UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

SAMESURF, INC., Plaintiff, v. INTUIT, INC., Defendant.	Case No.: 3:22-CV-00412-RSH-DDL **ORDER: (1) DENYING DEFENDANT'S MOTION TO DISMISS AND (2) DENYING DEFENDANT'S REQUEST FOR ORAL ARGUMENT** **[ECF Nos. 16, 23]**

On May 23, 2022, Defendant Intuit, Inc. ("Intuit") filed a motion to dismiss the Complaint of Plaintiff Samesurf, Inc. ("Samesurf") pursuant to Federal Rule of Civil Procedure 12(b)(6). ECF No. 16. On June 13, 2022, Samesurf filed a response in opposition to Intuit's motion to dismiss. ECF No. 19. On June 17, 2022, Intuit filed a reply. ECF No.

23.[1] For the reasons below, the Court denies Intuit's motion to dismiss Samesurf's Complaint.

I. Background

On March 29, 2022, Samesurf filed a Complaint against Intuit, alleging infringement of U.S. Patent Nos. 9,483,448 ("the '448 Patent"), 9,185,145 ("the '145 Patent"), and 8,527,591 ("the '591 Patent") (collectively, "the patents-in-suit"). ECF No. 1. Specifically, Samesurf asserts against Intuit claims 1-4, 6-8, 11-14, and 16 of the '448 Patent; claims 1-5, 7-14, and 16-17 of the '145 Patent; and claims 1-6, 10-12, and 14-16 of the '591 Patent. *See id.* ¶¶ 113–15, 153–55, 189–91; ECF No. 19 at 4. Samesurf alleges that Intuit has infringed these asserted claims by utilizing Samesurf's patented co-browsing technology as part of Intuit's TurboTax Online, QuickBooks Online, TurboTax Live, QuickBooks Live, Smartlook, and other co-browsing enabled Intuit products. *See* ECF No. 1 ¶¶ 47–49, 87–208.

The '591 Patent is entitled "method and apparatus for the implementation of a real-time, sharable browsing experience on a guest device," and was issued on September 3, 2013. U.S. Patent No. 8,527,591, at [45], [54] (issued Sept. 3, 2013). The '145 Patent, entitled the same, is a continuation of and claims priority to the '591 Patent. U.S. Patent No. 9,185,145, at [45], [54] (issued Nov. 10, 2015). The '448 Patent is entitled "method and apparatus for the implementation of a real-time, sharable browsing experience on a host device." U.S. Patent No. 9,483,448, at [45], [54] (issued Sept. 1, 2016).

The specifications of the patents-in-suit are essentially the same. *See* ECF No. 16-1 at 2; ECF No. 19 at 4 n.2. The patents-in-suit disclose "a method for joining a synchronized browsing session administered by a synchronization server, comprising activating a

[1] On June 17, 2022, Intuit also filed a request for oral argument in support of its Rule 12(b)(6) motion to dismiss. ECF No. 23. The Court, exercising its discretion, concludes that Intuit's motion to dismiss may be decided without oral argument and therefore denies Intuit's request. *See* Civ. L.R. 7.1(d)(1).

hyperlink associated with the synchronized browsing session, sending a request to join the synchronized browsing session to the synchronization server in response to the activation of the hyperlink, and joining the synchronized browsing session." '591 Patent col. 2 ll. 54–60.

In describing the background of the invention, the specification explains that there is a need and desire for a "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." *Id.* at col. 1 ll. 52, col. 2 ll. 12. In describing the problems of the current prior art methods, the specification explains:

> While some current methods such as "desktop or screen sharing" allow users to simply view the same internet content, these methods do not enable all users in a session to click, input, and log into those experiences in a simultaneous or nearly simultaneous manner. Furthermore, these methods are also less appealing because they work by broadcasting continuous screenshots of the host screen in large files or packets and require high levels of bandwidth and computer processing power. As a result of their high bandwidth and processing power requirements, current methods such as desktop sharing are inadequate for enabling larger groups to all view and fully interact with that interactive content in a simultaneous manner. Finally, current methods such as "desktop or screen sharing" afford little protection for the broadcasting host's private information since all participants in a particular session see the host screen as s/he enters sensitive information such as user names or passwords or when the host toggles back and forth in other areas on their desktop.

