

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner,

v.

SAMESURF, INC.,
Patent Owner.

IPR2023-00342
Patent 8,527,591 B2

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

BENNETT, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Intuit Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–18 (“the challenged claims”) of U.S. Patent No. 8,527,591 B2 (Ex. 1001, “the ’591 patent”), supported by the Declaration of Henry A. Lieberman (Ex. 1003). Samesurf, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”) supported by the Declaration of David S. Howell (Ex. 2003).

The Board’s authority to determine whether to institute an *inter partes* review is under 35 U.S.C. § 314. *See also* 37 C.F.R. § 42.4(a) (2020). To institute an *inter partes* review, the information presented in the Petition must show “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons set forth below, the information presented in the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to at least one challenged claim. Accordingly, we institute an *inter partes* review of claims 1–18 of the ’591 patent.

A. *Real Parties in Interest*

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

B. *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 3, 2. The parties identify the following district court case: *Samesurf, Inc. v. Intuit, Inc.*, No. 3:22-cv-

00412 (S.D. Cal.). The parties also each identify two concurrently filed petitions challenging different patents: IPR2023–00339 (challenging U.S. Patent No. 9,184,145 B2) and IPR2023–00341 (challenging U.S. Patent No. 9,483,448 B2). Pet. 3; Paper 3, 2.

C. The '591 Patent

The '591 patent is titled “Method and Apparatus for the Implementation of a Real-Time, Sharable Browsing Experience on a Guest Device.” Ex. 1001, code (54). The patent relates to a “sharable browsing experience” through “a synchronized browsing session on a guest device utilizing the transfer of URL [uniform resource locator], form data, script, and other information.” *Id.* at 1:8–12. In contrast with “desktop or screen sharing” approaches that “allow users to simply view the same content,” techniques described by the '591 patent purportedly 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 2:19–21, 2:41–43.

Figure 2(a), reproduced below, illustrates communication between various devices “to initialize a synchronized browsing session.” *Id.* at 4:10–13.

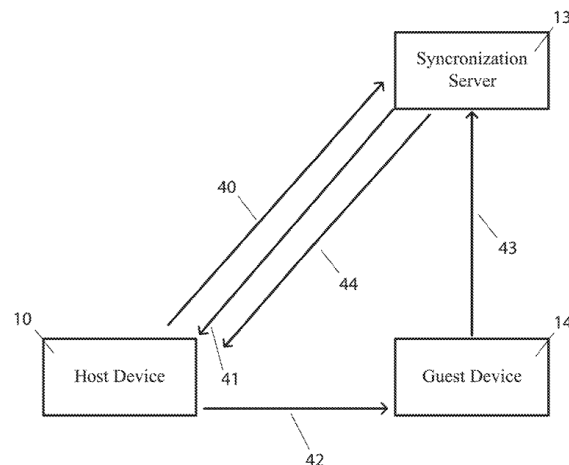


Figure 2(a) is a block diagram showing communication between host device 10, synchronization server 13, and guest device 14 to initialize a synchronized browsing session between host device 10 and guest device 14. *Id.* at 10:6–14; Fig. 2(a). Examples of host and guest devices include personal computers, mobile phones, and electronic tables with “a visual user interface and network connection.” *Id.* at 6:3–11 (identifying example host devices), 6:12–21 (identifying example guest devices). “Host device 10 transmits an 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 10:10–18. Host device 10 transmits session invitation 42 to guest device 14. *Id.* at 10: 19–22.

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 10:29–34. 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 10:40–43.

Figure 5(a), reproduced below, illustrates communication between various devices during a synchronized browsing session with a website server. *Id.* at 4:42– 45.

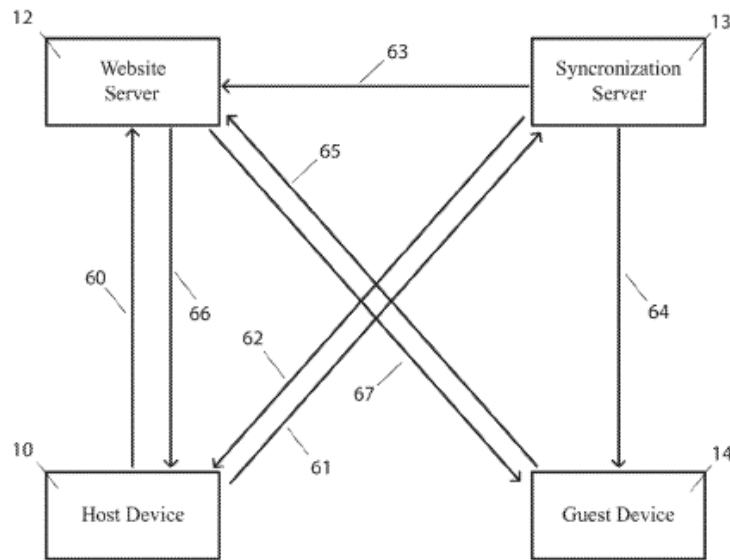


Figure 5(a) is a block diagram showing communication between website server 12, host device 10, synchronization server 13, and guest device 14 during a synchronized browsing session. *Id.* at 15:42–47. Host device 10 communicates with website server 12 to receive website content. *Id.* at 15:48–15:67. Host device 10 also transmits “webpage interaction information” to synchronization server 13. *Id.* at 16:1–12. Examples of website interaction information include URL of website server 12, cookie information, form data, java script, other types of user inputted information, or attached files. *Id.* at 16:4–7. Synchronization server 13 then forwards the communication message to guest device 14. *Id.* at 16:31–34, 16:54–55. Guest device 14 uses the communication message to send website request 65 to website server 12. *Id.* at 16:56–58. “In exemplary embodiments, website request 65 should be similar to or identical to website request 60.” *Id.* at 16:60–62. In other words, synchronized browsing between host device 10 and guest device 14 occurs 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 17:27–36.

Figure 5(d), reproduced below, illustrates steps used by a guest device during a synchronized browsing session with a host device. *Id.* at 18:64–66.

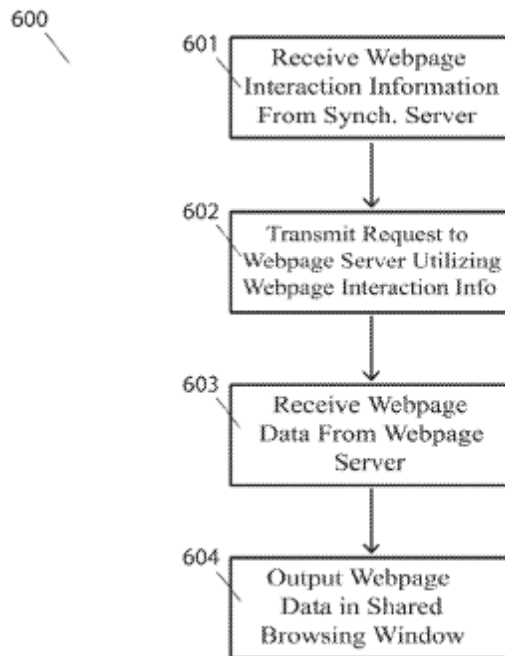


Figure 5(d) is “a flow chart of method 600 utilized by guest device 14 for the execution of a synchronized browsing session with host device 10.” *Id.* “In step 601, guest device 14 receives communication message 64 from synchronization server 13.” *Id.* at 19:5–6. As described previously and shown in step 601, communication message 64 includes webpage interaction information, which include a duplicate of host device’s website request 60 or the URL address of the website server. *Id.* at 19:5–7; Fig. 5(d); *see id.* at 16:31–40 (describing communication message 64).

“Guest device 14 formulates website request 65 by processing communication message 64.” *Id.* at 19:12–14. “In step 602, guest device 14

transmits website request 65 to website server 12.” *Id.* at 19:7–8. “In step 603, guest device 14 receives content reply 67 from website server 12.” *Id.* at 19:17–18. “Finally, in step 604, guest device 14 outputs content reply 67” through a user interface of guest device 14. *Id.* at 19:18–20. 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 19:19–25.

