

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner,

v.

SAMESURF, INC.,
Patent Owner.

IPR2023-00341
Patent 9,483,448 B2

Before KARL D. EASTHOM, BARBARA A. BENOIT, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining No Challenged Claims Unpatentable

35 U.S.C. § 318(a)

Granting in Part Petitioner's Motion to Exclude

Granting in Part Petitioner's Motion to Strike

37 C.F.R. § 42.64

I. INTRODUCTION

In this *inter partes* review instituted pursuant to 35 U.S.C. § 314, Intuit Inc. (“Petitioner”) challenges the patentability of claims 1–16 (“the challenged claims”) of U.S. Patent No. 9,483,448 B2 (Ex. 1001, “the ’448 patent”), owned by Samesurf, Inc. (“Patent Owner”).

We have jurisdiction under 35 U.S.C. § 6. We base our decision on the preponderance of the evidence standard. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Having reviewed the arguments of the parties and the supporting evidence, we determine that Petitioner has *not* shown by a preponderance of evidence that any of the challenged claims are unpatentable.

A. Procedural History

Petitioner filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of the challenged claims, to which Patent Owner filed a Preliminary Response (Paper 9, “Prelim. Resp.”). On June 28, 2023, we instituted an *inter partes* review of the challenged claims on all grounds asserted by Petitioner. Paper 13 (“Dec.” or “Institution Decision”). In the Institution Decision, we determined that there was a reasonable likelihood that Petitioner would prevail in demonstrating that claim 1 would have been obvious. Dec. 38, 60.

After institution, Patent Owner filed a Patent Owner Response (Paper 22, “PO Resp.”), to which Petitioner filed a Reply (Paper 27, “Pet. Reply”). In response, Patent Owner filed a Sur-reply (Paper 28, “PO Sur-

reply”). A hearing was held on March 27, 2024.¹ See Paper 42 (“Transcript” or “Tr.”).

B. Real Parties in Interest

The Petition indicates Intuit Inc. is the real party in interest. Pet. 3. Patent Owner identifies itself as the real party in interest. Paper 4 (Patent Owner’s Mandatory Notices), 2.

C. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 3; Paper 4, 2. The parties identify the following district court case: *Samesurf, Inc. v. Intuit, Inc.*, No. 3:22-cv-00412 (S.D. Cal.). Pet. 3; Paper 4, 2. The parties also each identify two concurrently filed petitions challenging different patents: IPR2023–00339 (challenging U.S. Patent No. 9,185,145 B2) and IPR2023–00342 (challenging U.S. Patent No. 8,527,591 B2). Pet. 3; Paper 4, 2.

D. The ’448 Patent

The ’448 patent is titled “Method and Apparatus for the Implementation of a Real-Time Sharable Browsing Experience on a Host Device.” Ex. 1001, code (54). The patent relates to a “sharable browsing experience” through “a synchronized browsing session on a host device utilizing the transfer of URL [uniform resource locator], form data, script, and other information.” *Id.* at 1:15–19.

¹ At the parties’ joint request (Paper 30), a consolidated hearing for this proceeding and two related proceedings was held. See Paper 33 (Order setting oral argument); Paper 42. This Decision is based on the record of this proceeding.

1. The Written Description

The techniques described by the '448 patent address the need for “all users in a session to interact with, discuss, log in separately or together, and share internet browsing in real time for online activities.” *Id.* at 2:47–50. In contrast, “desktop or screen sharing” approaches “allow users to simply view the same internet content” but “do not enable all users in a session to click, input, and log into those experiences in a simultaneous or nearly simultaneous manner.” *Id.* at 2:26–30. The '448 patent criticizes “desktop or screen sharing” methods “because they work by broadcasting continuous screenshots of the host screen in large files or packets and require high levels of bandwidth and computer processing power.” *Id.* at 2:31–34. Also, such methods “afford little protection for the broadcasting host’s private information since all participants in a particular session see the host screen as s/he enters sensitive information such as user names or passwords or when the host toggles back and forth in other areas on their desktop.” *Id.* at 2:38–43.

Figure 2(a), reproduced below, illustrates communication between various devices “to initialize a synchronized browsing session.” *Id.* at 4:19–22.

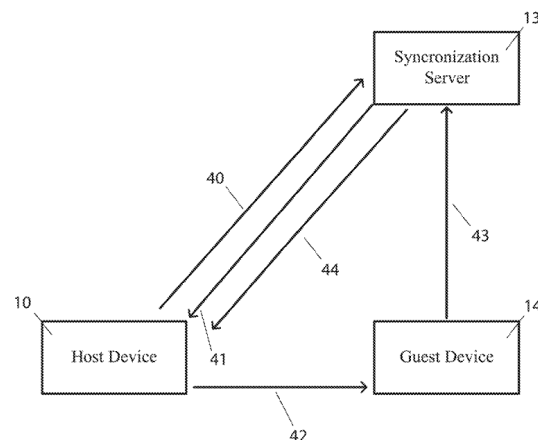


Figure 2(a) is a block diagram showing communication between host device 10, synchronization server 13, and guest device 14 to initialize a synchronized browsing session between host device 10 and guest device 14. *Id.* at 10:27–33, Fig. 2(a). Examples of host and guest devices include personal computers, mobile phones, and electronic tablets with “a visual user interface and network connection.” *Id.* at 6:22–26 (identifying example host devices), 6:30–36 (identifying example guest devices). “[H]ost device 10 transmits initialization request 40 to synchronization server 13,” which responds by sending confirmation message 41 that includes session identifier 19 for the synchronized browsing session. *Id.* at 10:34–38. Host device 10 transmits session invitation 42 to guest device 14. *Id.* at 10:44–46.

To join the synchronized browsing session with host device 10, guest device 14 transmits request to join 43, which includes session identifier 19, to synchronization server 13. *Id.* at 10:53–58. Synchronization server 13 “records identification and routing information of guest device 14” and, in some embodiments, sends “notification 44 to host device 10 [that] guest device 14 has joined the synchronized browsing session.” *Id.* at 10:61–67.

Figure 5(a), reproduced below, illustrates communication between various devices during a synchronized browsing session with a website server. *Id.* at 4:51–54.

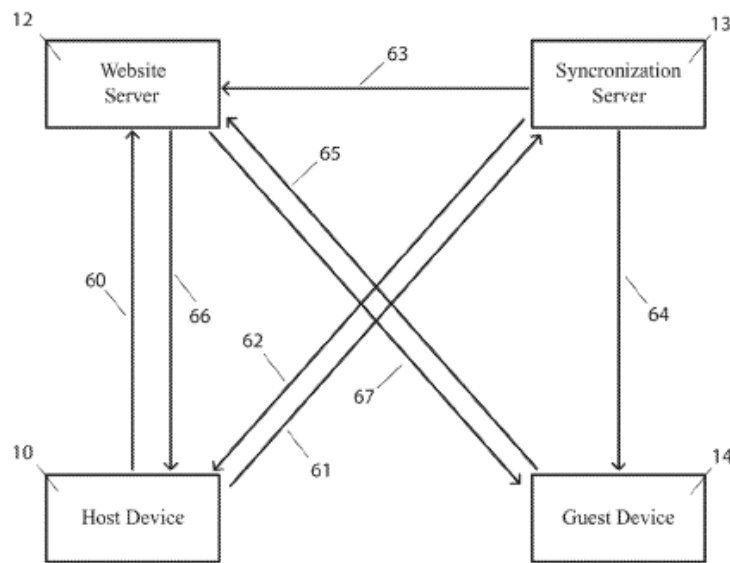


Figure 5(a) is a block diagram showing communication between website server 12, host device 10, synchronization server 13, and guest device 14 during a synchronized browsing session. *Id.* at 16:5–10. Host device 10 communicates with website server 12 to receive website content. *Id.* at 16:11–22. Host device 10 also transmits to synchronization server 13 communication message 61, which may include the URL address of website server 12, cookie information, form data, java script, other types of user inputted information, or attached files. *Id.* at 16:31–42. Communication message 61 may include “information indicating whether the webpage interaction information is to be relayed to the guest device 14.” *Id.* at 16:37–40. As such, the specification seems to equate the example information in the communication message—the URL address of website server 12, cookie information, form data, java script, other types of user inputted information, or attached files—with examples of webpage interaction information.

Synchronization server 13 then forwards the communication message to guest device 14. *Id.* at 16:63–17:4, 17:15–17. Guest device 14 uses the

communication message to send website request 65 to website server 12. *Id.* at 17:21–27. “In exemplary embodiments, website request 65 should be similar to or identical to website request 60.” *Id.* at 17:25–27. In one such exemplary embodiment, this enables synchronized browsing between host device 10 and guest device 14 because identical website content is provided by website server 12 to each device in response to identical requests sent by each device to the website server 12. *Id.* at 17:60–18:2.

Figure 5(d), reproduced below, illustrates steps used by a guest device during a synchronized browsing session with a host device. *Id.* at 19:33–35.

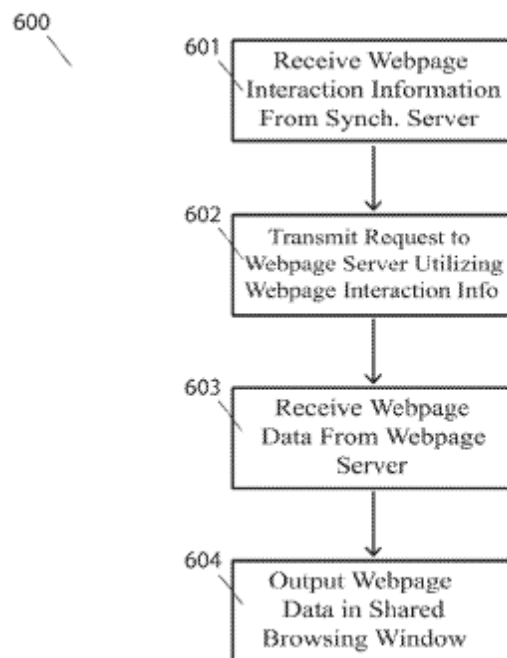


Figure 5(d) is “a flow chart of method 600 utilized by guest device 14 for the execution of a synchronized browsing session with host device 10.” *Id.* “In step 601, guest device 14 receives communication message 64 from synchronization server 13.” *Id.* at 19:41–43. As described previously, communication message 64 “is designed to be forwarded by synchronization

server 13 to guests in the synchronized browsing session, such as guest 14, to perform the synchronized browsing session.” *Id.* at 16:62–65. “In exemplary embodiments, communication message 64 may be a duplicate of [host device’s] website request 60, or may comprise the URL address of website server 12.” *Id.* at 16:65–17:1. “In other embodiments, communication message 64 may also include other transmitted data from [host device’s] website request, such as cookie information, form data, java script, or other user inputted information, or attached files.” *Id.* at 17:1–4.

“Guest device 14 formulates website request 65 by processing communication message 64.” *Id.* at 19:48–50. “In step 602, guest device 14 transmits website request 65 to website server 12.” *Id.* at 19:43–44. “In step 603, guest device 14 receives content reply 67 from website server 12.” *Id.* at 19:53–54. “Finally, in step 604, guest device 14 outputs content reply 67” through a user interface of guest device 14. *Id.* at 19:54–57. As shown, Figure 5(d) describes “content reply 67” as “webpage data.” The user interface may be part of specialized synchronization browsing software or may be output using a standard internet browser window. *Id.* at 19:57–61.

