

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.
Petitioner,

v.

SAMESURF, INC.
Patent Owner.

Case No.: IPR2023-00342
U.S. Patent No. 8,527,591

**PATENT OWNER'S CONTINGENT MOTION TO AMEND
AND REQUEST FOR PRELIMINARY GUIDANCE**

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List of Exhibits

Exhibit No.	Description
2001	Saif Askar's Declaration
2002	Saif Askar's Biography
2003	Declaration of David S. Howell

I. Introduction

Patent Owner SameSurf, Inc. submits this motion to amend U.S. Patent No. 8,527,591 (the “’591 Patent”) contingent on the outcome of this trial. If the Board finds any of the original independent claims 1 or 10 unpatentable, Patent Owner respectfully requests that the Board grant this motion to amend and issue substitute claims herein that respectively correspond to any of claims 1 or 10 found unpatentable, as well as amend and issue corresponding substitute dependent claims herein.

II. Statement of Requested Relief

First, Patent Owner respectfully requests preliminary guidance on this motion pursuant to the Board’s pilot program. *See* 84 Fed. Reg. 9497; Patent Trial and Appeal Broad Consolidated Trial Practice Guide (Nov. 2019) at 67.

Second, to the extent the Board finds either original independent claim 1 or 10 unpatentable in this proceeding, Patent Owner respectfully requests that the Board grant this motion with respect to the substitute claims, independent or dependent, corresponding to any claim found unpatentable. The Board should not consider this motion for each original claim it finds patentable.

III. The Substitute Claims Meet All Requirements of 35 U.S.C. § 316 and 37 C.F.R. § 42.121

A motion to amend must (1) propose a reasonable number of substitute

claims, (2) that respond to a ground of unpatentability involved in the trial, (3) that do not enlarge the scope of the claims or introduce new matter, and (4) are not shown by a preponderance of the evidence to be unpatentable. *See* Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) at 2; 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. It is Petitioner's burden to show that the proposed substitute claims are unpatentable. *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15, 4 (PTAB Feb. 25, 2019) (precedential).

A. The Number of Substitute Claims is Reasonable

“There is a rebuttable presumption that a reasonable number of substitute claims per challenged claim is one (1) substitute claim.” *Lectrosonics* at 4. In this proceeding, the Petitioner challenges 18 claims, and Patent Owner proposes 18 substitute claims. Of the 18 substitute claims, Patent Owner provides substantive amendments to the 2 independent claims and to 3 dependent claims, while 13 dependent claims are amended only to correct their dependencies or minor antecedent issues. The amendments to the 3 dependent claims were to avoid any confusion in how those claims may be read following amendments to claims 1 and 10. These 18 claims constitute a one-for-one substitution, which is reasonable and thus satisfies 35 U.S.C. § 316(d)(1)(B) and 37 C.F.R. § 42.121(a)(3). *See Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-00933, Paper 31, 9 (PTAB Dec. 3, 2019); *see also Lectrosonics* at 45-46.

**B. The Substitute Claims Respond to Patentability Grounds
Involved in this Trial**

Proposed substitute claims 19-36 respond to the grounds asserted in the Petition. For example, this motion proposes adding the following limitations to the original independent claim 1 (via substitute claim 19): 1) That the data shared from the host to the synchronization server, that is also received by the guest device, in addition to a URL and cookie data, includes “information related to a shared user input web browsing interaction that includes second data indicating at least one direct host device interaction with content of the website performed by the host device”; and 2) That the guest device “based at least in part on the second data... independently replicate the host device interaction with the content of the website, obtained by the guest device from a website server based on at least the first data.”

This motion proposes modification of independent claim 10 by adding the following limitations (via substitute claim 28): 1) That the data shared from the host to the synchronization server, that is also received by the guest device, in addition to a URL and cookie data, includes “information related to and derived from a shared user input web browsing interaction, the information including second data indicating at least one action performed by the host device on content of the website displayed in a host browser of the host device”; and 2) That the guest device, “based at least in part on the second data... independently replicate

the at least one action in the guest browser on content obtained by the guest device from a website server based on at least the first data.”

This motion proposes clarifying amendments to claims 7, 15 and 17, via substitute claims 25, 33 and 35, respectively, corresponding with the proposed amendments to claims 1 and 10 via substitute claims 19 and 36, respectively.

