

IPR2023-00341

Petitioner's Request for Director Review

Filed on behalf of Intuit Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner

v.

SAMESURF, INC.,
Patent Owner.

Inter Partes Review No. IPR2023-00341
Patent 9,483,448 B2

PETITIONER'S REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. LEGAL STANDARD	1
III. ARGUMENT	2
A. The Board Misapprehended the Teachings of Lebrun and Wang as they Relate to Limitations 1[c], 1[f]-1[g]	2
1. Limitation 1[c]: “sending an invitation to an invitee device to join the synchronized browsing session, wherein the invitation includes the session identifier.”	2
B. The Board Misapprehended Lebrun’s Disclosure	4
C. The Board Misapprehended Wang’s Disclosure	5
D. The Board Erred in Addressing the Combination of Lebrun and Wang	6
1. Limitations 1[e]-1[g]	7
2. Limitations 1[f.i]-1[f.iii]	11
3. Limitations 1[d] & 1[e]	13
IV. CONCLUSION	13

TABLE OF AUTHORITIES

Page(s)

CASES

<i>Axionics, Inc. v. Medtronic, Inc.</i> , 73 F.4th 950 (Fed. Cir. 2023)	3, 6
<i>DK Crown Hldg's Inc. v. Diogenes Ltd.</i> , IPR2023-00268, Paper 14 (P.T.A.B. Feb. 21, 2024).....	1
<i>Google LLC v. EcoFactor, Inc.</i> , 92 F.4th 1049 (Fed. Cir. 2024)	3
<i>In re Merck & Co., Inc.</i> , 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)	6
<i>In re Mouttet</i> , 686 F.3d 1322, 103 USPQ2d 1219 (Fed. Cir. 2012)	6
<i>Nichia Corp. v. Emcore Corp.</i> , IPR2012-00005, Paper 68 (P.T.A.B. Feb. 11, 2014).....	13
<i>SAS Inst., Inc. v. ComplementSoft, LLC</i> , 825 F.3d 1341, 1351 (Fed. Cir. 2016), <i>rev'd on other grounds sub nom</i>	4, 6
<i>SAS Inst., Inc. v. Iancu</i> , 138 S. Ct. 1348, 1356 (2018)	4
<i>Ultratec, Inc. v. CaptionCall, LLC</i> , 872 F.3d 1267 (Fed. Cir. 2017)	1

OTHER AUTHORITIES

IPR2023-00342. IPR2023-00342, Paper 32	13
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I. INTRODUCTION

The Director should grant review of the Board's Final Written Decision (FWD) because the Board erred by not considering the entirety of the evidence Petitioner relied upon, misapprehended Petitioner's arguments about the evidence, and misapprehended the disclosure of the references. In so doing, the Board considered only selected portions of the evidence as applied to certain limitations, thereby losing the context of the passages and how they come together in the references. The Board also failed to consider the interconnectedness of different limitations of the claims when considering application of the evidence to the claims.

II. LEGAL STANDARD

Director Review is appropriate when the Board's institution decision presents (a) an abuse of discretion or (b) important issues of law or policy. USPTO, *Revised Interim Director Review Process*, § 2.B. The Board abuses its discretion when its decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record without evidence on which the Board could base its decision. *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017). Director Review is available when the Board misapprehends: a claim term, the scope and content of the prior art, or the Petition's mapping of the prior art. *DK Crown Hldg's Inc. v. Diogenes Ltd.*, IPR2023-00268, Paper 14 at 2-4 (P.T.A.B. Feb. 21, 2024).

III. ARGUMENT

The Board abused its discretion by (1) not considering the entirety of the evidence cited and (2) misapprehending Lebrun's and/or Wang's disclosure and Petitioner's reliance thereon.

A. The Board Misapprehended the Teachings of Lebrun and Wang as they Relate to Limitations 1[c], 1[f]-1[g]

The Board appears to have done an about-face in the FWD from its position upon institution that Lebrun discloses limitations 1[c], 1[f]-1[g], despite considering the same evidence. In the Institution Decision (DI), the Board several times described Lebrun's disclosure of the limitations of claim 1 as relied upon by Petitioner as "unambiguous." DI 21, 33 ("Petitioner relies on Lebrun's unambiguous description that Lebrun's web clients can receive the next web page directly from the web site."), 36, 41. In the FWD, the Board erred by not considering the entirety of the evidence cited and misapprehended Lebrun's disclosure by considering reference portions out of their context within the whole of Lebrun.