D. Challenged Claims

All eighteen claims in the ’591 patent are challenged, of which claims 1 and 10 are independent. Illustrative claim 1 follows:

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

[1a] detecting an activation of a hyperlink associated with the synchronized browsing session by a guest device;

[1b] sending a request by the guest device to join the synchronized browsing session to the synchronization server in response to the activation of the hyperlink;

[1c] receiving from the synchronization server a notification that guest device has joined the synchronized browsing session;

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

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

Ex. 1001, 22:22–23:2 (bracketed annotations added).

E. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of the challenged claims on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–18	103 ¹	Lebrun ² and Wang ³
1–18	103	Prajapat ⁴ and Wang

Pet. 5–6.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

The level of ordinary skill in the art at the time of the invention 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)).

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103, was effective on March 16, 2013. Because the ’591 patent issued from an application filed on May 20, 2010, Petitioner “applies prior art with a priority date earlier” than that date and references the pre-AIA version of the statute. Pet. 4–5 n.2. Because this date is before the effective date of the applicable AIA amendment, the pre-AIA version of § 103 applies for purposes of institution.

² 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)).

³ US 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)).

⁴ US. 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)).

Petitioner asserts that a person of ordinary skill in the art “would have had a bachelor’s degree in computer science, computer engineering, or electrical engineering, or the equivalent, and at least two years of work experience in software development and/or web-based software.” Pet. 11 (citing Ex. 1003 ¶¶ 1–10, 17–20). Petitioner also indicates that “[a]dditional education could have substituted for professional experience, and significant work experience could have substituted for formal education.” *Id.*

Patent Owner asserts that a person of ordinary skill “would have had at least a bachelor’s degree in computer science, computer engineering, electrical engineering, or a similar field, and at least two years of professional experience or significant work experience in internet web browsing software development, web connectivity software development, or networking software development.” Prelim. Resp. 31 (citing Ex. 2003 ¶ 19).

The two proposals are materially similar in the education requirement and the time requirement (at least two years) of work experience. However, Petitioner’s proposal requires work experience in “software development and/or web-based software,” whereas Patent Owner’s proposal requires more specific work experience in “internet web browsing software development, web connectivity software development, or networking software development.” Pet. 11; Prelim. Resp. 32.

Determining the level of ordinary skill in the art involves various factors, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). The prior art of record also reflects the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

The asserted prior art, like the challenged patent, presents high-level functional descriptions of web-based software with flow charts and diagrams between server components. The asserted prior art relates to functional descriptions of internet messages sent between software devices, but does not have much discussion of the particulars of lower level communication protocols, such as cellular communication protocols or specific details of Internet protocols. For example, LeBrun’s technology relates to providing “access to personalized web sites” and describes messages sent over a network between web clients, a web site, and a personalization server. Ex. 1005, code (57), Figs. 1, 3. Wang describes a “collaboration system [that] includes a plurality of client devices individually connected to a network, and a server apparatus for receiving requests from the client devices, responding to the client devices, and providing a common collaboration environment among the client devices.” Ex. 1006, code (57), Fig. 3. Prajapat relates to “peer-to-peer dynamic web page sharing” and describes web browsers submitting requests for and receiving web pages, web servers providing web pages, and a web media server communicating shared web page information. Ex. 1007, codes (54, 57), Figs. 1–3.

Accordingly, based on this preliminary record, we find Patent Owner’s assessment of “internet web browsing software development, web connectivity software development, or networking software development” to be overly narrow in view of the asserted prior art that describes in large measure requesting and receiving web pages from web servers. Thus, we find that Petitioner’s assessment of “software development and/or web-based software” more appropriate for purposes of institution on this limited record. We also agree with Petitioner that additional education could have

substituted for professional experience, and significant work experience could have substituted for formal education.

For the purpose of this decision, for these reasons, we find that a person of ordinary skill in the art would have had (1) at least a bachelor's degree in computer science, computer engineering, electrical engineering, or a similar field, and (2) at least two years of work experience in software development and/or web-based software. We apply that level of ordinary skill in this decision. Our decision, however, would not change, however, if we had applied Patent Owner's proposed level of ordinary skill.

B. 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). We construe claim terms only as relevant to the parties' contentions and only to the extent necessary to resolve the issues in dispute. *See Nidec Motor Corp.*

v. Zhongshan Broad Ocean Motor Co., 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Neither Petitioner nor Patent Owner propose express constructions for any claim terms. Pet. 12; Prelim. Resp. 31. For purposes of this decision, we agree that no claim terms need be expressly construed. Nevertheless, Patent Owner’s arguments against the grounds of unpatentability set forth in the Petition implicitly raise questions of claim scope, and we preliminarily address those questions in our discussion of the asserted grounds below.

C. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103 “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103 (2011); *accord KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting similar language in pre-AIA version of 35 U.S.C. § 103). The question of obviousness involves resolving 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) objective indicia of nonobviousness when in evidence (none on this preliminary record). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

D. Obviousness over Lebrun and Wang

Petitioner asserts that claims 1–18 would have been obvious under 35 U.S.C. § 103 based on the combined teachings of Lebrun and Wang.

1. Lebrun's Disclosure

Lebrun is a WIPO (World Intellectual Property Organization) international application published under the PCT (Patent Cooperation Treaty,) published in English, 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 4:6–9.⁵

Figure 3, reproduced below, illustrates a system for group access to web sites. *Id.* at 29:25.

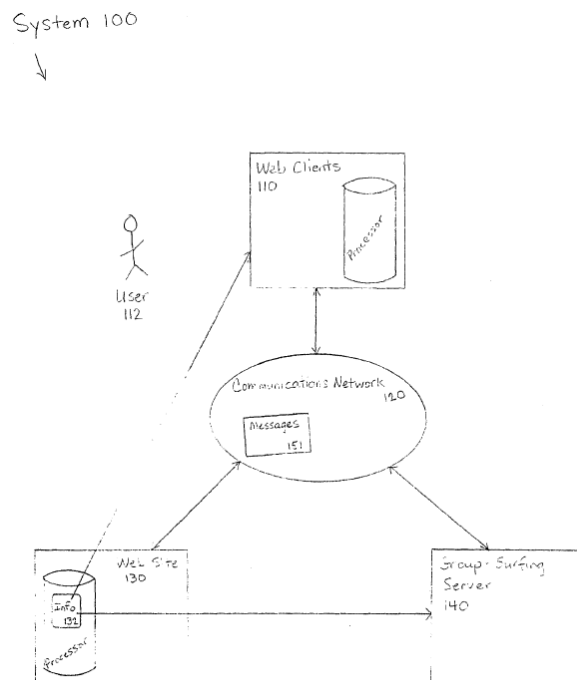


Figure 3 is a block diagram of “system 100 [that] includes a set of web clients 110, a communication network 120, at least one web site 130, and a group surfing server 140.” *Id.* at 29:27–28. Lebrun describes creating a “group-surfing session” in which “a first web client 110 sends a session-creation 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. Session-creation message 151 may include “an identifier for the group-surfing session, so that other web clients 110 can add themselves to the session.” *Id.* at 32:11–12. Lebrun also 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.