The motion also proposes fixing a possible antecedent basis issue via proposed claim 27 by changing “action” to “interaction.”

Petitioner alleges that the asserted prior art discloses aspects of the original independent claims, and this motion conditionally seeks to amend those claims to address Petitioner’s arguments. While Patent Owner does not concede that the original claims fail to overcome the grounds of unpatentability involved in this trial, these amendments further distinguish over and further overcome those grounds, as explained in Section VII below.

C. The Substitute Claims Do Not Broaden the Claim Scope or Introduce New Subject Matter

“A motion to amend may not present substitute claims that enlarge the scope of the claims of the challenged patent or introduce new subject matter.” *Lectrosonics* at 6-8 (citing 35 U.S.C. § 316(d)(3); 37 C.F.R. § 41.121(a)(2)(ii)). Patent Owner’s proposed claims comply with both of these requirements.

1. The Substitute Claims Do Not Broaden the Claim Scope

The proposed substitute independent claims (*i.e.*, 26, 33, and 37) retain all of the original independent claims' (*i.e.*, 1, 12, and 19) features and add narrowing elements as outlined in Section III.B above.

The proposed amendments further expressly define what data may be included with regards to the first data received from the synchronization server. Additionally, the replication action performed by the guest device using the guest browser, and based at least in part on the now-recited data, is now expressly recited. Each of these additions is made for the purpose of further distinguishing the claims over the prior art raised in the Petition. Both notions are encompassed by the original scope of the original claims, but now are expressly recited, thus plainly narrowing the scope in compliance with 37 C.F.R. § 42.121(a)(2)(ii). *See Lectrosonics* at 7 (noting that “a proposed substitute claim adding a novel and nonobvious feature or combination to avoid the prior art in an instituted ground of unpatentability will not enlarge the scope of the claims of the patent.”).

As a result, the proposed amendments narrow the claim scope in compliance with 37 C.F.R. §42.121(a)(2)(ii). *See Lectrosonics* at 7 (noting that “a proposed substitute claim adding a novel and nonobvious feature or combination to avoid the prior art in an instituted ground of unpatentability will not enlarge the scope of the claims of the patent.”).

2. The Substitute Claims Do Not Introduce New Matter

Second, as required by 37 C.F.R. 42.121(b), the proposed substitute claims are supported by the original non-provisional application and thus do not introduce new subject matter. The '591 Patent issued from Application Serial No. 12/783,743 (the "'743 Application") filed on May 20, 2010, which is included at pages 158-230 of Petitioner's Exhibit 1002. For the purposes of this motion, Patent Owner identifies the following portions of the '743 Application as providing support for the proposed amendments and showing information sufficient to inform a person of ordinary skill in the art ("POSITA") how to both make and use the invention as recited in the proposed substitute claims.

While support for claims is shown by reference to illustrative embodiments, those embodiments are examples only and do not limit the scope of a claim, or a specific limitation of that claim, thereto, as explained in the '743 Application. (*see e.g.*, '743 Application, [0041], [0152]¹.) Further, while more than adequate support is provided for each limitation, that support is non-exhaustive – additional examples of disclosure may also be found in the specification of the '743 Application and will be additionally cited as or if required.

Substitute Independent Claim 19. The '743 Application discloses a

¹ Cites to the '743 Application are to the application as filed, which is included in Ex. 1002, pages 158-230.

method for a guest device performing a synchronized browsing session administered by a synchronization server. (*Id.*, [Abstract], Fig. 5(a), [0009], [0047], [0073], [0076], [0115], [0125], [0127].) The '743 Application discloses detecting an activation of a hyperlink associated with the synchronized browsing session by a guest device. (*Id.*, FIG. 4(a): element 302, [0009], [0010], [0098], [0101].) The '743 Application discloses 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. (*Id.*, Fig. 4(a): element 306, [0009], [0010], [0098], [0099].) The '743 Application discloses receiving from the synchronization server a notification that guest device has joined the synchronized browsing session. (*Id.*, Fig. 7(a): element 73, [0144].) The '743 Application discloses receiving first data from the synchronization server, where the data relates to a website being accessed in real-time by a host device, (*Id.*, [0008], [0011], [0044], [0048], [0055], [0096], [0127], [0130]) – wherein the first data comprises a URL of the website, (*Id.*, [0042], [0050], [0110], [0113]) cookie information associated with the website and the host device, (*Id.*, [0042], [0110], [0047]) and information related to a shared user input web browsing interaction that includes second data indicating at least one direct host device interaction with content of the website performed by the host device. (*Id.*, [0013], [0042]-[0044], [0050], [0110], [0113], [0116], [0125], [0130].) The '743 Application discloses operating a browser by the guest device

based on at least the second data received from the synchronization server to independently replicate the host device interaction with the content of the website, obtained by the guest device from a website server based on at least the first data. (*Id.*, [0011]-[0013], [0042]-[0044], [0048], [0049], [0053], [0056], [0058], [0066], [0113], [0116], [0118], [0130], [0131].)

