousness grounds must demonstrate that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” (internal quotes omitted)); *see also In re Stepan Co.*, 868 F.3d 1342, 1347 (Fed. Cir. 2017) *quoting Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1365 (Fed. Cir. 2007) (“[T]o have a reasonable expectation of success, one must be motivated to do more than merely to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result.”)

Therefore, Petitioner fails to meet its burden with regard to obviousness.

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

First, Petitioner’s statement that “the POR did not acknowledge the Board’s preliminary finding or provide any basis for challenging it” (Pet. Reply, 9) is misleading. The Board’s preliminary finding acknowledged that PO did not address this limitation at the institution stage and, therefore, the Board’s preliminary finding simply summarized Petitioner’s position from the petition. PO challenged Petitioner’s position in its POR (POR, 42-44).

Second, Petitioner provides no clear argument to explain why Lebrun’s disclosure of the program fragment “catching” (Ex. 1005, 45:13-19) or “intercepting” (Ex. 1005, 37:5-6) the controlling web client’s selection of a link discloses “*recording* a shared web browsing interaction.” Here, the Petitioner only

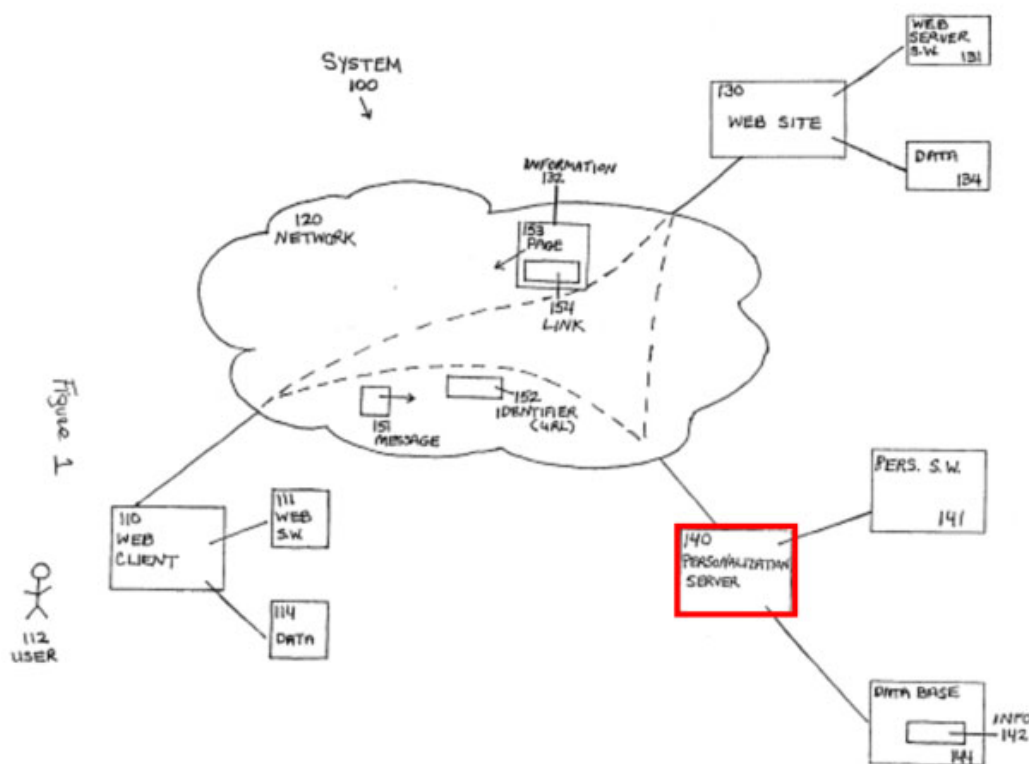
states that “[t]he POR provides no rationale as to why catching/intercepting is different from recording.” Pet. Reply, 10. However, it is Petitioner’s burden to prove that the limitations are met. Therefore, Petitioner must explain why “catching/intercepting” is different from “recording,” – and not the other way around. This is especially the case when the terms themselves are clearly different, as explained in both the POR and Mr. Friedman’s declaration. POR, 43-44; Ex. 2004, ¶74. Moreover, Petitioner’s only argument to refute this point is that “Lebrun discloses that the program fragment can manage databases; a POSITA would understand that it is capable of ‘recording’ such information.” Pet. Reply, 10, citing Ex. 1005, 49:13-14; Ex. 1003, ¶¶162-163. However, neither Petitioner’s cited disclosure in Lebrun nor its reliance on the cited portions of its expert’s declaration support this assertion. The cited portions of its expert’s declaration do not mention or cite to the Lebrun passage that Petitioner relies on.

