

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.
Petitioner

v.

SAMESURF, INC.
Patent Owner

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

PATENT OWNER'S RESPONSE

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P.O. Box 1450
Alexandria, VA 22313-1450

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2001	Saif Askar's Declaration
2002	Saif Askar's Biography
2003	Declaration of David S. Howell
2004	Declaration of Stacy Friedman
2005	Order Denying Defendant's Motion to Dismiss Pursuant to 35 U.S.C. § 101

I. INTRODUCTION

Samesurf, Inc.¹ (“Patent Owner” or “Samesurf”) submits this Patent Owner Response (“POR”) responding to the Petition for *Inter Partes* Review (“Petition”) of claims 1-18 of U.S. Patent No. 8,527,591 (the “’591 Patent”) filed by Intuit, Inc. (“Petitioner” or “Intuit”) and the Board’s subsequent decision to institute *Inter Partes* Review (“Institution Decision”) on the ’591 Patent.

The inventions described and claimed in the ’591 Patent relate in general to a method and apparatus that utilizes a “synchronization server” to establish and facilitate, with a “guest device,” a “synchronized browsing session,” that supports a real-time, sharable web browsing experience, among multiple users, each of whom utilizes a device to simultaneously and directly interact with a website server on the Internet.

Pursuant to the claims of the ’591 Patent, the “synchronized browsing sessions” of the inventions are achieved by transmitting certain data from the “synchronization server” to the “guest device,” which ultimately uses the received data to operate a browser. These transmissions of communication messages to the “guest device” from the “synchronization server,” and from the “guest device” to the website server, do not materially impose more bandwidth or processing power

¹ <https://www.samesurf.com/>

requirements than simply browsing the internet using standard, conventional methods. As a result, the “host device” and the “guest device” are synchronously sharing the same web browsing experiences and in real time, *i.e.*, the devices are participating in a “synchronized browsing session.”

The claimed sequence of steps and components is ***not*** taught or suggested by any of the three references relied on by Petitioner. Significant differences exist between the roles, components, and data flows of the '591 Patent's claimed “synchronized browsing session” as compared to those of Lebrun's “Group Surfing Server,” Prajapat's “Web Media Server,” and Wang's “Server Apparatus” in supporting “webpage sharing sessions.” Each of these references, which are the subject of the Board's Institution Decision, ***lacks*** multiple required elements of the independent claims of the '591 Patent, including both the “URL of the website and cookie information associated with the website and the host device” that is received by the “guest device” from the “synchronization server” and that is used to operate a browser on the “guest device.”

In Lebrun (Ex. 1005), the controlling web client (*i.e.* host device) selects a webpage out of a progression of pages for the group-surfing session. Lebrun's group-surfing server acts as a resource-intensive “middleman” server that is in

communication with the web clients and with the website server.² In this “page sharing” process, the “middleman” server contacts the website server containing the webpage and then directs the website server to deliver the webpage *to the group-surfing server itself*. The group-surfing server then re-sends that webpage to all of the web clients (host and guest devices). In an alternative embodiment “where no ‘cookies’ or other data related to identify are involved,” the group-surfing server may contact the website server containing the webpage and direct the web server to deliver the webpage to the web clients (host and guest devices), such that each web client receives the webpage directly from the web server.

In all of the Lebrun embodiments, it is the “middleman” group-surfing server that requests the subject webpages. Importantly, Lebrun’s group-surfing session involves a controlling web client (i.e. host device) selecting a *progression of pages* for the group-surfing session. Once those pages are selected, the group-surfing server *itself* accesses the web server and either (1) directs the web server to deliver the webpage to the group-surfing server so it can resend the page to the participating web clients (host and guest devices), or (2) in cases where there are no cookies or other data related to identity, the group-surfing server directs the web server to send

² As used herein, the term “middleman” server refers to a server that: (1) receives website pages from a website server; and (2) transmits the received website pages to the web clients participating in the session.

the page directly to the participating web clients (host and guest devices). Unlike the '591 Patent where the host and guest devices both are able to access the website server, Lebrun's group-surfing session necessarily requires that the group-surfing server access the website server *on behalf* of the participating web clients (host and guest devices).

Prajapat (Ex. 1007) encompasses two separately described systems for webpage sharing: (1) a peer-to-peer dynamic webpage sharing system (Ex. 1007 ¶¶12-40); and (2) a peer-to-peer simple webpage sharing system (Ex. 1007 ¶¶40-43).

In Prajapat's "peer-to-peer dynamic webpage sharing system," the web media server (which also acts as a "middleman" server) receives requests from browser 12a (*i.e.*, the host device) for one or more webpages. (Ex. 1007 ¶22). The web media server then locates the appropriate web content server that includes the webpage that is requested by the host device. (*Id.* ¶23). The web content server returns the requested webpage to web media server 14a and web media server 14a transforms the returned webpage into some "intermediate form" that may be rendered by the host device. (*Id.* ¶24-25). This "intermediate form" is communicated between web media server 14a and 14b. (*Id.* ¶26). Web media server 14b then transforms the "intermediate form" of the webpage into a form that can be rendered by browser 12b (*i.e.* the guest device).

Like Lebrun, Prajapat's configuration is distinctly different from the '591 Patent, in which the host and guest devices are both able to independently access the website server based on the received URL and cookie information. Prajapat's peer-to-peer dynamic page sharing session necessarily requires that the web media server (analogized in the Petition as the "synchronization server") access the website server *on behalf of* the host and guest devices. Moreover, while the '591 Patent's synchronization server merely forwards the webpage interaction information from the host device to the guest device (Ex. 1001, Fig. 5(d)), Prajapat's peer-to-peer dynamic page implements web media servers associated with the host and guest devices. The web media server associated with the host device transforms the requested webpage into an intermediate form and also transfers the intermediate form of the requested webpage to the web media server associated with the guest device. The web media servers (the purported "synchronization server") then transform the intermediate form of the requested webpage into a form that can be rendered by their respective devices.

Prajapat's "peer-to-peer simple system" is limited to merely allowing the guest device to request the same webpage as the host device from the web content server (*id.* ¶43). In short, the peer-to-peer simple system lacks the ability (1) to display webpages at substantially the same time and (2) to view altered webpages - which together define the "dynamic page sharing" version of Prajapat. (Compare

Ex. 1007, ¶12 to *id.* ¶43). As such, Prajapat’s peer-to-peer simple webpage sharing system merely acts as a general mechanism for sharing URLs that does not even provide a “synchronized browsing session,” as required by the ’591 Patent’s claims.

Thus, both Lebrun and Prajapat disclose an “middleman” server that: (1) receives the webpage requests from the participants; (2) transmits those requests to the webpage server *on behalf of* the participants; (3) receives the webpages from the website servers; and (4) transmits the received webpages to the devices participating in the browsing session. Unlike the inventions of the ’591 Patent, the “middleman” server in page sharing approaches like Lebrun and Prajapat transmits the webpage itself (in the appropriate format that corresponds to each participant’s device). Like screen sharing, page sharing also suffers from the significant shortcoming of “requir[ing] high levels of bandwidth and computer processing power” at the central “middleman” server. (Ex. 1001, 2:23-27).

Both Lebrun and Prajapat are therefore unrelated and antithetical to the “synchronized browsing sessions” that utilize the “synchronization server” and the “web browsing interaction data” contemplated by the ’591 Patent. Lebrun and Prajapat are therefore materially, and therefore patentably, different than the inventions claimed in the ’591 Patent.

Accordingly, Petitioner has not met its burden of proving that claims 1-18 of the ’591 Patent are obvious pursuant to 35 U.S.C. § 103. Confirmation of the validity

of claims 1-18 over Lebrun (Ex. 1005), Wang (Ex. 1006), and Prajapat (Ex. 1007) is therefore warranted.

II. THE INVENTIONS CLAIMED IN SAMESURF’S U.S. PATENT NO. 8,527,591

Inventor K. David Pirnazar filed the application that issued as the ’591 Patent on May 20, 2010.

A. The State of the Art in 2010 at the Time of the Claimed Inventions

Prior to May 2010, known techniques for sharing webpages included: (1) sharing the HTML for a webpage (“page sharing”); and (2) sharing visual images of a webpage that a browser has already rendered (“screen sharing”). (Ex. 2004, Declaration of Stacy Friedman (“Friedman Decl.”), ¶¶36-42). There also existed other general and well-known techniques for sharing information (*e.g.*, bookmarking, bookmark sharing, URL sharing, etc.). *Id.*

“Screen sharing” involves the continuous capture and broadcast of rapidly taken screenshots of the host screen for real time reception, processing, and viewing by the following participants. (Ex. 2004, ¶¶41-42). For use cases where multiple remote users wish to view the same web pages in real time, they can utilize screen sharing to broadcast the host’s entire screen or individual browser windows therein to display the subject web pages for the following participants. The predominant shortcomings of screen sharing include: (1) high resource utilization levels for CPU,

GPU, and bandwidth; (2) noticeable levels of latency and screen pixelation; and (3) the prospective disclosure of sensitive screen elements like credit card numbers or open windows on the screen broadcaster side during shared sessions. (*Id.*, ¶42).

“Web page sharing” or “page sharing” is an entirely different approach to sharing webpages that does not involve screen broadcasting at all. This legacy approach is described throughout Petitioner’s purported prior art references in, for example, Prajapat’s “Peer-to-Peer Dynamic *Web Page Sharing*.”³ In page sharing (or webpage sharing), the participants request and receive web pages from a “middleman” server that acts as an active “go-between” between the participants and the web content server. (Ex. 2004, ¶40). Page sharing enables session participants to view *a copy* of what the “middleman” server downloaded, as opposed to simultaneously sharing the same web experience in real time. (*Id.*)

The predominant issues with page sharing included: (1) high resource utilization levels; (2) significant latency; (3) the inability to support joint real time interaction with online content; and (4) disjointed webpage sharing sessions that are the byproduct of a process that enables all users to freely interact with different components and portions of the shared webpage on their own accord. (*See* Friedman Decl., ¶40).

³ Emphasis added throughout Response unless otherwise noted.

B. The Inventions Claimed in the '591 Patent Solved the High Bandwidth and Computer Processing Power Problems Caused by the Use of the “Middleman” Server in Page Sharing

The '591 Patent specification explains how, in 2010, there was a need for a device that allows all users in an Internet browsing session to interact with and share the same “Internet browsing experiences” in real time and in a simultaneous fashion from different devices. (Ex. 1001, 2:40-45; Ex. 2004, ¶¶31-35). As described above, the then-current art lacked “technology that would simultaneously connect two or more users in a medium that would allow all of them to both interact with one another and with the content itself in real time and in a synchronized or shared fashion.” (Ex. 1001, 1:67-2:4). In other words, there was no “fully interactive modality that enables a group of users to view and interact with internet content and media simultaneously with others on different computers or other connected devices with all of those users empowered to interact with that content in real-time on a simultaneous basis.” (Ex. 1001, 2:7-13).

The '591 Patent specification explains that, although some current methods in the prior art “such as ‘desktop or screen sharing’” allow users to view the same content, those methods suffer from the issue that they “do not enable all users in a session to click, input, and log into those experiences in a simultaneous or nearly simultaneous manner.” (Ex. 1001, 2:21-23). Desktop and screen sharing “work by broadcasting continuous screenshots of the host screen in large files or packets and

require high levels of bandwidth and computer processing power” (Ex. 1001, 2:24-27). Therefore, screen sharing and other alternatives like the page sharing constructs referenced in the purported prior art references were “inadequate for enabling larger groups to all view and fully interact with that interactive content in a simultaneous manner.” (Ex. 1001, 2:29-31).

To overcome these issues, the ’591 Patent teaches the use of the “synchronization server,” which establishes and facilitates a “synchronized browsing session” between a “host device” and a “guest device” in a manner that significantly improves the bandwidth and processing issues of resource intensive processes like screen sharing and page sharing. This occurs, in part, because the “synchronization server” of the present invention “does not materially impose more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods.” (Ex. 1001, 5:22-25).

Thus, the “synchronization server” of the claimed inventions sidesteps the need for a “middleman” server that serves as the centerpiece of the resource-intensive, page sharing process. The “synchronization server” of the ’591 Patent, among other things, eliminates the high bandwidth and computer power processing requirements necessary when utilizing a “middleman” server. Unlike the “middleman” server, which must itself request and receive webpages from the webpage server and then serve those webpages to the various guest devices, the

“synchronization server” simply coordinates the sharing of communication messages (e.g., “web browsing interaction data,” URL data, and/or cookie information associated with the host device) among the host device and the guest devices involved in a synchronized browsing session. Further, where the participants were joining page sharing sessions from a diverse range of devices and/or browsers, the “middleman” server was often required to serve multiple versions of the same webpage to each of the “guest devices,” thereby exasperating the bandwidth, resource utilization, and latency issues that characterize page sharing.

In the '591 Patent, unlike the references relied on by Petitioners, webpage server requests are made from the host and guest devices themselves and webpages are served to the host device and the guest devices by the webpage server, not from the “synchronization server,” thereby eliminating the need for a “middleman” server.

Thus, as compared to the “middleman” servers of the Lebrun, Prajapat, and Wang references, the “synchronization server” of the '591 Patent provides the numerous benefits described herein.

C. The Independent Claims of the '591 Patent Are Directed to “Synchronized Browsing Sessions” Wherein the “Guest Device” Receives “URL of the website and cookie information associated with the website and the host device” from a “Synchronization Server” and Uses the Data to Operate a Browser

There are two independent claims in the '591 Patent, both of which are directed to a “synchronized browsing session” using a “synchronization server,”

“URL of the website and cookie information associated with the website and the host device,” and a “guest device” that uses the data to operate a browser.

