

IPR2022-00342

Petitioner's Reply to Patent Owner's Response

Filed on behalf of Intuit Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTUIT INC.,  
Petitioner

v.

SAMESURF, INC.,  
Patent Owner.

*Inter Partes* Review No. IPR2023-00342  
Patent 8,527,591 B2

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**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE**

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**EXHIBIT LIST (37 C.F.R. § 42.63(e))**

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                                                                                                                         |
|----------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1001           | U.S. Patent No. 8,527,591                                                                                                                                                                                                                                                                                  |
| 1002           | File History of U.S. Patent No. 8,527,591                                                                                                                                                                                                                                                                  |
| 1003           | Declaration of Henry Lieberman                                                                                                                                                                                                                                                                             |
| 1004           | Curriculum Vitae of Henry Lieberman                                                                                                                                                                                                                                                                        |
| 1005           | International Patent Pub. No. WO 00/48110 to Lebrun et al. ("Lebrun")                                                                                                                                                                                                                                      |
| 1006           | U.S. Patent Pub. No. 2005/0033656 to Wang et al. ("Wang")                                                                                                                                                                                                                                                  |
| 1007           | U.S. Patent Pub. No. 2005/0021626 to Prajapat et al. ("Prajapat")                                                                                                                                                                                                                                          |
| 1008           | "NCSA Mosaic, Project Profile," University of Illinois, National Center for Supercomputing Applications (available at: <a href="https://www.ncsa.illinois.edu/research/project-highlights/ncsa-mosaic/">https://www.ncsa.illinois.edu/research/project-highlights/ncsa-mosaic/</a> )                       |
| 1009           | "Netscape Communications Corp.," Henry R. Norr, August 28, 2017, Encyclopedia Britannica, Inc. (available at: <a href="https://www.britannica.com/topic/Netscape-Communications-Corp">https://www.britannica.com/topic/Netscape-Communications-Corp</a> )                                                  |
| 1010           | "50 Years of Email," cloudHQ, April 6, 2021 (available at: <a href="https://www.prnewswire.com/news-releases/50-years-of-email-301262676.html">https://www.prnewswire.com/news-releases/50-years-of-email-301262676.html</a> )                                                                             |
| 1011           | "The History of Email: Major Milestones from 50 Years," Kasey Steinbrinck, January 28, 2021, Email on Acid Ina Fried, (available at: <a href="https://www.emailonacid.com/blog/article/email-marketing/history-of-email/">https://www.emailonacid.com/blog/article/email-marketing/history-of-email/</a> ) |
| 1012           | "10 Instant Messaging Services that Used to Be Popular," Elise Moreau, May 3, 2021, Lifewire Tech for Humans (available at: <a href="https://www.lifewire.com/once-popular-old-instant-messaging-services-3486135">https://www.lifewire.com/once-popular-old-instant-messaging-services-3486135</a> )      |