Id. at col. 2 ll. 18–36. The specification explains that in order to "minimize" these limitations in the prior art, "the present invention describes a method for joining a synchronized browsing session administered by a synchronization server." *Id.* at col. 2 ll. 51-55; *see id.* at col. 5 ll. 15–25 ("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. . . . [U]tilization of the present invention does not materially impose more

bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods.”).

As an example of the claimed invention, Independent Claim 1 of the ’591 Patent recites:

> 1. A method for a guest device performing a synchronized browsing session administered by a synchronization server, comprising:
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> 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;
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> receiving from the synchronization server a notification that guest device has joined the synchronized browsing session;
>
> 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
>
> operating a browser by the guest device based on the data received from the synchronization server.

Id. at col. 22 ll. 52 to col. 23 ll. 2.

By the present motion, Intuit moves pursuant to Rule 12(b)(6) to dismiss Samesurf’s Complaint for failure to state a claim. ECF No. 16-1. Specifically, Intuit argues that Samesurf cannot allege claims for infringement of the patents-in-suit because all of the asserted claims in the patents-in-suit claim patent-ineligible subject matter and, therefore, are invalid under 35 U.S.C. § 101. *Id.* at 21, 23.

II. Legal Standards

A. Rule 12(b)(6) Motion to Dismiss

A motion to dismiss under Federal Rule of Civil Procedure 12(b)(6) “tests the legal sufficiency of a claim.” *Navarro v. Block*, 250 F.3d 729, 732 (9th Cir. 2001). “To survive

a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)).

A claim is facially plausible "when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Iqbal*, 556 U.S. at 678. Plausibility requires pleading facts, as opposed to conclusory allegations or a "formulaic recitation of the elements of a cause of action." *Twombly*, 550 U.S. at 555. The factual allegations must rise above the mere conceivability or possibility of unlawful conduct. *Iqbal*, 556 U.S. at 678–79. "Factual allegations must be enough to raise a right to relief above the speculative level." *Twombly*, 550 U.S. at 555. "Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice." *Iqbal*, 556 U.S. at 678. "[F]or a complaint to survive a motion to dismiss, the non-conclusory 'factual content,' and reasonable inferences from that content, must be plausibly suggestive of a claim entitling the plaintiff to relief." *Moss v. U.S. Secret Serv.*, 572 F.3d 962, 969 (9th Cir. 2009) (quoting *Iqbal*, 556 U.S. at 678).

B. Legal Standards for Patent Eligibility Under 35 U.S.C. § 101

Section 101 of the Patent Act defines patent-eligible subject matter as "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. The Supreme Court has "long held that this provision contains an important implicit exception[:] Laws of nature, natural phenomena, and abstract ideas are not patentable." *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013) (quoting *Mayo Collaborative Servs. v. Prometheus Lab'ys, Inc.*, 566 U.S. 66, 70 (2012)). "This exception reflects the concern that patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity." *PersonalWeb Techs. LLC v. Google LLC*, 8 F.4th 1310, 1314 (Fed. Cir. 2021) (internal quotation marks omitted) (quoting *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014)); *see CareDx, Inc. v. Natera, Inc.*, 40 F.4th 1371, 1376 (Fed. Cir. 2022) ("These exceptions exist because monopolizing the basic tools of scientific work 'might

tend to impede innovation more than it would tend to promote it.'") (quoting *Mayo*, 566 U.S. at 71).

"The Supreme Court has established a two-step framework for evaluating patent eligibility under § 101." *Int'l Bus. Machines Corp. v. Zillow Grp., Inc.*, 50 F.4th 1371, 1377 (Fed. Cir. 2022) (citing *Alice*, 573 U.S. at 217). Under step one, the court "determine[s] whether the claim is 'directed to' a 'patent-ineligible concept,' such as an abstract idea." *Coop. Ent., Inc. v. Kollective Tech., Inc.*, 50 F.4th 127, 130 (Fed. Cir. 2022) (quoting *Alice*, 573 U.S. at 217). If so, the court proceeds to step two and "examine[s] 'the elements of the claim to determine whether it contains an "inventive concept" sufficient to "transform" the claimed abstract idea into a patent-eligible application.'" *Id.* (quoting *Alice*, 573 U.S. at 221). Specifically, the court determines "whether the claim elements, individually and as an ordered combination, contain an inventive concept, which is more than merely implementing an abstract idea using 'well-understood, routine, [and] conventional activities previously known to the industry.'" *Id.* (quoting *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014)).