Substitute Dependent Claim 20. The '743 Application discloses receiving an invitation to join the synchronized browsing session. (*Id.*, [0083], [0084], [0097], [0100]-[0102].)

Substitute Dependent Claim 21. The '743 Application discloses the invitation comprising the hyperlink associated with the synchronized browsing session. (*Id.*, [0083]-[0085], [0097], [0100]-[0102].)

Substitute Dependent Claim 22. The '743 Application discloses invitation further comprising a session identifier. (*Id.*, [0097], [0101].)

Substitute Dependent Claim 23. The '743 Application discloses the invitation being received via: a social network communication, a news feed, an email message, an instant message communication, a micro-blogging communication, a text message communication, or other communication medium. (*Id.*, [0096], [0097].)

Substitute Dependent Claim 24. The '743 Application discloses information related to the shared user input web browsing interaction comprising:

form data, java script data, or other web browsing interaction data. (*Id.*, [0042], [0050], [0113], [0116], [0120], [0130].)

Substitute Dependent Claim 25. The '743 Application discloses that the shared user input web browsing interaction replicated by the guest device is depicted in a first web browser window of the browser. (*Id.*, [0042]-[0044], [0066], [0131].)

Substitute Dependent Claim 26. The '743 Application discloses non-shared web browsing interactions being depicted in a second web browser window. (*Id.*, [0134]-[0136], [0139].)

Substitute Dependent Claim 27. The '743 Application discloses a shared user input web browser interaction further comprises a log-in into a restricted-access webpage. (*Id.*, [0044].)

Substitute Independent Claim 28. The '743 Application discloses an apparatus for a guest device performing a synchronized browsing session administered by a synchronization server. (*Id.*, [Abstract], Fig. 5(a), [0009], [0047], [0037], [0040], [0115], [0125], [0127].) The '743 Application discloses a network interface adapted to communicate with the synchronization server. ([0065].) The '743 Application discloses a processor adapted to detect an activation of a hyperlink associated with the synchronized browsing session by a guest device. (*Id.*, FIG. 4(a): element 302, [0009], [0010], [0098], [0101].) The

'743 Application discloses a processor adapted to send a request to join the synchronized browsing session to the synchronization server via the network interface, in response to the activation of the hyperlink. (*Id.*, Fig. 4(a): element 306, [0009], [0010], [0065], [0098], [0099].) The '743 Application discloses a processor adapted to receive from the synchronization server a notification that guest device has joined the synchronized browsing session. (*Id.*, Fig. 7a: element 73, [0144].) The '743 Application discloses a processor adapted to receive first data from the synchronization server, wherein the first data relates to a website being accessed in real-time by a host device, (*Id.*, [0008], [0011], [0044], [0048], [0055], [0096], [0127], [0130]) – wherein the first data comprises a URL of the website, (*Id.*, [0042], [0050], [0110], [0113]) cookie information associated with the website and the host device (*Id.*, [0042], [0110], [0113]) and information related to and derived from a shared user input web browsing interaction, the information including second data indicating at least one action performed by the host device on content of the website displayed in a host browser of the host device. (*Id.*, [0013], [0042]-[0044], [0050], [0110], [0113], [0116], [0125], [0130].) The '743 Application discloses a processor adapted to operate a guest browser by the guest device based at least in part on the second data received from the synchronization server to independently replicate the at least one action in the guest browser on content obtained by the guest device from a website server based on at least the first data.

(*Id.*, [0011]-[0013], [0042]-[0044], [0048], [0049], [0053], [0056], [0058], [0066], [0113], [0115], [0116], [0118], [0130], [0131].)

Substitute Dependent Claim 29. The '743 Application discloses a user interface adapted to initiate the processor to send the request in response to a user input. ([0066].)