| Exhibit | Description                                                                                                                                                                                                                                                                                                                        |
|---------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1013    | "Timeline of Social Media," Wikipedia (available at: <a href="https://en.wikipedia.org/wiki/Timeline_of_social_media">https://en.wikipedia.org/wiki/Timeline_of_social_media</a> )                                                                                                                                                 |
| 1014    | "Hyperlink," Wikipedia (available at: <a href="https://en.wikipedia.org/wiki/Hyperlink">https://en.wikipedia.org/wiki/Hyperlink</a> )                                                                                                                                                                                              |
| 1015    | U.S. Patent No. 5,708,780 to Levergood, et al.                                                                                                                                                                                                                                                                                     |
| 1016    | "Session Identification URI," W3C Working Draft WD-session-id-960221, w3 Org (available at: <a href="https://www.w3.org/TR/WD-session-id.html">https://www.w3.org/TR/WD-session-id.html</a> )                                                                                                                                      |
| 1017    | "Giving Web a Memory Cost Its Users Privacy," John Schartz, September 4, 2001, New York Times (available at: <a href="https://www.nytimes.com/2001/09/04/business/giving-web-a-memory-cost-its-users-privacy.html">https://www.nytimes.com/2001/09/04/business/giving-web-a-memory-cost-its-users-privacy.html</a> )               |
| 1018    | "GroupWeb: A WWW Browser as Real Time Groupware," Saul Greenberg and Mark Roseman, CHI '96 ACM Conference on Human Factors in Computing Systems, April 13-18, 1996 (available at: <a href="https://dl.acm.org/doi/pdf/10.1145/257089.257317">https://dl.acm.org/doi/pdf/10.1145/257089.257317</a> )                                |
| 1019    | "Let's Browse: A Collaborative Web Browsing Agent," IUI '99: ACM Proceedings of the 4th International Conference on Intelligent User Interfaces, December 1998 (available at: <a href="https://dl.acm.org/doi/10.1145/291080.291092">https://dl.acm.org/doi/10.1145/291080.291092</a> )                                            |
| 1020    | "Letizia: An Agent that Assists Web Browsing," Henry Lieberman, <i>International Joint Conference on Artificial Intelligence</i> , 1995 (available at: <a href="https://web.media.mit.edu/~lieber/Lieberary/Letizia/Letizia-AAAI/Letizia.html">https://web.media.mit.edu/~lieber/Lieberary/Letizia/Letizia-AAAI/Letizia.html</a> ) |
| 1021    | U.S. Patent No. 6,353,822 to Lieberman                                                                                                                                                                                                                                                                                             |
| 1022    | "Google Docs," Wikipedia (available at: <a href="https://en.wikipedia.org/wiki/Google_Docs">https://en.wikipedia.org/wiki/Google_Docs</a> )                                                                                                                                                                                        |

| Exhibit | Description                                                                                                                                                                                                                                                                     |
|---------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1023    | "Google Announces Google Docs & Spreadsheets," October 11, 2006, Google Press Release, (available at: <a href="http://googlepress.blogspot.com/2006/10/google-announces-google-docs_11.html">http://googlepress.blogspot.com/2006/10/google-announces-google-docs_11.html</a> ) |
| 1024    | "The History of JavaScript: Everything You Need to Know," T.J. DeGroat, August 19, 2019, Springboard (available at: <a href="https://www.springboard.com/blog/data-science/history-of-javascript/">https://www.springboard.com/blog/data-science/history-of-javascript/</a> )   |
| 1025    | "Adobe Flash," Wikipedia (available at: <a href="https://en.wikipedia.org/wiki/Adobe_Flash">https://en.wikipedia.org/wiki/Adobe_Flash</a> )                                                                                                                                     |
| 1026    | "What Does AJAX Even Stand For?," Jay Hoffman, March 4, 2019, The History of The Web (available at: <a href="https://thehistoryoftheweb.com/what-does-ajax-even-stand-for/">https://thehistoryoftheweb.com/what-does-ajax-even-stand-for/</a> )                                 |
| 1027    | <b>RESERVED</b>                                                                                                                                                                                                                                                                 |
| 1028    | Declaration of Michael J. Sacksteder in Support of Petitioner's Motion for Pro Hac Vice Admission of Michael J. Sacksteder Pursuant to 37 C.F.R. § 42.10(c)                                                                                                                     |
| 1029    | Declaration of Geoffrey R. Miller in Support of Petitioner's Motion for Pro Hac Vice Admission of Geoffrey R. Miller Pursuant to 37 C.F.R. § 42.10(c)                                                                                                                           |
| 1030    | Declaration of Daniel Ledesma in Support of Petitioner's Motion for Pro Hac Vice Admission of Daniel Ledesma Pursuant to 37 C.F.R. § 42.10(c)                                                                                                                                   |
| 1031    | "Microsoft Computer Dictionary 5th Edition," May 01, 2002, Microsoft Press                                                                                                                                                                                                      |
| 1032    | Claim 1 from each patent (as relied on during Friedman deposition)                                                                                                                                                                                                              |
| 1033    | Transcript of Deposition of Stacy Friedman, taken November 15, 2023                                                                                                                                                                                                             |
| 1034    | Declaration of Henry Lieberman in Support of Petitioner's Reply to Patent Owner's Response                                                                                                                                                                                      |