Claim 1 is a method claim performed by a “guest device” for performing a “synchronized browsing session” administered by a “synchronization server.” Claim 1 is reproduced below, with its important terms emphasized:

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

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

[1.b] 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;

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

[1.d] 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

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

Claim 10 is similar to claim 1 and claims a “apparatus for a guest device” performing a “synchronized browsing session” administered by a “synchronization server.” The arguments presented regarding independent claim 1 also apply to independent claim 10.

D. The “Synchronization Server” and How it Uses “a URL of the Website and Cookie Information Associated with the Website and the Host Device” to Administer a “Synchronized Browsing Session” Among a “Host Device” and a “Guest Device”

According to exemplary claim 1, the “guest device” joins a “synchronized browsing session” that is administered by a “synchronization server” pursuant to the steps described therein. The following is a description of the components and steps of exemplary claim 1 that are relevant to Patent Owner’s Response.

1. The “Host Device” and the “Guest Device”

Claim 1 of the ’591 Patent requires a “guest device” (“A method performed by a *guest device* for joining a synchronized browsing session. . .”) and a “host device” (“receiving . . . a session invitation . . . associated with a *host device* . . .”).

As shown in Figure 1(a), the “host device” and the “guest device” are independent of one another, of the synchronization server, and of the website server. Both are also connected to the Internet:

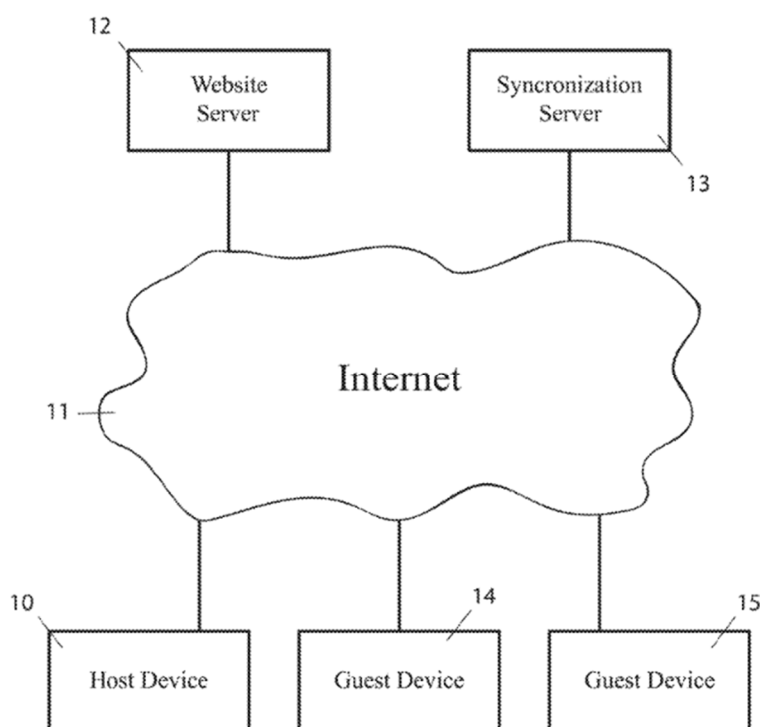


FIG. 1(a)

The “host device” “may initialize and conduct a synchronized browsing session with guest device 14 via synchronization server 13.” (Ex. 1001, 5:48-50). The “host device” is an “electronic device with a visual user interface and a network connection such that a user may access and view a third party website such as one provided by website server 12 over internet 11.” (Ex. 1001, 6:9-11).

“Guest devices” “may join a synchronized browsing session to view internet browsing conducted by host device 10.” (Ex. 1001, 6:12-15). Like the “host device,” a “guest device” is an “electronic device with a visual user interface and a network

connection such that a user may access and view an internet website such as one provided by website server 12 over internet 11.” (Ex. 1001, 6:18-21).

Pursuant to the claims, the “guest device” receives “a URL of the website and cookie information associated with the website and the host device” from the synchronization server and operates a browser based on the data. (Ex. 1001, Claim 1).

2. The “Synchronized Browsing Session”

Claim 1 of the ’591 Patent further describes a “synchronized browsing session”: “[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.”

Pursuant to the specification, a “synchronized browsing session” is a browsing session in which a “host device” shares its internet browsing interactions with a website with a “guest device,” via the “synchronization server,” in a simultaneous real-time fashion in order to support a multitude of synchronized use cases:

Specifically, there is a need for a device that allows all *users in a session to interact with, discuss, log in separately or together, and share internet browsing in real time for online activities* such as shopping together, booking travel together, watching or listening to media together, and browsing the internet together in a *simultaneous fashion* from different devices and/or locations.

* * *

The present invention allows two or more persons browsing the internet to share their internet browsing experience and have all users *simultaneously browse and fully interact* with web sites, games, virtual worlds, or other online applications in real time. *To share their internet browsing experience*, the present invention utilizes the passing of certain data such as *URL information*, form data, scripts (including java script), *cookies*, or other types of data information between browser clients. In a *synchronized browsing session*, two or more people may read the same article, watch the same video, or shop for the same item automatically, without the hassle of coordinating user input.

(Ex. 1001, 2:40-46, 5:11-21; *see also* '591 Patent, 5:26-56).

3. The “Synchronization Server”

Claim 1 requires a “synchronization server.” The “synchronization server” “is designed to establish and facilitate a synchronized browsing session between host device 10 and guest device 14.” (Ex. 1001, 9:24-26).

The manner in which the “synchronization server” establishes and facilitates a “synchronized browsing session” among a “host device” and a “guest device” is set forth in the steps of exemplary claim 1, as described below.

4. The Method by Which the “Synchronization Server” Establishes and Facilitates a “Synchronized Browsing Session” Among a “Host Device” and a “Guest Device”

In its five steps, exemplary claim 1 describes how the “synchronization server” establishes and facilitates a “synchronized browsing session” with a “guest device.” These five steps are described in further detail below.

a. Receiving and Activating the “Session Invitation”

The first three steps of exemplary claim 1 relate to: (1) detecting activation of a hyperlink associated with the synchronized browsing session by a guest device; (2) sending a request to join a “synchronized browsing session;” and (3) receiving from the “synchronization server” a notification that the guest device has joined the “synchronized browsing session.” (See Claim 1 at ’591 Patent; *see also* ’591 Patent, 10:2-14:45; FIGS. 2(a) – 4(e)).

b. Receiving “a URL of the Website and Cookie Information Associated with the Website and the Host Device” from the “Synchronization Server”

The fourth step of exemplary claim 1 requires that the “guest device” perform the following step: “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.*” (Ex. 1001, Claim 1).

According to the specification, “FIG. 5(a) illustrates a block diagram of exemplary data communication transferred between components of the present invention during a synchronized browsing session. FIG. 5(a) shows host device 10, website server 12, synchronization server 13 and guest device 14 transmitting data communication for a synchronized browsing session.” (Ex. 1001, 15:42-47; Ex. 2004, ¶32). FIG. 5(a) is reproduced below:

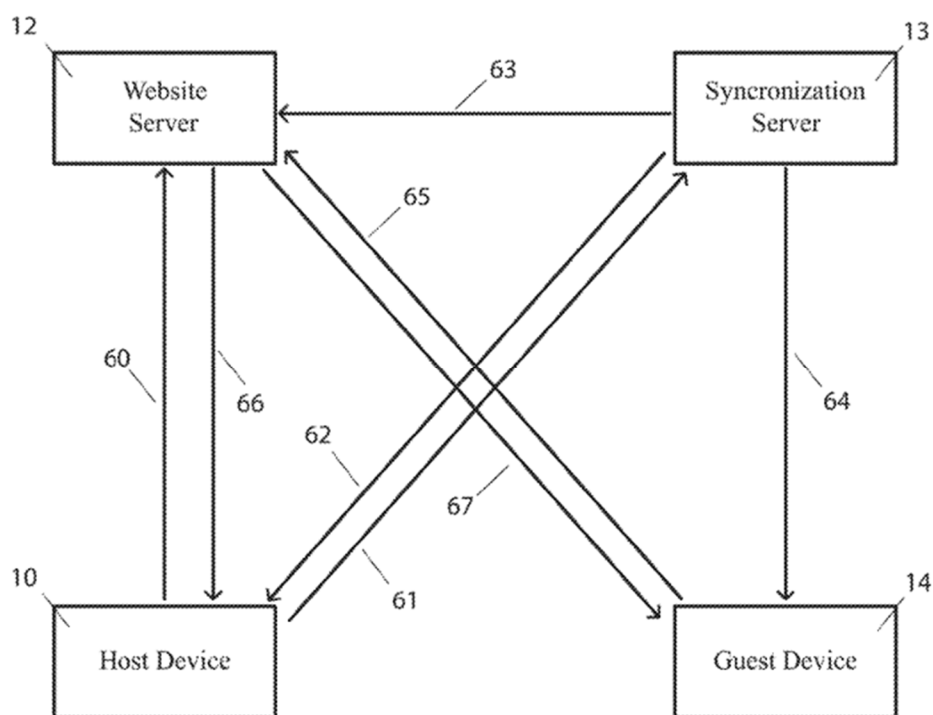
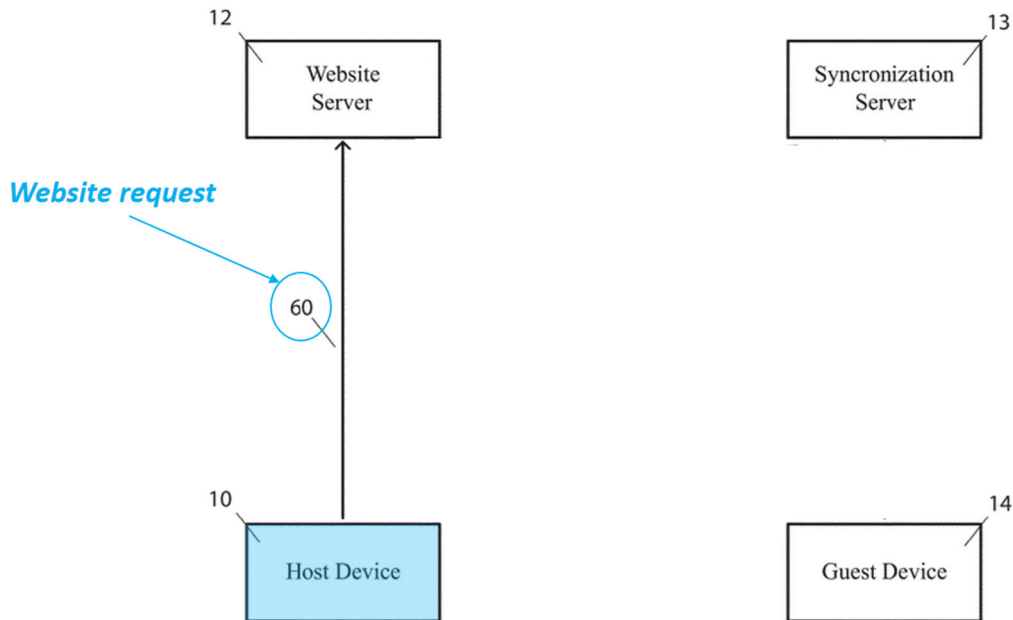


FIG. 5(a)

The specification describes the “data communication transferred between components of the present invention during a synchronized browsing session” as follows:

First, “[d]uring a synchronized browsing session, host device 10 may transmit website request 60 to website server 12. In an exemplary embodiment, website request 60 is a data communication message sent to request webpage content at a designated location, such as website server 12.” (Ex. 1001, at 15:50-55).

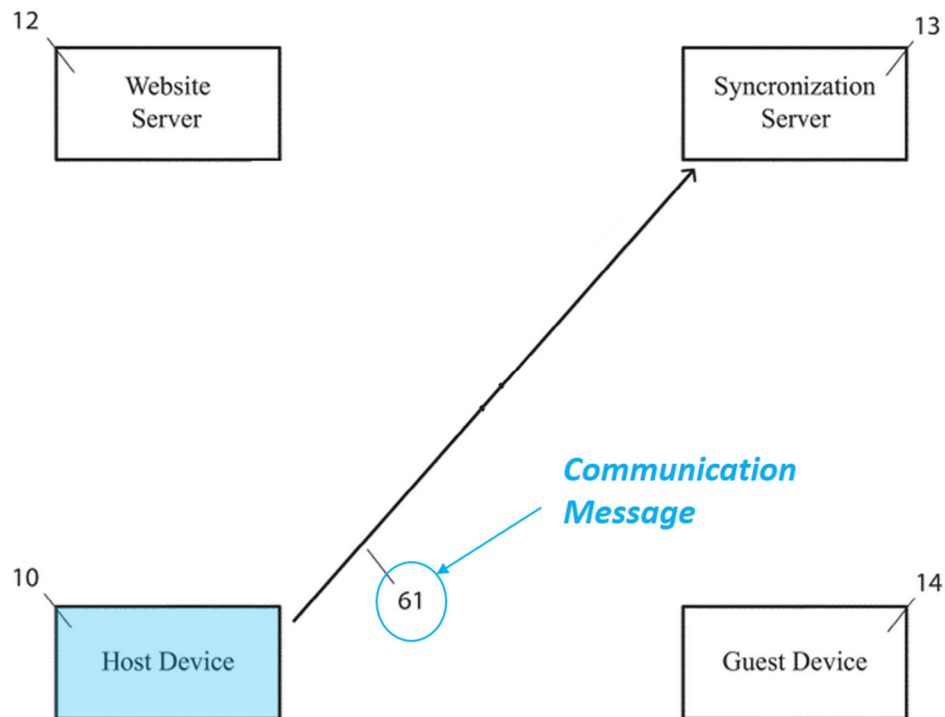
FIG. 5(a) is shown modified below in sequence to point out the sequence of steps. The first-step modified and annotated version of FIG. 5(a) below shows the “website request 60” from the “host device 10” to the “website server 12”:



Modified and Annotated FIG. 5(a)

Second, “[d]uring an exemplary synchronized browsing session, after host device 10 transmits website request 60 to website server 12, host device 10 transmits communication message 61 to synchronization server 13. Communication message 61 may comprise the URL address of website server 12, cookie information, form data, java script, or other user inputted information, or attached files.” (Ex. 1001, 16:1-7; *see also* 6:22-25; 16:63-66; 17:48-52).