2. Challenged Claims

All sixteen claims of the ’448 patent are challenged, of which claims 1 and 11 are independent. Illustrative claim 1 follows, with bracketed annotations for reference:

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,

[1f.i] 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 a² substantially the same webpage content as the request for the webpage content from the host device;

[1f.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, and

[1f.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; and

[1g] receiving, responsive to sending the request for webpage content to the website server and after transmitting the information related to the

² The “a” in the limitation “to retrieve a substantially the same webpage content” may reflect a particular drafting style rather than being a typographical error. In any event, we, like Petitioner and Patent Owner, are able to discern the meaning of the claim as “retrieving substantially the same webpage content.”

shared web browsing interaction to the synchronization server, the requested webpage content from the website server.

Ex. 1001, 23:30–24:8.; *see* Prelim. Resp. 11–13.

E. Grounds of Institution and Testimonial Evidence

1. Grounds of Institution

We instituted trial on the following grounds (Dec. 9, 47):

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–16	103 ³	Lebrun ⁴ and Wang ⁵
1–16	103	Prajapat ⁶ and Wang

2. Testimonial Evidence

In support of their positions, Petitioner and Patent Owner each cite the declaration testimony of their respective experts. Specifically, Petitioner cites the declaration testimony of Henry A. Lieberman in support of its Petition (Ex. 1003) and its Reply (Ex. 1034) to Patent Owner’s Response.

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amending 35 U.S.C. § 103, was effective on March 16, 2013. The ’448 patent claims the filing benefit of a patent that issued from an application filed on May 20, 2010, which is before the effective date of the applicable AIA amendment. Ex. 1001, code (63), 1:8–11. We, therefore, apply the pre-AIA version of § 103 for purposes of institution. *See also* Pet. 6 n.2 (noting Petition references are to the pre-AIA version of the statute).

⁴ WIPO International Publication No. WO 00/48110, published August 17, 2000 (Ex. 1005). *See* Pet. 5 (asserting the reference is prior art under pre-AIA 35 U.S.C. § 102(a), § 102(b)).

⁵ U.S. Patent Appl. Pub. No. US 2005/0033656 A1, published February 10, 2005 (Ex. 1006). *See* Pet. 5 (asserting the reference is prior art under pre-AIA 35 U.S.C. § 102(b), § 102(e)).

⁶ U.S. Patent Appl. Pub. No. US 2005/0021626 A1, published January 27, 2005 (Ex. 1007). *See* Pet. 5 (asserting the reference is prior art under pre-AIA 35 U.S.C. § 102(b), § 102(e)).

Patent Owner cites the declaration testimony of Stacy Friedman (Ex. 2004). Additionally, Petitioner cites the cross-examination testimony of Mr. Friedman (Ex. 1033).

II. ANALYSIS

A. Legal Standards Concerning Demonstrating Unpatentability

To prevail in challenging the patent claims, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e) (2012); 37 C.F.R. § 42.1(d) (2017). “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied on). This burden never shifts to Patent Owner except in limited circumstances not present here. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

Petitioner asserts that the challenged claims are unpatentable under 35 U.S.C. § 103(a). A patent claim is unpatentable under 35 U.S.C. § 103(a) “if

the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective indicia of nonobviousness.⁷ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Consideration of the *Graham* factors “helps inform the ultimate obviousness determination.” *Apple v. Samsung Elecs. Co.*, 839 F.3d 1034, 1048 (Fed. Cir. 2016) (en banc).

B. Level of Ordinary Skill in the Art

We review Petitioner’s asserted obviousness contentions in view of the understanding of a person of ordinary skill in the art at the time of the invention. *Graham*, 383 U.S. at 17. This level is a factual determination that provides a primary guarantee of objectivity in an obviousness analysis. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991)).

In the Institution Decision, after considering the respective proposals of the parties, we found that a person of ordinary skill in the art (“POSITA”) “would have had (1) at least a bachelor’s degree in computer science,

⁷ Patent Owner has not offered objective evidence of non-obviousness. *See generally* PO Resp.; PO Sur-reply; *see also* Pet. 21 (indicating Petitioner is not aware of any evidence of secondary considerations).

computer engineering, or electrical engineering, or a similar field, and (2) at least two years of work experience in software development and/or web-based software,” which reflected Petitioner’s proposal. Dec. 12; *see* Dec. 10–12 (discussing the respective proposals and level of ordinary skill reflected in the challenged patent and asserted prior art). Patent Owner accepts this level of ordinary skill in the art. PO Resp. 37. Accordingly, we apply this determination of the level of ordinary skill in the art for purposes of this Decision.

C. Prior Art Disclosures

1. Lebrun’s Disclosure

Lebrun is a WIPO (World Intellectual Property Organization) international application published under the PCT (Patent Cooperation Treaty) and titled “Personalized Access to Web Sites.” Ex. 1005, code (54). Among other features, Lebrun indicates “multiple related users can simultaneously access a sequence of web sites (web surfing), such that each of the related users has substantially the same content presented at the same times.” *Id.* at 4:6–9.⁸

⁸ Page numbers refer to the original page numbers in the lower center of the document pages (i.e., not the page numbers added by Petitioner in the lower left of the document pages). This is consistent with Petitioner’s citations. *See, e.g.*, Pet. 22 (citing Ex. 1005, 32:9–12; quoting references to “session-creation message”).

Figure 3⁹, reproduced below, illustrates a system for group access to web sites. *Id.* at 29:25.

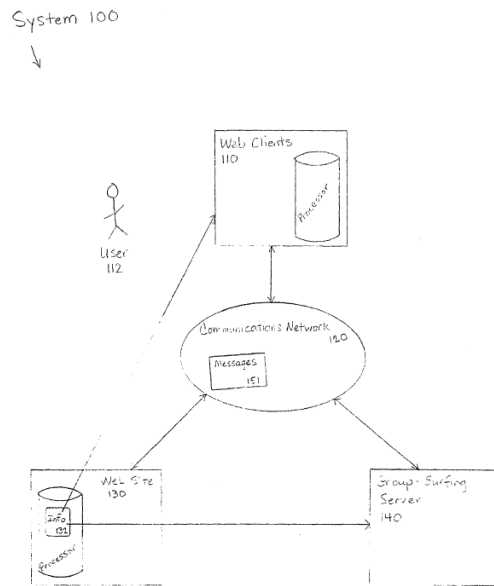


Figure 3 is a block diagram of “system 100 [that] includes a set of web clients 110, a communication network 120, at least one web site 130, and a group surfing server 140.” *Id.* at 29:27–28. Lebrun describes creating a “group-surfing session” in which “first web client 110 sends a session-creation message 151 to the group-surfing server” 140 to create a group-surfing session. *Id.* at 32:9–11. The message is sent in response “to an action by the user of the web client software 111, such as by selecting a web page or a link to a web page.” *Id.* at 32:5–7, Fig. 1 (showing web client software 111 of web client 110). Session-creation message 151 may include “an identifier for the group-surfing session, so that other web clients 110 can add themselves to that session.” *Id.* at 32:11–12. Lebrun further indicates that “group-surfing server 140 can also assign the identifier in a reply to the session-creation message 151.” *Id.* at 32:12–14.

⁹ Best available quality from Ex. 1005.

The group-surfing server 140 receives the session-creation message 151 and responds by (1) creating a group-surfing session and (2) “informing” the other web clients 110 participating in the group-surfing session. *Id.* at 32:26–31. “To add itself to the session, a second (or further) web client 110 sends a session-join message 151,” which in a preferred embodiment includes the identifier for the group-surfing session, to the group-surfing server 140. *Id.* at 33:2–4.

Lebrun also describes group surfing server 140 adding web clients 110 to a group-surfing session in relation to steps in a flow chart shown in Figure 4. *Id.* at 44:18–26. After receiving the session-join message 151 from “the new web client 110,” the group-surfing server 140 sends to the new web client 110 “a program fragment (preferably a Java applet and JavaScript code)” that is used to process web pages received as part of the group-surfing session. *Id.* at 44:29–31. In general, in response to a link on a web page being selected to request another web page, the program fragment “intercepts the request before it is sent to the web site 130, and redirects the selection to the group-surfing server 140.” *Id.* at 44:31–33. The group-surfing server 140 is then able to “assure” that the next web page selected is “presented to all participating web clients 110.” *Id.* at 45:1–2.

Lebrun describes a more particular example of group-surfing server, web clients, and web site communication during a group-surfing session in which web page selections from first web client 110 (or “controlling web client 110”) are presented at each of the other web clients participating in the group-surfing session. *Id.* at 45:6–46:15. First web client 110 receives a web page 153 from group-surfing server 140 (which in turn had received that page from the web site 130). *Id.* at 45:13–14. First web client 110

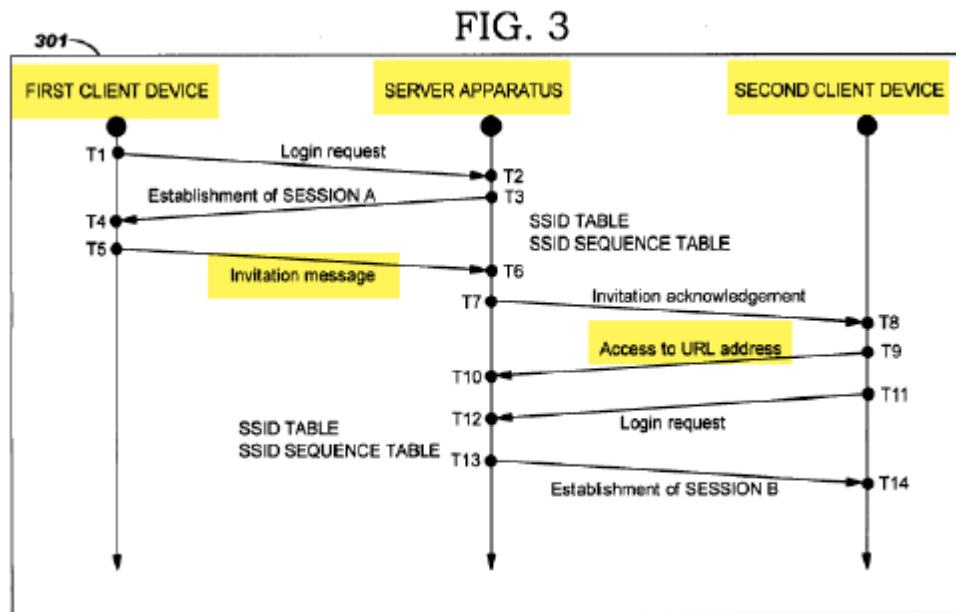
selects a link 152 on web page 153, and “the selection is caught by the program fragment, which sends the selection” including “a next-page message 151 to the group-surfing server 140, indicating next page 153 in the progression of pages in the session.” *Id.* at 45:14–16, 45:21–23. Group-surfing server 140 adds “proper cookie or other identity information” and “directs that target web site 130 to deliver the next page 153 to the group-surfing server 140 itself.” *Id.* at 45:25–28. “The group-surfing server 140 then re-sends that page 153 to those web clients 110 participating in the session.” *Id.* at 45:28–29.