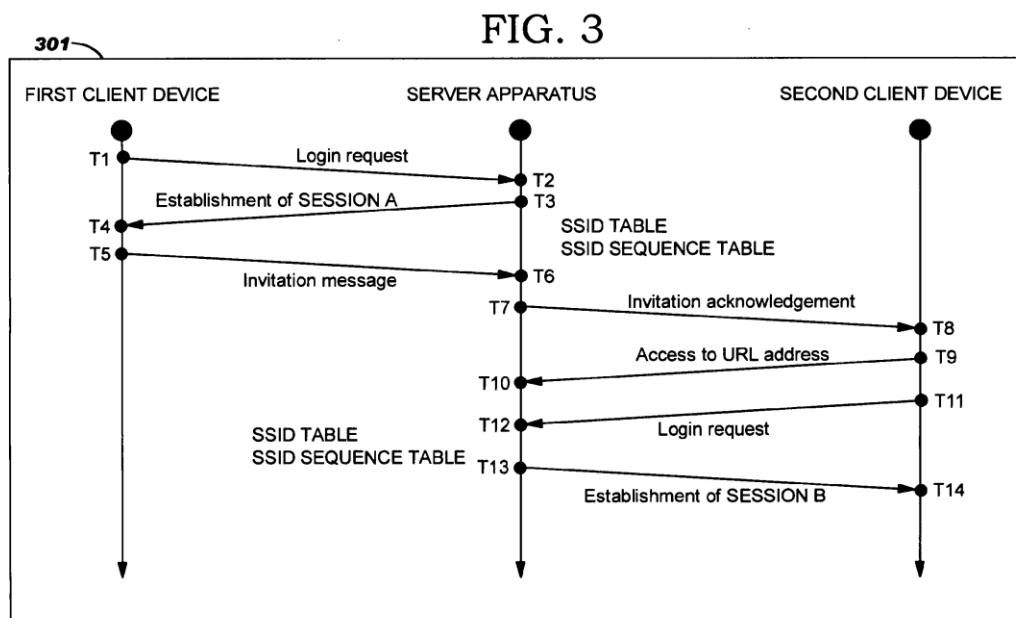
“The group-surfing server 140 receives the session-creation message 151, and responds by (1) creating a group-surfing session, and (2) informing the participants in the group-surfing session.” *Id.* at 32:26–31. “To add itself to the session, a second (or further) web client 110 sends a session-join message 151, which may include 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.

⁵ 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 right of the document pages).

2. Wang's Disclosure

Wang is a U.S. Published Patent Application and titled "Collaboration System Suitable for On-Line Shopping." Ex. 1006, code (54). Wang's collaboration system includes a server that receives and responds to requests from multiple client devices and provides a group session that synchronizes the displays on each of the client devices. *Id.* at code (57).

Wang's Figure 3 is reproduced below:



Wang's Figure 3 depicts a "a timing chart which illustrates the case wherein the client devices and a server apparatus establish a group session." *Id.* ¶ 46. Wang indicates that one example of a group session may be provided in the context of a virtual shopping system that allows multiple parties to participate in a group shopping session. *Id.* Wang's group session is initiated when a first client device "transmits a message inviting other client devices to the shopping session" (*id.*) and then "the server apparatus transmits an invitation notice and a URL address to be used, such as 'Invitation Acknowledgement, myURL address,' to a second client device"

(*id.* ¶ 48). When the second client device receives the invitation and URL, “the second device accesses the designated URL address” and “[s]ubsequently, the server apparatus receives . . . a login request from the second client.” *Id.* ¶ 49.

3. Claim 1

a. Claim 1 Preamble

Claim 1’s preamble recites “[a] method for a guest device performing a synchronized browsing session administered by a synchronization server.” Petitioner relies on Lebrun’s group surfing session created by group surfing server 140 for teaching a synchronized browsing session administered by a synchronization server. *See* Pet. 21–22 (citing Ex. 1005, 7:3–5; 32:1–19, 26–31; 33:2–4). Petitioner relies on Lebrun’s web client that adds itself to the group-surfing session for teaching a guest device that joins the browsing session as required by the preamble of claim 1. *See* Pet. 22–23 (citing Ex. 1005, 30:19–28; 32:1–19; 33:2–4;; Fig. 4 (step 212)). Regardless of whether the preamble is limiting, Petitioner’s showing for the preamble is sufficient for purposes of institution because Petitioner relies on a plain reading of the cited passages discussed above with respect to Lebrun’s disclosure. Patent Owner does not address Petitioner’s showing as to this limitation. *See generally* Prelim. Resp.

b. Claim 1 Limitation [1a]

The first limitation in the body of claim 1 recites “detecting an activation of a hyperlink associated with the synchronized browsing session by a guest device”⁶ (limitation [1a] or “the detecting limitation”). For the

⁶ This limitation appears to have an antecedent basis problem. The recitation of “a guest device” in limitation [1a] is the second recitation of “a guest

detecting limitation, Petitioner relies on both Lebrun and Wang. *See* Pet. 23. Specifically, Petitioner relies on Lebrun’s description of a first client device sending a session creation message to the group-surfing server, in combination with Wang’s description of a client device receiving and accessing the designated URL address to join a group session, to teach the portion of the detecting limitation that recites “a hyperlink associated with the synchronized browsing session.” *See* Pet. 23 (citing Ex. 1005, 32:9–31; Ex. 1006 ¶ 47⁷). Petitioner asserts that a person of ordinary skill in the art would have had reason to combine Lebrun and Wang. *See* Pet. 18–19 (characterizing combination as one of known prior art elements yielding predictable results), 25 (arguing that utilizing Wang’s hyperlink would further Lebrun’s objective of providing improved group access to web sites).

Petitioner further relies upon Lebrun’s discussion of informing the web client participants regarding the group-surfing session for teaching that the guest device performs the detecting—i.e., “by the guest device.” *See* Pet. 23 (citing Ex. 1005, 32:9–31). Petitioner relies on Lebrun’s description of a second web client sending a session-join message to the group-surfing server for teaching “detecting an activation.” *See* Pet. 24 (citing Ex. 1005, 32:5–7, 9–31, 33:2–4). Petitioner posits that “[b]ecause both the ‘session-creation message’ and the ‘session-join message’ are labelled [similarly], and both of these messages contain an identifier for the group-surfing session, a [person of ordinary skill in the art] would have understood that the

device” in the claim. That is, the preamble of claim 1 also references “a guest device.” For purposes of our analysis, we interpret the recitation of “a guest device” in limitation [1a] to be the same guest device referenced in the preamble.

⁷ Although Petitioner cites paragraph 47, the selected quotations are from Wang’s paragraph 49.

‘session-join message 151’ is a reply message to ‘the session-creation message 151’ that they include the same identifier.” *Id.* (citing Ex. 1005, 33:2–4; Ex. 1003 ¶ 155).

Lebrun describes that after a first web client 110 sends a session creation message to the group-surfing server 140 to create a group-surfing session (Ex. 1005, 32:9–11), a second web client 110 can “add itself to the session” by sending “a session-join message 151 to the group surfing server 140” (*id.* at 33:2–3). The session creation message sent by second web client, which corresponds to the recited guest device, is sufficient to teach or suggest detecting an activation associated with the synchronized browsing session at this preliminary juncture. Lebrun differs from the detecting limitation in that it does not expressly describe that the session creation message is sent by activating a hyperlink. However, Wang’s description of a second client device joining a group session via the myURL address is sufficient at this preliminary stage to address the deficiency in Lebrun.

On this preliminary record, Petitioner’s showing of a rationale to combine Lebrun and Wang is also sufficient for purposes of institution. Specifically, the proffered reasoning that utilizing Wang’s designated URL address to activate a session join invitation would enable Lebrun’s group-surfing server to coordinate and manage the group-surfing session and further Lebrun’s goal of providing improved group access to web sites (*see* Pet. 25), is sufficient at this early stage. Patent Owner does not address Petitioner’s showing as to this limitation. *See generally* Prelim. Resp.

Accordingly, Petitioner’s showing as to limitation [1a] is sufficient for institution.

c. Claim Limitation [1b]

Claim 1 further recites “sending a request by the guest device to join the synchronized browsing session to the synchronization server in response to the activation of the hyperlink” (limitation [1b] or the “sending a request limitation”).

Petitioner again relies on Lebrun and Wang for this limitation. See Pet. 25–27. Petitioner relies on Lebrun’s description of the second web client sending a session-join message to the group-surfing server to teach sending a request by the guest device to join the synchronized browsing session. See Pet. 25–26 (citing Ex. 1005, 33:2–4). According to Petitioner, Lebrun teaches the sending a request limitation because a person of ordinary skill in the art would have understood that receiving a session-creation message necessarily comprises detecting the activation of a hyperlink within the message. See Pet. 26.

Petitioner also cites the teaching of Wang “[t]o the extent that Lebrun is found not to explicitly disclose ‘in response to the activation of the hyperlink.’” Pet. 26. Petition again relies on Wang’s description of the myURL address that is utilized by a second client device to join a group session. See Pet. 26–27 (citing Ex. 1006 ¶ 49; Ex. 1003 ¶ 160).