"Patent eligibility is a question of law that may involve underlying questions of fact. *PersonalWeb*, 8 F.4th at 1314; *see Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018). "Thus, patent eligibility may be resolved at the Rule 12 stage only if there are no plausible factual disputes after drawing all reasonable inferences from the intrinsic and Rule 12 record in favor of the non-movant." *Coop. Ent.*, 50 F.4th at 130 (collecting cases). "But 'not every § 101 determination contains genuine disputes over the underlying facts material to the § 101 inquiry.' Indeed, that inquiry 'may be, and frequently has been, resolved on a Rule 12(b)(6) or (c) motion where the undisputed facts, considered under the standards required by that Rule, require a holding of ineligibility under the substantive standards of law.'" *PersonalWeb*, 8 F.4th at 1314 (citations omitted).

The party challenging the validity of the patents-in-suit bears the burden of proof under the § 101 two-step framework. *See Illumina, Inc. v. Ariosa Diagnostics, Inc.*, 967

F.3d 1319, 1328 (Fed. Cir. 2020); *Confident Techs., Inc. v. AXS Grp. LLC*, No. 17-CV-02181-H-MDD, 2018 WL 539166, at *3 (S.D. Cal. Jan. 23, 2018) ("The accused infringer bears the burden of proof on both steps."); *see also Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 95 (2011) ("[T]he burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.") (quoting 35 U.S.C. § 282). Further, any fact pertinent to the § 101 eligibility analysis must be proven by clear and convincing evidence. *See Berkheimer*, 881 F.3d at 1368; *see also Microsoft*, 564 U.S. at 95 (holding that § 282 requires that an invalidity defense "be proved by clear and convincing evidence").

III. Analysis

A. Intuit's Use of a Representative Claim

As an initial matter, Intuit asserts that independent claim 1 of the '591 Patent is representative of all of the asserted claims from the patents-in-suit for the purposes of the Court's § 101 eligibility analysis. ECF No. 16-1 at 3–5; ECF No. 22 at 1. Samesurf disputes this and argues that Intuit has failed to meet its initial burden of proving that claim 1 of the '591 Patent is representative of all of the other asserted claims. ECF No. 19 at 9–12. Samesurf argues that, therefore, Intuit should be required to separately address each asserted claim under its § 101 analysis. *Id.* at 12.

The Federal Circuit has explained that "[c]ourts may treat a claim as representative [for purposes of a § 101 eligibility analysis] in certain situations, such as if the patentee does not present any meaningful argument for the distinctive significance of any claim limitations not found in the representative claim or if the parties agree to treat a claim as representative." *Berkheimer*, 881 F.3d at 1365; *accord Sensormatic Elecs., LLC v. Wyze Labs, Inc.*, No. 2020-2320, 2021 WL 2944838, at *4 (Fed. Cir. July 14, 2021). Here, resolution of this issue is unnecessary because even if the Court assumes that independent claim 1 of the '591 Patent is representative of all of the asserted claims for the purposes of the Court's § 101 analysis, Intuit has failed to establish that claim 1 of the '591 Patent is invalid under § 101.