Lebrun continues, “[i]n a preferred embodiment, in order to reduce load on the group-surfing server 140, the group-surfing server 140 sends only the page 153 itself without any multimedia elements (such as embedded sound, images, or program fragments).” *Id.* at 45:29–46:1. “Each participating web client 110 requests those multimedia elements directly from the web site 130.” *Id.* at 46:1–2 (describing step 234). “At step 235, the page 153 is presented at each of the web clients 110 participating in the session.” *Id.* at 46:4–5.

2. Wang’s Disclosure

Wang is a published patent application titled “Collaboration System Suitable for On-Line Shopping.” Ex. 1006, code (54). Wang’s server receives and responds to requests from multiple client devices and synchronizes the displays on each of the client devices. *Id.*, code (57). A client device receives an invitation to join a group shopping session. *Id.* ¶¶ 46–48, Fig. 3. The invitation includes “URL address to be used” to access the shopping session. *Id.* ¶ 48. Figure 3, reproduced below as

annotated by Petitioner, illustrates a process to establish a group session.
Pet. 27; Ex. 1006 ¶ 27.



Wang’s Figure 3 is a “timing diagram for a process” that illustrates messages sent between two client devices and a server to establish “a group session,” which refers to “a session which enables client devices included in a group designated by a fixed identification value to access a common application service.” Ex. 1006 ¶¶ 27, 46. Wang indicates an example of a common application service may be “a virtual shopping system,” in which case the group session “may be referred to as a shopping session.” *Id.* ¶ 46.

More specifically, Figure 3 shows various messages sent between a first client device and a server apparatus and between the server apparatus and a second client device. *See id.* ¶¶ 47–49, Fig. 3. Among the messages exchanged, is a “message invitation” that the first client device sends to the server apparatus to invite “other client devices to the shopping session.” *Id.* ¶ 47. In response, the server apparatus sends to the second device a message, such as an email, that includes “a URL address to be used” to join

the shopping session. *Id.* ¶¶ 48–49, Fig. 3. The second client then “accesses the designated URL address,” and the server apparatus receives an access notice and login request from the second client. *Id.* ¶ 49. The server apparatus subsequently “completes the establishment of the group session.” *Id.*

3. Prajapat’s Disclosure

Prajapat relates to peer-to-peer web content sharing, such as may be used in a call center to share content with a customer. Ex. 1007 ¶¶ 1–2. Figure 1, reproduced below, illustrates an example of such a communication system. *Id.* ¶ 12.

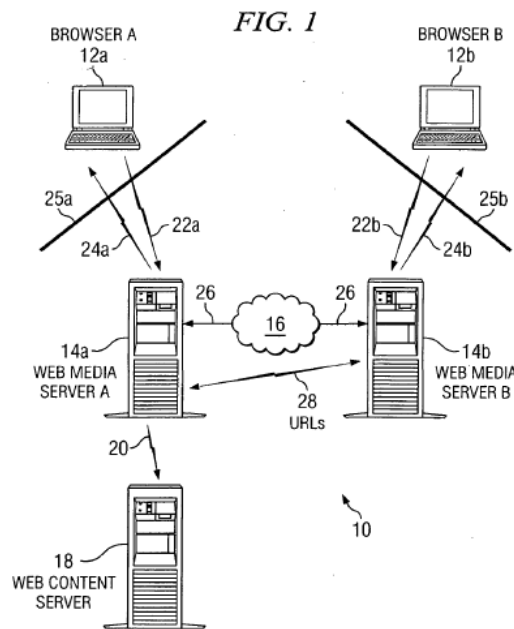


Figure 1 shows communication system 10 that includes browsers 12a and 12b, web media servers 14a and 14b, and web content server 18. *Id.* ¶ 12. Web media servers 14a and 14b are “coupled via network 16,” and web content server 18 is “coupled to web media server 14a via link 20.” *Id.*

A user associated with browser 12a may “desire to co-browse or share one or more web pages” with a user associated with browser 12b. *Id.* ¶ 16.

Prajapat uses the term “co-browse” to describe a variety of situations, including (i) browsers 12a and 12b displaying “the same web pages at substantially the same time,” (ii) browser 12b viewing web pages alterations by browser 12a, and (iii) similarly, browser 12a viewing web page alterations by browser 12b. *Id.* ¶ 12.

Prajapat describes an example of peer-to-peer dynamic web page sharing. *Id.* ¶ 34, Fig. 2. “[B]rowser 12a establishes a communication session with media server 14a” and submits a request to co-browse with browser 12b. *Id.* ¶ 35. After receiving the request, web media server 14a locates and establishes a communication session with “web media server 14b with which browser 12b is associated.” *Id.* A communication session also is established between web media server 14b and browser 12b. *Id.*

In response to browser 12a’s request for a web page, web media server 14a requests the web page from web content server 18, which, in turn, provides the requested web page to the web media server 14a. *Id.* ¶¶ 36–37. Web media server 14a communicates the web page or a notification that the web page is available to browser 12a, which retrieves the web page from web media server 14a. *Id.* ¶ 38. Web media server 14a also communicates the web page in some form to web media server 14b. *Id.* ¶ 39. Web media server 14b communicates the web page or a notification that the web page is available to browser 12b. *Id.* Browser 12b retrieves the web page from web media server 14b. *Id.*

In another example, Prajapat describes “peer-to-peer simple web page sharing” using a web content server that returns the requested web page to a browser. *Id.* ¶ 41. Figure 3, reproduced below, illustrates an example of such a communication system. *Id.* ¶¶ 10, 41.

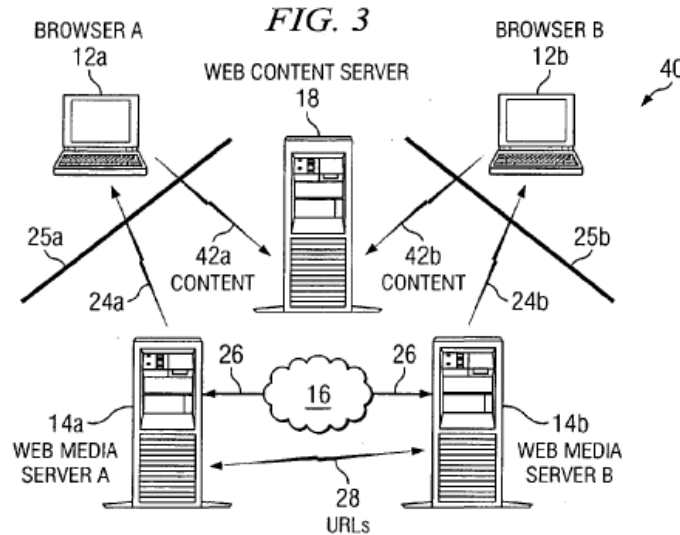


Figure 3 shows communication system 40 that, like Figure 1, includes browsers 12a and 12b, web media servers 14a and 14b, and web content server 18. *Id.* ¶ 41. Similar to the description above, browser 12a submits to web media server 14a a request for a web page sharing session with browser 12b; web media server 14a locates the web media server 14b associated with browser 12b; and web media server 14a establishes a “media session” with web media server 14b that allows the web media servers to communicate “media between each other.” *Id.* ¶¶ 41–42.

In contrast to the process described above with respect to Figure 1, in this example, browser 12a submits a request for a web page to web content server 18, which returns the requested web page to requesting browser 12a. *Id.* ¶ 43. Browser 12a communicates “the URL or other suitable information regarding the requested web page to web media server 14a,” which, in turn, communicates that information to web media server 14b. *Id.* Web media server 14b then communicates “the URL or other suitable information to browser 12b.” *Id.* Browser 12b uses the information “to request from web content server 18 the web page that browser 12a requested.” *Id.*

D. Claim Construction

In *inter partes* reviews, the Board construes claims using the same claim construction standard employed in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b) (2020). Under the principles set forth by our reviewing court, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would have been understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Claims should be interpreted in light of the specification, but limitations from the specification should not be read into the claims. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996), *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014).

Furthermore, only claim terms that are in controversy need to be construed and only to the extent necessary to resolve the controversy. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

In our Institution Decision, we agreed with the parties that no claim terms needed to be expressly construed to determine whether to institute an *inter partes* review. Dec. 13 (citing Pet. 12; Prelim. Resp. 34). We did note,

however, “information related to the shared web browsing interaction” recited in each of the independent claims. Dec. 13. Based on the preliminary record at the time of institution, we determined the scope of “information related to the shared web browsing interaction” encompassed web pages that are shared across the browsers engaged in the co-browsing or sharing session. Dec. 54. Both parties address this issue after institution. PO Resp. 25–36 (Patent Owner disagreeing with our preliminary analysis in our Institution Decision); Pet. Reply 1–5. We need not decide that issue in this Final Written Decision, however, because we determine that Petitioner has not met its burden to demonstrate unpatentability for reasons unrelated to the parties’ arguments concerning the scope of “information related to the shared web browsing interaction.”

After institution, Petitioner proposed that portions of both independent claims were directed to “intended use” and should not be given any weight. Pet. Reply 6. We disagree for the reasons explained below.

1. Purported Intended Use of “Wherein” Limitations

Independent claims 1 and 11 each recite three “wherein” clauses:

- [1.f.i] 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;
- [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, and
- [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;

Ex. 1001, 23:52–24:3 (“wherein” clauses in claim 1); *see also* Ex. 1001, 25:11–30 (“wherein” clauses in claim 11).

For the first time in its Reply, Petitioner contends that these “wherein” clauses “modify limitation [1f] and describe the intended use of ‘the information related to the shared web browsing interaction.’” Pet. Reply 6; *see* Ex. 1001, 23:52–24:3 (“wherein” clauses in claim 1), 25:11–30 (“wherein” clauses in claim 11). Petitioner argues that these “wherein” clauses, therefore, should not be given patentable weight. Pet. Reply 6 (citing *Minton v. Nat’l Ass’n of Sec. Dealers, Inc.*, 336 F.3d 1373, 1381 (Fed. Cir. 2003); *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1376 (Fed. Cir. 2001)). Petitioner further argues that “[c]laim 1 recites a method that is performed by a host device, while subparts [1f.i]–[1f.iii] recite limitations not performed by the claim actor, i.e., the host device.” Pet. Reply 6.

In response, Patent Owner contends that limitations [1f.i]–[1f.iii] may not be ignored when reading the claims. PO Sur-reply 16–17. As Patent Owner indicates, the Examiner allowed the claims after amendments were made, including amendments to limitation [1f.i]. PO Sur-reply 16–17 (citing Ex. 2008, 2–3, 7–8, 10¹⁰); Ex. 1002, 35–36, 40–41, 43. Patent Owner further and correctly indicates that “[t]he Examiner specifically stated [as a Reason for Allowance] that the temporal ordering of the claims, including “enables the invitee device to generate its own request for the webpage to retrieve substantially the same content as the [host] device” overcomes the

¹⁰ Exhibit 2008 is an excerpt of pages 34–42 of the prosecution history exhibit (Ex. 1002).

prior art. PO Sur-reply 16 (citing Ex. 2008, 10); Ex. 1002, 43 (identifying in Reasons for Allowance—“[s]uch ordering (record the interaction, send a request for the webpage to a website server, then transmit the information to the synchronization server for the invitee device to generate its own request for the webpage to retrieve substantially the same content as the [host] device[])”).