Substitute Dependent Claim 30. The '743 Application discloses that the user input comprises activation of the hyperlink for initializing sending of the request to join the synchronized browsing session. (*Id.*, FIG. 4(a): element 302, [0009], [0010], [0098], [0101].)

Substitute Dependent Claim 31. The '743 Application discloses a memory adapted to store one or more software modules for controlling the processor. (*Id.*, [0065], [0066].)

Substitute Dependent Claim 32. The '743 Application discloses the hyperlink being received from a host device via: a social network communication, a news feed, an email message, an instant message communication, a micro-blogging communication, a text message communication, or other communication medium. (*Id.*, [0083]-[0085], [0097], [0100]-[0102].)

Substitute Dependent Claim 33. The '743 Application discloses a user interface adapted to depict the shared user input web browsing interactions, including at least the replicated at least one action, in a shared web browsing

window of the guest browser. (*Id.*, [0042]-[0044], [0065], [0066], [0131].)

Substitute Dependent Claim 34. The '743 Application discloses information related to the shared user input web browsing interaction comprising: form data, java script data, or other web browsing interaction data. ([0042], [0050], [0113], [0116], [0120], [0130].)

Substitute Dependent Claim 35. The '743 Application discloses that the shared user input web browsing interaction is depicted in a first web browser window of the guest browser, by display of the replicated at least one action. (*Id.*, [0042]-[0044], [0065], [0066], [0131].)

Substitute Dependent Claim 36. The '743 Application discloses that non-shared web browsing interactions are depicted in a non-shared web browser window. (*Id.*, [0134]-[0136], [0139].)

D. Listing of Proposed Substitute Claims

Patent Owner submits substitute claims 19-36 as shown in Appendix A as required by 37 C.F.R. §42.121(b).

IV. Level of Ordinary Skill in the Art

In this motion, Patent Owner applies Petitioner's and the Board's definition of a POSITA.

V. The Scope and Content of the Prior Art

Patent Owner presumes that Petitioner set forth what Petitioner believed to

be the closest prior art in this preceding. None of that art describes all of the features recited in the proposed substitute claims, for at least the reason that none of that art discloses, alone or in combination, the language additionally added by the substitute independent claims 19 or 28, as discussed in greater detail in Section VII below. Moreover, Patent Owner does not bear the burden of persuasion or production regarding the patentability of substitute claims. *Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1296 (Fed. Cir. 2017).

VI. Construction of the '591 Patent Claim Terms

Under 37 C.F.R. §42.100, claim terms should be given “their ordinary and customary meaning” as would be understood by a POSITA in question at the time of the invention, in light of the claim language, the specification and the prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005). In this motion, Patent Owner applies the ordinary and customary meaning of the claim terms of the proposed substitute claims.

VII. The Substitute Claims are Patentable Over the Art

While Patent Owner does not bear the burden of persuasion or production regarding the patentability of substitute claims, it nevertheless sets forth reasons why the prior art does not teach or suggest at least the subject matter added by amendment. *Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1296 (Fed. Cir. 2017.)

A. The Substitute Independent Claims 19 and 28 are

Patentable Over the Instituted Art in This Preceding

1. Substitute Claims 19 and 28 are Patentable Over the Asserted Grounds

Substitute claim 19 recites “receiving first data from the synchronization server, where the first data relates to a website being accessed in real-time by a host device” and “wherein the first data comprises a URL of the website, cookie information associated with the website and the host device, and information related to a shared user input web browsing interaction that includes second data indicating at least one direct host device interaction with content of the website performed by the host device.” *See* Appendix A (Substitute Independent Claim 19.)

These limitations set up several premises – 1) that the data received by the guest from the synchronization server relates to a website being accessed by a host; and 2) that the data includes at least “second data indicating at least one direct host device interaction with content of the website performed by the host device.”

Substitute claim 19 further specifies how data is used by the guest device, namely, “operating a browser... based on at least **the second data**... to independently replicate the host device interaction with the content of the website.” Again, the “second data” is the data, received from the server, that “indicat[es] at least one direct host device interaction with content of the website performed by

the host.”

This independent replication performed by the guest device, after the data is received and without assistance of the host or server, is performed by the guest device based on the data received from the server and constitutes a replication of the host device interaction with the content.