Petitioner’s showing for limitation [1b] is sufficient for purposes of institution. On this preliminary record, we agree with Petitioner that Lebrun’s description of sending “a session-join message 151 to the group surfing server 140” (Ex. 1005, 33:2–3) teaches sending a request by the guest device to join the synchronized browsing session. As was the case with limitation [1a], Wang’s description of a second client device joining a group session via the myURL address is sufficient to teach the recited hyperlink, and Petitioner’s reasoning in support of combining Lebrun and

Wang is also sufficient for purposes of institution at this preliminary juncture. Patent Owner does not address Petitioner’s showing as to this limitation. *See generally* Prelim. Resp.

Accordingly, Petitioner’s showing as to limitation [1b] is sufficient for institution.

d. Claim Limitation [1c]

Claim 1 further recites “receiving from the synchronization server a notification that guest device has joined the synchronized browsing session” (limitation [1c] or “the receiving a notification limitation”).⁸ Petitioner relies on Lebrun’s description of the group-surfing server’s notifications to other participants in response to the session-join message to teach the receiving a notification limitation of claim 1. *See* Pet. 27 (citing Ex. 1005, 33:6–10). Petitioner asserts that a person of ordinary skill in the art “would have understood that the group-surfing server 140 informing the other participants of the newly added web client causing other web clients to receive a notification discloses this limitation.” *Id.* (citing Ex. 1003 ¶ 161).

Petitioner has made a sufficient showing as to limitation [1c]. Lebrun’s group-surfing server informs other participants in the group-surfing session when a new participant is added. Ex. 1005, 33:6–10. By informing the other participants, Lebrun’s group-surfing server—which corresponds to the recited synchronization server—provides a notification that a new participant has joined the synchronized browsing session.

Patent Owner does not address Petitioner’s showing as to this limitation. *See generally* Prelim. Resp. On this preliminary record,

⁸ Limitation [1c] recites “notification that guest device” that appears to be missing an article, such as “a” or “the” preceding “guest device.”

therefore, we find Petitioner's showing as to limitation [1c] sufficient for institution.

e. Claim Limitation [1d]

Claim 1 also recites "receiving data from the synchronization server, where the data relates to a website being accessed in real-time by a host device; and wherein the data comprises a URL of the website and cookie information associated with the website and the host device" (limitation [1d] or "the receiving URL and cookie information" limitation). Unlike the previous limitations, for the receiving URL and cookie information limitation, Patent Owner responds with particularity to Petitioner's contentions.

(i) Petitioner's Contentions

For "receiving data from the synchronization server, where the data relates to a website being accessed in real-time by a host device," Petitioner relies on Lebrun's description of (1) the first web client accessing a web page the user wants to share, (2) the first web client sending a session-creation message that identifies an initial web page to the group-surfing server, (3) the group-surfing server directing the target web site to deliver the page to the group-surfing server, and (4) the group-surfing server resending the page to the other participating web clients. See Pet. 28–29 (citing Ex. 1005, 32:9–19, 32:26–31, 35:5–28, 32:9–19, 43:13–22). For the recitation "the data comprises a URL of the website," Petitioner contends that "a [person of ordinary skill in the art] would have understood sharing web pages to include the URL of web site 130." Pet. 30 (citing Ex. 1005, 43:13–22). According to Petitioner, Lebrun discloses that "instead of receiving the actual web page from the synchronization server, 'the second

web client can only receive a list of pointers (such as URLs) to those pages presented during the group-surfing session.”” *Id.*

For the recitation that the data comprises “cookie information associated with the website and the host device,” Petitioner relies upon Lebrun’s indication that when the group-surfing server sends a page to participating clients, it uses cookies to deliver those pages. *See* Pet. 30 (citing Ex. 1005, 35:5–28). According to Petitioner, “[a person of ordinary skill in the art] would have understood Lebrun to disclose that the data being shared between the web clients comprises cookie information associated with the web site 130 and the controlling web client.” Pet. 30–31 (citing Ex. 1003 ¶ 168).

(ii) Patent Owner’s Contentions

Patent Owner contends that Petitioner fails to demonstrate a reasonable likelihood that Lebrun in view of Wang teaches the receiving URL and cookie information limitation of claim 1. Prelim. Resp. 35–42. Patent Owner argues the Petition “relies on elements from different embodiments of Lebrun that operate in distinct ways” (*id.* at 37), but Petitioner has not shown how the elements from different embodiments could be combined, and the relied upon embodiments “explicitly teach away from the combination proposed in the Petition” (*id.* at 38). Patent Owner further contends that “[a] key difference between the claimed synchronized browsing invention and the ‘page sharing’ solution like the one shown in Lebrun is the latter’s dependence on a middleman server (Lebrun’s group-surfing sever) that acts as an intermediary between the browsing devices (such as the host and guest browsing devices) and the relevant website servers.” Prelim. Resp. 38. According to Patent Owner, “the group-surfing server serves as a proxy that sends that user input information to the web site

that is being browsed, and then passes the HTML markup of the webpage to other web clients 110 that are participating in the browsing session.” *Id.* at 39.

Patent Owner further asserts that Lebrun’s description of sending URLs by the group-surfing server to guest devices occurs only in situations where no cookies are involved. Prelim. Resp. 41 (citing Ex. 1005, 35:17–19). As a result, the guest devices in Lebrun cannot receive both a URL of the website and cookie information associated with the website as claimed. *Id.*

Patent Owner further asserts that because Lebrun specifically disclaims sending URLs when cookies are involved, the Petition fails to provide an adequate rationale in support of combining Lebrun’s different embodiments to achieve sending both URLs and cookies together as required in claim 1. Prelim. Resp. 42.

(iii) Analysis of claim limitation [1d]

We find Petitioner’s showing as to claim limitation [1d] sufficient for institution. Lebrun describes an embodiment in which the group-surfing server, in response to a session-creation message, creates a group-surfing session, informs the participants of the session, and begins operation of the session. Ex. 1005, 32:9–13, 32:26–31. Lebrun indicates that initiating operation of the group-surfing session “caus[es] the web site 130 to deliver the initial page 153 to the web clients 110 participating in the session.” *Id.* at 32:30–31.

Lebrun’s primary embodiment is consistent with Patent Owner’s characterization in that the group-surfing server acts as a middleman and receives pages from the web site servers and sends the received pages to the participating clients. *Id.* at 35:10–12 (“In a preferred embodiment, the

group-surfing server 140 directs the target web site 130 to deliver that next page 153 to the group-surfing server 140 itself. The group-surfing server 140 then re-sends that page 153 to those web clients 110 participating in the session.”). Thus, Patent Owner is correct that Lebrun’s primary embodiment, although it sends cookie information to the participating clients, differs from limitation [1d] because the data received from the synchronization server is the web page itself, and does not include a URL of the website as limitation [1d] requires.

However, Lebrun also discloses embodiments where the group-surfing server sends information directly from the web site itself. For example, Lebrun describes one alternative embodiment “where no ‘cookies’ or other data related to identity are involved, [and] each web client 110 can receive the next page directly from the web site 130.” *Id.* at 35:17–19. Patent Owner contends that this embodiment cannot be relied for two reasons: (1) it explicitly states that no cookies are involved; and (2) the website sends a web page, and not a URL to the clients. Prelim. Resp. 40–41. We agree with Patent Owner. As noted above, this alternative embodiment indicates that it is intended for situations where “no ‘cookies’ or other data related to identity are involved.” *Id.* Thus, as Patent Owner correctly argues, any data sent from the group-surfing server would not include cookie information associated with the website and the host device as required by limitation [1d]. Moreover, we also agree with Patent Owner that because this alternative embodiment Lebrun indicates that the clients “receive *the next page* directly from the web site” (Ex. 1005, 35:18–19), Lebrun’s session participants do not receive *a URL of the website* as limitation [1d] requires.