B. Step One of the § 101 Inquiry

Under step one, the court "determine[s] whether the claim is 'directed to' a 'patent-ineligible concept,' such as an abstract idea." *Coop. Ent.*, 50 F.4th at 130 (quoting *Alice*, 573 U.S. at 217). The Federal Circuit has "approached the Step 1 directed to inquiry by asking what the patent asserts to be the focus of the claimed advance over the prior art. In conducting that inquiry, [courts] must focus on the language of the asserted claims themselves, considered in light of the specification." *Yu v. Apple Inc.*, 1 F.4th 1040, 1043 (Fed. Cir. 2021) (cleaned up) (quoting *TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1292 (Fed. Cir. 2020)); *see also CardioNet, LLC v. InfoBionic, Inc*, 955 F.3d 1358, 1372–73 (Fed. Cir. 2020) ("In determining what the claims are directed to and whether they are directed to an abstract idea, a court may well consult the plain claim language, written description, and prosecution history."). The step one inquiry "presents a legal question that can be answered based on the intrinsic evidence." *CardioNet*, 955 F.3d at 1372.

Under step one, "[i]f the focus of the claim is a specific and concrete technological advance, for example an improvement to a technological process or in the underlying operation of a machine, [the court's] inquiry ends and the claim is eligible." *Adasa Inc. v. Avery Dennison Corp.*, 55 F.4th 900, 2022 WL 17725736, at *5 (Fed. Cir. 2022). "In cases involving software innovations, the step-one inquiry often turns on whether the claims focus on specific asserted improvements in computer capabilities or instead on a process or system that qualifies as an abstract idea for which computers are invoked merely as a tool." *Int'l Bus. Machines*, 50 F.4th at 1377 (cleaned up) (quoting *TecSec*, 978 F.3d at 1292); *see also In re Killian*, 45 F.4th 1373, 1380 (Fed. Cir. 2022) ("We have distinguished between claims 'directed to an improvement in the functioning of a computer,' versus those . . . that simply recite 'generalized steps to be performed on a computer using conventional computer activity.'" (quoting *In re TLI Commc'ns LLC Pat. Litig.*, 823 F.3d 607, 612 (Fed. Cir. 2016))). The Federal Circuit "ha[s] routinely held software claims patent eligible under *Alice* step one when they are directed to improvements to the functionality of a computer or network platform itself." *Uniloc USA, Inc. v. LG Elecs. USA, Inc.*, 957 F.3d 1303, 1307

(Fed. Cir. 2020); *see Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) ("The Supreme Court has suggested that claims 'purport[ing] to improve the functioning of the computer itself,' or 'improv[ing] an existing technological process' might not succumb to the abstract idea exception."). In contrast, the Federal Circuit has "held claims ineligible as directed to an abstract idea when they merely collect electronic information, display information, or embody mental processes that could be performed by humans." *Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1346–47 (Fed. Cir. 2017) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016) (collecting cases)); *see Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1011 (Fed. Cir. 2018) (describing as ineligible "claims that merely 'collect, organize, and display information on a generic display device'") (cleaned up) (quoting *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1345 (Fed. Cir. 2018)).

The Federal Circuit has cautioned that the step one directed to inquiry does not "simply ask whether the claims involve a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions involves a law of nature and/or natural phenomenon—after all, they take place in the physical world." *Enfish*, 822 F.3d at 1335. Thus, courts must "be careful to avoid oversimplifying the claims by looking at them generally and failing to account for the specific requirements of the claims." *CardioNet*, 955 F.3d at 1371; *see TLI Commc'ns*, 823 F.3d at 611 ("[I]n determining whether the claims are directed to an abstract idea, we must be careful to avoid oversimplifying the claims because '[a]t some level, 'all inventions . . . embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.'") (quoting *Alice*, 573 U.S. at 217).

In its motion to dismiss, Intuit contends that the asserted claims are directed to the abstract idea of "organizing human activity," specifically "sending and receiving information for simultaneous interactions." ECF No. 16-1 at 6–7; *see* ECF No. 22 at 3. In response, Samesurf argues that Intuit oversimplifies the asserted claims and fails to recognize the computer-based nature of the problem being solved by the claims. ECF No.

19 at 1, 13. The Court agrees with Samesurf. Intuit's step one arguments engage in the precise type of inaccurate oversimplification of the claims that the Federal Circuit has cautioned against.