The second-step modified and annotated version of FIG. 5(a) below shows the “communication message 61” sent from the “host device 10” to the “synchronization server 13”:

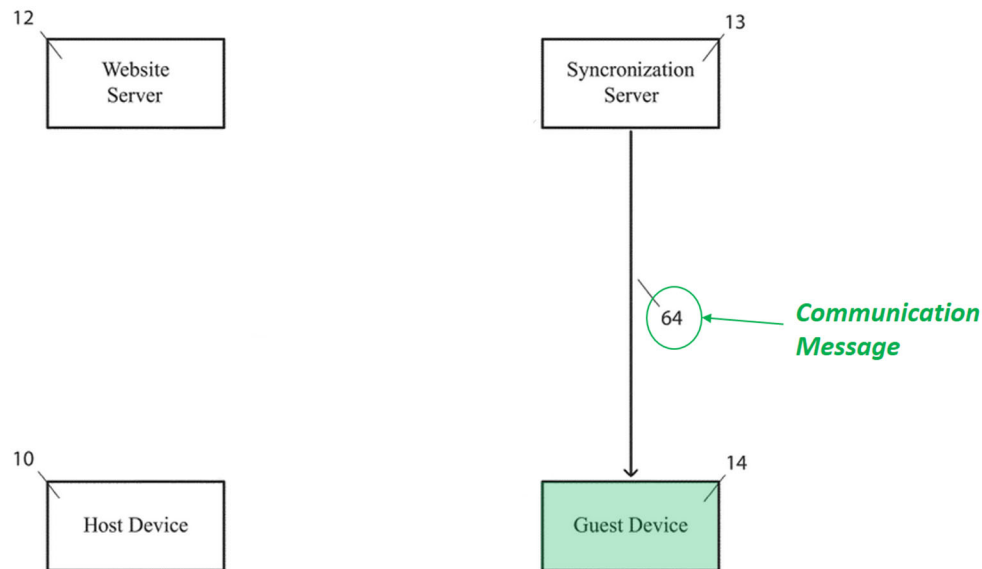


Modified and Annotated FIG. 5(a)

Third, “[a]fter host device 10 transmits communication message 61 to synchronization server 13, synchronization server 13 forwards communication message 64 to guest devices.” (Ex. 1001, 16:51-53). “Communication message 64 is designed to be forwarded by synchronization server 13 to guests in the synchronized browsing session, such as guest 14, to perform the synchronized browsing session. In exemplary embodiments, communication message 64 may be

a duplicate of website request 60, or may comprise the *URL address of website server 12*. In other embodiments, communication message 64 may also include other transmitted data from website request 60, such as *cookie information*, form data, java script, or other user inputted information, or attached files.” (Ex. 1001, 16:31-40; *see also* 6:40-41; 19:5-9; FIG. 5(d), step 601).

The next-step modified and annotated version of FIG. 5(a) below shows the “communication message 64” sent from “synchronization server 13” to the “guest device 14:”



Modified and Annotated FIG. 5(a)

The specification elsewhere refers to the message that is sent from the “synchronization server” to the guest device (*e.g.*, communication message 64) as “webpage interactions:” “A following device, such as guest device 14, may be

defined as any device that receives relayed webpage interactions from synchronization server 13. In exemplary embodiments, relayed webpage interactions may include data such as URL, form data, scripts, advertising codes, or other information.” (Ex. 1001, at 6:64-7:2; *see also* ’591 Patent, 6:51-63; 7:56-60).

Claim [1.d] specifically recites that the guest device receives “data [that] comprises a URL of the website and cookie information associated with the website and the host device.” (Ex. 1001, claim [1.d]).

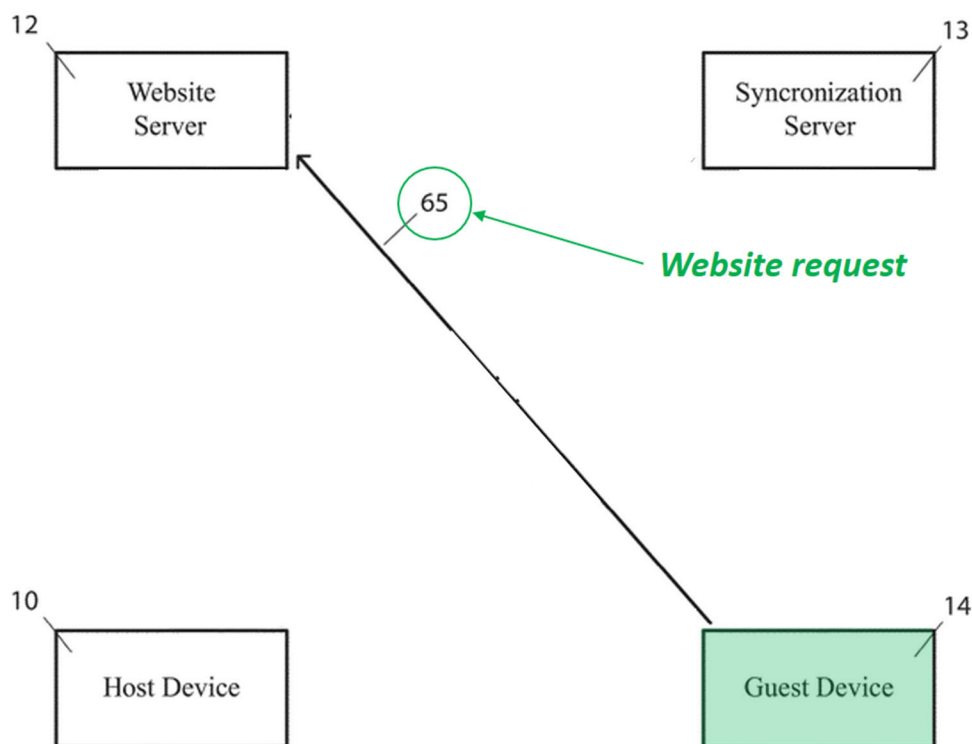
c. Operating a Browser Based on the “Data Received from the Synchronization Server”

The fifth and final step of exemplary claim 1 requires that the “guest device” operate a browser based on the “data comprises a URL of the website and cookie information associated with the website and the host device” received from the “synchronization server” to operate a browser: “[1.e] operating a browser by the guest device *based on the data received* from the synchronization server.” (Ex. 1001, claim [1.e]).

According to the specification, the “communication message 64” (*i.e.*, the “web browsing interaction data”), sent from the synchronization server to the guest device in the prior step, “may be used by guest device 14 to formulate website request 65 to be sent from guest device 14 to website server 12. Website request 65 is a data communication message transmitted by guest device 14 to website server

12. In exemplary embodiments, website request 65 should be similar or identical to website request 60.” (Ex. 1001, 16:56-62). “Guest device 14 formulates website request 65 by processing communication message 64. In exemplary embodiments, information in communication message 64, **including URL**, form data, **cookies** or other data, is transmitted in website request 65.” (Ex. 1001, 19:12-16).

The next-step modified and annotated version of FIG. 5(a) below shows the “website request 65” sent from the “guest device 14” to the “website server 12:”

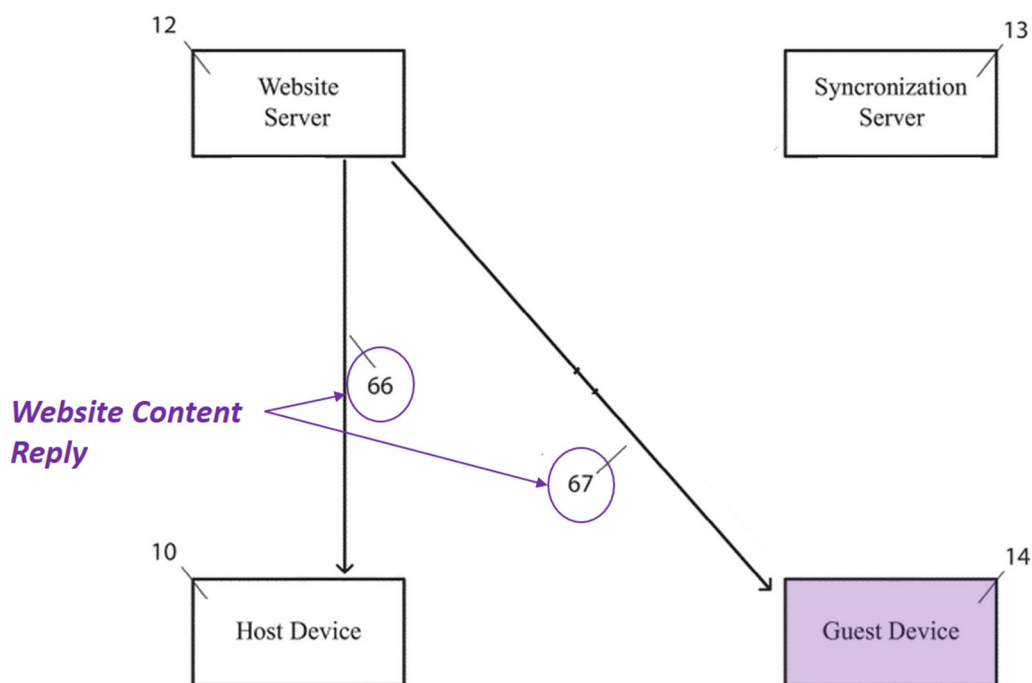


Modified and Annotated FIG. 5(a)

When the “website request 65” sent from the “guest device” to the “website server” is identical to the “website request 60” sent from the host device to the

“website server,” as described in the specification, the “website content reply 67, the data content sent by website server 12 in response to website request 65, is similar or identical to website content reply 66. As such, in a synchronized browsing session between host device 10 and guest device 14, audio and visual output of shared browsing window 17 on guest device 14 is similar or identical to that on host device 10 unless personalization settings, such as private cookie information, are triggered for one of the devices on the site.” (Ex. 1001, 17:27-36).

The next-step modified and annotated version of FIG. 5(a) below shows the “website content reply 66” sent from the “website server 12” to the “host device 10” and shows the “website content reply 67” sent from the “website server 12” to the guest device 20:



Modified and Annotated FIG. 5(a)

When “website request 65 is similar or identical to website request 60, audio and visual output of content reply 67 is similar or identical to audio and visual output of content reply 66 unless one or more of the users has already registered with that site and certain personalization settings are triggered for that user at that site in which case the rendered site would also include those settings within the context of the requested site.” (Ex. 1001, 19:25-32). In other words, when “website request 60” from the “host device 10” and “website request 65” from the “guest device” are identical, “website content reply 66” will be similar or identical to “website content reply 67,” and therefore the user of the “host device” and the user of the “guest device” will be engaging in a “synchronized browsing session,” per the claims of the ’591 Patent.

Thus, importantly, the website content is sent from the website server to both the “host device” and to the “guest device.” The website content is not transmitted to the “synchronization server.” Similarly, the “synchronization server” does not transmit website content to the “guest device.” This configuration results in significant bandwidth and computer processing power savings at the “synchronization server,” since the “synchronization server” does not receive or transmit and website content.

The distinct system architecture and method utilizing webpage interaction information including a URL of the website and cookie information associated with the website and the host device described and claimed in the '591 Patent results in significant improvements over the cited prior art. These improvements include, for example, enabling “all users in a session to click, input, and log into fully interactive experiences in a simultaneous or nearly simultaneous manner” within a framework that requires less bandwidth and processing power than prior art systems while significantly enhancing the security and protection of private information during shared sessions. Ex. 1001, 2:7-36.

Thus, the '591 Patent is distinguished from the cited prior art references that merely teach the highly inefficient process of requiring a middleman server to transmit recompiled webpages to one or more guest devices.

5. The Southern District of California Court Found that the Claims of the '591 Patent are Directed to Patentable Subject Matter Pursuant to 35 U.S.C. § 101

On March 29, 2022, Samesurf, owner of the '591 Patent and related patents, filed a complaint in the District Court for the Southern District of California for, among other things, infringement by Intuit of the '591 Patent and related patents.

On May 23, 2022, Intuit filed a motion to dismiss Samesurf's complaint on the grounds that the claims of the '591 Patent and related patents are directed to an

abstract idea and are therefore invalid for failing to claim patentable subject matter pursuant to 35 U.S.C. § 101.

On January 10, 2023, the Southern District of California court issued an Order *denying* Intuit’s motion to dismiss. (“Order”; Ex. 2005). In its Order, the district court held that, because the ’591 Patent teaches that the “synchronization server” included in the claims overcame the bandwidth and processing issues of the prior art, the claims are directed to a specific solution to a problem arising in the realm of computer networks: “the asserted claims offer a specific technologic solution/mechanism—utilization of a synchronization server—to address the identified problems with the prior art.” (Ex. 2005, 16). The court thus held that the claims are not directed to an abstract idea. (*Id.*).