We agree with Patent Owner that limitations [1f.i]–[1f.iii] must not be ignored in our analysis. First, limitation [1f.i] was amended to gain allowance and so must not be ignored for at least that reason. *See Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333 (Fed. Cir. 2003) (giving weight to phrases added to gain allowance of the claims because “patentability of the claims hinged upon their presence in the claim language”); PO Sur-reply 17 (citing same).

Additionally, limitations [1f.ii] and [1f.iii] recite active steps that must be performed for a synchronized browsing session—“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” (limitation [1f.ii]) and “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” (limitation [1f.ii]).

Accordingly, for these reasons, we do not agree with Petitioner that the “wherein” clauses in claim 1 (Ex. 1001, 23:52–24:3) and in claim 11 (Ex. 1001, 25:11–30) should receive no weight in our analysis.

2. Other Claim Terms

In addition, we discuss claim interpretation to the extent it is necessary in the context of determining whether Petitioner has shown the challenged claims are unpatentable.

E. Asserted Obviousness of Claims 1–16 over Lebrun and Wang

Petitioner asserts that claims 1–16 would have been obvious under 35 U.S.C. § 103 based on the combined teachings of Lebrun and Wang. For the reasons that follow, we are not persuaded that Petitioner has established by a preponderance of the evidence that these claims are unpatentable under § 103(a) based on Petitioner’s combination of Lebrun and Wang.

1. Independent Claim 1

Regarding its proposed combination of Lebrun and Wang, Petitioner relies on Lebrun’s group surfing session created by group surfing server 140 for disclosing or suggesting the limitations recited by claim 1. *See, e.g.*, Pet. 21–35. In Lebrun’s group-surfing session, “[m]ultiple 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.” Ex. 1005, 7:7–9; *see* Pet. 22 (quoting Ex. 1005, 7:7–9). Petitioner maps Lebrun’s group-surfing session to the recited “synchronized browsing session.” Pet. 22 (quoting Ex. 1005, 4:6–7, 7:7–9). Petitioner maps Lebrun’s first or controlling web client to the recited host device, Lebrun’s other web clients to the recited invitee device, and Lebrun’s group-surfing server to the recited synchronization server. *See, e.g.*, Pet. 22 (citing Ex. 1005, 32:9–12 (“first web client”)); Pet. 33 (citing Ex. 1005, 35:26–28, 45:21–29 (“controlling web client”)); Pet. 22 (citing Ex. 1005, 32:14–16 (inviting other web clients participating in the session)); Pet. 24 (citing

Ex. 1005, 32:9–12 (“group-surfing server”). Petitioner also argues that “Wang also discloses” many of the limitations recited by claim 1. *See* Pet. 23 (limitation [1a]), 25 (limitation [1c]), 27–28 (limitation [1e]), 29 (limitation [1f]), 30–31 (limitation [1f.i]), 32 (limitation [1f.ii]), 34 (limitation [1f.iii]), 35 (limitation [1g]).

Patent Owner contends with particularity that Petitioner’s combination of Lebrun and Wang does not disclose limitations [1c]–[1g]. PO Resp. 40–56; PO Sur-reply 11–20. As an initial matter, Patent Owner argues that the claimed steps reflect the invention in the specification:

[T]he “synchronized browsing sessions” of the inventions are achieved by first transmitting “information related to the shared web browsing interaction” from a host device to a “synchronization server.” The “information related to the shared web browsing interaction” is then transmitted from the “synchronization server” to an “invitee device.” The “invitee device” next uses the received “information related to the shared web browsing interaction” to perform the same web browsing interactions that the host device performed. As a result, the “host device” and the “invitee device” are synchronously sharing the same web browsing experiences in real-time.

PO Resp. 1-2; *see also* PO Resp. 12–25 (specification description of how the synchronization server uses “information related to the shared web browsing interaction” to administer a synchronized browsing session between a host device and an invitee device). In allowing the claims that issued as the challenged patent, the Examiner similarly identified as a reason for allowance the temporal ordering of the claims in which a host device (1) records shared web browsing interaction, (2) sends a request for webpage content to a website server, and (3) then transmits the information related to the shared web browsing interaction “to the synchronization server for the invitee device to generate its own request for the webpage [content] to

retrieve substantially the same content as the [host device].” Ex. 1002, 43; *see* PO Resp. 16 (citing same Reasons for Allowance).

For the reasons set forth below, we determine independent and separate reasons for our conclusion that Petitioner does not satisfy the burden to demonstrate by a preponderance of evidence that claim 1 is unpatentable over Lebrun and Wang.

a. Limitation [1c]

Claim 1 recites “sending an invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier” (limitation [1c]). For this limitation Petitioner relies on Lebrun and also on Wang. *See* Pet. 24–25 (“Lebrun discloses . . . Wang also discloses this limitation.”). Patent Owner contends that Petitioner has failed to show by a preponderance of the evidence that Petitioner’s combination of Lebrun and Wang discloses or suggests “sending an invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier,” as recited in limitation [1c]. PO Resp. 40–42; PO Sur-reply 11–13. For the reasons set forth below we find that Petitioner has failed to meet its burden to demonstrate that the combination of Lebrun and Wang discloses or suggests limitation [1c].

i. Lebrun

For the invitation, Petitioner relies on Lebrun’s session-creation message sent by the first web client (mapped to the recited host device) to the group-surfing server (corresponding to the recited synchronized browsing session). Pet. 25 (citing Ex. 1005, 32:9–12). For further support, Petitioner identifies two types of information included in Lebrun’s session-creation message. First, Petitioner relies on Lebrun’s session-creation

message including an “identifier for the group-surfing session.” Pet. 25 (citing Ex. 1005, 32:9–12; citing prior-Petition Sections IX.1.a–c). Second, in an earlier reference to “information to invite web clients,” Petitioner also relies on Lebrun’s session-creation message that “can include information *to invite* ‘web clients’ that are ‘participating in’ or ‘permitted to participate in’ the session.” Pet. 22 (Petition Section IX.1.a citing Ex. 1005, 32:14–16) (emphasis added).

Patent Owner contends that Lebrun’s session-creation message does not meet the claim limitation because the first web client (mapped to the recited host device) sends the message to the group-surfing server (mapped to the synchronization server) and not the other web clients participating in the group-surfing session (mapped to the invitee device) as required by limitation [1c]. PO Resp. 41. In response, Petitioner contends that the claim does not require the host device to send the invitation *directly* to the invitee device. Pet. Reply 7. Based on Lebrun’s description that the group-surfing server “informs the participants in the group-surfing session” after receiving the session-creation message from the first web client (as acknowledged by Patent Owner), Petitioner contends that the session-creation message sent by the first web client is “forwarded to the invitee, which meets the limitation.” Pet. Reply 8 (citing Ex. 1003 ¶¶ 37, 149; PO Resp. 41–42)¹¹; Pet. 24 (Petition Section IX.1.c quoting Ex. 1005, 44:12–14).

¹¹ Petitioner accepts Patent Owner’s position that the host device is required to perform the sending recited in limitation [1c]. *See* Pet. Reply 8 (contending the group-surfing server forwards the received message); Pet. Reply 6 (“Claim 1 recites a method that is performed by a host device, while subparts [1f.i]–[1f.iii] recite limitations not performed by the claim actor, i.e., the host device.”). Although Petitioner argued at the hearing that the limitations need not be performed by the host device (Tr. 9:8–10:12), this

Patent Owner is correct that Lebrun does not describe the group-surfing server as forwarding the session-creation message to the invited web client. PO Sur-reply 12. Although Lebrun describes the group-surfing server as “informing the participants in the group-surfing server session” after receiving the session-creation message and creating the group-surfing session, Lebrun does not describe forwarding or otherwise sending the session-creation message to the participants. Ex. 1005, 32:26–28, 44:12–14.

Petitioner’s citations in this regard to Dr. Lieberman’s declaration do not adequately support Petitioner’s “forwarding” contention. Pet. Reply 8 (citing Ex. 1003 ¶¶ 37, 149); Ex. 1003 ¶ 37 (indicating the challenged patent describes the invitation as being sent by email, instant message, or social network communication); Ex. 1003 ¶ 149 (describing the group-surfing server receiving the session-creation message, creating the group-surfing session, and “inform[ing] the participants in the group-surfing session”). Petitioner does not identify any testimony from Dr. Lieberman that supports Petitioner’s Reply position that Lebrun’s group-surfing server “forwards” the session-creation message to the group-surfing session participants, nor are we aware of any such testimony. *See, e.g.*, Ex. 1003 ¶ 149 (The group-surfing server “responds to the group session request ‘by (1) creating a group-surfing session, and (2) informing the participants [web clients] in the group-surfing session.’”); *see generally* Ex. 1034. Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

statement contradicts Petitioner’s statements in its Reply (Pet. Reply 8). Moreover, Petitioner’s arguments are based on the session-creation message sent by the host device, not on other communications in Lebrun. Pet. 25.

Thus, even if we were to agree with Petitioner that limitation [1c] was sufficiently broad to encompass the host device sending an invitation indirectly through the synchronization server to the invitee device, Petitioner has not demonstrated by a preponderance of the evidence that Lebrun's group-surfing server informing the participants in the group-surfing session after receiving the session-creation message would have suggested that the first web client (mapped to the recited host device) sends an invitation through the group-surfing server (mapped to the recited synchronization server) to the participating web clients (mapped to the recited invitee device).

Accordingly, we agree with Patent Owner that Petitioner does not demonstrate by a preponderance of the evidence that one of ordinary skill would understand Lebrun to disclose or suggest the host device sending an invitation to an invitee device, as required by limitation [1c].

ii. Wang

For limitation [1c], Petitioner indicates that "Wang also discloses this limitation" but does not identify any invitation in Wang. Pet. 25; *see* PO Resp. 42; PO Sur-reply 12 (arguing that Wang does not disclose the recited invitation). Rather, Petitioner relies on Wang's "communication means for enabling the client devices to display a message for other client devices" (Ex. 1006 ¶ 20). Pet. 25 (citing Ex. 1006 ¶ 20). Petitioner contends, paraphrasing Dr. Lieberman's testimony, that "[t]he client device *could* send an invitation via the 'communication means' to join the session." Pet. 25 (citing Ex. 1006 ¶ 20; Ex. 1003 ¶ 160) (emphasis added).

Neither Dr. Lieberman nor Petitioner sufficiently explains why the mere description of a communication means for displaying a message to other client devices would be understood by one of ordinary skill as

disclosing or suggesting sending an invitation to an invitee device to join the synchronized browsing session, as required by limitation [1c]. That a communication means could be so used is not sufficient. *See Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.”).

Petitioner adds in its Reply that Wang discloses (1) an invitation message sent from the first client device (mapped to the recited host device) to the server apparatus (mapped to the recited synchronization server) and (2) an invitation notice or acknowledgement from the server apparatus to the second client device (mapped to the invitee device). Pet. Reply 8 (citing Ex. 1007¹² ¶¶ 47–48). Patent Owner contends that neither Wang’s invitation nor Wang’s invitation notice satisfy limitation [1c]. PO Sur-reply 12.