However, Petitioner also relies on yet another embodiment disclosed by Lebrun. Specifically, Lebrun’s description of maintaining multiple group-surfing sessions by the group-surfing server. *Id.* at 43:5–22. Lebrun describes a primary embodiment for a multiple group-surfing session in which a user can add a page to a session by sending a message to the group-surfing server to add the page to a session such that the page is presented by the group-surfing server to other clients participating in the session *Id.* at 43:13–16. Lebrun also details that “[i]n alternative embodiments, the second web client 110 can receive only a list of pointers (such as URLs) to those pages presented during the group-surfing session, dynamically updated when a new page is added.” *Id.* at 43:20–22. Unlike the alternative, “no cookies” embodiment discussed above, Lebrun does not provide any indication that this alternative embodiment is used only in the absence of cookies. *See id.* (making no mention of the presence or absence of cookies). Moreover, unlike the earlier discussed “no cookies” alternative embodiment, the alternative multiple group-surfing session embodiment explicitly states that URLs, and not “the next page” (*id.* at 35:19), are sent to participating clients.

Patent Owner maintains that “Lebrun explains that this embodiment is only to be used ***without cookies.***” Prelim. Resp. 41 (citing Ex. 1005, 35:17–19). This argument conflates two different embodiments in Lebrun. The multiple group-surfing session embodiments are detailed at page 43 of Lebrun’s disclosure. Patent Owner relies on Lebrun’s description of an alternative embodiment described at page 35 of Lebrun, and relates to single group-surfing session embodiments. Patent Owner fails to explain, however, why Lebrun’s description of an alternative embodiment in the context of a single group-surfing session environment applies to an

embodiment described eight pages later in the context of a multiple group-surfing session environment. Nor are we aware of any statement in Lebrun indicating that *all* alternative embodiments must be implemented without cookies.

On this preliminary record, therefore, we find Petitioner’s showing as to limitation [1d] sufficient for institution.

f. Claim Limitation [1e]

Claim 1 also recites “operating a browser by the guest device based on the data received from the synchronization server” (limitation [1e] or “the operating a browser” limitation).

For the recitation “operating a browser by the guest device,” Petitioner relies on Lebrun’s disclosure of multiple web clients sharing web pages using ordinary web surfing techniques, including some web clients corresponding to the ’591 patent’s host device and other web clients corresponding to guest devices. See Pet. 31. For the recitation “based on the data received from the synchronization server,” Petitioner relies on Lebrun’s description of using sending cookies to participating web clients (citing Ex. 1005, 35:13–15) and the second web client receiving URLs in the group-surfing session (citing *id.* at 43:13–22). See Pet. 31.

Patent Owner contends that because the Petition fails to show that the prior art teaches or suggests the “receiving URL and cookie information” step of claim 1, Petitioner also “fails to demonstrate a reasonable likelihood that Lebrun in view of Wang teaches ‘operating a browser by the guest device based on data received from the synchronization server.’” Prelim. Resp. 42. More specifically, Patent Owner asserts that because the “receiving” step requires that both a URL and cookie information be

received, “it naturally follows that the guest device must operate the browser using both the URL and the cookie information.” Prelim. Resp. 43.

Patent Owner emphasizes that claim 1 requires that the claimed guest device must use the received URL and cookie information “to access the website server independently, i.e. without mediation from the synchronization server” (*id.*) and that Petitioner’s reliance on Lebrun is deficient because “[i]n the preferred embodiment of Lebrun, the group-surfing server directly sends the next page to the guest web clients” (*id.* at 46) and “[t]he other embodiment of Lebrun cited in the Petition explicitly notes that cookie information is not involved” (*id.* at 47 (citing Ex. 1005, 35:17–19)).

Petitioner’s showing for limitation [1e] is sufficient for institution. For the most part, Patent Owner’s arguments with respect to the operating a browser limitation are contingent on the success of their arguments with respect to the preceding limitation. That is, Patent Owner does not appear to dispute that Lebrun teaches operating a browser based on data received from the synchronization server. Rather, Patent Owner only disputes that the data received includes a URL and cookie information. See Prelim. Resp. 45–46 (explaining that “[b]ecause Lebrun fails to disclose receiving both [a URL and cookie information] in one embodiment, then both of those elements could not be used to ‘operat[e] a browser . . . based on the data received from the synchronization server.’”). We don’t agree with Patent Owner’s contention that the claimed guest device must use the received URL and cookie information “to access the website server independently, i.e. without mediation from the synchronization server” because we discern no requirement in the language of limitation [1e] requiring that the *website server be accessed independently*, or even at all—the limitation only

requires that the browser be operated based on the data received from the synchronization server.

Accordingly, Petitioner's showing for the operating a browser limitation is sufficient for purposes of institution.

g. Conclusion Regarding Claim 1

As discussed above, Petition's showing regarding the limitations of claim 1 and the reasons a person of ordinary skill in the art would have combined Lebrun and Wang to achieve the invention of claim 1, are sufficient for institution of this proceeding.

Having considered the Petition, Preliminary Response, and prior art evidence cited therein, we determine that Petitioner has established a reasonable likelihood that the combination of Lebrun and Wang renders the subject matter of claim 1 obvious. This showing is sufficient to institute an *inter partes* review on all challenged claims on all asserted grounds in the Petition. See *SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

Below, we provide additional analysis as to the remaining challenged claims in this asserted ground, and we also provide analysis as to certain challenged claims in the additional ground of obviousness over Prajapat and Wang.

4. *Independent Claim 10*

Claim 10 is independent, and recites an apparatus for a guest device performing a synchronized browsing session including a network interface and a processor adapted to perform steps similar to those recited in claim 1.⁹

Relying generally on its showing with respect to claim 1, Petitioner provides a similar showing for independent claim 10. *See* Pet. 32–34 (claim 10). Patent Owner also recognizes that claim 10 has “analogous limitations” to claim 1 and relies on its arguments presented with respect to claim 1. Prelim. Resp. 47.

Accordingly, for the reasons discussed above with respect to claim 1, Petitioner also sufficiently establishes for purposes of institution a reasonable likelihood that the combination of Lebrun and Wang renders the subject matter of claim 10 obvious.

5. *Dependent Claims 2–9 and 11–18*

The ’591 patent includes claims 2–9 (depending directly or indirectly from claim 1) and claims 11–18 (depending directly or indirectly from claim 10). In its assertions that these claims would have been obvious over Lebrun and Wang, Petitioner maps the added limitations of the dependent claims to the asserted prior art and provides why one of ordinary skill would have combined the references with a reasonable expectation of success for purposes of institution. Pet. 34–47; *see also* Pet. 18–19 (discussing

⁹ Claim 10 appears to be a mixed-type claim, because it recites a process step “receiving data from the synchronization server . . .” among the other recited limitations for the claimed apparatus. *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005). For purposes of this proceeding, we interpret the “receiving data” limitation as meaning that the claimed processor is adapted to receive data.

motivation to combine Lebrun and Wang). Patent Owner does not offer arguments against these assertions at this time. *See generally* Prelim. Resp.

For claim 2's recitation of receiving an invitation to join the synchronized browsing session, Petitioner relies on Lebrun's description of the group-surfing server creating a group-surfing session and informing participants in the group-surfing session. *See* Pet. 34 (citing Ex. 1005, 32:1–31). Petitioner also relies on Wang's use of the myURL address to provide an invitation to join a session. *See* Pet. 35 (citing Ex. 1006 ¶ 49). Claims 3 and 4 each depend from claim 2, and recite additional limitations regarding the content of the received invitation. For claim 3's limitation that the invitation comprises a hyperlink, Petitioner relies on Lebrun's session-creation message sent to participants and Wang's use of a myURL address to invite participants to join a session. *See* Pet. 35–36. Claim 4 specifies that the invitation includes a session identifier. For this limitation, Petitioner relies on the identifier included in Lebrun's session-creation message. *See* Pet. 36–37 (citing Ex. 1005, 32:9–31). Petitioner also relies on Wang's session invitation, asserting that a person of ordinary skill in the art would have understood Wang's session invitation to necessarily included a session identifier. *See* Pet. 37.