Substitute claim 28 is similar to claim 19 with the primary distinction being that the second data indicates at least one action performed by the host device “on content of the website displayed in a host browser,” and the independent replication “replicates the at least one action in the guest browser on content obtained by the guest device.”

a. Ground 1 – Lebrun and Wang

Petitioner relies on Wang for the invitation aspects of claims 1 and 10, and Lebrun is the exclusive reference cited by Petitioner for teaching the aspects of claims 1 and 10 narrowed by the substitute amendments. Explanations are thus addressed to Lebrun’s teachings, but as Patent Owner notes in closing, the addition of Wang does not change the outcome of any argument, nor was it ever alleged to be applicable in these regards in the original Petition.

Lebrun describes the creation of a group browsing session with group-surfing server 140, which comes from “a first web client 110” (Ex. 1005, 32:9) and which can include “a request to create... a group-surfing session” (*Id.*, 32:9-

11.) For any pages 153 that are to be displayed at web clients 110, Lebrun teaches that “the group-surfing server contacts the web site 130 having that next page 153 and directs that target web site 130 to deliver that next page...” (*Id.*, 35:6-8.) When there are cookies to be used, the group surfing server has the web site 130 “... deliver the next page 153 to the group-surfing server itself.” (*Id.*, 35:10-11.)

Lebrun contrasts this with “alternative” situations “where no cookies or other data related to identity are involved,” wherein “each web client 110 can receive the page directly from the web site 130.” (*Id.*, 35:17-18.)

In the latter case, in conjunction with embodiments where the client “receives the page directly from the website,” Lebrun provides two functional options – either the group-surfing server retrieves the page itself and sends it to the clients 110, or the group-surfing server uses a multi-cast protocol to multicast the next page to clients 110. (*Id.*, 35:19-24.)

Thus, in total, Lebrun effectively discusses two paradigms – the group surfing server retrieving the website and delivering the site to the clients 110 (seemingly whether or not there are cookies – *see, Id.*, 35:10-15 compared to the alleged alternative embodiment discussed at *Id.*, 35:19-21); or the group-surfing server using a multi-cast protocol. Even if one contends that there is a third paradigm wherein the client 110 receives the page directly from the website in a third manner different from those discussed, there is plainly nothing that indicates

a client device 110 receives, from the group-surfing server, “second data indicating at least one direct host device interaction with content of the website performed by the host device” or “second data indicating at least one action performed by the host device on content of the website displayed in a host browser,” as claimed in substitute claims 19 and 28, respectively.

Further, there is nothing in Lebrun that teaches or suggests “operating a browser by the guest device based on at least the second data received from the synchronization server” to either: “independently replicate the host device interaction with the content of the website, obtained by the guest device from a website server based on at least the first data” (substitute claim 19); or “independently replicate the at least one action in the guest browser on content obtained by the guest device from a website server based on at least the first data.” (substitute claim 28.)

Lebrun never receives the second data claimed in substitute claims 19 or 28 (as noted above), and the absence of such data would render the claimed replication impossible. Further, Lebrun never teaches a guest device independently replicating the claimed host interaction with or host action on content of an obtained website.

Wang relates to passing snapshots of websites from a first client to a host to a second client (Ex. 1006, [0041], [0043]). The browser of the second client in

Wang merely displays the snapshot. (*Id.*, [0062].) Moreover, Wang does not specify that anything beyond a snapshot of the current webpage of a user who “has the initiative” is displayed – *i.e.*, this appears to be simple sharing of a snapshot of whatever page the user is viewing, and there is no provision for capturing or sharing interactions. (*see, e.g., Id.*, [0077].) Thus, Wang does not cure any of the noted deficiencies of Lebrun and the substitute claims 19 and 28 are patentable over the combination of Lebrun and Wang for at least the reasons presented above.

b. Ground 2 – Prajapat and Wang

As with Ground 1, Petitioner relies solely on the primary reference, this time Prajapat, with respect to the limitations altered by the proposed amendment. Again, PO’s arguments are thus addressed to Prajapat, but also again, as PO notes in closing, the addition of Wang does not change the outcome of any argument.

Prajapat discloses two discrete embodiments, one described with respect to Figs. 1/2 – a complex sharing system wherein intermediary servers 14a and 14b coordinate with each other and a content server to obtain, templatize, modify and deliver web content to respective browsers 12a and 12b – and another described with respect to Fig. 3 – a system for “simple sharing” which lacks virtually all of the intermediary coordination and control provided by the servers 14a/14b of the Fig. 1/2 system. (Ex. 1007, [0019]-[0027], [0041]-[0043].)