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

Again, Petitioner’s statement that the “POR does not mention the Board’s preliminary finding that the Petition’s proffered evidence meets this limitation” (Pet. Reply, 9) is misleading for the same reasons stated in Section II.E.2, *supra*. PO challenged Petitioner’s position in its POR (POR, 44-47).

Petitioner’s reliance on Figure 1 of Lebrun to substantiate this argument (as well as its arguments with regard to limitations [1.f.iii] and [1.g], discussed *infra*) is

inapt. “Figure 1 shows a block diagram of a system for access to personalized web sites” (Ex. 1005, 12:1-2) and is directed to a system mediated by a “personalization server,” as illustrated in the annotated Figure 1 below, as opposed to the group-surfing server that Petitioner incorrectly contends is analogous to the synchronization server. Ex. 1005, 12:1-9. The system illustrated in Figure 1, which Petitioner relies upon, does not even include the group-surfing server as a component. *Id.*



Petitioner attempts to combine two entirely different systems. In doing so, 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. Moreover, Petitioner does not even acknowledge its reliance on two different systems. Accordingly, Petitioner's argument fails to address the arguments set forth in the POR.

Petitioner also fails to address any of the arguments in the POR with regard to Wang's failure to disclose this limitation.

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

Petitioner does not address the arguments in the POR that Lebrun's "next-page message" does not constitute "information related to the shared web browsing interaction." Pet. Reply, 12-13; POR, 47-48. Petitioner also does not address arguments in the POR with regard to Wang. *Id.*

5. Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.f.i]-[1.f.iii]

Petitioner asserts for the first time that these subparts "indicate the intended use of the IRTTSWBI and should not be given weight." Pet. Reply, 6. Petitioner is incorrect.

During prosecution, the Examiner amended the "wherein" limitations to the independent claims in order to allow the claims. Ex. 2008, 2-3, 7-8, 10. In allowing the claims, the Examiner specifically stated that the temporal ordering of the claims, including "the invitee device to generate its own request for the webpage to retrieve substantially the same content as the first device" as described in Limitations [1.f.i]-

[1.f.iii], overcomes the prior art. *Id.*, 10. Therefore, these subparts do not indicate an “intended use” that may be ignored when reading the claims. Otherwise, the Examiner would not have amended and relied upon them to overcome the prior art to allow the claims. *See Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333 (Fed. Cir. 2003) (Phrases “were added to gain allowance of the claims” and “[w]e must therefore give them weight, for the patentability of the claims hinged upon their presence in the claim language.”); *see also Netflix, Inc. v. Blockbuster, Inc.*, 477 F. Supp. 2d 1063, 1076 (N.D. Cal. 2007) *citing Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1367 (Fed. Cir. 2003) (Clear reliance on certain claim language (*e.g.* the preamble or the “wherein” subparts in this case) in the prosecution history transforms the language into a claim limitation because the patentee used it to define the claimed invention.)

6. Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.f.i]

Although Petitioner argues that the “claim recites only that the IRTTSWBI ‘*enables* the invitee device to generate a request to *retrieve* substantially the same webpage content’” (second emphasis added), Petitioner somehow concludes, despite the plain language of the claim, that “neither ‘retrieving’ nor ‘receiving’ are required.” Pet. Reply, 14. This flies in the face of what the Board clearly noted as a distinction between the terms “receive” in Lebrun and “retrieve” in the claims. ’448 Institution at 25 n.10.

Nevertheless, in an attempt to show Lebrun discloses the “retrieve” limitation, Petitioner cites to Lebrun, 35:17-19, which is inapt since that particular embodiment requires no identifying information (POR, 50). 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.” Petitioner’s reliance on its expert’s declaration is also inapt because Petitioner’s expert simply assumes, without providing any basis, that the “receive” and “retrieve” limitations of claims are met. Pet. Reply, 14 *citing* Ex. 1003, ¶¶165, 173, 180.