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

The invitations as described in both Lebrun and in Wang as being sent by the client device are intended to reach a second client device. This is the entire purpose of a group-surfing (Lebrun) or client synchronization (Wang) session. The group-surfing server (Lebrun) or server apparatus (Wang) facilitates the session but

is not a party in the session. Thus, although sent indirectly through these servers, the first client device merely uses the server as a conduit for sending the invitation to invite the second client device to attend a group/synchronized session.

Nothing in the claim requires that the host/first client device send the invitation to the invitee/second client device directly and the Board did not explicitly construe it as such. Indeed, if anything the Board implicitly construed the claims as *not* requiring that the sending be direct, since it preliminarily concluded upon institution that Lebrun's several embodiments disclose it. DI, 19-20 (Board concluded Petitioner's showing for the limitation was "based on a straightforward mapping of Lebrun descriptions to the claim limitations."); *see Google LLC v. EcoFactor, Inc.*, 92 F.4th 1049, 1055 (Fed. Cir. 2024) (if the outcome of the analysis of the claim term establishes the scope (e.g., boundaries) and meaning of the patented subject matter, the Board has mostly likely construed the claim) Thus, if the Board is found to have implicitly construed the limitation such that the invitation must be sent directly from the host to the invitee device, that is a change to the construction applied by the Board, to which Petitioner improperly was not afforded an opportunity to respond. *See Axonics, Inc. v. Medtronic, Inc.*, 73 F.4th 950, 958 (Fed. Cir. 2023) ("before the Board decides a case under a construction adopted after the institution decision, it must give a petitioner an opportunity to respond to the new construction," and "[i]n particular, the petitioner must be afforded a reasonable

opportunity in reply to present argument and evidence under that new construction.”); *SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1351 (Fed. Cir. 2016), *rev'd on other grounds sub nom. SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (under the APA, the Board “may not change theories in midstream” by adopting a different claim construction in the final written decision than that adopted in the institution decision “without giving respondents reasonable notice of the change and the opportunity to present argument under the new theory”).

B. The Board Misapprehended Lebrun's Disclosure

The Board erred by considering only selected portions of the cited evidence from Lebrun in isolation and misapprehended Lebrun by ignoring the context of how the passages describing the content of the message and the actions related to the message fit together. Lebrun describes at page 32 both the contents of the session creation message and what the server does with the information in that message, which must be read together for context.

First, the section header on page 32 is titled “*Creating a group surfing session*” and doing so is the action described therein. Ex. 1005, 32. Without *inviting* the other clients to join, there is no “group” session. Lebrun first describes the session-creation message 151 as including “an identifier for the group-surfing session” (Ex. 1005, 32:9-12), which corresponds to the recited “session identifier.” Pet., 25; Reply, 7-8. Lebrun specifically states that this identifier is included in the

message “*so that* the other web clients 110 *can add themselves* to that session.”

Ex. 1005, 32:12-13 (emphasis added). To do so, the web clients must *receive the identifier* of the session. Indeed, the words “so that” in the quoted section reveals the *very purpose* of the first web client including the identifier in the message is *to invite* other clients to the session. When citing this section in the FWD, the Board cut off the “so that” clause, which removes the context of why the identifier is included in the message.

A few lines later, Lebrun explains *how* the invitation is passed on. After receiving the message, the group-surfing server creates the session and “*inform[s] the participants* in the group-surfing session” of the session. Ex. 1005, 32:26-27. When read in context, this “informing” is how the other web clients receive the session identifier, passing on the invitation from the first web client “so that other clients 110 *can add themselves* to that session.” Ex. 1005, 32:12-13 (emphasis added). The Board erred in not considering this evidence as a whole, which provides essential context for how the first web client sends the invitation to the other web clients.

C. The Board Misapprehended Wang's Disclosure

The Board erred by misapprehending Wang's disclosure about its invitation process. The Board itself notes in the FWD that Wang describes an *invitation message* sent from the first client device to the server apparatus and a corresponding

invitation notice or acknowledgment sent from the server apparatus to the second client device. FWD 31. PO had also admitted that Wang performs these actions. POR 42. Yet the Board concluded from this evidence that Petitioner has not established that Wang discloses or suggest this limitation, without ever conveying why this disclosure of Wang does not meet the limitation. FWD 31-32. Here again, the Board does not appear to have provided an explicit construction that the host sending the invitation to the invite device must do so directly, and if it had, it would be a new construction as compared to the implicit construction in the institution decision. *See Axonics*, 73 F.4th at 958; *SAS Inst.*, 825 F.3d at 1351.