In order to understand what is meant by “simple” with respect to the Fig. 3

embodiment (contrasted with the complex system of Figs. 1/2), it is useful to understand how both embodiments function differently. To facilitate more complex interactions, such as browser 12b viewing a webpage altered by browser 12a, Prajapat provides an embodiment explained in Fig. 1/2. (*Id.*, [0012].) In this example, two Web Media servers 14a, 14b reside between respective browsers 12a, 12b and the content server 18. (*Id.*, Fig. 1, [0012].)

Servers 14a/14b provide a very specific role in the shared browsing experience of Figs. 1/2, the role of transforming content, received from the content server 18, into “information that may be required to properly render the web page on [the] browser.” (*Id.*, [0017]) *I.e.*, the servers 14a and 14b both handle requests to the website (*Id.*, [0016]) and work in concert to attempt to unify an experience between 12a and 12b in some manner. (*Id.*, [0020], [0025], [0026].)

In furtherance of such unification, the media server 14a “may transform the intermediate form of the retrieved web page into a renderable form that may be rendered by browser 12a.” (*Id.*, [0025], [0038].) That intermediate form is then also sent from server 14a to server 14b. *Id.*, ([0026].) Media server 14b then transforms that intermediate form into a renderable form for browser 14b. (*Id.*, [0026].) These renderable forms may be different, because of, *inter alia*, “... differences between browsers 12a and 12b.” (*Id.*)

To reconcile possible inconsistencies resulting from uses of different

devices, different software, different platforms, etc., Prajapat uses the intermediary servers 14a/14b to maintain a consistency-of-experience via their cooperative communication to unify an experience and enact transforms of content as required for the respective browsers 12a and 12b. Thus, in the Fig. 1/2 embodiment, the browsers 12a and 12b never, for example, obtain the content “from a website server” as required by claims 19 and 28.

The complex system of Fig. 1/2 can be contrasted with the Fig. 3 system, a system that is described as providing “**simple** web page sharing.” (*Id.*, [0041].) It is worth noting that Prajapat did not merely describe this as “an alternative embodiment for sharing,” but rather an embodiment that was operable to provide “simple” sharing. (*Id.*)

Web servers 14a/14b still play a role in the simple sharing, but that role is greatly reduced. That reduction, in turn, removes capabilities of the coordinated system, which, is one of the reasons why the sharing capability has been reduced to and described as “simple” sharing. For example, the only role imparted to web servers 14a/14b in the Fig. 3 embodiment that Prajapat expressly equates to the role those servers play in Fig. 1/2 is the role of server 14a finding server 14b for purposes of establishing a communication session. (*Id.*, [0041].)

Following session establishment, browser 12a requests content from server 18. (*Id.*, [0043].) Once the webpage has been returned to browser 12a, browser 12a

communicates the URL to web media server 14a. (*Id.*) Server 14a's only other role (beyond session-establishment) is to convey the URL to server 14b, which then conveys the URL to browser 12b. (*Id.*) Browser 12b then uses the URL to request "the web page that browser 12a requested." (*Id.*)

Since browser 12b is ultimately only concerned with "requesting the webpage that 12a requested," and has no other taught or suggested coordinated control beyond obtainment, browser 12b can obtain the webpage using the same information browser 12a used to request the webpage – i.e., the URL sent by 12a once 12a had received the page. While [0043] does discuss transmission of "other suitable information regarding the requested webpage," this "other information" certainly would not include any "interaction with the website performed by the host device" because the shared information was merely shared for the purpose of obtaining the webpage – not following an interaction with or action on its content.

That is, the claimed interaction represented by the second data is with or on content of an obtained webpage, which would be something the host does *after* the host obtains the page represented by the URL — and there is no teaching or suggestion in Prajapat that such post-obtainment actions would be shared between browsers 12a and 12b. Nor is there any teaching or suggestion of how browser 12b could or would "replicate" such interactions with or interactions on the content.

Even were Petitioner to contend that the Fig. 1/2 embodiment provided such

capability on some level, that would be in the context of a complete system where the intermediary servers perform a number of roles, including any alleged passed-information handling and replication — there is no teaching that the browser 12b in Fig. 3 would inherit what would essentially be an alleged capability of server 14b from Fig. 1/2, nor any reason for browser 12b to function in such a manner, as its sole job and function (related to sharing), in the Fig. 3 system, is to obtain a copy of the same webpage browser 12a is viewing.