Petitioner also fails to respond to the argument in the POR that “Wang teaches that the web page or the snapshot data is ‘given’ or ‘displayed’ to the client devices from the server apparatus, rather than the client devices thus ‘generat[ing] a request to retrieve substantially the same webpage content as the request for the webpage content from the host device’ as required by the claim language.” POR, 52.

7. Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.f.ii]

Petitioner relies upon the same disclosure that was relied upon for limitation [1.c] above to disclose the “transmitting” subpart of this limitation. Petitioner cannot rely on the same disclosure to satisfy multiple claim limitations. *Becton, Dickinson and Co. v. Tyco Healthcare Gr., LP*, 616 F.3d 1249 (Fed. Cir. 2010) (“[w]here a claim lists elements separately, ‘the clear implication of the claim language is that those elements are ‘distinct component[s]’ of the [claimed] invention.”); *see also*

Hopkins Manufacturing Corp. v. Cequent Performance Products, Inc. (IPR 2015-00613, Paper 9, August 7, 2015) (The prior art disclosure of an accelerometer with an output signal could not be applied as teaching both the claimed limitations of “deceleration signal” and an “inclination signal.”)

Moreover, Petitioner argues there is no requirement for “synchronization.” Pet. Reply, 16-17. Petitioner is incorrect for the same reasons that are stated in Section II.C, *supra*.

8. Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.f.iii]

In this instance, Petitioner relies on two previously incorrect assumptions and arguments as purporting to demonstrate that Lebrun discloses limitation [1.f.iii]. First, as explained in Sections II.D and II.E.6, *supra*, 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. Second, Petitioner relies on the same inapplicable system illustrated by Figure 1, as discussed in Section II.E.3, *supra*, to argue that the “content sent from the web site to the web clients is the result of requests from the web clients.” Pet. Reply, 17-18.

Finally, Petitioner fails to meet its burden of why a POSITA would be motivated to combine Lebrun and Wang to meet this limitation.

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

Similar to Petitioner's argument with regard to limitation [1.e] in Section II.E.3, *supra*, Petitioner relies on the same inapplicable system illustrated by Figure 1 to argue that that this limitation is met. Pet. Reply, 18-19. Petitioner is incorrect that the limitation is met when "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.'" Pet. Reply, 18. 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.'" POR, 56.

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

Petitioner has not met its burden of showing that a POSITA would have been motivated at the time of the '448 Patent (*i.e.*, without hindsight) to combine Lebrun with Wang to arrive at the inventions claimed in the '448 Patent. *Endo Pharms., Inc. v. Actavis LLC*, 922 F.3d 1365, 1373 (Fed. Cir. 2019) ("An obviousness determination requires finding that a [POSITA] would have been motivated to combine or modify the teachings in the prior art and would have had a reasonable expectation of success in doing so.") (*quoting Regents of Univ. of Cal. v. Broad Inst., Inc.*, 903 F.3d 1286, 1291 (Fed. Cir. 2018)).

Petitioner *ignores* PO's contention that Petitioner failed to "discuss what obviousness-related modifications to Lebrun . . . should be made with the disclosure of Wang" (POR, 74-75). Instead, Petitioner uses hindsight to piece together components from different systems between the prior art references without providing any reason why a POSITA may be motivated to make such combinations or why such combinations would have had a reasonable expectation of success. *See, e.g.*, POR, 41-42, 46-48, 51-56, 69-75.

For example and with regard to limitation [1.c], Petitioner simply states the following:

"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. Reply, 8. Petitioner further states that "this is a combination of prior art elements according to known methods yielding predictable results" (internal quotes omitted). *Id.* These conclusory statements do not meet Petitioner's burden to prove obviousness. *See TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1357-1361 (Fed. Cir. 2019) (rejecting obviousness determinations based on conclusory and unsupported expert testimony: "crediting such testimony risks allowing the challenger to use the challenged patent as a roadmap to reconstruct the claimed invention using disparate

elements from the prior art—i.e., the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against.”)