D. The Board Erred in Addressing the Combination of Lebrun and Wang

Following its discussion of the references individually, the Board stated that since it concluded that neither of Lebrun or Wang individually disclose this limitation, it *needs not reach the argument* that a person of skill in the art would have been motivated to combine them. FWD 32, 39 (similar for 1[g]). But “the test for obviousness is what the combined teachings of the references would have suggested to [a POSITA].” *In re Mouttet*, 686 F.3d 1322, 1333, 103 USPQ2d 1219, 1226 (Fed. Cir. 2012); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) (one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references).

Petitioner relied on the *combination* of Lebrun and Wang for the limitation, not merely Lebrun and Wang individually. Pet., 24 (“Lebrun in View of Wang Discloses 1[c]”); Reply 7-8. The Board appears to have failed to consider Petitioner’s arguments about motivation to combine the references as it relates to this limitation. See Pet., 19. Petitioner argued “both Lebrun and Wang describe a process in which of first user initiates a collaborative browsing session by sending a request to a server to create a group browsing session and to *send invitations to other users* to join the session” Reply, 8. Like Lebrun, the very reason for Wang to provide the invitation notice to the second client device is to invite that second client device to join the session.

1. Limitations 1[e]-1[g]

The Board made three errors that led it to incorrect conclusions about limitations 1[f] and 1[g]. The Board overlooked the entirety of the evidence relied upon by Petitioner, failed to consider the interrelatedness of limitations 1[e]-1[g], and failed to consider Petitioner’s argument about why Lebrun’s “embodiments” would be combined by a POSITA.

Limitation 1[e] recites “sending a request for webpage content to a website server independent of the synchronization server”; limitation 1[f] recites “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”; and limitation 1[g] recites “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.” These limitations require that the transmitting of 1[f] occurs after the sending of 1[e], and that the receiving on 1[g] occurs both responsive to the sending of 1[e] and after the transmitting of 1[f]. The Board did not address whether Lebrun discloses limitation 1[e].

The Board failed to consider the entirety of the evidence relied upon by Petitioner. In the FWD, the Board implies that Petitioner's only evidence for limitation 1[e]'s request was based on the session initiation message, which it notes does not align with the next page message as limitation 1[g]'s receiving in response to that same request. But Petitioner did not rely solely on the session initiation message. The Board erroneously ignores that Petitioner relied on the next page message for limitation 1[e] as well: “Lebrun explains that ‘each web client’ is able to retrieve the next web page ‘directly from the web site.’ Ex. 1005, 35:17-19.” Pet., 27. Retrieving encompasses both request and response.

Contrary to the Board's position that Petitioner's reliance is inconsistent as between limitations 1[e] and 1[g], when all proffered evidence is considered, the same aspect of Lebrun – the next-page message – is cited for both the request of

limitation 1[e] and the receiving in response of limitation 1[g]. Upon institution, the Board found this evidence “unambiguous” as it relates to Lebrun’s disclosure of limitation 1[g]: “Petitioner relies on Lebrun’s *unambiguous* description that Lebrun’s web clients can receive the next web page directly from the web site.” DI, 33, citing Pet. 30, citing Ex. 1005, 35:17-19.

Next, in concluding that Petitioner did not show timing requirement of 1[g], the Board erroneously failed to consider how Lebrun’s disclosure of limitation 1[f] impacts and informs limitation 1[g]. Limitation 1[f]’s “transmission” is what provides the “timing requirement” of limitation 1[g] that the Board concludes Petitioner did not show is disclosed in Lebrun.

For 1[f], Petitioner showed, and PO agreed, that Lebrun’s program fragment catches/intercepts *selection of the link* by the first web client and directs that selection to the group-surfing server. Pet., 25-26; POR, 43. This disclosure corresponds to the claimed the transmission as recited in 1[f]. Further, before the selection is intercepted by the program fragment on the web client, the web client “sends” the request for webpage content to the website server (1[e]) via the look ahead functionality. Reply, 9-10; Pet., 25-26; *see* Ex. 1005, 37:27-38:13. This catch/intercept is *how* Lebrun discloses the transmission timing (1[f]) as *necessarily* occurring before the host device’s receipt of the website content recited in 1[g].

In summary, the (host) web client sends a request for website content to the website server (1[e]). The program fragment “catches” the selection of the link (request) by the (host) web client, which redirects the information about the link so that it is transmitted to the group-surfing server (1[f]). This happens first, before the (host) web client can receive a response to the request for website content (1[g]); the catch/intercept thus ensures the specific timing recited by the claim. Because 1[g] is described as occurring after 1[f], the Board erred in not considering the evidence as a whole as it relates to these explicitly intertwined limitations.