The asserted claims are not merely directed to sending and receiving information for simultaneous interaction. Rather, the asserted claims are specifically directed to performing a synchronized browsing session between two electronic devices (a host device and a guest/invitee device) via a synchronization server. For example, the preamble of independent claim 1 of the '591 Patent, which Intuit asserts is representative of all of the asserted claims, provides that the claim is directed to a method for "performing a synchronized browsing session administered by a synchronization server." '591 Patent col. 22 ll. 52–53; *see, e.g.*, *Data Engine Techs.*, 906 F.3d at 1008–11 (relying on language in the claim's preamble when performing the step one directed to inquiry).[2] The body of independent claim 1 then provides the method steps for performing this synchronized browsing session via a synchronization server, a host device, and a guest device. *See* '591 Patent col. 22 ll. 55 to col. 23 ll. 2.

That the asserted claims are specifically directed to performing a synchronized browsing session between two electronic devices via a synchronization server is also supported by a review of the specification of the patents-in-suit, particularly, the specification's description of the claimed advance over the prior art. In describing the background of the invention, the specification explains that there is a need and desire for a "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

[2] The Court notes that the preamble of independent claim 1 of the '145 Patent similarly provides that the claim is directed to a method for "joining a synchronized browsing session administered by a synchronization server." '145 Patent col. 22 ll. 62–64. In addition, the preamble of independent claim 1 of the '448 Patent similarly provides that the claim is directed to a method for "establishing a synchronized browsing session between a host device and an invitee device." '448 Patent col. 23 ll. 30–32.

devices with all of those users empowered to interact with that content in real-time on a simultaneous basis." *Id.* at col. 1 ll. 52, col. 2 ll. 12. The 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 are "less appealing" because they "require high levels of bandwidth and computer processing power." *Id.* at col. 2 ll. 23–27; *see id.* at col. 2 ll. 27–31 ("As a result of their high bandwidth and processing power requirements, current methods such as desktop sharing are inadequate for enabling larger groups to all view and fully interact with that interactive content in a simultaneous manner."). The specification also explains that the patents-in-suit "minimize" the bandwidth and processing issues of the prior art by providing "a method for joining a synchronized browsing session administered by a synchronization server." *Id.* at col. 2 ll. 51–55; *see id.* col. 5 ll. 15–25 ("[U]tilization of the present invention does not materially impose more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods."). As such, the specification, similar to the claim language in the asserted claims, describes the invention claimed in the patents-in-suit as being directed to performing a synchronized browsing session between two or more Internet users/devices via a synchronization server. *See id.* at col. 5 ll. 43–47 ("[U]tilization of the present invention facilitates the initialization and implementation of a synchronized browsing session between two or more internet users, thereby allowing all of them to view and fully interact with the same internet content without the hassle of coordinated user input.").

With this accurate characterization of what the asserted claims are directed to, it is clear that the asserted claims are not directed to an abstract idea. Rather, the claims are directed to a specific solution that is rooted in computer technology to overcome a problem specifically arising in the realm of computer networks—using a synchronization server to administer synchronized browsing sessions in order to overcome the bandwidth and processing issues of the prior art. The bandwidth and processing issues of the prior art methods of "desktop and screen sharing" for simultaneous internet viewing are issues that

exist only in the realm of computer networks and the Internet. Similarly, the specific solution to these issues presented by the patents-in-suit—using a synchronization server to administer a synchronized browsing session between two or more electronic devices/internet users—is a solution that is rooted in computer networking technology and cannot be performed outside of the realm of computers and the Internet.

Intuit argues that the asserted claims are directed to abstract ideas because "sending and receiving information and data for simultaneous interactions . . . is a conventional practice that has long been the subject of organized human activity in the pre-Internet world." ECF No. 16-1 at 10; *see id.* at 6 (arguing that the claims merely utilize "generic devices that permit the same simultaneous interaction humans have engaged in since the dawn of man"). To support this contention, Intuit provides several purported pre-Internet analogies to the claimed invention: (1) people sending letters to communicate and collaboratively work on a task; (2) people gathering around an overhead projector and taking turns to revise a document; and (3) hunters on opposite sides of a ravine using hand signals to simultaneously communicate with each other. *Id.* at 1, 10; ECF No. 22 at 5. The Court rejects all of these analogies.