Indeed, the obviousness analysis must also account for “reasons not to combine,” which are facts relevant to the overall consideration of obviousness. *Teva Pharms. Int’l GmbH v. Eli Lilly & Co.*, 8 F.4th 1349, 1358 (Fed. Cir. 2021).

F. Petitioner Has Not Met its Burden of Proving, Pursuant to Section 103, that Prajapat in Combination with Wang Renders Obvious to a POSITA Any Claim of the ’448 Patent (Ground 2)

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

Petitioner acknowledges that Prajapat discloses multiple, distinct embodiments, but contends that “Prajapat *explicitly contemplates* combining its embodiments” based on statements in the specification relating to the dynamic sharing embodiment. Pet. Reply, 20-21 *citing* Ex. 1007, [0012]-[0014]. This is incorrect. Petitioner’s relied-upon statements are made in the context of Prajapat’s “peer-to-peer *dynamic* web page sharing” system and neither explicitly nor implicitly contemplate combination with Prajapat’s “peer-to-peer *simple* web page sharing” system.

Prajapat discloses a first “peer-to-peer dynamic web page sharing” embodiment at Ex. 1007, [0012]-[0040]. However, nowhere in its description of that embodiment does Prajapat state the description applies to any other embodiment.

Prajapat discloses a second “peer-to-peer simple web page sharing” embodiment at Ex. 1007, [0041]-[0043]. Prajapat states how the web media server 14a locates the web media server associated with browser 12b to operate in a substantially similar manner to the first embodiment. Ex. 1007, [0041]. Prajapat does not state that any other feature of this second embodiment operates similarly to a feature in the first embodiment.

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

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

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

As discussed at Section II.C., *supra*, the claims require “synchronized browsing sessions,” *i.e.*, shared internet browsing “in real time” and in a “simultaneous fashion from different devices and/or locations.” Petitioner contends that in its “peer-to-peer dynamic web page sharing” embodiment, Prajapat discloses

that browser 12a and 12b display the same web pages at substantially the same time, citing Ex. 1007, [0012] and Ex. 1003, ¶286. Pet. Reply, 16.

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

3. Petitioner Has Not Met Its Burden of Proving that Prajapat Alone or in Combination with Wang Renders Obvious Limitations [1.f]-[1.g]

First, Petitioner's argument that "PO's construction of IRTTSWBI is incorrect" misses the mark. *See* Section II.B, *supra*.

Second, Petitioner fails to describe any application of the so-called "red herring argument" with regard to any of Prajapat's disclosures or particular claim limitations.

Third and as described in Section II.E.5, *supra*, the limitations recited in [1.f.i]-[1.f.iii] do not recite an intended use.

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

For the reasons discussed in Section II.E.10, *supra*, Petitioner has not met its burden of proving that a POSITA would have been motivated to combine Prajapat with Wang. Pet. Reply, 20-21.

G. Petitioner Has Not Met its Burden of Proving that Lebrun in Combination with Wang or Prajapat in Combination with Wang Renders Obvious the Dependent Claims of the '448 Patent

Petitioner fails to refute PO's argument with regard to claims 4-6. Instead, Petitioner merely states that "PO relies on its failed arguments for independent claim 1." Pet. Reply, 23.

Petitioner further fails to refute PO's arguments with regard to claims 8-9 and 14-15, opting instead to incorrectly argue that PO relies on its failed arguments for claim 1. However, the POR specifically argues that the Petitioner's reliance on Lebrun's "Web Page Special Access" and "Web Page Look Ahead" is inapt since neither of these features disclose "the web browsing window [that] is capable of accepting both shared and non-shared web browsing interactions." POR, 77-78.

III. CONCLUSION

Claims 1-16 of the '448 Patent are patentable over Lebrun in view of Wang and over Prajapat in view of Wang.

Date: January 31, 2024

Respectfully submitted,

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CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S SUR-REPLY** specified in 37 C.F.R. § 42.24 have 5,592 words, in compliance with the 5,600 word limit set forth in 37 C.F.R. § 42.24(c). This word count was prepared using Microsoft Word.

Date: January 31, 2024

Respectfully submitted,

/ Saif M. Askar /

Saif M. Askar (*pro hac vice*)

CERTIFICATION OF SERVICE

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

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