Claim 5 also depends from claim 2, and recites that the received invitation is received via any one of various different communication media. Petitioner relies on both Lebrun and Wang to teach the subject matter of claim 5. Specifically, Petitioner relies on various communication media disclosed in Lebrun for communication over a network. *See* Pet. 38 (citing Ex. 1005, 41:16–22, 30:30–31:15). Petitioner also relies on Wang's disclosure of sending an invitation and URL address via email. *Id.* (citing

Ex. 1006 ¶¶ 48, 66). We note the broad language of “other communication medium” as recited in claim 5.

Dependent claims 6 and 16 recite similar limitations and are addressed together in the Petition. Specifically, claims 6 and 16 depend from claims 1 and 10, respectively, and recite in part, “information related to the shared user input web browsing interaction.” The phrase “shared user input web browsing interaction” lacks antecedent basis in the independent claims. Claims 6 and 16 additionally specify that the information comprises “form data, script data, or other web browsing interaction data.” Petitioner relies on Lebrun’s description of the group-surfing server receiving a page from a web site and passing it to web clients participating in a group session teaches the recited other web browsing interaction data. *See* Pet. 39 (citing Ex. 1005, 35:5–28, 46:7–11. We note the broad scope of “other web browsing interaction data” as recited in claims 6 and 16.

Dependent claims 7 and 17 also depend respectively from claims 1 and 10, and recite “wherein the shared user input web browsing interaction is depicted in a first web browser window.” For this limitation, Petitioner relies on Lebrun’s controlling web client making browser inputs resulting in a progression of web pages viewed that are presented at the web clients participating in the session. *See* Pet. 39 (citing Ex. 1005, 34:15–21, 35:5–28). We again note a lack of antecedent basis for the phrase “the shared user input web browsing interaction.”

Claims 8 and 18 depend from claim 7 and 17, respectively, and recite the limitations “wherein non-shared web browsing interactions are depicted in a second web browser window” and “wherein non-shared web browsing interactions are depicted in a non-shared web browser window,” respectively. For these claims, Petitioner relies on Lebrun’s look ahead

function that allows the controlling web client to determine whether certain pages require special access before being presented to session participants. *See* Pet. 40 (citing Ex. 1005, 37:29–38:27). Petitioner contends that the ability to require special access means that the controlling web client can access certain pages that are not made available to other participants in the group-surfing session. *Id.* at 40–41 (citing Ex. 1005, 47:1–6, 47:22–27, 47:29–31).

Claim 9 depends from claim 1 and recites the limitation “wherein the shared user input web browser action further comprises a log-in into a restricted-access webpage.” We again note the lack of antecedent basis for “the shared user input web browser action.” Petitioner relies on Lebrun to teach this limitation. Specifically, Petitioner relies on the same special access functionality discussed above, and in particular, that Lebrun’s special access pages correspond to the recited restricted-access webpage. *See* Pet. 41. Additionally, Petitioner contends that Lebrun’s controlling web client is able to present information from an HTML form to web clients participating in the session.

Claim 11 depends from claim 10 and recites the additional limitation “a user interface adapted to initiate the processor to send the request in response to a user input.” For this limitation, Petitioner relies on Lebrun’s description of a web client user sending a message to the group-surfing server using ordinary web surfing techniques. *See* Pet. 42 (citing Ex. 1005, 12:24–28, 30:14–17, 43:13–22).

Claim 12 depends from claim 11 and additionally specifies that “the user input comprises activation of the hyperlink for initializing sending of the request to join the synchronized browsing session.” Petitioner relies on Lebrun’s description of sending a session-creation message for a group-

surfing session by selecting a web page or a link to a web page. *See* Pet. 42–43 (citing Ex. 1005, 32: 9–11, 32:5–7). Petitioner also relies on Wang’s myURL address in combination with Lebrun, contending that the use of the myURL address teaches the claimed activation of the hyperlink to join a session, and asserts that a person of ordinary skill in the art would have understood that Lebrun’s messages to the group-surfing server could be modified to include Wang’s myURL address. *See* Pet. 43 (citing Ex. 1006 ¶ 47).

Claim 13 depends from claim 10 and recites that the apparatus of claim 10 further includes “a memory adapted to store one or more software modules for controlling the processor.” Petitioner relies on Lebrun for claim 13, asserting that Lebrun’s description of the web clients utilizing a general purpose computer teaches the subject matter of claim 13. *See* Pet. 44 (citing Ex. 1005, 12:24–28, 30:14–17, 30:19–28). We note the broad language of claim 13.

Claim 14 depends from claim 10, and is nearly identical to claim 5, discussed above. Claim 14 differs from claim 5 only in that it specifies that a “hyperlink” (instead of the more general “invitation”) is received from the host device via communication media. Petitioner relies on both Lebrun and Wang to teach the subject matter of claim 14. *See* Pet. 44–46. Specifically, Petitioner relies on Lebrun’s session-creation messages in combination with Wang’s myURL address, which can be sent via email. *See* Pet. 44–45 (citing Ex. 1005, 41:16–22, 32:9–11; Ex. 1006 ¶¶ 48, 66). We again note the broad language of “other communication medium” as recited in claim 14.

Claim 15 depends from claim 10 and recites “a user interface adapted to depict the shared user input web browsing interactions in a shared web

browsing window.” Claim 15 is similar to claim 7 discussed above, except that claim 15 additionally includes a user interface. As with claim 7, the phrase “the shared user input web browsing interaction” lacks antecedent basis. For claim 15, Petitioner relies on the same subject matter relied upon for claim 7. *See* Pet. 46 (citing Ex. 1005, 12:24–28, 30:14–17, 43:13–22). Petitioner further relies upon Lebrun’s discussion of sending different versions of the same page to accommodate different web clients as demonstrating Lebrun’s use of the claimed user interface. *Id.* (citing Ex. 1005, 36:11–17).

Petitioner’s showing as to the dependent claims relies on many of the same passages in Lebrun as discussed above with respect to claim 1. Several of the dependent claim broadly recite the use of conventional computer-related components such as, computer memory, user interfaces, and the like, and Petitioner relies on Lebrun’s description of a web-based environment to teach these computer-related components. Patent Owner does not present separate arguments regarding any of the dependent claims.

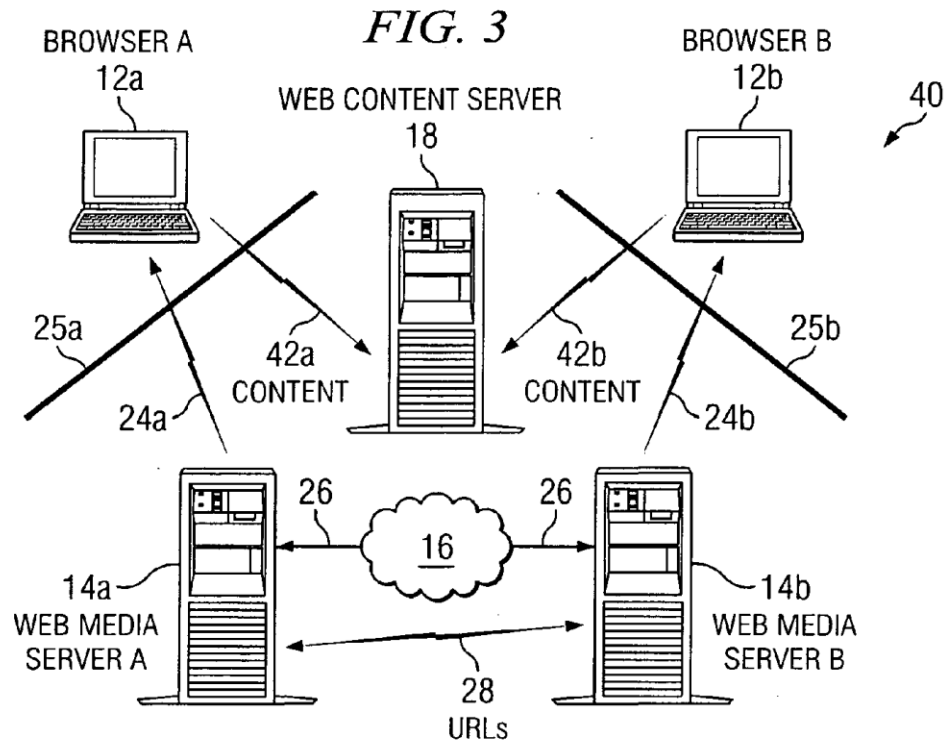
E. Obviousness over Prajapat and Wang

Petitioner asserts that claims 1–18 would have been obvious under 35 U.S.C. § 103 based on the combined teachings of Prajapat and Wang.