III. LEVEL OF ORDINARY SKILL IN THE ART

In its Institution Decision, the Board found 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.” (Institution Decision, at 11).

Patent Owner accepts the Board’s level of ordinary skill in the art.

IV. THE CITED REFERENCES DO NOT RENDER ANY CHALLENGED CLAIM UNPATENTABLE

As shown below, each of the three references relied upon by the Board in its Institution Decision—Lebrun (Ex. 1005), Wang (Ex. 1006), and Prajapat (Ex. 1007)—fail to teach or suggest at least: (1) step [1.d] of exemplary claim 1: “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 (2) step [1.e] of exemplary claim 1: “operating a browser by the guest device based on the data received from the synchronization server. . .” As such, there is **no** combination of these three references that discloses each of the limitations of claims 1-18 of the '591 Patent.

Accordingly, Petitioner has not proven that claims 1-18 of the '591 Patent are obvious over any combination of these references pursuant to 35 U.S.C. § 103. In an *inter partes* review, the petitioner must show with particularity why each challenged claim is unpatentable. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016); 37 C.F.R. § 42.104(b) (2020). The burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

The Board should therefore affirm the validity of claims 1-18 over these references.

A. Ground 1: Intuit Fails to Demonstrate that All Claims Are Rendered Obvious by Lebrun in Combination with Wang

The Board found that there is 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 over Lebrun (Int'l Publ. No. WO 00/48110 (Ex. 1005)) in view of Wang (U.S. Patent Pub. No. 2005/0033656 (Ex. 1006)).

Lebrun (Ex. 1005) sought to “provide an improved technique for group access to web sites,” “in which 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.” (Ex. 1005, 4:6-9). Lebrun discloses multiple different embodiments to achieve its desired goal. “In a first embodiment, a selected one of the related users controls the web surfing process,” while “[i]n a second embodiment, a selected plurality of the users collectively control the web surfing process.” (Ex. 1005, 4:9-11).

Lebrun’s system operates in the following manner:

After creating a “group-surfing session” that includes identifying all of the web clients that are participating in the group-surfing session, “a progression of pages” is determined for the group-surfing session. When there is a single

controlling web client, then that single controlling web client determines the progression of pages 153 to be viewed during the group surfing session. (Ex. 1005, 34:15-17). If there are multiple controlling web clients, the “controlling web clients act in concert to determine the progression of pages 153 viewed during the group-surfing session.” (Ex. 1005, 34:19-22). A variety of techniques are described to how the progression of pages is moderated. (Ex. 1005, 34:24-35:2). After this, the group-surfing server determines which webpage to deliver to the participating web clients. (Ex. 1005, 35:5-9).

Having received from the controlling web client the identity of the webpage to be delivered to the participating web clients, “[t]he group-surfing server 140 contacts the web site 130 having that next page 153, and directs that target web site 130 to deliver that next page 153 so it can be presented [by the group-surfing server 140] to those web clients 110 participating in the session” (Ex. 1005, 35:6-8). In other words, “[t]he group-surfing server 140 (1) contacts the web site 130 having that next page 153 after adding proper cookie or other identity information, and directs that target web site 130 to deliver that next page 153 to the group-surfing server 140 itself.” (Ex. 1005, 45:25-28; Ex. 2004, ¶¶43-45).

In some circumstances, where the web clients participating in the “group-surfing session” comprise different types of devices such as smartphones or “Palm

Pilots,” the “group-serving server” must make multiple requests for the web site to send different versions of the same webpage. (Ex. 1005, 36:11-17).

Since it is the “group-surfing server” that requests and receives the webpage from the website, it is also the “group-surfing server”—*not the web clients*—that receives “a ‘cookie’ or other data relating to identity or session from the web site 130.” (Ex. 1005, 46:7-8). The “group-surfing server” “records the ‘cookie’ in a cookie database relatively local to the group-surfing server 140 and session.” (Ex. 1005, 46:8-9). “Each time the group-surfing 140 requests a page from the web site 130, the group-surfing server 140 also sends any relevant ‘cookies’ that were received from the web site 130.” (Ex. 1005, 46:10-11).

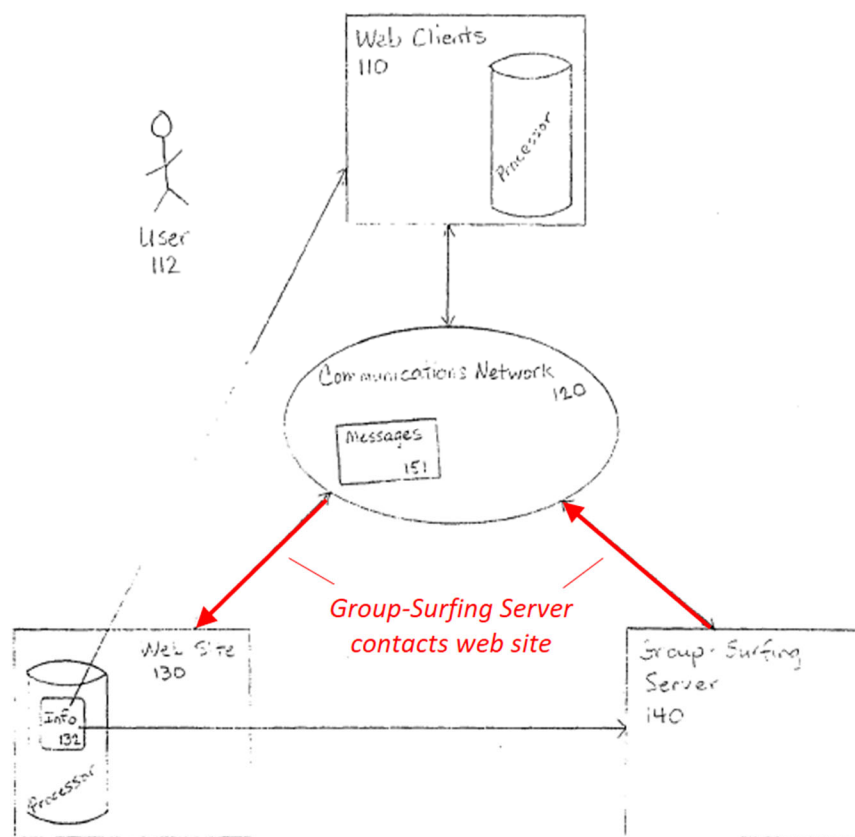
After receiving the different versions of the webpage from the website server, “the group-surfing server 140 then re-sends that page 153 to those web clients 110 participating in the session.” (Ex. 1005, 45:28-29).

Lebrun teaches that load can be reduced on the “group-surfing server” by using a “program fragment” loaded at each web client. (Ex. 1005, 36:21-22). “The program fragment can include one or more of, or any combination of, a Java applet, a section of JavaScript code, a web browser plug-in, an active-X element, or another technique for interfacing with the web client 25 110 and affecting its operation with the web site 130 and the group-surfing server 140.” (Ex. 1005, 36:22-25). Lebrun lists five functions of the program fragment. (Ex. 1005, 36:31-37:17).

Further, where the webpages include “multimedia (such as embedded sound, images, or program fragments),” Lebrun teaches that, “in order to reduce load on the group-serving server 140, the group-serving server 140 sends only the page 153 itself without any multimedia elements (such as embedded sound, images, or program fragments). Each participating web client 110 requests those multimedia elements directly from the web site 130.” (Ex. 1050, 45:31-46:2).

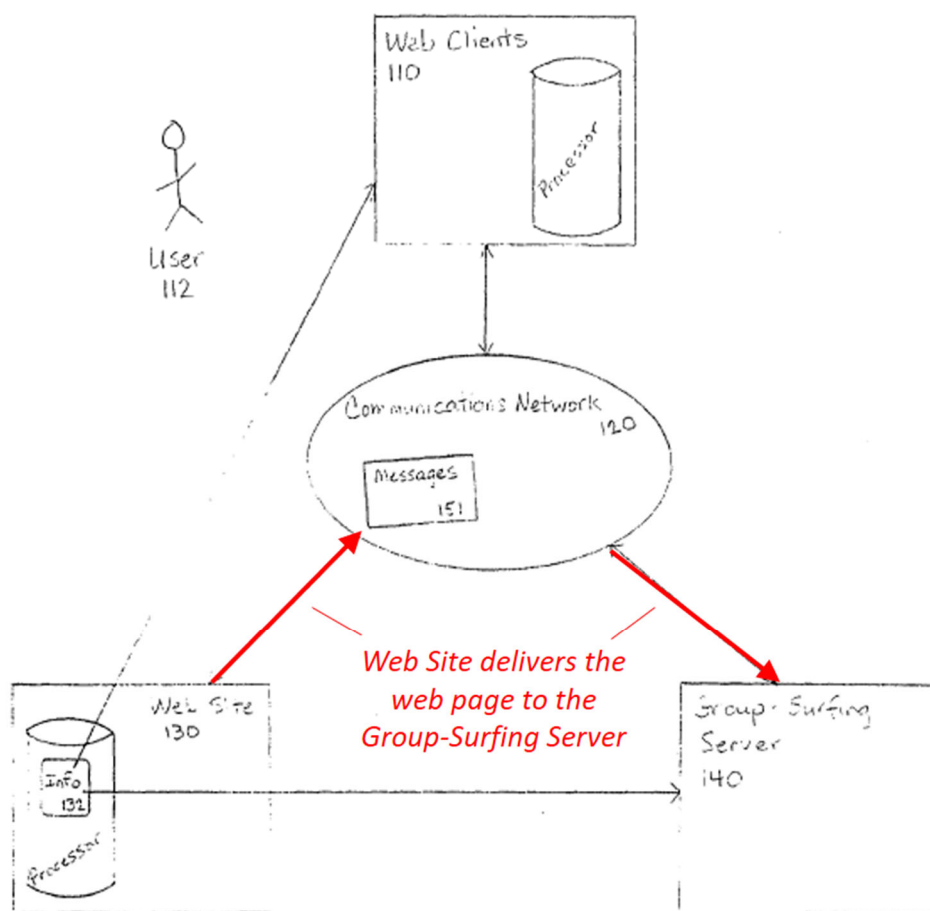
The three primary steps taught by Lebrun to conduct the group-surfing session—(1) the “group-surfing server” contacting the website server; (2) the website server delivering the webpage to the “group-surfing server”; and (3) the “group-surfing server” re-sending the full webpage to the web clients (where no multimedia is embedded) or, where multimedia is embedded, re-sending a partial webpage wherein each web client separately requests the embedded multimedia elements directly from the web site—are depicted below using Figure 3 of Lebrun.

First, the modified and annotated version of Figure 3 of Lebrun below shows the group-surfing server contacting, via the added red arrows, the web site having the next webpage and directing the web site to deliver the webpage to the group-serving server:



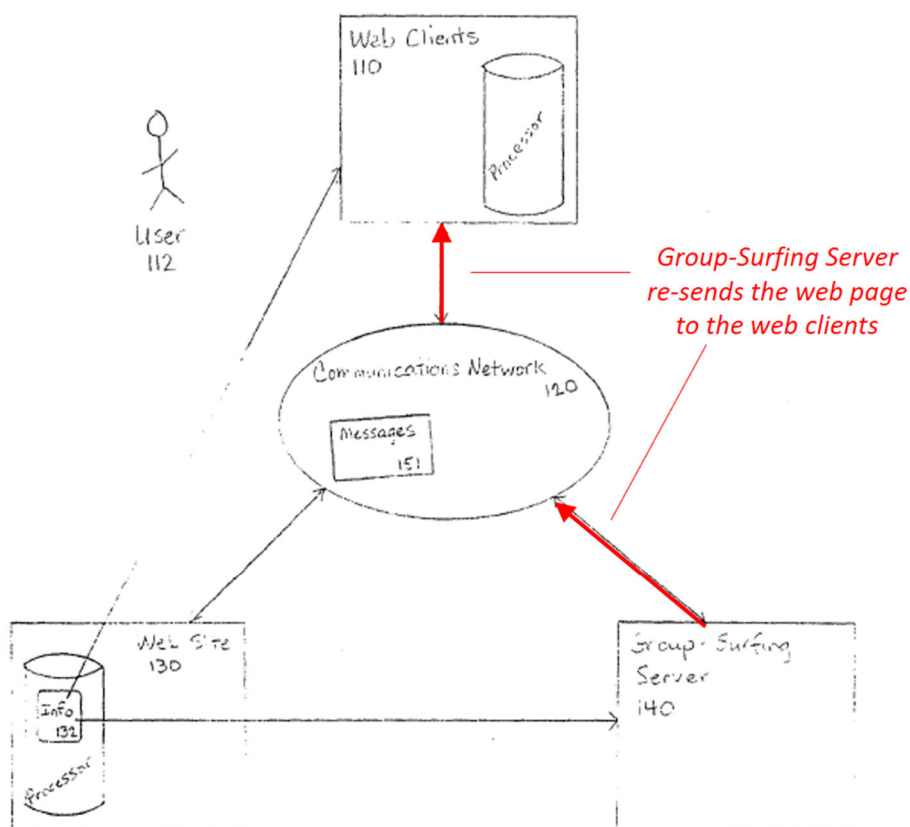
Modified and Annotated Figure 3 of Lebrun

Second, the modified and annotated version of Figure 3 of Lebrun below shows the web site delivering the webpage to the group-serving server:



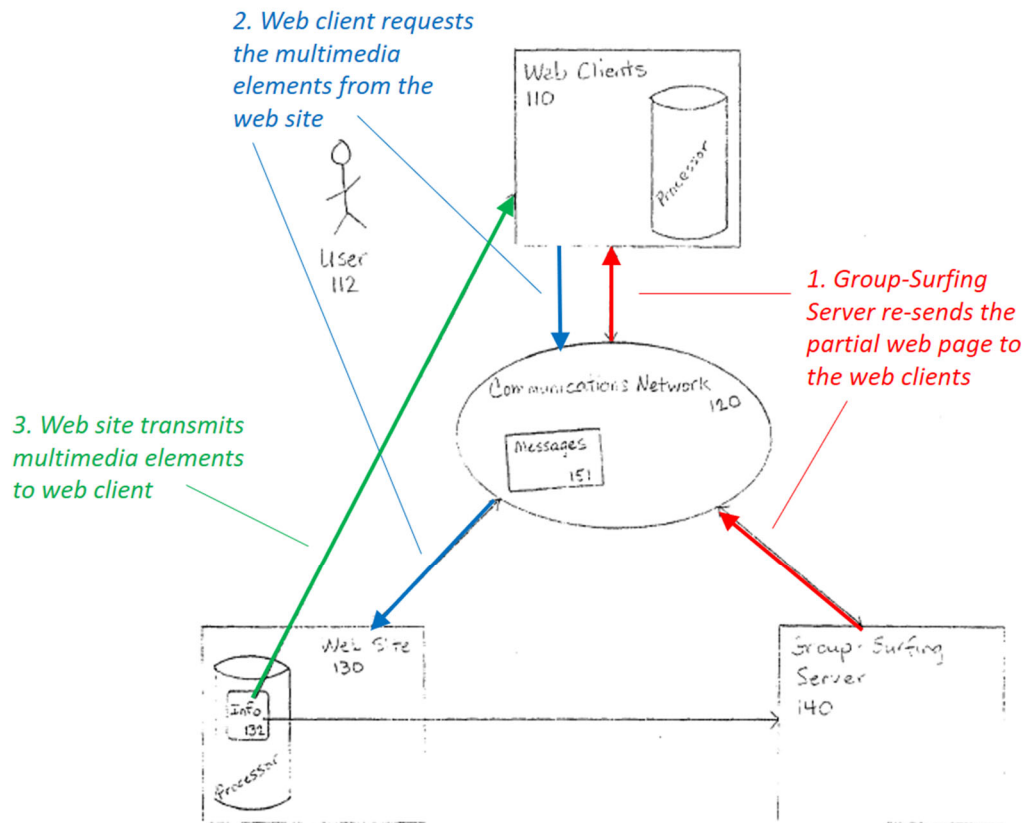
Modified and Annotated Figure 3 of Lebrun

Third, in instances where the webpage contains no embedded multimedia elements, the modified and annotated version of Figure 3 of Lebrun below shows the group-surfing server 140 re-sending the full webpage 153 to those web clients 110 participating in the session:



Modified and Annotated Figure 3 of Lebrun

Fourth, in instances where the webpage contains embedded multimedia elements, the modified and annotated version of Figure 3 of Lebrun below shows the group-surfing server 140 re-sending a partial webpage 153 to those web clients 110 participating in the session and the web clients requesting the multimedia elements directly from the web site:



Modified and Annotated Figure 3 of Lebrun

The Board found Petitioner's showing regarding Lebrun to be sufficient for institution. (Institution Decision, at 28). As explained in detail below, Petitioner has not met its burden of proving that Lebrun meets steps [1.d] and [1.e] of exemplary claim 1 of the '591 Patent.

1. Lebrun and Wang fail to disclose “receiving data from the synchronization server, ... wherein the data comprises ... cookie information associated with the website and the host device.” [1.d]

Lebrun and Wang fail to disclose “receiving data from the synchronization server, ... wherein the data comprises ... cookie information associated with the website and the host device,” element [1.d].

Patent owner discusses element [1.d] in two parts, in this section and the next. For the first part of step [1.d], the Petition must show that Lebrun’s guest “web clients 110” receive the claimed “cookie information associated with the website and the host device” from Lebrun’s “group-surfing server 140,” which Petitioner incorrectly analogizes to the claimed synchronization server.

There are several reasons why Lebrun does not disclose [1.d]. As explained above, in the preferred embodiment of Lebrun (Ex. 1005, 35:10-15) that was cited to in the Petition, the group-surfing server 140 contacts the website, receives the webpage, and then re-sends the webpage to the web clients 110. (Pet. 28). Lebrun’s architecture requires that the group-surfing server 140 manages all of the cookies used in the group surfing session: “This allows usage of a single set of ‘cookies,’ or other data related to identity or session, sent by the web site 130 and stored by the group-surfing server 140.” (Ex. 1005, 35:11-15; Ex. 2004, ¶¶61-65).

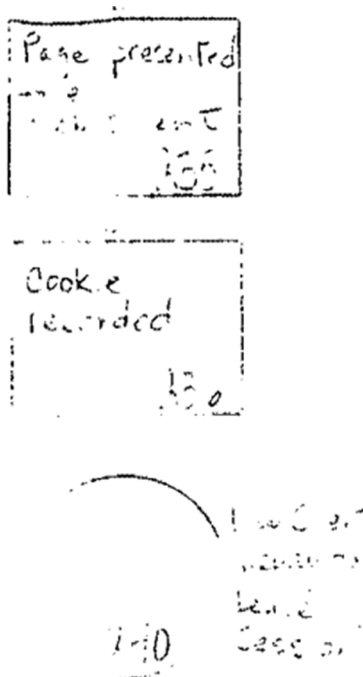
First, in Lebrun, the cookie information is associated with the group-surfing server 140, rather than the host device, as required by the claim. (Ex. 2004, ¶¶58-60). As described above, and in Lebrun, the controlling web clients moderate the progression of pages in Lebrun, but they do not actually retrieve the webpages from the website. Instead, the group surfing server performs this task for the group surfing session in the primary embodiment. (*Id.*) It retrieves the cookie information from the website based on its own browsing. (*Id.*) Lebrun explains “if the group-surfing server 140 receives a ‘cookie’ or other data relating to identity or session from the web site 130, the group-surfing server 140 records the ‘cookie’ in a cookie database relatively local to the group-surfing server 140 and session.” (Ex. 1005, 46:7-11; Ex. 2004, ¶60).

In other words, in the group surfing-session described by Lebrun, the cookie is only associated with the group-surfing server—it is not associated with any other device, including the host device (which, according to the Petition is the “controlling web client”). (Ex. 2004, ¶¶59-63).

A cookie is a small piece of data created by a web server of a web site that is stored on a user’s device while that user is browsing a web site. (Ex. 2004, ¶¶37). The web server can use that cookie to maintain a session while the device is browsing through the website. (*Id.*) Cookies can also be used to track a device while browsing. (*Id.*)

Importantly, because the group-surfing server does the browsing in a group surfing session, all of the cookies that will be collected by the group-surfing server during the browsing session will only be associated with the group-surfing server. (Ex. 2004, ¶¶59-63). Neither the Petition nor Dr. Lieberman provide any technical description of how a cookie received by one device (the group-surfing server) while browsing to a website would be associated with *another* device (the host device) that plays no part in the browsing action. (Ex. 2004, ¶¶59-63). The cookie information is thus not “associated with ... the host device,” as required in [1.d]. (Ex. 2004, ¶63).

Second, the preferred embodiment of Lebrun does not actually disclose in this embodiment that the single set of cookies is received *by each of the participating web clients*. (Ex. 2004, ¶¶61-65). Instead, Lebrun discloses at step 236 in method 200 that 1) “the group-surfing server receives a ‘cookie’ or other data relating to identity or session from the web site 130” and 2) “the group-surfing server 140 records the ‘cookie’ in a cookie database relatively local to the group-surfing server 140 and session.” (Ex. 1005, 46:7-9.) Figure 4, which “shows a process flow diagram for a method of using a system for group access to web sites,” identifies only that the “cookie [is] recorded” at step 236, indicating that the cookie is recorded in the cookie database. (Ex. 1005, Figure 4.)



(Ex. 1005, Fig. 4 (image quality from original)).

Other disclosures related to the database indicate that it is used to store “information regarding a set of individual users,” including “for each individual user, a set of web sites 130 having personalized information for that individual user, and a corresponding set of access information for each individual user for each web site 130, such as a login name and a password.” (Ex. 1005, 56:9-13.) Accordingly, when Lebrun discusses the “usage of a single set of ‘cookies’” “sent by the web site 130 and stored by the group-surfing server 140 at each participating web client 110” (Ex. 1005, 35:11-15), the act of storing “at each participating web client 110” indicates storing *in the database* for each entry associated with the participating web

client—not at the web client itself. (Ex. 2004, ¶¶60-65). There is no other disclosure that indicates sending the single set of cookies to the web clients.

Third, the first cited alternative embodiment of Lebrun does not disclose receiving “cookie information associated with the website and the host device” because it explicitly excludes use cases in which cookies are involved. (Ex. 2004, ¶¶58-65). The Petition also cites this embodiment, in which the group-surfing server directs the website to directly send the webpage to the participating web clients 110. (Pet. 30, citing embodiment at Lebrun 35:17-28). However, Lebrun explicitly explains that this embodiment is only to be used *without* cookies: “In alternative embodiments, where *no ‘cookies’ or other data related to identity are involved*, each web client 110 can receive the next page 153 directly from the web site 130.” (Ex. 1005, 35:17-19). In agreeing with the Patent Owner’s preliminary response, the Institution Decision stated “this alternative embodiment indicates that it is intended for situations where no cookies or other data related to identity are involved,” and that “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].” (Institution Decision, 24).

Fourth, the second alternative embodiment of Lebrun also does not disclose receiving “cookie information associated with the website and the host device” because Lebrun indicates that “*only* a list of pointers” is passed. (Ex. 1005, 43:13-

22; hereinafter, the “only a list of pointers” embodiment; Ex. 2004, ¶¶66, 69-73). The Petition cites to this second alternative embodiment of Lebrun for element [1.d]. (Pet. 30, citing embodiment at Lebrun, 43:13-22).

In the preliminary response, Patent Owner argued that the second cited alternative embodiment did not disclose passing cookie information because it was effectively the same embodiment as the first cited alternative embodiment. (Preliminary Response at 40-41). In the Institution Decision, the Board disagreed, stating that the second cited alternative embodiment was not related to the “no cookies” alternative embodiment, and thus the restriction for the “no cookie” alternative embodiment would not apply to the second alternative embodiment. (Institution Decision 25). However, the Institution Decision failed to realize that the second cited alternative embodiment indicates that the web client receives “*only* a list of pointers (such as URLs) to those pages presented during the group-surfing session.” (Lebrun 43:13-22; Ex. 2004, ¶¶66, 69-73). If “only a list of pointers” is sent to the web client, then there is no disclosure in this embodiment that cookies are also sent to the web client. (Ex. 2004, ¶¶66, 69-73).

Thus for each of the embodiments cited in the Petition, including the preferred embodiment, the “no cookies” embodiment, and the “only a list of pointers” embodiment, cookie information is **not** received by the guest devices. (Ex. 2004,

¶¶58-73). Further, the only cookies that are mentioned are used by the group-surfing server.

2. Lebrun and Wang fail to disclose “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....” [1.d]

For the second part of step [1.d], the Petition must show two subparts: (1) that the guest device receives a URL of the website, and (2) that the URL relates to a website being accessed in real-time by a host device.

The group browsing session performed in Lebrun is fundamentally different from the synchronized browsing session disclosed in the '591 Patent. In Lebrun, the group-surfing server generally performs the task of executing web browsing as it retrieves webpages that are then sent to each of the web clients (including the controlling web client) that are participants in the group-surfing session. (Ex. 2004, ¶¶58-60, 65-68).

In contrast, as it relates to the '591 Patent, the host device browses to a website to retrieve a webpage on its own. At the same time, the host device sends data to the synchronization server which, as recited in the '591 Patent's claims, includes “a URL of the website and cookie information *associated with the website and the host device.*” The synchronization server then sends this data to the guest device, and the guest device uses this information to operate the browser.

In other words, in Lebrun, the group-surfing server coordinates and actually performs all access to the website server in the preferred embodiment while the web clients do not directly access the website server themselves. (Ex. 2004, ¶¶58-60). In direct contrast, in the '591 Patent, the host device and guest device are able to independently access the website server based on the information received from the synchronization server.

Due to this fundamental difference, the webpage that is retrieved by Lebrun's group-surfing server and then sent to the web clients is a reformulation of a webpage—it is not a URL of the website from which the webpage was retrieved, as is required by the claims. (Ex. 2004, ¶¶58-60). In the preferred embodiment of Lebrun (Ex. 1005, 35:10-15), the group-surfing server 140 performs the content request, retrieval, and recompiling processes on behalf of the web clients 110. Lebrun's group-surfing server captures user input in a browsing session by the controlling web client, and then, instead of sending that data to the other web clients in the co-browsing session for independent processing, the group-surfing server serves as a middleman proxy that sends that user input information to the web site that is being browsed, and then passes the webpage to the other web clients 110 that are participating in the page sharing session. Lebrun states that “[i]n 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,*” and “then *re-sends that*

page 153 to those web clients 110 participating in the session.” (Ex. 1005, 35:10-12 (cited at Petition, 28); Ex. 2004, ¶44).