It is undisputed that Wang does not disclose an invitation message that is sent from the host device to an invitee device. Rather, Wang describes an invitation message sent from the first client device to the server apparatus (Ex. 1007 ¶ 47) and describes an invitation notice or acknowledgement sent from the server apparatus to the second client device (Ex. 1007 ¶ 48). Wang describes these messages as separate communications. *See* Ex. 1007 ¶¶ 47, 48, Fig. 3. Petitioner’s own single-sentence argument itself acknowledges that the invitation and the invitation notice are distinct communications. *See* Pet. Reply 8 (“[Patent Owner] makes a similar admission regarding Wang: “the *invitation message* from

¹² We understand Petitioner citation to be to Wang (Ex. 1006), not Prajapat (Ex. 1007).

the first client device (T5) is sent to the server apparatus (T6) . . . [which] then ‘transmits *an invitation notice* . . . to a second client device.’”).

Accordingly, we determine that Petitioner has not shown by a preponderance of the evidence that Wang discloses or suggests limitation [1c].

iii. Conclusion Regarding Petitioner’s Combination of Lebrun and Wang

As discussed above, Petitioner has not demonstrated that Lebrun and Wang individually disclose or suggest sending an invitation as required in limitation [1c]. *See, e.g.*, Pet. 25 (“Wang also discloses this limitation.”). As such, we need not reach Petitioner’s argument that a POSITA would have been motivated to combine “Wang’s ‘communication means’ with Lebrun’s ‘first web client,’ because it is a combination of prior art elements according to known methods yielding predictable results.” Pet. 25. This is because Wang’s communication means does not disclose or suggest the required limitation so even if properly combined Petitioner’s combination of Lebrun and Wang would not disclose or suggest limitation [1c].

Accordingly, we conclude that Petitioner has not demonstrated that the subject matter of limitation [1c] would have been obvious over Lebrun and Wang.

b. Limitations [1e] and [1g]

Claim 1 recites “sending a request for webpage content to a website server independent of the synchronization server” (limitation [1e]), “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” (limitation [1f]), and “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” (limitation [1g]).

As noted above, the Examiner noted as a reason for allowance the temporal ordering of the limitations, including that the host device “transmit[s] the information to the synchronization server for the invitee device to generate its own request for the webpage to retrieve substantially the same content as the [host] device” after recording the shared web browsing interaction and then sending the request for the webpage content to the synchronization server. Ex. 1002, 43. Limitation [1g] further requires the host device to receive the webpage content from the website requested in limitation [1e] “after transmitting the information related to the shared web browsing interaction to the synchronization server,” as discussed further below. For the reasons set forth below we find that Petitioner has not shown that Lebrun or Wang discloses or suggests limitation [1g].

i. Host Device Requests and Receives Webpage Content

Patent Owner argues that “the fundamental differences in components, topology, and flows [of the prior art and the claimed subject matter] would not have been obvious to POSITA at the time of the [challenged patent], and Petitioner has not met its burden of proving otherwise.” PO Sur-reply 1; *see, e.g.*, PO Resp. 12–22 (describing how the claims administer a synchronized browsing session among a host device and an invitee device).

Claim 1 requires the host device to request and receive webpage content from the website server in a particular manner as recited in limitations [1e]–[1g]. Specifically, the host device first sends a request for webpage content to a website server independent of the synchronization

server (limitation [1e]), then transmits information related to the shared web browsing interaction to the synchronization server (limitation [1f]), and only after that transmission, receives the requested webpage content from the website server (limitation [1g]).

According to the plain language of the claim, the webpage content received in limitation [1g] is the content requested in the request sent in limitation [1e]. This is because the requested webpage content is received “responsive to sending the request for webpage content to the website server” (limitation [1g]). Also, limitation [1g] uses antecedent basis to refer to the “request for webpage content” recited in limitation [1e].

Moreover, regarding the device that requests and receives webpage content, the only limitation in claim 1 requesting webpage content is limitation [1e]. Limitation [1f.iii], in referring by antecedent basis to “the webpage content” in “the data associated with the webpage content *requested by the host device*” (emphasis added), clarifies that the webpage content in limitation [1e] is requested by the host device.¹³

ii. Parties’ Contentions

For the specific requirements recited by claim 1 for the host device’s requesting and receiving the webpage content from the website server, Petitioner relies in its Petition on Lebrun’s session-creation message that includes an identifier for the initial page (and so discloses or suggests, according to Dr. Lieberman, entering the webpage URL into the web client); Lebrun’s statement that in some circumstances “each web client 110 can

¹³ As noted earlier, Petitioner acknowledges in its Reply that the host device performs these steps. Pet. Reply 6 (“Claim 1 recites a method that is performed by a host device, while subparts [1f.i]–[1f.iii] recite limitations not performed by the claim actor, i.e., the host device.”).

receive the next page 153 directly from the web site”; and Lebrun’s program fragment that determines which web page to retrieve. Pet. 27 (citing Ex. 1005, 32:9–12, 32:21–24, 35:17–19; Ex. 1003 ¶ 165); Pet. 34 (citing Ex. 1005, 36:21–25, 32:21–24).

Patent Owner contends, regarding limitation [1e], that Lebrun “only discloses the controlling web client sending a session creation message that identifies an initial page to the group-surfing server, which then retrieves the webpage and sends it to the participating web clients (including the controlling web client).” PO Resp. 44 (citing Ex. 1005, 32:9–31). Patent Owner also notes that the direct retrieval from the website (Ex. 1005, 35:17–19) relied on by Petitioner is only applicable where no data related to identity are involved, and so, according to Patent Owner, this passage is inapposite because limitation [1b] requires “the session identifier is associated with the host device and the established synchronized browsing session.” PO Resp. 45–46. Patent Owner contends that Lebrun does not disclose limitation [1g] reciting receiving the requested webpage because the host device does not request the webpage content from the website server. PO Resp. 56.

In Reply, Petitioner relies on Lebrun’s Figure 1 that is related to Lebrun’s techniques for access to personalized web sites (not Lebrun’s embodiments related to group access to websites) that shows a line connecting web site 130 and web client 110. Pet. Reply 11–12 (limitation [1e]); Pet. Reply 18–19 (limitation [1g]).

Patent Owner contends that, in relying on Lebrun’s Figure 1 in its Reply, Petitioner improperly combines different embodiments in Lebrun without providing any reason why one of ordinary skill would combine the

two different systems. PO Sur-reply 15–16 (limitation [1e]); PO Sur-reply 20 (limitation [1g]).

iii. Lebrun

Even setting aside Petitioner’s failure to explain why one of ordinary skill would look to the personalized web site embodiment in Lebrun in the context of requesting and receiving webpage content for group access to websites, Petitioner does not address the particular timing required by limitation [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.”

Petitioner relies on Lebrun’s first web client entering a URL to access the initial web page directly from the web site. Pet. 27 (citing Ex. 1005, 32:9–12, 32:21–24, 35:17–19; Ex. 1003 ¶ 165); Pet. 34 (citing Ex. 1005, 36:21–25, 32:21–24). Petitioner contends that this web page access of the initial page occurs before sending the session-creation message to the group-surfing server. Pet. 27 (“Thus, before sending a request to initiate a session, the user must independently enter the web page URL into the web client, *before adding this information into the ‘session-create message.’*” (emphasis added)). In Reply, Petitioner further relies for limitation [1e] on Lebrun’s functionality of sending a web page from the web server to the web client as shown in Lebrun’s Figure 1. Pet. Reply 11 (citing Ex. 1005, 32:21–24, 31:27–30, Fig. 1). Specifically, Petitioner contends that Lebrun’s separate disclosures of (i) a URL for the initial web page is included in session-creation message 151 (Ex. 1005, 32:21–24), (ii) the web site sending a web page directly to the web client (Fig. 1), and (iii) the web site delivers information 132 to web clients or the group-surfing server 140 “in response

to requests made using the communication protocol” (Ex. 1005, 32:27–30), taken together disclose or suggest the subject matter of limitation [1e].

Petitioner acknowledges in another argument context that the host device must receive the requested webpage content after transmitting. Pet. Reply 22 (“All that is required of the host with respect to the [information related to the shared web browsing interaction] 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)].”). Notably, however, Petitioner does not address how the URL access to create the session-creation message meets the timing required in limitation [1g]. *See* Pet. 27, 34–35; Pet. Reply 10–12, 18–19.

Petitioner relies on the first or controlling web client sending a “next-page message” to the group-surfing server as meeting the transmitting limitation [1f]. Pet. 28–29. As such, Petitioner argues the initial page access by URL discloses or suggests sending the request in limitation [1e] but the next-page activity discloses or suggests the receiving required in limitation [1g]. As discussed above, however, the webpage content received in limitation [1g] is the same webpage requested in limitation [1e]. This further supports a finding that Petitioner fails to demonstrate that the web page access related to the session-creation message using the initial page shared in Lebrun, meets the claim requirements that the requested webpage content is received from the website server “after transmitting the information related to the shared web browsing interaction”—that is, the next-page message according to Petitioner, as required by limitation [1g].

Even if we were to agree with Petitioner that Lebrun discloses that the first (or controlling) web client directly accesses the web site to request and

receive web pages (as Petitioner argues), that is insufficient to meet the specific requirements of limitation [1g].

iv. Wang

Petitioner additionally relies on Wang's page navigation means for disclosing limitations [1e] and [1g]. Pet. 27–28, 35. Wang describes the page navigation means as a component of the client device that “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.” Ex. 1006 ¶ 41; Pet. 27 (citing Ex. 1006 ¶ 41); PO Resp. 46 (citing Ex. 1006 ¶ 41). Petitioner maps Wang's client device to Lebrun's first/controlling web client. Pet. 27.

Patent Owner contends, however, that Wang's client device sends a request for webpage content to the server apparatus, not to the website server as required by the claim. PO Resp. 47–48 (citing Ex. 1006 ¶ 41; Ex. 2004 ¶ 85). We agree with Patent Owner. Petitioner does not identify a website server independent of the server apparatus (mapped to the recited synchronization server) in Wang. Additionally, we credit Mr. Friedman's testimony that “Wang fails to disclose the website server independent of the synchronization server” because Mr. Friedman relies on passages in Wang that support his conclusion. Ex. 2004 ¶ 85 (discussing Ex. 1006 ¶¶ 42–44, Fig. 2, Fig. 5); *see* PO Resp. 46 (citing Ex. 2004 ¶ 85).

Because Wang does not disclose the client device sending a request for webpage content to a website server independent of its server apparatus (mapped to the synchronization server), we agree with Patent Owner that Petitioner has not shown Wang discloses limitation [1e] or receiving the requested webpage content from the website server as required by limitation [1g].

v. Conclusion Regarding Petitioner's Combination of Lebrun and Wang

As discussed above, Petitioner has not demonstrated that Lebrun and Wang individually disclose or suggest receiving the webpage content requested from the website server (limitation [1g]). *See, e.g.*, Pet. 25 (“Wang also discloses this limitation.”). As such, we need not reach Petitioner’s argument that one of ordinary skill “would have been motivated to combine Wang’s ‘server apparatus’ with synchronization functionality with Lebrun’s ‘group-surfing server,’ because it is a combination of prior art elements according to known methods yielding predictable results.” Pet. 35. This is because Wang’s server apparatus does not disclose or suggest the required receiving limitation as argued by Petitioner, so Petitioner’s combination relying on Wang for this limitation likewise fails to disclose or suggest the required limitation.