1. Prajapat’s Disclosure

Prajapat is a U.S. Published Patent Application and titled “Peer-to-Peer Dynamic Web Page Sharing.” Ex. 1007, code (54). Prajapat relates to a “communication system [that] includes a first browser operable to submit requests for one or more web pages and a request to share the one or more requested web pages with another browser.” *Id.* at code (57).

Prajapat’s Figure 3 is reproduced below:



Prajapat's Figure 3 "illustrates an example of a communication system 40 operable to provide peer-to-peer simple web page sharing" and "includes browsers 12, web media servers 14, and web content server 18." Ex. 1007 ¶ 41. Prajapat details that "[i]n operation of the system 40, browser 12a may request a web page sharing session with one or more other browsers 12 (in this example, browser 12b)." *Id.* Prajapat further describes that "[b]rowser 12a may submit a request to web content server 18 for one or more web pages using link 42a, for example." *Id.* ¶ 43. The browser 12a may also "communicate the URL and any other suitable information regarding the requested web page to web media server 14a," which in turn "may communicate the URL and any other suitable information to web media server 14b." *Id.* The web media server 14b "may communicate the URL and any other suitable information to browser 12b" which "may use

the URL and any other suitable information to request from web content server 18 the web page that browser 12a requested.” *Id.*

2. Claim 1

a. Claim 1 Preamble

As we noted above, claim 1’s preamble recites “[a] method for a guest device performing a synchronized browsing session administered by a synchronization server.” Petitioner relies on Prajapat’s peer-to-peer web page sharing via a web media server for teaching a synchronized browsing session administered by a synchronization server recited in claim 1. *See* Pet. 47–48 (citing Ex. 1007 ¶¶ 12, 41). Petitioner relies on Prajapat’s description of an associated browser 12b that joins a synchronized browsing session for teaching a guest device. *See* Pet. 49 (citing Ex. 1007 ¶ 16). Regardless of whether the preamble is limiting, Petitioner’s showing for the preamble is sufficient for purposes of institution because Petitioner relies on a plain reading of the cited passages discussed above with respect to Prajapat’s disclosure. Patent Owner does not address Petitioner’s showing as to this limitation. *See generally* Prelim. Resp.

b. Claim 1 Limitation [1a] – The Detecting Limitation

For “detecting an activation of a hyperlink associated with the synchronized browsing session by a guest device,” Petitioner relies on both Prajapat and Wang. *See* Pet. 49–51. Specifically, Petitioner relies on Prajapat’s co-browsing request process, by which a URL and other suitable information are transmitted from a first browser through a media server and to a second browser. *See* Pet. 49–50 (citing Ex. 1007 ¶¶ 19, 22, 26–27, 36, 39, 43). Petitioner contends that a “[person of ordinary skill in the art] would have understood browser 12b’s receipt of browser 12a’s request to

co-browse to comprise detecting an activation of a hyperlink associated with the synchronized browsing session by a guest device.” Pet. 50 (citing Ex. 1003 ¶¶ 220–21).

Petitioner also cites Wang in combination with Prajapat for the “detecting” limitation of claim 1, applying Wang’s teachings similar to how they were applied with respect to Ground 1 above. Specifically, Petitioner relies on Wang’s description of the use of a myURL address to allow a second client device to join a session, in combination with Prajapat’s request from a first browser to a second browser to co-browse. Petitioner asserts that “[a person of ordinary skill in the art] would also have understood Prajapat’s disclosure of browser 12b receiving browser 12a’s request to co-browse to include receiving ‘myURL address’ of Wang.” See Pet. 50 (citing Ex. 1003 ¶ 222).

Petitioner contends that a person of ordinary skill in the art would have been motivated to combine Wang’s URL-based session invitation with Prajapat co-browsing request because doing so would allow Prajapat’s guest device to perform collaborative browsing and would further provide control over the time that other browser could join a co-browsing session. See Pet. 50–51. Petitioner also contends that the combination of Prajapat and Wang would have been obvious because both references are directed to problems relating to collaborative browsing. See Pet. 20 (citing Ex. 1007 ¶ 5, Fig. 2; Ex. 1006 ¶¶ 9–10, 13). Petitioner further asserts that a person of ordinary skill in the art would have sought out various available solutions for enabling co-browsing. *Id.* (citing *KSR*, 550 U.S. at 421).

Patent Owner does not address Petitioner’s showing as to limitation [1a]. See *generally* Prelim. Resp. Petitioner’s showing maps the claim

elements to straightforward descriptions in Prajapat and Wang as described above.

c. Claim 1 Limitation [1b] – The Sending a Request Limitation

For the limitation “sending a request by the guest device to join the synchronized browsing session to the synchronization server in response to the activation of the hyperlink,” Petitioner again relies on both Prajapat and Wang. See Pet. 51–52. Specifically, Petitioner cites Prajapat’s communication session between browser 12b and web media server 14b having an outgoing channel 30b that allows the browser to submit requests for web pages. See Pet. 51. Citing Dr. Lieberman’s declaration, Petitioner avers that “[a person of ordinary skill in the art] would have understood browser 12b submitting requests for web pages may be in response to the receipt of the request to co-browse.” See Pet. 51 (citing Ex. 2003 ¶ 224). Petitioner further relies on Wang’s teachings, arguing that Wang’s second client device accessing the myURL address and subsequently sending a login request to a server apparatus teaches the “sending” limitation. See Pet. 51–52 (citing Ex. 1006 ¶ 49). Petitioner further contends that a person of ordinary skill in the art would have understood Prajapat’s browser request and Wang’s myURL address “to be in response to the activation of the hyperlink.” Pet. 52. Petitioner also argues that a person of ordinary skill in the art would have also understood Prajapat’s browser making requests for web pages would have included accessing a designated URL address and that Wang’s sending a login request would have included sending a request by the guest device to join the synchronized browsing session. See Pet. 52 (citing Ex. 1003 ¶ 225).

Patent Owner does not address Petitioner’s showing as to limitation [1b]. See generally Prelim. Resp. Petitioner’s showing maps the claim

elements to straightforward descriptions in Prajapat and Wang as described above.

d. Claim 1 Limitation [1c] – The Receiving a Notification Limitation

For the limitation “receiving from the synchronization server a notification that guest device has joined the synchronized browsing session,” Petitioner relies on Prajapat’s description of web media server 14b’s use of incoming channel 32b to communicate notifications and other information to browser 12b. See Pet. 52–53 (citing Ex. 1007 ¶¶ 21, 35). Relying on Dr. Lieberman’s declaration, Appellant asserts that “[a person of ordinary skill in the art] would have understood this disclosure to show receiving from the synchronization server a notification that the guest device has joined the synchronized browsing session.” Pet. 53 (citing Ex. 1003 ¶ 227).

Patent Owner does not address Petitioner’s showing as to limitation [1c]. See generally Prelim. Resp. Petitioner’s showing maps the claim elements to straightforward descriptions in Prajapat as described above.

e. Claim 1 Limitation [1d] – The Receiving Data Limitation

For the recitation “receiving data from the synchronization server,” Petitioner relies on Prajapat’s incoming channel between web media server 14b and browser 12b. See Pet. 53 (citing Ex. 1007 ¶¶ 21, 35). Petitioner also relies on Prajapat’s description of a user desiring to co-browse with other users to teach “where the data relates to a website being accessed in realtime by a host device,” See Pet. 53–54 (citing Ex. 1007 ¶¶ 12, 16). For the recitation “and wherein the data comprises a URL of the website,” Petitioner relies on Prajapat’s description of browser 12a submitting requests for web pages using the URL of the web site. *Id.* at 54 (citing Ex. 1007 ¶¶ 22, 36, 43). Petitioner also relies on Prajapat’s disclosure that browser

12a's web page request may include cookies and other information needed to properly render the webpage to teach "cookie information associated with the website and the host device." *Id.*

Patent Owner contends that the disclosures in Prajapat relied upon by Petitioner "focus on two fundamentally different systems." Prelim.