First, the Petition contends that “a [person of ordinary skill in the art] would have understood sharing webpages to include the URL of web site 130.” Pet. 30 (citing Ex. 1005, 43:13–22). In support, the Petition cites to element [1.a]. Pet. 30 (citing Section IX.A.1.b). As a base point, sharing a webpage via “page sharing” does not include sharing the URL of a website. (Ex. 2004, ¶40, 58-65). A key difference between the claimed synchronized browsing invention and the “page sharing” solution from Lebrun is that Lebrun’s group-surfing server acts as a middleman server that acts as an intermediary between the browsing devices (such as the host and guest browsing devices) and the relevant website servers. (Ex. 2004, ¶40, 58-65, 68). Lebrun fails to teach a guest device receiving a URL of the website and cookie information associated with the website and the host device. The Institution Decision credited this argument, stating “Patent Owner is correct that Lebrun’s primary embodiment” “differs from limitation [1d] because the data received from the synchronization server is the webpage itself, and does not include a URL of the website as limitation [1d] requires.” (Institution Decision 24).

Second, the Petition’s citation to element [1.a] fails to disclose receiving a URL as required per element [1.d]. The Petition cites to IX.A.1.b, which discusses a URL that is associated with Wang, regarding an “invitation acknowledgment,

myURL address” that Petitioner purports to be the “activation of a hyperlink” used to join a synchronized browsing session. (Pet. 23). This invitation acknowledgment does not relate to element [1.d] in that it is not related to “a URL of the website” that is “being accessed in real-time by a host device,” as required by element [1.d]. Further, if Wang’s “invitation acknowledgment, myURL address” relates to “detecting an activation of a hyperlink associated with the synchronized browsing session by a guest device,” then that same element ***cannot also*** be the use of “a URL of the website” to access a website server, as required by step [1.d] of exemplary claim 1. The Petition and Dr. Lieberman’s declaration fail to provide any other context in which this disclosure is intended to be used. (*See generally*, Petition and Lieberman Decl.).

Third, Lebrun’s “no cookies” embodiment does not disclose receiving at a guest device “a URL of the website” that is “being accessed in real-time by a host device.” The “no cookies” embodiment recites that “each web client 110 can receive *the next page 153 directly from the web site 130.*” (Ex. 1005, 35:17-19). Accordingly, the web clients 110 receive the next page directly from the web site 130, and they do not receive a URL of the website from the group-surfing server, as required by claim element [1.d]. In the Institution Decision, the Board agreed, stating “we also agree with Patent Owner that because this alternative embodiment [of] 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.” (Institution Decision 24).

Fourth, the “only a list of pointers” embodiment is no longer associated with a “synchronized browsing session.” The only embodiment which discusses receiving URLs is the “only a list of pointers” embodiment, which, as discussed above, does not disclose receiving cookie information because the “only a list of pointers” are received. In this embodiment, Lebrun discloses receiving a list of pointers that may be updated. This embodiment is not practicing a “synchronized browsing session” that is recited in each of the preamble and first three elements of claim 1. (Ex. 2004, ¶¶68-70). A synchronized browsing session requires that the host and guest devices see similar pages at a synchronized timeframe. (Ex. 2004, ¶¶69-71).

However, receiving “only a list of pointers,” as with this embodiment of Lebrun, indicates the exact opposite—that a guest device may access any webpage in the history of webpages that were part of Lebrun’s group-surfing session while the controlling host is viewing the most recent page. Lebrun discloses that “[w]hen a web client 110 adds itself to the participating web clients 110 in a group-surfing session, it is presented with the most recent viewed page, and is able to review the history of pages viewed prior to joining that group-surfing session.” If a participating web client is able to review “the history of pages viewed prior to joining that group-

surfing session,” then that web client is not *necessarily* viewing what the controlling web client is viewing, and the browsing session is no longer synchronized. (Ex. 2004, ¶¶71-73). Accordingly, under the “only a list of pointers” embodiment, Lebrun fails to disclose a “synchronized browsing session,” as claimed. (*Id.*)

3. Lebrun and Wang fail to disclose “operating a browser by the guest device based on the data received from the synchronization server.”

With respect to step [1.e] which reads “operating a browser by the guest device based on the data received from the synchronization server,” Petitioner contends that this step is met by Lebrun’s system, because in Lebrun, “a second web client ... then receives the page or the URLs of the page through the group-surfing server 140, giving it access to the selected page.” (Pet. 31-32, citing Ex. 1005, 35:5-28, 43:13-22; Ex. 2004, ¶¶67, 69). Petitioner discusses that the URLs that may be received in the “only a list of pointers” embodiment is used to operate a browser. But the claim language requires that “the data received” be used to operate the browser—not some of the data received, or a portion of the data received—and so the guest device must operate the browser using both the URL and the “cookie information associated with the website and the host device.” As discussed above, this embodiment discloses that “only” a list of pointers is received—it does not disclose receiving cookies as well. And in the preferred embodiment of Lebrun, the next page is delivered by the group-surfing server to the web clients. Lebrun does

not disclose sending cookies to the web clients, nor would there be any need to do so—the cookies would be inoperative during the group-surfing session because the web clients are sent the next page by the group-surfing server. A cookie would be inoperative because in the group-surfing session, the web clients would not access the website that originally generated the cookie. Therefore, the requirement of step [1.e] of “operating a browser by the guest device based on the data received from the synchronization server” is not met by Lebrun.

4. Petitioners Rely on Incompatible Embodiments Within Lebrun

Not only does Petitioner (and Petitioner’s expert) fail to address how Lebrun’s embodiments would operate together to arrive at the ’591 Patent’s claims, but Petitioner fails to even address that the different embodiments within Lebrun operate differently, or that there would be a motivation to combine them. Petitioner and its purported expert, Dr. Lieberman, misstate the teachings of Lebrun by improperly combining features of different embodiments without pointing to any teachings within Lebrun, or any other art, that suggests a proper combination.

As discussed above, Lebrun discloses multiple distinct embodiments, including at least the preferred embodiment (Ex. 1005, 35:7-15), the “no cookies” embodiment (Ex. 1005, 35:17-21), the “only a list of pointers” embodiment (Ex. 1005, 43:13-22), and others.

The Institution Decision recognized Lebrun’s “multiple group-surfing session embodiments” (Institution Decision 25). Petitioner even acknowledges that Lebrun includes multiple embodiments by noting that Lebrun describes “*an embodiment of the invention [as one] in which 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.*” (Pet. 18). Despite this, the Petition tries to improperly interweave disclosures from the different embodiments without any further discussion. As one example, neither the Petition nor Petitioners’ expert ever acknowledges how or why portions of the disclosure from the “no cookies” embodiment would be combined with the disclosure from the “only a list of pointers” embodiment or the preferred embodiments.

This faulty premise dooms the Petition on its face. For obviousness grounds, even obviousness based on a single reference, the Board “consider[s] whether a POSITA would have been motivated to combine the prior art to achieve the claimed invention.” *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (internal quotation marks, brackets, and citation omitted); *see KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.” *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); *see also In re Stepan Co.*, 868 F.3d 1342, 1346 (Fed. Cir. 2017) (“Whether a

rejection is based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or selecting from large lists of elements in a single reference, there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”)

Here, Petitioner fails to even acknowledge in their Petition that elements from different embodiments are implicated, let alone provide any rationale for combining the various different embodiments from Lebrun. Accordingly, the Petition fails as a matter of law. *In re Kotzab*, 217 F.3d at 1370; *see also, Cisco Sys., Inc. v. Bockstar Tech. LLC*, IPR2014-01192 (P.T.A.B. Feb. 2, 2015), Paper 10 at 7; *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1361-62 (Fed. Cir. 2016). Therefore, because in an *inter partes* review, the burden of persuasion never shifts to Patent Owner (*Dynamic Drinkware*, 800 F.3d at 1378), the petitioner must show with particularity why each challenged claim is unpatentable. (*Harmonic*, 815 F.3d at 1363; 37 C.F.R. § 42.104(b) (2020)). Here, the Petitioner has failed to meet its burden. This is grounds for the Board to enter an order finding that the claims of the ’591 patent are patentable over the asserted references.

The different embodiments relied upon by Petitioner cannot be combined because even Lebrun itself admits as much. The “no cookies” embodiment specifically identifies that cookies will not be received by Lebrun’s web clients. The

“only a list of pointers” embodiment similarly describes that *only* a list of pointers is sent to the web clients—necessarily meaning that cookies will not be sent as well. Neither Petitioner nor its expert addresses the differences between the embodiments. In fact, the Petition never even provides a single reason to combine these separate systems, choosing instead to ignore the disclosures within Lebrun and present these different embodiments as a single system. For this reason alone, the Petition’s proposed ground that relies on Lebrun should be denied.

Petitioner also fails to include any evidence that a POSITA would expect success in combining the specific references that are relied upon. Without evidence directed to the expectation of success, there is no way for the Board to determine whether “a person of ordinary skill in the art would have...had a reasonable expectation of success” in combining the embodiments in the matter claimed. *Personal Web Techs.*, 848 F.3d at 991. As such, there is insufficient evidence to support an obviousness determination.

B. Ground 2: Intuit Fails to Demonstrate that All Claims 1-18 Are Rendered Obvious By Prajapat And Wang

The Board found that there is a reasonable likelihood that the Petitioner would prevail in showing at least one of claims 1-18 of the ’591 Patent is unpatentable under 35 U.S.C. § 103 over Prajapat (U.S. Patent Pub. No. 2005/0021626 (Ex. 1007) (Ex. 1005)) in view of Wang (U.S. Patent Pub. No. 2005/0033656 (Ex. 1006)).

Petitioner fails to demonstrate that all claims 1-18 are rendered obvious by Prajapat and Wang.

Prajapat relates to users in a call center environment who “desire to share [] web pages with one or more other users such that the users are viewing at least portions of the same web page.” (Ex. 1007, ¶[0002]).

Prajapat discloses two embodiments: (1) “peer-to-peer dynamic web page sharing,” and (2) “peer-to-peer simple web page sharing.” (Ex. 1007, ¶¶[0012]; [0041]; Ex. 2004, ¶¶46-48). In both embodiments, Prajapat teaches the use of “peer-to-peer” multiple web media servers, *e.g.*, “web media server 14a” and “web media server 14b,” which, according to Prajapat, provides the technical advantages of splitting processing between web media servers to thereby provide better scalability. (Ex. 1007, ¶[0033]).

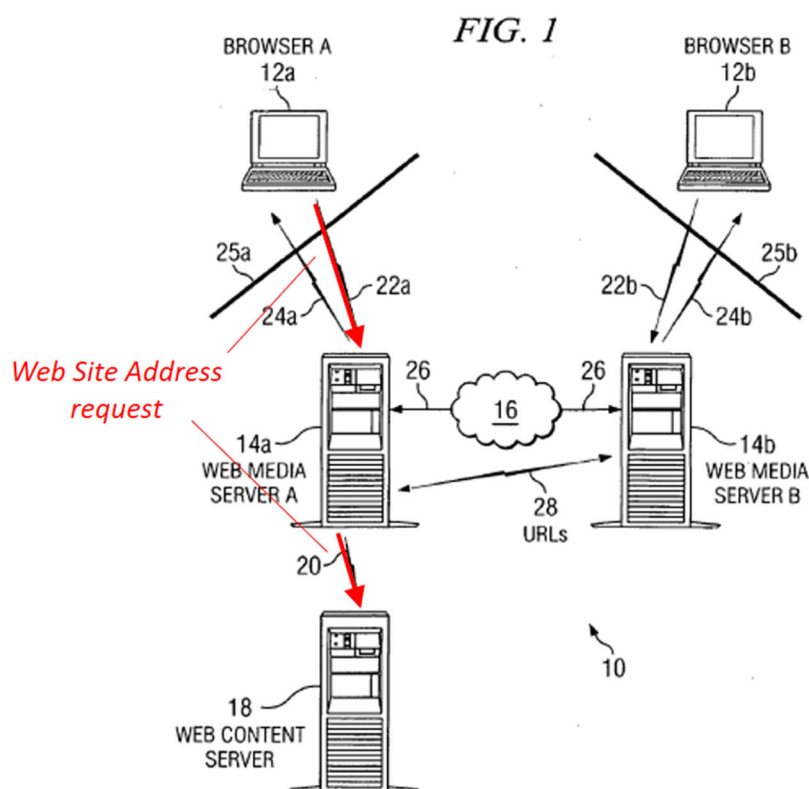
As discussed below, in neither of Prajapat’s embodiments does Prajapat teach or suggest the use of the “URL of the website and cookie information associated with the website and the host device” that a “guest device” receives from a “synchronization server” and uses to operate a browser as claimed in elements 1[d] and 1[e].

1. Prajapat's "Peer-to-Peer Dynamic Web Page Sharing" Embodiment

In one embodiment, Prajapat teaches "peer-to-peer dynamic web page sharing," which allows two browsers to "co-browse." (Ex. 1007, ¶[0012]).

First, "browser 12a may submit a web site address to web media server 14a, and web media server 14a may locate web content server 18 using the web site address." (Ex. 1007, ¶[0023]; *see also* ¶¶[0036-37]).