Thus, as noted previously, the embodiments of Figs. 1/2 lack at least a teaching of the website obtaining content from a website server, and as noted immediately above, the embodiment of Fig. 3 lacks at least the claimed receipt of and utilization of second data, at the guest device, to replicate host interactions with or actions on the content. Combining aspects of the two embodiments would be nothing more than an attempt at hindsight reconstruction, and would require modifications to the system of Fig. 3 that are neither taught nor suggested, nor which have any assurances of functional compatibility. Nor would such a combination be even reasonable, in light of the fact that Prajapat already provides a system, in Figs. 1/2, that is already suitable for more complex sharing.

It would be irrational to simply ignore the working Fig. 1/2 system while at the same time stripping it for parts in an attempt to build a Frankenstein's monster of a system using Fig. 3 (solely to meet the claims). Nor are there any assurances

that such a system would even function, since the servers 14a/14b, which Prajapat teaches to play a significant role in more complex sharing, would still be utilized for nothing more than mere data-passing, and not, for example, in the “transformation” role they serve when complex sharing is implicated.

Additionally, if all the capability of servers 14a and 14b from Fig. 1/2 could simply be passed to browsers 12a and 12b, then the system of Figs. 1/2 would be completely superfluous, which obviously is not what Prajapat contemplates.

Wang, again never presented by Petitioner as being relevant to this sort of teaching in any event, does not cure the deficiencies of Prajapat, as it too is silent on the claimed sharing of such information and replication as noted herein on pages 17 and 18, *supra*.

For at least these reasons, substitute claims 19 and 28 are patentable over the combination of Prajapat and Wang.

VIII. Conclusion

For each original claim the Board finds unpatentable, Patent Owner requests that the Board grant this motion to amend as to the corresponding substitute claim.

Respectfully submitted,

Dated: September 27, 2023

/ Bernard P. Tomsa /
Bernard P. Tomsa (Reg. No. 60,121)
Andrew B. Turner (Reg. No. 63,121)

Brooks Kushman P.C.

1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner

Certificate of Service

The undersigned hereby certifies that the foregoing **CONTINGENT MOTION TO AMEND**, is being served on counsel for via electronic mail on September 27th, 2023, in its entirety on the following counsel of record:

LEAD COUNSEL	BACK-UP COUNSEL
Jennifer R. Bush jbush-ptab@fenwick.com	Michael J. Sacksteder msacksteder@fenwick.com Gregory R. Miller gmiller@fenwick.com Daniel Ledesma dledesma@fenwick.com Christopher L. Larson clarson@fenwick.com

Respectfully submitted,

Dated: September 27, 2023

/ Bernard P. Tomsa /
Bernard P. Tomsa (Reg. No. 60,121)
Andrew B. Turner (Reg. No. 63,121)

Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner

Certificate of Compliance Pursuant to 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24. The paper contains 24 pages, excluding the parts of the paper exempted by §42.24(a).

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

Respectfully submitted,

Dated: September 27, 2023

/ Bernard P. Tomsa /
Bernard P. Tomsa (Reg. No. 60,121)
Andrew B. Turner (Reg. No. 63,121)

Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner

Appendix A - Substitute Claims

19. (Proposed substitute for claim 1, if claim 1 found unpatentable) A method for a guest device performing a synchronized browsing session administered by a synchronization server, comprising:

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

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;

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

receiving first data from the synchronization server, where the first data relates to a website being accessed in real-time by a host device; and

wherein the first data comprises a URL of the website, ~~and~~ cookie information associated with the website and the host device, and information related to a shared user input web browsing interaction that includes second data indicating at least one direct host device interaction with content of the website performed by the host device; ~~and~~

operating a browser by the guest device based on at least the second data received from the synchronization server to independently replicate the host device interaction with the content of the website, obtained by the guest device from a website server based on at least the first data.

20. (Proposed substitute for claim 2, if claim 1 found unpatentable)

The method of ~~claim 1~~[claim 19](#), further comprising receiving an invitation to join the synchronized browsing session.

21. (Proposed substitute for claim 3, if claim 1 found unpatentable)

The method of ~~claim 2~~[claim 20](#), wherein the invitation comprises the hyperlink associated with the synchronized browsing session.