The Board further erred by stating that Petitioner failed to explain why Lebrun's “embodiments” would be combined. FWD 16, 36, 42 (discussing application of different embodiments). The Board appears to not have considered Petitioner's *full page of explanation* of why Lebrun expressly contemplates consideration of its “embodiments” together, and why several of the “alternatives” discussed are not actually discrete embodiments. Reply, 19-20 (not cited at FWD, 36, 42); Ex. 1005, 75:18-20 (“many variations are possible which remain within the concept, scope, and spirit of the invention, and these variations would become clear to those skilled in the art”); *see also id.* 37:21-25, 39:19 (“variations on the group-surfing session”), 44:1-3. Moreover, the Board itself instituted based on arguments relying on combinations of different embodiments from Lebrun. *See* DI, 17-38. PO

made an argument against combining embodiments in its POPR, but the Board found Petitioner's showing sufficient for institution. DI, 17-18, 38; *see* Reply, 19.

2. Limitations 1[f.i]-1[f.iii]

For these limitations, the Board misapprehended how Petitioner mapped the limitations to Lebrun's disclosure. These limitations require the information to enable the invitee device to request substantially the same webpage content as the host (1[f.i]), the synch server to transmit the information to the invited device to enable that request (1[f.ii]), and the invitee device to use that information to retrieve data from the website (1[f.iii]). These limitations are interrelated as to the actions of the invitee device. And here again the Board failed to consider all of the evidence Petitioner put forth for these limitations.

The Board misapprehended Petitioner's argument as the next-page message being "mapped to" the "information related to the shared web browsing interaction." FWD, 41. Yet Petitioner instead relied on certain of the information from the next-page message (e.g., what is the next page) being passed on to the invitee device. Pet., 32; Reply, 16. The other web clients receive the information (from the next-page request) from the group-surfing server as to which web page to retrieve and retrieve the webpage content directly from the website. Pet., 33; Reply, 14-18. Doing so satisfies limitations 1[f.i]-1[f.iii] because – as the Board recognized at institution – the claim requires that the invitee device is "enabled" to retrieve

substantially the same content but *does not require a particular manner of doing so*. DI 29; Reply, 14.

Similar to the limitations described above, the Board had found upon institution that Lebrun's "unambiguous description" discloses these limitations. DI, 33, 36. The Petition noted that the "program fragment," which is controlled by the "group-surfing server," interfaces with and affects the operations of a "web client," which includes determining which "web page" to retrieve. Pet., 33; Ex. 1005, 32:21-24, 36:21-25; 45:21-46:5.

Lebrun also describes that while in some cases the group-surfing server directs that the webpage content is sent to the other web clients, in other circumstances, the web clients can retrieve the webpage content directly from the website, as the Board explicitly acknowledged upon institution. DI, 32 ("Lebrun describes that each web client can receive the next web page directly from the web site"), 37 ("we do not agree with Patent Owner. Petitioner's position is that Lebrun describes or at least suggests that the web client retrieves, not merely receives, the next page directly from the website in some embodiments."); see Ex. 1005, 35:17-19, 46:1-2; Reply, 14-15.

As with the above limitations, the Board again hinted that Lebrun's embodiments should not be combined. Such statements are directly contrary to the Board's conclusion that Lebrun contemplates combining embodiments in related

case IPR2023-00342. IPR2023-00342, Paper 32 at 12 (agreeing with Petitioner that “Lebrun contemplates combining embodiments”); Paper 51 at 41 (“Lebrun’s express disclosures and consistent organization and structure, Lebrun describes various features that may be combined and often complimentary of each other, and not as separate unrelated embodiments that cannot be combined”; “combining the embodiments described with respect to Figures 3 and 4 would not ‘require a leap of inventiveness.’”); *see also generally id.* at 40-43. Although those statements were made by the Board in a case regarding a different but related patent, the same reference and same embodiments are at issue in this case, and thus the Board’s conclusions in the FWD directly contradict its express statements in IPR2023-00342 about combining Lebrun’s embodiments.

3. Limitations 1[d] & 1[e]

The Board did not provide a finding in the FWD whether the references disclose limitations 1[d] or 1[e]. Thus, if the Director agrees that Board’s findings were erroneous, the Board should address these limitations on remand to preserve a complete record for appeal. *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, Paper 68 at 59 (P.T.A.B. Feb. 11, 2014) (there is a strong public policy for making all information filed in proceeding available to the public).

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests Director Review.

IPR2023-00341

Petitioner's Request for Director Review

Dated: July 25, 2024

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on July 25, 2024, I caused a true and correct copy of the foregoing PETITIONER'S REQUEST FOR DIRECTOR REVIEW to be electronically served on the Patent Trial Board and Appeal Director and Petitioner's lead and backup counsel at the following addresses:

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