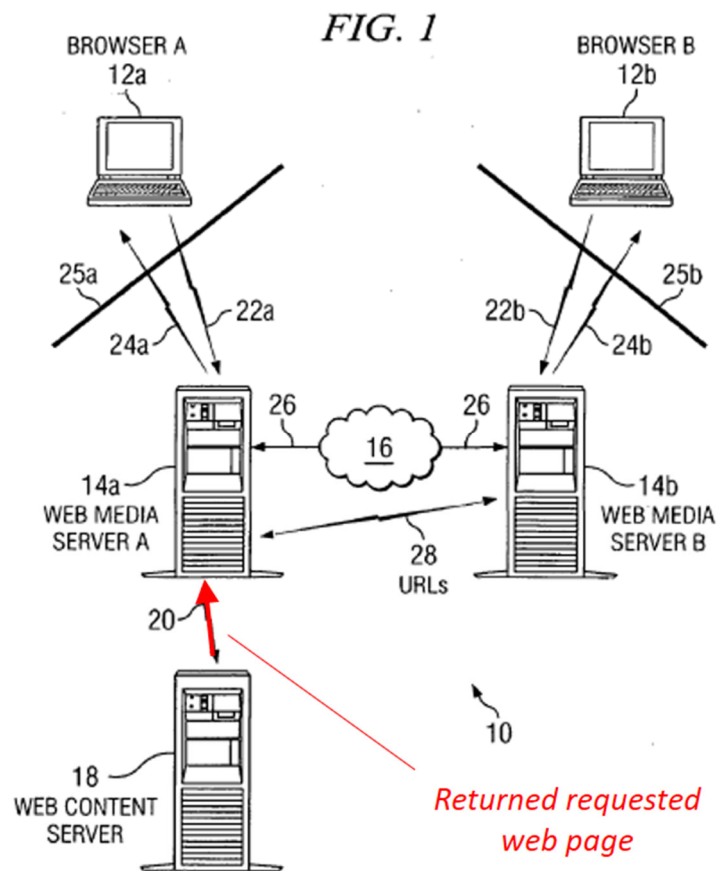
The modified and annotated version of Figure 1 of Prajapat below shows the request from browser 12a to web media server 14a and then from web media server 14a to web content server 18:



Modified and Annotated Figure 1 of Prajapat

Second, “[w]eb content server 18 may return a requested web page to web media server 14a.” (Ex. 1007, ¶[0024]; *see also* ¶[0037]).

Modified and annotated version of Figure 1 of Prajapat below shows the web content server 18 returning the requested webpage to web media server 14a:



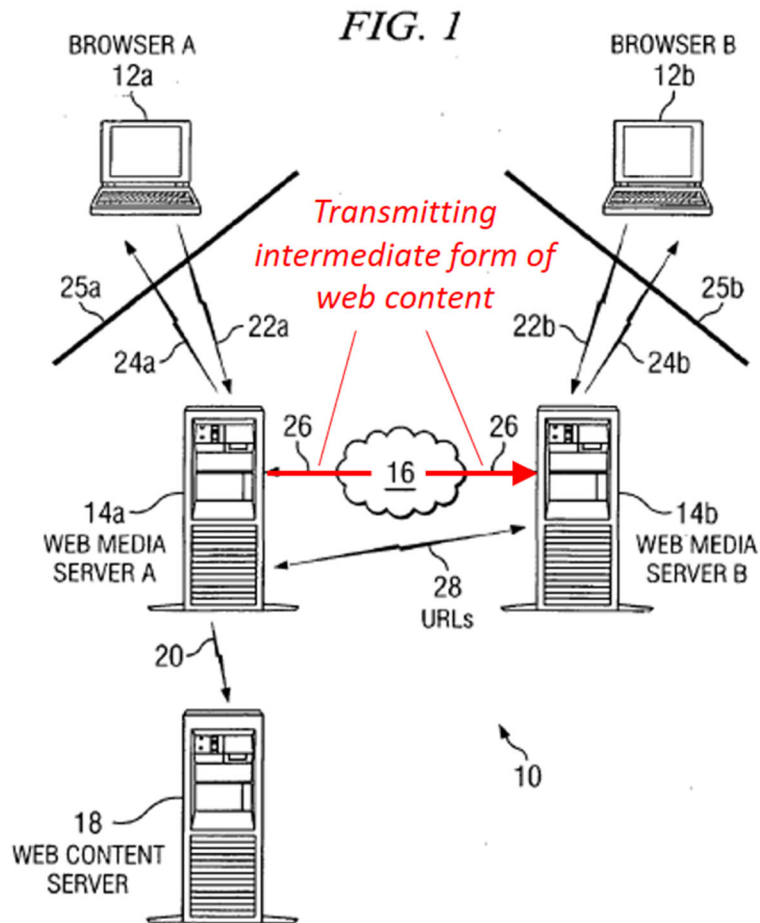
Modified and Annotated Figure 1 of Prajapat

Third, the “[w]eb media server 14a may transform the returned web page into some intermediate form” “that may be rendered by browser 12a.” (Ex. 1007

¶¶[0024-25]; *see also* ¶¶[0037-38]). According to Prajapat, these transformations are necessary depending on the type of browser within which the webpage content is to be displayed, *i.e.*, “in an embodiment in which the retrieved web page includes HTML content, one transformation may need to be applied, while in the case of an IP phone display, another transformation may need to be applied.” (Prajapat ¶24; *see also* ¶37). In effect, web media server 14a would then “transform[s] the intermediate form of the retrieved web page into a renderable form that may be rendered by browser 12a.” (Prajapat ¶25; *see also* ¶38).

Fourth, the web media server 14a transmits the intermediate form of the web content to web media server 14b, which is associated with browser 14b. (Ex. 1007, ¶[0025]; *see also* ¶[0038]). Web media server 14b then transforms the intermediate form of the retrieved webpage into a renderable form that may be rendered by browser 12b. (Ex. 1007, ¶[0026]; *see also* ¶[0039]).

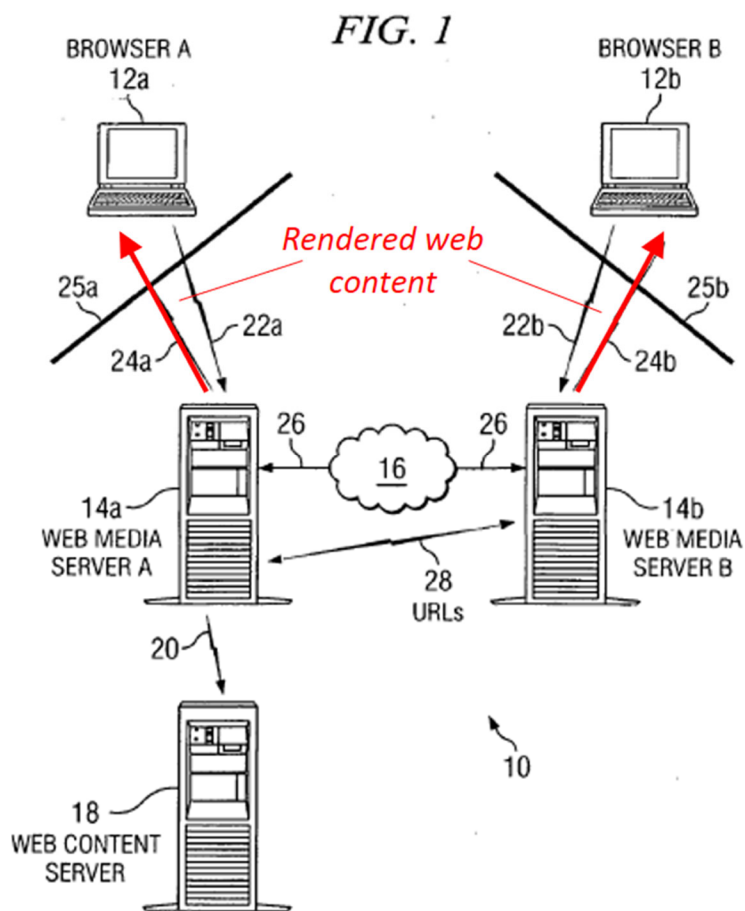
The modified and annotated version of Figure 1 of Prajapat below shows the transmission of the intermediate form of the retrieved webpage from web media server 14a to web media server 14b:



Modified and Annotated Figure 1 of Prajapat

Fifth, the rendered form of the web content is transmitted from the web media servers to their respective browsers. (Ex. 1007, ¶¶[0025-26]; *see also* ¶¶[0038-39]).

Modified and annotated version of Figure 1 of Prajapat below shows the web media servers transmitting the rendered form of the web content to their respective browsers:



Modified and Annotated Figure 1 of Prajapat

2. Prajapat's "Peer-to-Peer Simple Web Page Sharing" Embodiment

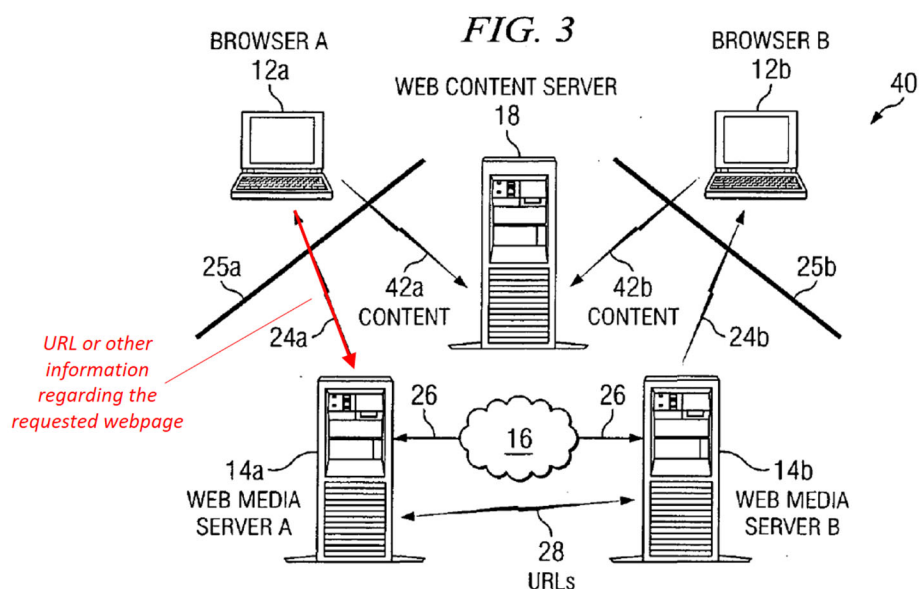
In another embodiment, Prajapat teaches "peer-to-peer simple web page sharing." (Ex. 1007, ¶¶[0041-43]; Ex. 2004, ¶¶46-47). In this embodiment, a URL or other suitable information regarding the requested web page is transmitted from one browser to another browser via the web media servers. There is, however, no teaching or suggestion by Prajapat that the two browsers are simultaneously, or even nearly simultaneously, sharing internet browsing on the same web page in real time,

i.e., that the browsers are engaged in a “synchronized browsing session,” as stated in the claims. Furthermore, Prajapat does not disclose that the browsers are simultaneously, or nearly simultaneously, sharing the URL for the requested web page in real time. (Ex. 2004, ¶¶47-51). Instead, Prajapat states that each event in the “peer-to-peer simple web sharing” embodiment “*may*” occur, not that it *will* occur, or that it does occur *simultaneously, or nearly simultaneously*, with any other event in real time. (Ex. 1007, ¶[0043]; Ex. 2004, ¶¶47-51).

Prajapat’s “peer-to-peer simple web page sharing” embodiment operates as follows:

First, after browser 12a “submit[s] a request to web content server 18 for one or more web pages using link 42a” and “[w]eb content server 18 [] return[s] the requested web page to browser 12a,” “[b]rowser 12a may communicate the URL or other suitable information regarding the requested web page to web media server 14a.” (Ex. 1007, ¶[0041]; Ex. 2004, ¶¶46-47).

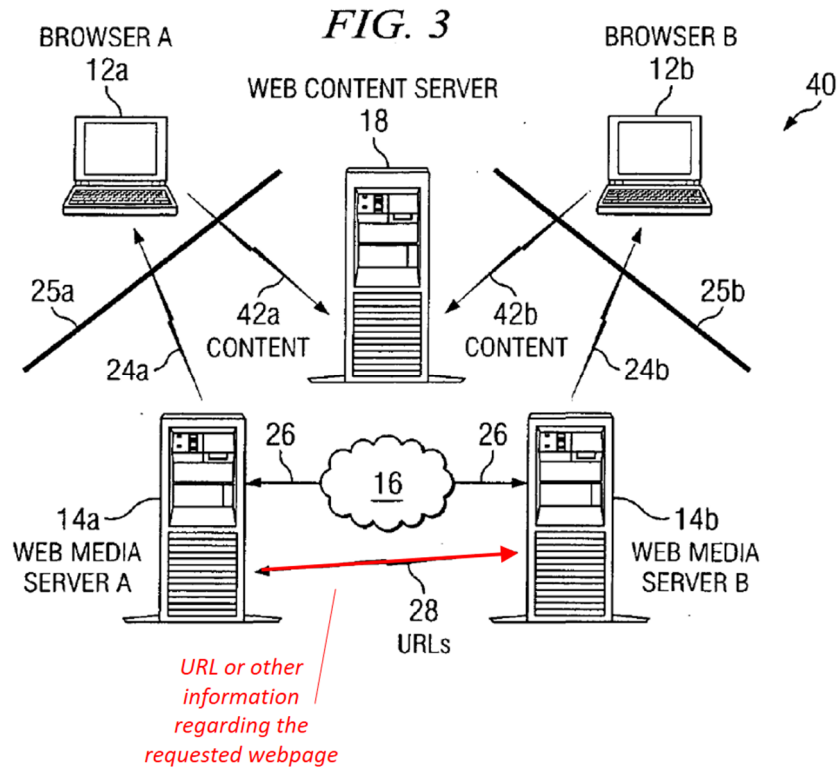
The modified and annotated version of Figure 3 of Prajapat below shows the browser 12a communicating the URL or other suitable information regarding the requested webpage to web media server 14a:



Modified and Annotated Figure 3 of Prajapat

Second, “[w]eb media server 14a may communicate the URL and any other suitable information to web media server 14b, using media session 28 for example.” (Ex. 1007, ¶¶0041]; Ex. 2004, ¶¶46-47).