In presenting these analogies, Intuit again engages in an improper oversimplification of the asserted claims. The specific issues addressed by the asserted claims are the bandwidth and processing issues of the prior art methods of "desktop and screen sharing" in order to allow for real-time simultaneous internet viewing and interaction. *See* '591 Patent col. 2 ll. 5–31, col. 5 ll. 22–25. This is a problem that exists only in the realm of the Internet and computer networks, and all of Intuit's analogies are faulty. Intuit's letter analogy is faulty because sending letters back and forth to collaboratively work on a task is not a real-time simultaneous interaction between two people. Intuit's overhead projector analogy is faulty because in that situation the people are all in the same physical space (gathered around the projector) looking at the same projection/display. Further, taking turns to revise a document are not simultaneous interactions with the document. In contrast to Intuit's projector analogy, the problem addressed by the asserted claims is how to best

allow people to simultaneously see and interact with the same Internet content in real-time on two separate displays/devices. Finally, Intuit's hunter analogy is faulty because in that instance there are no displays at all and the two hunters are in the same general physical space. Two people on two separate displays/devices without any restrictions on their physical locations attempting to view and interact with the same Internet content (*e.g.*, website or application) is a human activity that only came into existence upon the invention of computer networks and the Internet.[3]

[3] In light of this, the present case is easily distinguishable from many of the Federal Circuit cases cited by Intuit in support of its contention that the asserted claims are directed to an abstract idea. *See* ECF No. 16-1 at 9, 13. In many of the cases cited by Intuit, the Federal Circuit found that the claims at issue were directed to an abstract idea because the claims simply automated or computerized conventional human processes that existed well before the advent of computers and the Internet. *See Intell. Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1330 (Fed. Cir. 2017) ("Remotely accessing and retrieving user-specified information is an age-old practice that existed well before the advent of computers and the Internet."); *Intell. Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1314 (Fed. Cir. 2016) ("[I]t was long-prevalent practice for people receiving paper mail to look at an envelope and discard certain letters, without opening them, from sources from which they did not wish to receive mail based on characteristics of the mail. The list of relevant characteristics could be kept in a person's head. . . . The patent merely applies a well-known idea using generic computers . . . ."); *Repifi Vendor Logistics, Inc. v. IntelliCentrics, Inc.*, No. 2021-1906, 2022 WL 794981, at *2 (Fed. Cir. Mar. 15, 2022) (finding claims directed to an abstract idea because they merely automated a credentialing process, which is "a well-established business practice" and a "conventional human process"); *LendingTree, LLC v. Zillow, Inc.*, 656 F. App'x 991, 996–97 (Fed. Cir. 2016) (finding claims directed to abstract idea because the claims merely automated the conventional activity of coordinating loans); *see also Pragmatus Telecom, LLC v. Genesys Telecommunications Lab'ys, Inc.*, 114 F. Supp. 3d 192, 200 (D. Del. 2015) (finding claims directed to an abstract idea because they merely automated the well-established process of connecting customers to call centers); *Content Aggregation Sols. LLC v. Blu Prod., Inc.*, No. 316CV00527BENKSC, 2016 WL 6995490, at *5 (S.D. Cal. Nov. 29, 2016) ("The patent claims a process that humans have long performed, but implements it on a generic Internet-connected device used in its ordinary capacity."). Two people on two separate display/devices attempting to view and interact with the same Internet content is not an

Intuit also argues that that it is improper to characterize the focus of the asserted claims as addressing the bandwidth issues of the prior art because nowhere does the claim language recite the words "bandwidth." ECF No. 22 at 7. The Court rejects this argument. The Federal Circuit has repeatedly explained that in performing the step one direct to analysis, courts should consider the claim language "in light of the specification." *Yu*, 1 F.4th at 1043; *accord TecSec*, 978 F.3d at 1292; *Enfish*, 822 F.3d at 1335; *see CardioNet*, 955 F.3d at 1372–73 ("In determining what the claims are directed to and whether they are directed to an abstract idea, a court may well consult the plain claim language, written description, and prosecution history."). Here, the specification details the need for simultaneous viewing of and interacting with Internet content in real-time, and the bandwidth and processing problems of the current prior art methods. *See* '591 Patent col. 2 ll. 5–31. The specification explains that the claimed invention minimizes these bandwidth and processing issues by utilizing a synchronization server to administer a synchronized browsing session. *See id.* at col. 2 ll. 51–60, col. 5 ll. 22–25. And this specific technologic

age-old conventional human process that exists outside the realm of computer networks. It is a process that only came into existence with the advent of computers and the Internet.