Resp. 48. Specifically, Patent Owner argues that most cited portions of Prajapat relate to peer-to-peer dynamic web page sharing, while paragraph 43 of Prajapat relates to a different peer-to-peer simple web page sharing. *Id.* at 48–49. Patent Owner asserts that Prajapat's dynamic web page sharing is fundamentally different from the '591 patent because it relies on intermediate web media servers to retrieve web content data. *Id.* at 49–53 (detailing the differences in the architecture of Prajapat's Figure 1 and requirements of claim 1). Patent Owner also argues that Prajapat's peer-to-peer simple web page sharing merely involves web page sharing sessions, but does not allow for co-browsing functionality akin to the synchronized browsing of the '591 patent. Prelim. Resp. 53–54.

At this preliminary juncture, we find Petitioner's showing as to limitation [1d] sufficient for institution. Patent Owner contends that Prajapat's Figure 3 embodiment is limited to a simple web page sharing session. However, Patent Owner does not explain the specific functional difference between web page sharing sessions and co-browsing, nor is any specific difference apparent to us in Prajapat's description. Moreover, we note that Prajapat expressly indicates that the web page sharing of Figure 3 is the same as that described in the dynamic web page sharing embodiment of Figures 1 and 2. Ex. 1007 ¶ 47 ("In this example, web pages may be shared in a substantially similar manner to that described above with reference to FIGS. 1 and 2."). Thus, we do not agree that Petitioner

improperly relies on disclosures regarding both Prajapat's dynamic web page sharing and simple web page sharing.

f. Claim 1 Limitation [1e] – The Operating a Browser Limitation

For the limitation “operating a browser by the guest device based on the data received from the synchronization server,” Petitioner relies on substantially the same disclosure in Prajapat as with the preceding limitation. *See* Pet. 55–56. More specifically, Petitioner relies on Prajapat's description that browsers 12a and 12b display the same web pages at substantially the same time during a co-browsing session. *Id.* (citing Ex. 1007 ¶¶ 12, 16). Petitioner further relies on Prajapat's description that information for rendering the page passes from the first browser 12a through the web media server 14a and 14b, and then to the second browser 14b. *Id.* (citing Ex. 1007 ¶¶ 22, 26–27, 36, 39, 43).

Relying on the same arguments presented with respect to limitation [1d] above, Patent Owner contends that because Prajapat fails to teach the recited “URL and cookie information,” it must also fail to teach operating a browser based on that same information. Prelim. Resp. 55. We did not agree with Patent Owner's arguments with respect to limitation [1d], so we do not agree with this argument regarding limitation [1e]. Petitioner's showing as to limitation [1e] is sufficient for institution.

3. Independent Claim 10

Relying generally on its showing with respect to claim 1, Petitioner provides a similar showing for independent claim 10. *See* Pet. 56–58 (claim 10). Patent Owner also recognizes that claim 10 has “analogous limitations” to claim 1 and relies on its arguments presented with respect to claim 1. Prelim. Resp. 57.

4. *Dependent Claims*

Petitioner cites various portions of Prajapat and Wang for the additional subject matter recited by dependent claims 2–9 and 11–18. Pet. 58–70. Patent Owner does not address the sufficiency of Petitioner’s showing regarding the dependent claims. *See generally* Prelim. Resp.

F. *Qualifications of Petitioner’s Declarant*

In its Preliminary Response, Patent Owner contends that Petitioner’s Declarant, Dr. Lieberman, does not have the requisite level of skill to testify from the perspective of one of ordinary skill either under Patent Owner’s proposed level of ordinary skill or under Petitioner’s proposed level of ordinary skill. Prelim. Resp. 33–35.

More specifically, Patent Owner contends that Dr. Lieberman’s Curriculum Vitae (“CV”) does not describe at least two years of experience in internet web browsing software development, web connectivity software development, or networking software development as required under Patent Owner’s proposed level of ordinary skill. *Id.* at 33–34 (citing Ex. 1004). Patent Owner further contends that Dr. Lieberman lacks “two years of work experience in software development and/or web-based software [development],” as Petitioner proposes. *Id.* at 34–35. *Id.* For these reasons, Patent Owner indicates Dr. Lieberman does not possess the requisite level of ordinary skill to testify from the perspective of one of ordinary skill and his opinions should be given little or no weight. *Id.* at 35.

“To offer expert testimony from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art.” *Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1376–77 (Fed. Cir. 2022).

Patent Owner is correct that Dr. Lieberman's CV on its face does not include two years in a position titled as software developer, web-based developer, or the like. *See generally* Ex. 1004. Dr. Lieberman, however, has a degree in “*Informatique*” from the University of Paris VI (Sorbonne), as Patent Owner acknowledges (Prelim. Resp. 34), and this degree is in addition to Dr. Lieberman's Bachelor of Science degree from the Massachusetts Institute of Technology (MIT). Ex. 1004, 12–13. This University of Paris VI (Sorbonne) degree is additional education beyond the required bachelor's degree and could have substituted for some amount of professional experience, as we note in our determination of the level of ordinary skill for this institution decision in Section II.A.

We also note Dr. Lieberman's extensive work experience, beginning in 1973 as a research scientist at MIT's Artificial Intelligence Laboratory, may include the requisite two years of work experience. *Id.* at 4. Dr. Lieberman's professional activities unequivocally demonstrate work experience related to web technology. He delivered an invited keynote speech at IEEE/ACM Conference on Web Intelligence and Intelligent Agent Technology in 2005. *Id.* at 9. Dr. Lieberman served as conference chair and program committee member for the American Association for Artificial Intelligence (AAAI) Special Track on AI and the Web in 2008 and for the World Wide Web Conference in 1999 and 2000. *Id.* at 10. Dr. Lieberman also presented a publication at the Workshop on the Social Mobile Web at the International AAAI Conference on Weblogs and Social Media, Barcelona, Catalonia, Spain in July 2011. *Id.* at 19. He co-wrote chapters in *No Code Required: Giving Users Tools to Transform the Web* in 2010—a nineteen-page chapter titled “A Goal-Oriented Web Browser” and a fifteen-

page chapter titled “Knowing What You’re Talking About: Natural Language Programming of an Multi-Player Online Game.” *Id.* at 21.

Accordingly, there is evidence to consider in making a determination of whether Dr. Lieberman possesses the requisite ordinary level of skill. We, however, need not make such a determination for purposes of this decision because it has not been necessary for us to rely on Dr. Lieberman’s declaration in this decision.

“No rule requires a Petition to be accompanied by any declaration, let alone one from an expert guiding the Board as to how it should read prior art.” *Belden Inc. v. Berk–Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015). “[E]xpert testimony is not required when the references and the invention are easily understandable.” *Id.* (quoting *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1242 (Fed. Cir. 2010)). “Board members, because of expertise, may more often find it easier to understand and soundly explain the teachings and suggestions of prior art without expert assistance.” *Id.*

Here, the invention and prior art are presented in high-level functional terms and are easily understandable, as we indicated previously in Section II.A and as shown by our discussion of the invention and prior art throughout this decision. To determine that the Petition met the institution threshold of showing “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition,” we have not relied on Dr. Lieberman’s declaration testimony. Patent Owner, of course, may raise the issue of Dr. Lieberman’s qualifications during trial.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner

would prevail in showing at least one of claims 1–18 of the ’591 patent is unpatentable under 35 U.S.C. § 103. We, therefore, institute an *inter partes* review of all challenged claims on all asserted grounds. 37 C.F.R.

§ 42.108(a); *see SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

IV. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–18 of the ’591 patent on all the grounds set forth in the Petition; and,

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

FOR PETITIONER:

Jennifer Bush
jbush-ptab@fenwick.com

Christopher Larson
clarson@fenwick.com

PATENT OWNER:

Scott Hejny
shejny@mckoolsmith.com

Ryan McBeth
rmcbeth@mckoolsmith.com

Archis Ozarkar
nozarkar@mckoolsmith.com