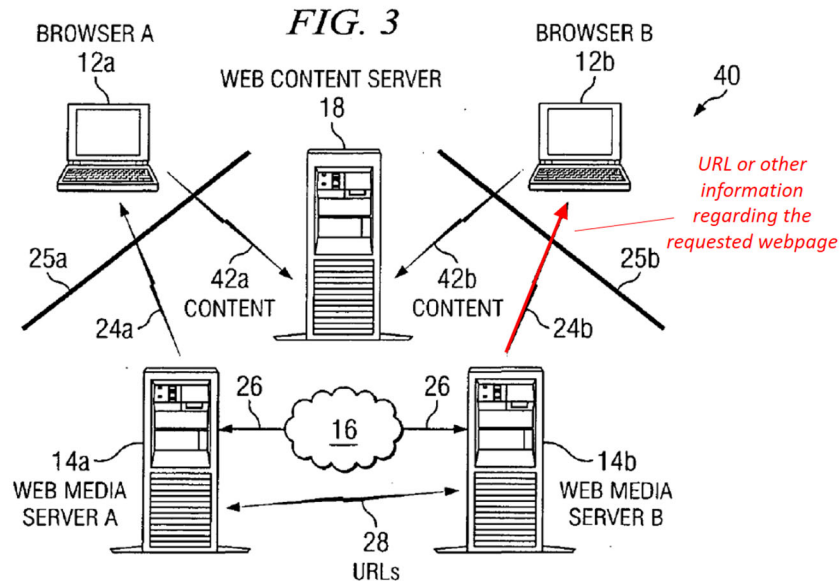
The modified and annotated version of Figure 3 of Prajapat below shows web media server 14a communicating the URL and any other suitable information to web media server 14b:



Modified and Annotated Figure 3 of Prajapat

Third, “[w]eb media server 14b may communicate the URL and any other suitable information to browser 12b.” (Ex. 1007, ¶¶0041]; Ex. 2004, ¶¶46-47).

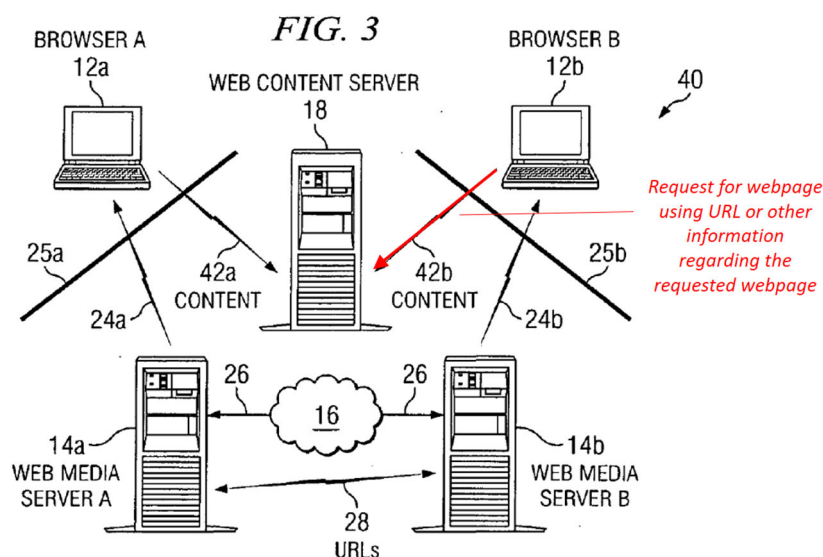
The modified and annotated version of Figure 3 of Prajapat below shows web media server 14b communicating the URL and any other suitable information to browser 12b:



Modified and Annotated Figure 3 of Prajapat

Fourth, “[b]rowser 12b may use the URL and any other suitable information to request from web content server 18 the web page that browser 12a requested.” (Ex. 1007, ¶[0041]; Ex. 2004, ¶¶46-47).

Modified and annotated version of Figure 3 of Prajapat below shows browser 12b using the URL and any other suitable information to request from web content server 18 the webpage that browser 12a requested:



Modified and Annotated Figure 3 of Prajapat

Thus, in the “peer-to-peer simple web page sharing” embodiment, Prajapat teaches the mere direct transmission of a URL from one browser to another browser, in “any time” sequence. (Ex. 2004, ¶¶47-51). Accordingly, Prajapat provides no information to suggest that this transmission is “simultaneous,” in “real-time,” or temporally coordinated in any manner, through “peer-to-peer” web media servers. (Ex. 2004, ¶¶47-51). Prajapat’s disclosure is therefore similar to simply posting a webpage bookmark URL or emailing the URL (or other suitable information regarding the requested webpage) from one device to another device using email servers. As such, the act of posting a webpage bookmark URL or emailing a URL from one user to another does *not* result in simultaneous (or even nearly

simultaneous) real time sharing of the internet browsing experience, as claimed with a “synchronized browsing session” in the ’591 Patent. (Ex. 2004, ¶¶47-55).

3. Prajapat and Wang fail to disclose, in a “synchronized browsing session,” “receiving data from the synchronization server ... wherein the data comprises ... cookie information associated with the website and the host device.” [1.d]

The Petition relies on Prajapat at ¶¶[0012], [0016], [0022], [0026]-[0027], [0036], [0039], and [0043] as allegedly teaching information related to this claim limitation.⁴ (Pet. Section IX(B)(1)(e)). However, none of these paragraphs specifically disclose “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 ... cookie information associated with the website and the host device” at a guest device.

The majority of the cited paragraphs of Prajapat refer to its “peer- to-peer dynamic web page sharing” embodiment. Prajapat at paragraph [0043] refers to the second system, the “peer-to-peer simple web page sharing” embodiment. “Peer-to-peer dynamic web page sharing,” as described in detail in Section IV.B.1, is fundamentally different from that which is disclosed in the ’591 Patent.

Prajapat’s “dynamic web page sharing system” relies on middleman web media servers 14a and 14b to retrieve data from the web content server 18. In the

⁴ The Petition does not rely on Wang for this limitation.

“dynamic web page sharing embodiment,” the browsers 12a and 12b of Prajapat are delivered snapshots of a webpage, which Prajapat refers to as an “intermediate form” that is communicated between web media server 14a and 14b. (*Id.* ¶[0026]). Web media server 14b then transforms the “intermediate form” of the webpage into a form that can be rendered by browser 12b (i.e. the guest device). By receiving only “intermediate form web pages” from the web media server 14a and 14b, Prajapat does not disclose that the any underlying information, such as the claimed URL and cookie information associated with the website and the host device, is ultimately received by any of the browsers. (Ex. 2004, ¶¶49-54, 74-80).

The Petition further relies on references to Prajapat’s “peer-to-peer simple web page sharing” system (as opposed to the entirely distinct “peer-to-peer dynamic web page sharing” system described above) to meet this limitation. (Pet. 53-54, citing Ex. 1007, [0043]). The Petition states that “‘browser 12a’ requests to co-browse with ‘browser 12b,’ by communicating ‘the URL or other suitable information regarding the requested web page to web media server 14a,’ which then passes the information to ‘browser 12b’ through ‘web media server 14b.’” (Pet. 53, citing Ex. 1007, ¶[0043]). However, this embodiment fails to disclose element [1.d] for at least three reasons.

First, as discussed above in the “peer-to-peer simple web page sharing” embodiment, Prajapat teaches only the transmission of a URL from one browser to

another. Accordingly, there is no restriction on any time sequence—Prajapat provides no information to suggest transmission is “simultaneous,” in “real-time,” or temporally coordinated whatsoever, through “peer-to-peer” web media servers. As such, Prajapat does not disclose the claim element of performing or participating in a “synchronized browsing session,” and therefore there is no synchronization to be had if a guest device receives a number of URLs without a requirement for those URLs to be browsed at the same time by multiple devices. (Ex. 2004, ¶¶49-54, 74-80). Without such coordination, Prajapat’s “peer-to-peer simple web page sharing” simply discloses only asynchronous access of browsing results by multiple units. (*Id.*)

While Prajapat’s “peer-to-peer dynamic web page sharing” system contemplates what Prajapat refers to as a “co-browse” functionality (as opposed to the “synchronized browsing” contemplated by the ’591 Patent), its “peer-to-peer simple web page sharing” system only contemplates “web page sharing sessions” via the passing of URLs. (Compare Ex. 1007 ¶[0012] (“In general, web media servers 14 allow browser 12a to co-browse one or more web pages with browser 12b”) with Ex. 1007 ¶[0041] (“In operation of system 40, browser 12 a may request a web page sharing session with one or more other browsers 12”); *see also* Ex. 2004, ¶¶46-47, 74-77, 80).

Second, Prajapat does not disclose *receiving cookie information* at the guest device, where the cookie is associated with the host device and the website. (Ex. 2004, ¶¶46-47, 74-77, 80). Rather, the cookie information is sent to the web media server 14a to aid in formulating a request, but there is no disclosure that the cookie information is passed to another browsing device. Such a disclosure would actually not even make sense, as the web media server only sends intermediate form webpages back to the browsers 12a and 12b. (Ex. 2004, ¶¶46-47, 74-77, 80).

Third, Prajapat's simple web page sharing and phone-to-phone web page sharing embodiments do not teach co-browsing or a "synchronized browsing session," as claimed. (Ex. 2004, ¶¶74-80). Rather, it teaches only unsynchronized web link sharing. (Ex. 2004, ¶¶39-40).

4. Petitioners Rely on Incompatible Embodiments Within Prajapat

As with Lebrun, Petitioner and its purported expert, Dr. Lieberman, misstate the teachings of Prajapat by improperly combining features of different embodiments without pointing to any teachings within Prajapat, or any other art, that suggests a proper combination. The Petition relies on two entirely different embodiments of Prajapat, the "peer-to-peer simple web page sharing" embodiment, and the "peer- to-peer dynamic web page sharing" embodiment. However, the

architectures that underlie these two embodiments are fundamentally different from one another. (*Compare* Prajapat Figure 1 and Figure 3; Ex. 2004, ¶¶46-55, 74-80).

Neither the Petition nor Petitioners' expert ever acknowledges how or why portions of the disclosure from these two embodiments would be combined. (Ex. 2004, ¶55, 74-77). As explained above with Lebrun, even in a single reference obviousness rejection, the Board must "consider whether a POSITA would have been motivated to combine the prior art to achieve the claimed invention." *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (internal quotation marks, brackets, and citation omitted); *see also In re Stepan Co.*, 868 F.3d 1342, 1346 (Fed. Cir. 2017) ("Whether a rejection is based on combining disclosures from multiple references, combining multiple embodiments from a single reference, or selecting from large lists of elements in a single reference, there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.").

Petitioner also fails to include any commentary or evidence that a POSITA would expect success in combining the specific references that are relied upon. Without evidence directed to the expectation of success, there is no way for the Board to determine whether "a person of ordinary skill in the art would have...had a reasonable expectation of success" in combining the embodiments in the matter

claimed. *Personal Web Techs. v. Apple, Inc.*, 848 F.3d 987, 991 (Fed. Cir. 2017). As such, there is insufficient evidence to support an obviousness determination.

C. Petitioner Fails to Articulate a Proper Obviousness Analysis for Each Ground

“The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called secondary considerations.” *Apple Inc. v. Yu*, IPR2019-01258, Paper No. 29 at 39 (PTAB Jan. 5, 2021) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)). Neither the Petition nor Dr. Lieberman’s declaration attempt to identify differences between the claimed subject matter and the prior art, and does not discuss what obviousness-related modifications to Lebrun in Ground 1 (or Prajapat in Ground 2) should be made with the disclosure of Wang.

Further, a POSITA would also not be motivated to combine Lebrun and Wang or Prajapat and Wang. (Ex. 2004, ¶¶56-57, 81-87). “A POSITA would not have been motivated to combine Wang with either Lebrun or Prajapat due to the incompatible system architectures and purposes. Wang’s system is designed to store a snapshot of page data locally to the server performing the synchronization and distribute that snapshot data to participating client browsers. ... a POSITA would think that

Lebrun's preferred embodiment of sending 'only the page 153 itself without any multimedia elements (such as ...images)' teaches away from the snapshot data of Wang that is 'compiled by linking text, hypertext, image data and the like together.'" (*Id.*) A POSITA would similarly not have been motivated to combine Prajapat and Wang given their differing architectures. (*Id.*) Referring to those differences, "a POSITA would have understood that the system can produce either single snapshot data or multiple renderable forms, but it cannot do both simultaneously." (*Id.*)

V. CONCLUSION

For the reasons stated above, the Board should deny the Petition on the grounds that Petitioner has not met its burden of proving that claims 1-18 of the '591 Patent are obvious over combinations of Lebrun, Wang, and Prajapat. (Ex. 2004, ¶188). Claims 1-18 are therefore patentable over these references.

Date: September 27, 2023

Respectfully submitted,

/ Scott W. Hejny /

Scott W. Hejny

Reg. No. 45,882

shejny@mckoolsmith.com

McKool Smith, P.C.

300 Crescent Court, Suite 1500

Dallas, Texas 75201

Telephone: 214-978-4000

Fax: 214-978-4044

Counsel for Patent Owner, Samesurf, Inc.

CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S RESPONSE** specified in 37 C.F.R. § 42.24 have 13,105 words, in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(1). This word count was prepared using Microsoft Word 2016 and by adding 123 words as counted from text annotations in the figures.

Date: September 27, 2023

Respectfully submitted,

/ Scott W. Hejny /
Scott W. Hejny
Reg. No. 45,882

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S RESPONSE** is being served on counsel for petitioner via electronic mail on, in its entirety on the following counsel of record for Petitioner on this 27th day of September 2023:

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

McKool Smith, P.C.

/ Scott W. Hejny /

Scott W. Hejny
Reg. No. 45,882