In addition, for similar reasons, the present case is also easily distinguishable from the Federal Circuit cases cited by Intuit holding that mere automation of manual processes that can be performed by a human with a pen and paper are abstract ideas. *See* ECF No. 16-1 at 11 (citing *Univ. of Fla. Rsch. Found., Inc. v. Gen. Elec. Co.*, 916 F.3d 1363, 1367 (Fed. Cir. 2019); *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017)); ECF No. 22 at 5-6 (same). Intuit fails to provide any explanation of how a human with a pen and paper would be able to simultaneously display content on two separate electronic devices in real-time and allow for simultaneous interaction with that content by both devices.

Finally, the Court does not find persuasive Intuit's reliance on the district court cases *Pragmatus Telecom, LLC v. Genesys Telecommunications Laboratories, Inc.*, 114 F. Supp. 3d 192 (D. Del. 2015), and *Williamson v. Citrix Online, LLC*, 212 F. Supp. 3d 887, 897 (C.D. Cal. 2016). *See* ECF No. 16-1 at 9. Both cases are pre-*Enfish* non-binding district court decisions, and the Court declines to follow the analysis presented in those decisions.

solution is presented in the claim language of the asserted claims as all the asserted claims encompass "a synchronized browsing session administered by a synchronization server." *Id.* at col. 22 ll. 52–53, col. 23 ll. 33–35; '145 Patent col. 22 ll. 62–64, col. 23 ll. 37–38; *see also, e.g.*, '448 Patent col. 23 ll. 31–34, col. 24 ll. 51–55. As such, that the focus of the asserted claims is addressing the bandwidth and processing issues of the prior art via use of a synchronization server is well supported by the intrinsic record.[4]

Further, Intuit argues that the asserted claims are directed to an abstract idea because even if they are focused on addressing bandwidth and processing issues, the claims fail to sufficiently describe how to achieve the solution in a non-abstract way. ECF No. 1-1 at 14 (citing *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017)). Intuit contends that the asserted claims merely recite results-focused functional language without offering any specific mechanism or technologic solution that confines the claims to a particular solution to an identified problem. *Id.* at 14–15. The Court disagrees.

The specification of the patents-in-suit explains that the claimed invention minimizes the bandwidth and processing issues of the prior art by utilizing a

[4] The Court acknowledges Federal Circuit precedent explaining that "while the specification may help illuminate the true focus of a claim, when analyzing patent eligibility, reliance on the specification must always yield to the claim language in identifying that focus." *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1346 (Fed. Cir. 2019) (quoting *ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 766 (Fed. Cir. 2019)). But, here, there is no claim language to which the specification must yield. Rather, the specification consistent with the claim language explains that the claimed invention utilizes a synchronization server to administer a synchronized browsing session. The specification merely provides additional information to explain how this utilization of a synchronization server minimizes the bandwidth and processing problems of the prior art methods. It is entirely permissible for the Court to rely on language in the specification for this purpose. *See ChargePoint*, 920 F.3d at 767 ("The 'directed to" inquiry may . . . involve looking to the specification to understand 'the problem facing the inventor' and, ultimately, what the patent describes as the invention.") (quoting *TLI Commc'ns*, 823 F.3d at 612).

synchronization server to administer a synchronized browsing session as opposed to the current prior art methods of desktop or screen sharing. *See* '591 Patent col. 2 ll. 18–31, col. 2 ll. 51–60, col. 5 ll. 22–25. The asserted claims then provide specific guidance on how precisely the "synchronization server" interacts with the two electronic devices (the host device and the guest/invitee device) to achieve the claimed "synchronized browsing session." *See, e.g.*, *id.* at col. 22 ll. 55 to col. 23 ll. 2; '145 Patent col. 22 ll. 65 to col. 23 ll. 15; '448 Patent col. 23 ll. 33 to col. 24 ll. 8. As such, the asserted claims offer a specific technologic solution/mechanism—utilization of a synchronization server—to address the identified problems with the prior art.[5]