For these reasons, we conclude that Petitioner has not demonstrated by a preponderance of the evidence that the subject matter of limitation [1g] would have been obvious over Lebrun and Wang.

c. Limitations [1f] and [1f.i]–[1f.iii]

Claim 1 also requires the invitee device to retrieve from the website server data associated with the webpage content requested by the host device in a particular manner recited in limitations [1f] and [1f.i]–[1f.iii]. Claim 1 requires the host to transmit, subsequent to sending the request for webpage content to the website server, information related to the shared web browsing interaction to the synchronization server (limitation [1f]). “[I]n response to receiving the information related to the shared web browsing interaction from the host device,” the synchronization server transmits the information to the invitee device (limitation [1f.ii]). In response to receiving

that information, the invitee device retrieves, from the website server, data associated with the webpage content requested by the host device and the information related to the shared web browsing interaction (limitation [1f.iii]. For the reasons set forth below we find that neither Lebrun nor Wang discloses or suggests limitations [1f] and [1f.i]–[1f.iii].

i. Lebrun

For these related limitations, Petitioner relies on the first/controlling web client sending a next-page message to the group-surfing server, which causes the next page to be presented to the other web clients by the group-surfing server. Pet. 29, 31, 33–34. Petitioner asserts that “when the controlling web client chooses the next page, the program fragment on the other web clients uses this information to request the web page.” Pet. 30 (citing Ex. 1005, 35:17–19; Ex. 1003 ¶ 173; Ex. 1005, 36:21–25, 45:21–46:5).

Patent Owner contends that Lebrun’s next page message “is a command from the controlling web client directing the group-surfing server to access and direct the web site to deliver the next page to the group-surfing server itself.” Ex. 1005, 45:21–29; *see* PO Resp. 47 (citing Ex. 1005, 45:21–29; Ex. 2004 ¶¶ 70–73). We agree with Patent Owner. “At a step 233, the controlling web client 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.” Ex. 1005, 45:21–23. At step 234, the group-surfing server 140 receives the next-page message 152, contacts the web site 130 having the next page “after adding proper cookie and other identity information,” and directs the web site “to deliver that next page 153 to the group-surfing server 140 itself.” Ex. 1005, 45:25–28. “The group-surfing server 140 then re-

sends that page 153 to those web clients 110 participating in the session.”
Ex. 1005, 45:28–29.

The next-page message (mapped to the recited “information related to the shared web browsing interaction”) is not transmitted to a web client as required by claim [1f.ii] and, as such, is not processed by the browser of the web client and does not enable the web client to generate a request to receive substantially the same content as the request for the webpage content from the controlling web client as required by claim [1f.i]. *See* PO Resp. 47–49, 52–53. Consequently, a web client that never receives the next-page message cannot “retrieve data from the website server in response to receiving the information related to the shared web browsing interaction”—that is, in response to receiving the next-page message, as required in claim [1f.iii].

In Reply, Petitioner relies on Lebrun’s disclosure that the web client can receive the next page directly from the web site “where no ‘cookies’ or other data relating to identity are involved” (Ex. 1005, 17–19) and retrieving multimedia elements directly from the website (Ex. 1005, 46:1–2). Pet. Reply 15 (citing Ex. 1005, 35:17–19, 46:1–2). Petitioner, however, unduly focuses on generating a request to retrieve the web content without addressing the lack of transmission of the next-page message to the web client.

Moreover, Petitioner does not contend that the multimedia element links on the partial web page used by the web client to directly retrieve multimedia elements from the web site constitute “information related to the shared web browsing interaction” as required by claim 1. *See, e.g.*, Pet. 25–

26, 28–29, 30 (discussing choosing the next page)¹⁴; Pet. Reply 15 (citing Ex. 1005, 35:17–19, 46:1–2). Although we could speculate ways in which a link to multimedia elements in a web page might disclose or suggest “information related to the shared web browsing interaction,”¹⁵ we are not permitted to make arguments that the Petitioner could have made but did not. *Magnum Oil*, 829 F.3d at 1381 (indicating that the Board is not free “to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR”).

Additionally, Lebrun indicates that the group-surfing server contacts the web site having the next-page “after adding proper cookie and other identity information,” whereas the direct receipt from the web site only occurs “where no ‘cookies’ or other data relating are involved.” Ex. 1005, 45:25–28, 35:17–19; *see* PO Resp. 45–46 (contending the alternative embodiment in Ex. 1005, 35:17–19 is inapplicable to claim 1). Petitioner does not address this issue raised by Patent Owner (PO Resp. 45–46), which further undermines Petitioner’s position. *See generally* Pet. Reply 9–10, 14–18.

¹⁴ Petitioner includes a “see also” cite to the partial web pages example but does not discuss that the links in that embodiment constitute “information related to the shared web browsing interaction.” Pet. 30 (citing Ex. 1005, 36:21–25, 45:21–46:5). Nor does Petitioner do so in its Reply. *See* Pet. Reply 15 (citing Ex. 1005, 35:17–19, 46:1–2).

¹⁵ We recognize that in IPR2023-00339 Petitioner made extensive arguments regarding the claim term “web browsing interaction data” and Lebrun’s multimedia embodiment. Those arguments are not before us, however, in this proceeding. We also recognize that Patent Owner argues that “partial webpages (those which contain removed multimedia elements)” are not “information related to the shared web browsing interaction” (PO Resp. 49). We do not view Patent Owner’s mere mention of multimedia elements not argued by Petitioner sufficient to impute such an argument to Petitioner.

For these reasons, we determine that Petitioner has not shown that Lebrun discloses or suggests the subject matter recited in limitations [1f] and [1f.i]–[1f.iii].

ii. Wang

Petitioner also relies on Wang as disclosing limitations [1f] and [1f.i–1f.iii]. Pet. 29 (limitation [1f]); Pet. 30–31 (limitation [1f.i]); Pet. 32 (limitation [1f.ii]); Pet. 34 (limitation [1f.iii]).

Regarding limitation [1f], Petitioner cursorily asserts:

Each client device sharing the web page “access the server through its own individual session,” so that the client devices “can access an application execution unit through a dedicated URL address to engage in a group session.”

Pet. 29 (citing Ex. 1006 ¶ 15). Petitioner does not adequately explain how Wang’s description that client devices use the same URL address to access the application execution unit discloses or suggests “transmitting information related to the shared web browsing interaction to the synchronization server,” much less doing so in the manner required by limitation [1f]—“subsequent to sending the request for webpage content to the website server.” Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *Magnum Oil*, 829 F.3d at 1380.

Petitioner additionally relies on Wang’s “client synchronization control unit (CSC)” in the server apparatus for the subject matter recited in limitations [1f.i] and [1f.iii]. Pet. 30–31 (citing Ex. 1006 ¶¶ 23, 43, 14); Pet. 34 (citing Ex. 1006 ¶¶ 23, 43). Wang’s control unit in the server apparatus “gives the web page or the snapshot data to the client devices among which the web page is to be shared, so that the same web page is displayed

synchronously on the plurality of different client devices.” Ex. 1006 ¶ 43; *see* Pet. 30 (quoting Ex. 1006 ¶ 43).

We agree with Patent Owner that Wang’s description of giving the web page to the client device for display does not disclose or suggest the client device generating a request to retrieve webpage content or retrieve data from the website server. *See* PO Resp. 52 (“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 ‘generat[ing] a request . . .’ as required by the claim language.”); PO Resp. 55 (Wang’s “server apparatus operates through its CSC component to display a web page to the client devices rather than the claimed step whereby the invitee device itself ‘retrieves data from the website server.’”); Ex. 1006 ¶ 43.

Petitioner further relies on Wang’s page navigation means for disclosing limitation [1f.ii]. Pet. 32 (citing Ex. 1006 ¶¶ 23, 41). As discussed above with respect to limitations [1e] and [1g], we agree with Patent Owner that Petitioner does not identify a website server independent of the server apparatus (mapped to the recited synchronization server) in Wang. Rather, as Patent Owner indicates with respect to limitation [1f.ii], “Wang’s page navigation means . . . allows the client device to access the server apparatus and acquire web pages.” PO Resp. 53 (citing Ex. 1006 ¶¶ 41, 67–68, 87–89, Fig. 2).

For these reasons, we determine that Petitioner has not shown that Wang discloses or suggests the subject matter recited in limitations [1f and 1f.i–1f.iii].

iii. Conclusion Regarding Petitioner’s Combination of Lebrun and Wang

As discussed above, Petitioner has not demonstrated that Lebrun and Wang individually disclose or suggest the subject matter recited in limitations [1f and 1f.i–1f.iii]. *See, e.g.*, Pet. 29, 30, 32, 34 (each contending “Wang discloses this limitation”). Because we do not find that the combination of Lebrun or Wang discloses the limitations, we need not reach Petitioner’s argument that one of ordinary skill would be motivated to combine Wang’s feature with Lebrun’s feature because the combination would be “a combination of prior art elements according to known methods yielding predictable results” (Pet. 29, 31, 34) or “to receive information from a user about which web pages are shared to other users in a session” (Pet. 32).

For these reasons, we conclude that Petitioner has not demonstrated by a preponderance of the evidence that the subject matter of limitations [1f] and [1f.i–1f.iii] would have been obvious over Lebrun and Wang.

d. Claim 1 Conclusion

“Once all relevant facts are found, the ultimate legal determination [of obviousness] involves the weighing of the fact findings to conclude whether the claimed combination would have been obvious to an ordinary artisan.” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1361 (Fed. Cir. 2017). As noted above, we have identified differences between the claimed subject matter and the scope and content of the prior art (Lebrun and Wang). *Graham*, 383 U.S. at 17. We also address here Patent Owner’s more general argument that “the fundamental differences in components, topology, and flows [of the prior art and the claimed subject matter] would not have been obvious to POSITA at the time of the [challenged patent], and

Petitioner has not met its burden of proving otherwise.” PO Sur-reply 1; *see, e.g.*, PO Resp. 12–22 (describing how the claims administer a synchronized browsing session among a host device and an invitee device). We agree with Patent Owner.

As discussed above, claim 1 requires the host device to request and receive webpage content from the website server in particular ways as identified in limitations [1e] and [1g]. Similarly, claim 1 requires the invitee device to retrieve data from the website server in response to receiving “the information related to the shared web browsing interaction from the synchronization server” (limitation [1f.iii]). For the reasons discussed above, Petitioner has *not* shown by a preponderance of the evidence its combination of Lebrun and Wang does so.

For the required website server interaction, in its Petition, Petitioner relies on Lebrun’s description of an alternative embodiment applicable only when no cookies or other identity information are involved (Ex. 1005, 35:17–19). *See, e.g.*, Pet. 30 (citing Ex. 1005, 35:17–19). As Patent Owner indicates, this alternative is not relevant to the subject matter recited in claim 1 which requires identity information. PO Resp. 45. Petitioner does not address this shortcoming in its Reply. *See generally* Pet. Reply.