22. (Proposed substitute for claim 4, if claim 1 found unpatentable)

The method of [claim 20](#)~~claim 2~~, wherein the invitation further comprises a session identifier.

23. (Proposed substitute for claim 5, if claim 1 found unpatentable)

The method of [claim 20](#)~~claim 2~~, wherein the invitation is received via: a social network communication; a news feed; an email message; an instant message communication; a micro-blogging communication; a text message communication; or other communication medium.

24. (Proposed substitute for claim 6, if claim 1 found unpatentable)

The method of [claim 19](#)~~claim 1~~, wherein information related to the shared user input web browsing interaction comprises: form data; java script data; or other web browsing interaction data.

25. (Proposed substitute for claim 7, if claim 1 found unpatentable)

The method of [claim 19](#)~~claim 1~~, wherein the shared user input web browsing interaction [replicated by the guest device](#) is depicted in a first web browser window [of the browser](#).

26. (Proposed substitute for claim 8, if claim 1 found unpatentable)

The method of ~~claim 7~~[claim 25](#), wherein non-shared web browsing interactions are depicted in a second web browser window.

27. (Proposed substitute for claim 9, if claim 1 found unpatentable)

The method of [claim 19](#)~~claim 1~~, wherein the shared user input web browser [inter](#)action further comprises a log-in into a restricted-access webpage.

28. (Proposed substitute for claim 10, if claim 10 found unpatentable)

An apparatus for a guest device performing a synchronized browsing session administered by a synchronization server, comprising:

a network interface adapted to communicate with the synchronization server; and

a processor adapted to:

detect an activation of a hyperlink associated with the synchronized browsing session by a guest device;

send a request to join the synchronized browsing session to the synchronization server via the network interface, in response to the activation of the hyperlink;

receive from the synchronization server a notification that guest device has joined the synchronized browsing session;

~~receiving~~receive first data from the synchronization server, wherein the first data relates to a website being accessed in real-time by a host device, and wherein the first data comprises a URL of the website, ~~and~~ cookie information associated with the website and the host device and information related to and derived from a shared user input web browsing interaction, the information including second data indicating at least one action performed by the host device on content of the website displayed in a host browser of the host device; and

operate a guest browser by the guest device based at least in part on the second data received from the synchronization server to independently replicate the at least one action in the guest browser on content obtained by the guest device from a website server based on at least the first data.

29. (Proposed substitute for claim 11, if claim 10 found unpatentable)

The apparatus of ~~claim 10~~claim 28, further comprising a user interface adapted to initiate the processor to send the request in response to a user input.

30. (Proposed substitute for claim 12, if claim 10 found unpatentable)

The apparatus of claim 29~~claim 11~~, wherein the user input comprises activation of

the hyperlink for initializing sending of the request to join the synchronized browsing session.

31. (Proposed substitute for claim 13, if claim 10 found unpatentable)

The apparatus of [claim 28](#)~~claim 10~~, further comprising a memory adapted to store one or more software modules for controlling the processor.

32. (Proposed substitute for claim 14, if claim 10 found unpatentable)

The apparatus of [claim 28](#)~~claim 10~~, wherein the hyperlink is received from a host device via: a social network communication; a news feed; an email message; an instant message communication; a micro-blogging communication; a text message communication; or other communication medium.

33. (Proposed substitute for claim 15, if claim 10 found unpatentable)

The apparatus of [claim 28](#)~~claim 10~~, further comprising a user interface adapted to depict the shared user input web browsing interactions, [including at least the replicated at least one action](#), in a shared web browsing window [of the guest browser](#).

34. (Proposed substitute for claim 16, if claim 10 found unpatentable)

The apparatus of [claim 28](#)~~claim 10~~, wherein information related to the shared user input web browsing interaction comprises: form data; java script data; or other web browsing interaction data.

35. (Proposed substitute for claim 17, if claim 10 found unpatentable)

The apparatus of [claim 28](#)~~claim 10~~, wherein the shared user input web browsing interaction is depicted in a first web browser window [of the guest browser, by display of the replicated at least one action](#).

36. (Proposed substitute for claim 18, if claim 10 found unpatentable)

The apparatus of [claim 35](#)~~claim 17~~, wherein non-shared web browsing interactions are depicted in a non-shared web browser window.