In sum, the asserted claims are directed to a specific solution that is rooted in computer technology to overcome a problem specifically arising in the realm of computer networks. As such, the asserted claims are not directed to an abstract idea. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (finding claims

[5] Because the asserted claims offer a specific concrete technologic solution to the problem identified by the patents-in-suit, the present case is distinguishable from the Federal Circuit's decision in *In re Greenstein*, 778 F. App'x 935 (Fed. Cir. 2019), cited by Intuit. ECF No 16-1 at 9; *see Greenstein*, 778 F. App'x at 938 (finding claims directed to abstract idea because they "do not provide any concrete solution" and instead "provide functional, results-oriented limitations"). This also makes the present case distinguishable from the Federal Circuit's decision in *Sensormatic Elecs., LLC v. Wyze Labs, Inc.*, No. 2020-2320, 2021 WL 2944838 (Fed. Cir. July 14, 2021). In *Sensormatic*, the Federal Circuit rejected the patentee's contention that the claimed invention's improvements to bandwidth rendered the claims at issue not directed to an abstract idea. *Id.* at *3. The Federal Circuit explained: "dual encoding is itself abstract. The concept of encoding or decoding image data is abstract, even if for the purpose of transmitting files to devices with less memory or bandwidth or by transcoding data into multiple formats." *Id.* In this passage, the Federal Circuit explained that implementing an abstract idea to improve/reduce bandwidth still leaves the claims directed to an abstract idea. In contrast, in this case, the asserted claims do not implement an abstract idea to achieve the purported bandwidth improvements. Rather, the asserted claims utilize a specific, concrete technological component—a synchronization server—to achieve the purported bandwidth and processing improvements.

not directed to an abstract idea where "the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks"); *Uniloc*, 957 F.3d at 1307 ("We have routinely held software claims patent eligible under *Alice* step one when they are directed to improvements to the functionality of a computer or network platform itself."); *SRI Int'l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1303 (Fed. Cir. 2019) (finding claims not directed to an abstract idea where the claims "are directed to using a specific technique . . . to solve a technological problem arising in computer networks"); *Packet Intel. LLC v. NetScout Sys., Inc.*, 965 F.3d 1299, 1309–10 (Fed. Cir. 2020) (finding claims not directed to an abstract idea where "the claimed invention presented a technological solution to a technological problem"); *Data Engine*, 906 F.3d at 1011 ("[U]nlike ineligible claims that merely 'collect, organize, and display information on a generic display device,' claim 12 recites 'a specific improvement to the way computers operate.'") (cleaned up); *Enfish*, 822 F.3d at 1339 ("[T]he claims are directed to a specific implementation of a solution to a problem in the software arts. Accordingly, we find the claims at issue are not directed to an abstract idea."). Because the asserted claims are not directed to a patent-ineligible concept under step one of the § 101 inquiry, "the claims satisfy § 101 and [the Court] need not proceed to the second step." *CardioNet*, 955 F.3d at 1368 (citation omitted); *see Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016) ("If the answer [to the step one inquiry] is no, the inquiry is over: the claim falls within the ambit of § 101.").

Accordingly, Intuit has failed to demonstrate that the asserted claims are invalid under § 101, and, therefore, the Court denies Intuit's motion to dismiss Samesurf's Complaint for failure to state a claim. *See, e.g.*, *Confident*, 2018 WL 539166, at *7 (denying Rule 12(b)(6) motion to dismiss where defendants failed to demonstrate that the asserted claims are directed to an abstract idea).

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IV. Conclusion

For the foregoing reasons, the Court denies Defendant Intuit's Rule 12(b)(6) motion to dismiss Plaintiff Samesurf's complaint. ECF No. 16. Intuit must file an answer to Samesurf's Complaint within fourteen (14) days from the date this order is filed. *See* Fed. R. Civ. P. 12(a)(4)(A).

IT IS SO ORDERED.

Dated: January 10, 2023

Hon. Robert S. Huie
United States District Judge