Rather, in its Reply, for website server interaction, Petitioner relies on Lebrun’s functionality of sending a web page from the web server to the web client as shown in Lebrun’s Figure 1. *See, e.g.*, Pet. Reply 11 (citing Ex. 1005, 32:21–24, 31:27–30, Fig. 1). Specifically, Petitioner contends that Lebrun discloses that (i) a URL for the initial web page is included in session-creation message 151 (Ex. 1005, 32:21–24), (ii) the web site sends a web page directly to the web client (Fig. 1), and (iii) the web site delivers information 132 to web clients or the group-surfing server 140 “in response

to requests made using the communication protocol” (Ex. 1005 32:27–30). Pet. Reply 11. Although this shows the web site sending a web page directly to a web client, the prior art of Lebrun does not do so in the manner required by the claims (limitations [1e], [1f.i], [1f.iii], [1g]).

Petitioner also cites Lebrun’s partial web page that does not include multimedia elements. Pet. 12–14 (summarizing Lebrun); Pet. 30 (citing but not discussing Ex. 1005, 45:21–46:5); Pet. 31 (citing but not discussing Ex. 1005, 45:21–46:5); Pet. Reply 15 (“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 . . .”). Lebrun indicates that each web client “requests those multimedia elements directly from the web site.” Ex. 1005, 46:1–2. Petitioner, however, does not adequately explain how this description would result in the subject matter recited in limitations [1f.i], [1f.iii], and [1g].¹⁶

Regarding the differences between Wang and the web site server access required by claim 1, as discussed above, we agree with Patent Owner that Wang does not disclose or suggest either client device requesting and receiving webpage content from the website server as required by claim 1.

For the separate and independent reasons discussed above, and having considered the arguments and evidence of record, we additionally determine that Petitioner has *not* demonstrated by a preponderance of the evidence that the differences between the subject matter in claim 1 and the prior art of

¹⁶ We are aware of arguments that Petitioner made regarding Lebrun’s multimedia embodiment in other proceedings before the Board. *See generally* IPR2023-00339, Paper 2 (Petition). We, however, decide whether Petitioner has demonstrated unpatentability by a preponderance of the evidence here based only on the record developed for this proceeding.

Lebrun and Wang are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

2. Conclusion Regarding Obviousness over Lebrun and Wang

Independent claim 11 recites many of the same limitations as recited by independent claim 1. *Compare* Ex. 1001, 24:57–59, *with* limitation [1a]; *compare* Ex. 1001, 24:60–64, *with* limitation [1b]; *compare* Ex. 1001, 24:65–68, *with* limitation [1c]; *compare* Ex. 1001, 25:1–4, *with* limitation [1d]; *compare* Ex. 1001, 25:5–6, *with* limitation [1e]; *compare* Ex. 1001, 25:7–10, *with* limitation [1f]; *compare* Ex. 1001, 25:11–17, *with* limitation [1f.i]; *compare* Ex. 1001, 25:18–24, *with* limitation [1f.ii]; *compare* Ex. 1001, 25:24–30, *with* limitation [1f.iii]; *compare* Ex. 1001, 25:31–26:2, *with* limitation [1g]. For independent claim 11, Petitioner relies on its arguments regarding claim 1 (Pet. 37–40) and additionally contends that Lebrun and Wang disclose the recited elements of an apparatus, a network interface, and a processor (Pet. 36–37). For the same reasons discussed above, we conclude that Petitioner has not shown that the subject matter of claim 11 would have been obvious over Lebrun and Wang at the time of the invention.

Furthermore, for the same reasons, we conclude that Petitioner has not shown that the subject matter of dependent claims 2–10 and 12–16 of the challenged patent would have been obvious over Lebrun and Wang at the time of the invention. *Mylan Pharm. Inc. v. Research Corp. Techs., Inc.*, 914 F.3d 1366, 1376 (Fed. Cir. 2019) (“Dependent claims, with added limitations, are generally not obvious when their parent claims are not.”); *see* Pet. 40–45; *see generally* Pet. Reply 7–20 (not arguing dependent claims).

Accordingly, we agree with Patent Owner that “Petitioner fails to meet its burden of proving that all the claims of the [challenged patent] are rendered obvious by Lebrun in combination with Wang.” PO Resp. 38.

F. Asserted Obviousness of Claims 1–16 over Prajapat and Wang

Petitioner asserts that claims 1–16 would have been obvious under 35 U.S.C. § 103 based on the combined teachings of Prajapat and Wang. Pet. 6, 46–73. For the reasons that follow, we are not persuaded that Petitioner has established by a preponderance of the evidence that these claims are unpatentable under § 103(a) based on Petitioner’s combination of Prajapat and Wang.

1. Independent Claim 1

Regarding its proposed combination of Prajapat and Wang, Petitioner relies on Prajapat’s techniques related to “peer-to-peer dynamic web page sharing” and “peer-to-peer simple web page sharing.” Pet. 16–17, 46–61; *see* PO Resp. 57–58. Petitioner identifies Prajapat’s techniques discussed above for peer-to-peer dynamic web page sharing as disclosing the method “performed by a host device for establishing a synchronized browsing session between the host device and an invitee device,” recited in claim 1. Pet. 46 (citing Ex. 1007 ¶¶ 12, 16). Petitioner identifies Prajapat’s web media servers 14a and 14b for the recited “synchronization server.” Pet. 47 (citing Ex. 1007 ¶ 16 (addressing limitation [1.a])), 48 (citing Ex. 1007 ¶ 22 (addressing limitation [1.b])). Petitioner identifies Prajapat’s browser 12a as the recited host device that establishes the synchronized browsing session and that meets the limitation [1.a] requirement to send to the synchronization server a request to establish a synchronized browsing session. Pet. 46–47 (citing Ex. 1007 ¶¶ 12, 16). In addition to relying on Prajapat, Petitioner

also asserts that “Wang also discloses this limitation” and provides purported reasons one of ordinary skill would have made the proposed combination. *See, e.g.*, Pet. 47 (regarding limitation [1.a]); Pet. 49–50 (regarding limitation [1.c]); Pet. 51–52 (regarding limitation [1.e]).

Patent Owner contends, with particularity, that Petitioner’s combination of Prajapat and Wang does not disclose limitations [1a]–[1e] and [1f.i]–[1f.iii]. PO Resp. 69–70; PO Sur-reply 16.

For the reasons set forth below, we determine that Petitioner does not satisfy its burden to demonstrate by a preponderance of evidence that claim 1 is unpatentable over Prajapat and Wang.

a. Limitation [1b]

As discussed above, limitation [1b] requires receiving from the synchronization server a confirmation message including a session identifier having specific characteristics—“generated by the synchronization server” and “is associated with the host device and the established synchronized browsing session.” For this limitation, Petitioner relies on Prajapat’s dynamic co-browsing description that “a browser ‘may submit requests for one or more web pages by communicating a request to web media server,’ where the request may ‘may specify the web page to retrieve and display,’ and ‘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.’” Pet. 48 (quoting Ex. 1007 ¶ 22; citing Ex. 1007 ¶ 12). Petitioner does not rely on any disclosure in Wang for limitation [1b]. Pet. 48–49.

Petitioner recognizes the gap between this description of a browser (mapped to the host device) requesting a web page and including session information and the claim requirement of a host device receiving a

confirmation message having session information of specific characteristics. Pet. 49. In an attempt to bridge the gap, Petitioner relies on Dr. Lieberman’s testimony and asserts “[a] POSITA would have understood that a [sic] upon creating a ‘co-browsing session,’ the ‘web media server’ would necessarily send a confirmation message containing ‘session information’ to a ‘browser’ as part of inherent communication between the browser and the server, and thus would meet this limitation.” Pet. 49 (citing Ex. 1003 ¶ 228; “Section VII.E, *supra*”¹⁷).

Even crediting Dr. Lieberman’s testimony that a confirmation message would be sent, neither Petitioner nor Dr. Lieberman address the specific requirements of the session information generated by the synchronization server—“the session identifier is associated with the host device and the established synchronized browsing session.” Although Dr. Lieberman’s testimony concludes that “a session identifier with information regarding the synchronized browsing session” would be generated by the synchronization server (Ex. 1003 ¶ 228), it does not provide any reasoning or analysis regarding “the session identifier with information regarding the synchronized browsing session” meeting the specific claim requirement that “the session identifier is associated with the host device and the established synchronized browsing session.” At best, Dr. Lieberman’s testimony is understood as concluding “a session identifier with information regarding the synchronized browsing session” meets the claim requirement that a session identifier generated by the web media

¹⁷ Section VII relates to Claim Construction and does not have a subsection E. *See* Pet. 11–12. Section VIII.E relates to motivation to combine Prajapat with Wang but does not address inherent communications. *See* Pet. 19–20.

server would be associated with the established synchronized browsing session, but not the host device.

We do not have sufficient basis from Petitioner’s arguments, Prajapat’s cited descriptions of session information included in a web page request, or Dr. Lieberman’s testimony to conclude that one of ordinary skill would understand a session identifier generated by the web media server would be associated with the browser requesting the web page (corresponding to the host device) and the established synchronized browsing session, as required by limitation [1b].

Although we could speculate reasons supporting a server sending a confirmation message having a session identifier of the particular type required by limitation [1b] generated by the server, we are not permitted to adopt arguments on behalf of petitioners that could have been, but were not, raised. *Magnum Oil*, 829 F.3d at 1381 (indicating that the Board is not free “to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR”).

For these reasons, we conclude that Petitioner has not demonstrated that the subject matter of limitation [1b] would have been obvious over its combination of Prajapat and Wang.

b. Limitation [1c]

Claim 1 recites “sending an invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier” (limitation [1c]). Petitioner relies on Prajapat’s description that browser 12a (corresponding to the recited host device) may specify in a request to co-browse “one or more names or other identifiers of other browsers 12 with which browser 12a desires to co-browse” (Ex. 1007 ¶ 17). Pet. 49 (citing Ex. 1007 ¶ 17). Petitioner also contends that the information

included in the request from browser 12a to the web media server “necessarily includes an identifier for other browsers to join the co-browsing session.” Pet. 49–50 (citing Ex. 1007 ¶ 231). As such, Petitioner identifies as the invitation a request sent from browser 12a (corresponding to the recited host device) to the web media server (corresponding to the recited synchronization server).

We agree with Patent Owner that Prajapat’s description of sending the request to the web media servers is not sufficient because the claim requires the host device to send an invitation to the invitee device and, in contrast, Petitioner identifies a request sent by browser 12a (mapped to the recited host device) to the web media server (mapped to the recited synchronization server). PO Resp. 72–73; *see* Pet. 49–50. Petitioner in its Reply does not address Patent Owner’s arguments. *See, e.g.*, Pet. Reply 22 (contending Prajapat does disclose “information related to the shared web browsing interaction” as recited in limitations [1f]–[1g]).

Petitioner also relies on Wang’s “communication means for enabling the client devices to display a message for other client devices” (Ex. 1006 ¶ 20). Pet. 50 (citing Ex. 1006 ¶ 20). Petitioner contends, paraphrasing Dr. Lieberman’s testimony, that “[t]he client device *could* send an invitation via the ‘communication means’ to join the session” and that one of ordinary skill “would have been motivated to combine Wang’s ‘communication means’ with Prajapat’s ‘browser,’ because it would be a combination of prior art elements according to known methods yielding predictable results.” Pet. 50 (citing Ex. 1006 ¶ 20; Ex. 1003 ¶ 232; Pet. Section VII.E) (emphasis added).

Neither Dr. Lieberman nor Petitioner sufficiently explains why the mere description of a communication means for displaying a message to

other client devices would be understood by one of ordinary skill as disclosing or suggesting the sending of an invitation to an invitee device to join the synchronized browsing session, as required by limitation [1c]. That a communication means could be so used is not sufficient. *See Belden*, 805 F.3d at 1073 (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.”).

For these reasons, we conclude that Petitioner has not demonstrated that the subject matter of limitation [1c] would have been obvious over its combination of Prajapat and Wang.

c. Limitation [1g]

As discussed above, claim 1 recites specific requirements in limitation [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.”

In contrast with specific requirements linked to the request sent by the host device in limitation [1e], Petitioner’s contentions for limitation [1g] rely on the request by browser 14b (mapped to the invitee device) for the web page content from the web content server (mapped to the website server) and implied presentation of the returned web page. Pet. 59–60 (citing Ex. 1007 ¶ 43). Petitioner asserts that “[a] POSITA would have understood that [limitation [1g] is met] when ‘browser 12a’ presents web pages to ‘browser 12b,’ via the ‘web media server.’” Pet. 60 (citing Ex. 1003 ¶ 254). Thus, Petitioner here does not squarely address the requested webpage content being received at browser 12a (mapped to the recited host device), as required by limitation [1g].

Also, Petitioner’s argument regarding receiving webpage content at browser 12b (mapped to the recited invitee device) is inconsistent with Petitioner’s arguments regarding limitation [1e]. Petitioner argues for limitation [1e] that browser 12a (mapped to the recited host device) sends the request for webpage content, but here argues that the web content is presented at the browser 12b (mapped to the recited invitee device). Pet. 51 (citing Ex. 1007 ¶ 43). For this additional reason, Petitioner fails to demonstrate by a preponderance of the evidence that Prajapat discloses or suggests limitation [1g].

Furthermore, in terms of Prajapat’s simple web page sharing description, browser 12a (mapped to the host device) is required to receive webpage content from the web content server 18 (mapped to the website server) after transmitting “the URL or other suitable information regarding the requested web page” (mapped to the information related to the shared web browsing interaction) to the web media server (mapped to the synchronization server). Although not expressly addressing limitation [1g], Patent Owner contends that Prajapat describes simple web page sharing as browser 12a communicates “the URL or other suitable information regarding the requested web page to the web media server” after browser 12a submits a request to the web content server for a web page and the web content server returns the requested web page to browser 12a. PO Resp. 64 (quoting Ex. 1007 ¶ 43¹⁸). Patent Owner’s position reflects the order of Prajapat’s description—“Web content server 18 may return the requested web page to browser 12a. Browser 12a may communicate the

¹⁸ Patent Owner quotes three long phrases from paragraph 43 although Patent Owner mistakenly cites to Ex. 1007 ¶ 41.

URL or other suitable information regarding the requested web page to web media server 14a.” Ex. 1007 ¶ 43.

As such, Prajapat does not describe with respect to simple web page sharing the specific manner of the host device receiving the requested webpage content recited in limitation [1g]—that the web content is received by browser 12a (mapped to the host device) after the browser 12a transmits the URL to the web media server (mapped to the synchronization server). Neither Petitioner nor Dr. Lieberman address the timing requirements by the plain language of limitation [1g], although Petitioner acknowledges in the context of another argument that the host device must receive the requested webpage content after transmitting the “information related to the shared web browsing interaction.” *See* Pet. 60 (citing Ex. 1003 ¶ 254); Ex. 1003 ¶ 254; Pet. Reply 22 (acknowledging the timing required in limitation [1g]). This is another reason Petitioner does not demonstrate that Prajapat discloses or suggests limitation [1g].

Petitioner also relies on Wang’s description that web pages may be displayed synchronously on different client devices and URL address and other information can be displayed on the client devices. Pet. 60 (Ex. 1006 ¶¶ 54, 43, 44). Petitioner’s assertions, however, do not adequately address the specific requirements recited in limitation [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.”

Accordingly, because Petitioner has not demonstrated that Prajapat or Wang individually disclose or suggest this limitation and has not argued that the combination would do so without relying on one of the references, we

determine that Petitioner has not demonstrated that its combination of Prajapat and Wang would have rendered obvious the subject matter recited in limitation [1g].

d. Claim 1 Conclusion

“Once all relevant facts are found, the ultimate legal determination [of obviousness] involves the weighing of the fact findings to conclude whether the claimed combination would have been obvious to an ordinary artisan.” *Arctic Cat*, 876 F.3d at 1361. As noted above, we have identified differences between the claimed subject matter and the scope and content of the prior art (Prajapat and Wang). *Graham*, 383 U.S. at 17. We address here Patent Owner’s more general argument that “the fundamental differences in components, topology, and flows [of the prior art and the claimed subject matter] would not have been obvious to POSITA at the time of the [challenged patent], and Petitioner has not met its burden of proving otherwise.” PO Sur-reply 1; *see, e.g.*, PO Resp. 12–22 (describing how the claims administer a synchronized browsing session among a host device and an invitee device). We agree with Patent Owner.

Prajapat describes in paragraph 43 a “simple web page sharing” embodiment of a browser sending a request for web page content to a web content server, which returns the requested web page to browser 12a. Browser 12a communicates the URL for the web page content to web media server 14a, which communicates the URL to browser 12b. Browser 12b uses the URL “to request from the web content server the web page that browser 12a requested.” Ex. 1007 ¶ 43 (reference numeral omitted). As discussed above, the difference between this description and the claimed subject matter is the particular timing required in the plain language of limitation [1g].

Another difference between the claimed subject matter and Prajapat's request to co-browse, as discussed above, is the claimed invitation required by limitation [1c] and lack of a session identifier generated by the synchronization server required by limitation [1b]. The timing required by limitation [1g] similarly has not been shown. As discussed above with regard to Wang, the web site server access required by claim 1 is not present in Wang.

For the separate and independent reasons discussed above, and having considered the arguments and evidence of record, we determine that Petitioner has *not* demonstrated by a preponderance of the evidence that the differences between the subject matter in claim 1 and the prior art of Prajapat and Wang are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

2. Conclusion Regarding Obviousness over Prajapat and Wang

For independent claim 11, Petitioner relies on its arguments regarding claim 1 (Pet. 62–65) and additionally contends that Prajapat and Wang disclose the recited elements of an apparatus, a network interface, and a processor (Pet. 61–62). For the same reasons discussed above, we conclude that Petitioner has not shown that the subject matter of claim 11 would have been obvious over Prajapat and Wang at the time of the invention.

Furthermore, for the same reasons, we conclude that Petitioner has not shown that the subject matter of dependent claims 2–10 and 12–16 of the challenged patent would have been obvious over Prajapat and Wang at the time of the invention. *Mylan*, 914 F.3d at 1376 (“Dependent claims, with added limitations, are generally not obvious when their parent claims are

not.”); *see* Pet. 66–71; *see generally* Pet. Reply 7–20 (not arguing dependent claims).

Accordingly, we agree with Patent Owner that Petitioner fails to demonstrate that all the claims are rendered obvious by Prajapat in combination with Wang. PO Resp. 57.

G. Petitioner’s Motions

Petitioner filed a Motion to Strike Patent Owner’s Exhibits 2006–2008 (Paper 31) and a Motion to Exclude Exhibits 2005–2008 (Paper 34). Patent Owner filed oppositions to each. Papers 32, 37. Petitioner then filed a Reply to Patent Owner’s opposition to the Motion to Exclude. Paper 38.

Exhibit 2008 is a portion of the prosecution history of the application that issued as the challenged patent. Ex. 2008 (Notice of Allowability for Application No. 14/830,710). It is undisputed that Exhibit 2008 is cumulative of a portion of Exhibit 1002. *See* Paper 34 (Motion to Exclude), 5; Paper 32 (Opposition to Motion to Strike), 1 (“Exhibit 2008 is an excerpt of Ex. 1002 filed with the Petition”). Petitioner is correct that 37 C.F.R. § 42.6(d) prohibits filing a document already of record in a proceeding without express Board authorization, which Patent Owner did not obtain. Paper 38 (Petitioner’s Reply to Opposition), 4 (citing 37 C.F.R. § 42.6(d)).

Exhibit 2008 has been referenced by Patent Owner in its Sur-reply addressing Petitioner’s argument first raised in its Reply that certain limitations of both independent claims challenged in this proceeding should not be given patentable weight. Pet. Reply 6; PO Sur-reply 16. In our Final Written Decision we cite to corresponding pages in Exhibit 1002 in addressing Patent Owner’s contentions relying on Exhibit 2008. This

preserves clarity in the record of the proceeding. Accordingly, Petitioner's Motion to Exclude as to Exhibit 2008 is granted and Petitioner's Motion to Strike as to Exhibit 2008 is granted.

Relevant to Petitioner's Motions, Patent Owner argued in its Sur-reply that Petitioner's arguments in this proceeding conflicted with its arguments made in district court concerning "synchronized browsing sessions" with respect to patent-eligible subject matter under 35 U.S.C. § 101 of the challenged claims. PO Sur-reply 7–9 (citing Ex. 2005, 2006, 2007). As discussed above, we have determined that Petitioner has not demonstrated by a preponderance of the evidence that the challenged claims would have been obvious without addressing Patent Owner's arguments regarding the meaning of "synchronized browsing session." *See* PO Sur-reply 7–9; PO Resp. 14 (regarding interpretation of "synchronized browsing session").

Under the particular circumstances in this case, we need not assess the merits of Petitioner's Motion to Exclude and Motion to Strike as to these exhibits. As such, Petitioner's Motion to Strike as to Exhibits 2006 and 2007 is dismissed as moot and Petitioner's Motion to Exclude as to Exhibits 2005–2007 is dismissed as moot.

In sum, Petitioner's Motion to Strike Exhibits 2006–2008 is granted as to Exhibit 2008 and dismissed as moot as to Exhibits 2006 and 2007. Petitioner's Motion to Exclude Exhibits 2005–2008 is granted as to Exhibit 2008 and is *dismissed* as moot as to Exhibits 2005–2007.

III. CONCLUSION¹⁹

Having considered all the arguments and evidence of record, based on determinations of (1) the scope and content of the asserted prior art references, (2) differences between the subject matter of the challenged claims and the disclosures of the asserted prior art references, and (3) the level of ordinary skill in the art²⁰ (*Graham*, 383 U.S. at 17–18), and for reasons discussed above, we conclude that Petitioner has *not* shown by a preponderance of the evidence that any of the challenged claims are unpatentable.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–16	103	Lebrun, Wang		1–16
1–16	103	Prajapat, Wang		1–16
Overall Outcome				1–16

¹⁹ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. §§ 42.8(a)(3), (b)(2).

²⁰ Neither party proffered any objective evidence of nonobviousness for us to consider.

IV. ORDER

Accordingly, it is

ORDERED that claims 1–16 of the '448 patent have *not* been shown to be unpatentable;

FURTHER ORDERED that Petitioner's Motion to Strike (Paper 31) is granted as to Exhibit 2008 and dismissed as to Exhibits 2006 and 2007;

FURTHER ORDERED that Petitioner's Motion to Exclude (Paper 34) is granted as to Exhibit 2008 and dismissed as to Exhibits 2005–2007; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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