| <b>Exhibit</b> | <b>Description</b>                                                                                     |
|----------------|--------------------------------------------------------------------------------------------------------|
| 1035           | U.S. Patent Publication No. 2002/0143878 to Birnbaum et al. ("Birnbaum")                               |
| 1036           | Declaration of Henry Lieberman in Support of Petitioner's Opposition to Patent Owner's Motion to Amend |

**I. INTRODUCTION**

Samesurf ("PO"), in its Patent Owner's Response ("POR"), cannot dispute that the claim limitations are rendered obvious by the prior art. So, in an attempt to avoid a clear finding of unpatentability, they attempt to re-write the claims under an improper and unsupported claim construction, distort the plain teachings of the specification, concoct an irrelevant attorney-argument theory about a "middleman" server, and apply the wrong standard for obviousness. The Board should disregard these arguments and find the challenged claims unpatentable.

**II. PO MISREPRESENTS THE SPECIFICATION AND PRIOR ART DISCLOSURES**

The POR relies on two incorrect representations of the '591 patent specification and corresponding prior art. These misrepresentations inform the errors in PO's analysis and must be corrected.

*First*, PO's repeated assertion that the '591 patent specification disparages "page sharing" as too "resource intensive" is wrong. *See* POR, 2-11 (citing Ex. 1001, 2:23-27). The '591 specification makes no mention of "page sharing" nor does it disparage such technology. Rather, in its discussion of background technology, it describes "desktop or screensharing" as a preexisting co-browsing technology. Ex. 1001, 2:23-27; *see also* Ex. 1033, 96:4-97:21 (PO expert admitting same). "[D]esktop or screensharing," works by "broadcasting continuous screenshots of the host screen in large files or packets," and "require[s] high levels

of bandwidth and computer processing power.” *Id.* As a result, according to the specification, it is “inadequate for enabling larger groups to all view and fully interact with interactive content in a simultaneous manner.” *Id.* 2:23-31; Ex. 1034, ¶5.

“Desktop or screensharing,” however, is irrelevant to the present inquiry. No asserted prior art reference discloses or describes any technology that involves “broadcasting continuous screenshots of the host screen.” Lebrun describes a collaborative web browsing system that works by creating and participating in a group surfing session on a group surfing server, where that server invites web clients to join the group session and delivers webpages, or a progression of webpages, as selected by the controlling client, to each participating web client. Ex. 1005, 32:1-31, 35:5-8, 35:24-25, 36:5-17, 44:5-13, Fig. 4. Prajapat describes a collaborative browsing system where multiple client browsers can co-browse one or more webpages together using web media servers as the synchronizing service in a joint browsing session. Once the joint session is set up, any of the browsers can ask their servers for web pages, and the servers work together to coordinate the retrieval and display of the requested content on each browser. Ex. 1007, [0009-10], [0012], [0016-17], [0019-21], [0022-26]. Wang provides for a collaborative browsing system that works through a synchronization server. Ex. 1006, [0063]. The system allows a user to request a group session from the server, which then creates the group

browsing session, gives it an identifier, and sends an invitation with a special URL that invited users can click to join. *Id.* [0015], [0046-48]. Once users join, the synchronization server ensures that everyone sees the same web pages at the same time on their devices. *Id.*, [0015], [0018-19], [0045-49], [0054-55].

*Second*, PO's contention that the '591 patent requires (1) that "the host and guest devices each access the website server on their own," and (2) that "the 'synchronization server' does not need to communicate with a website server to achieve synchronization," and thereby eliminates problems with so-called "middleman" servers, is also incorrect. POR, 2-6.

The '591 patent does not identify or describe any "middleman" server or disparage the use of a server to relay webpage information to or from a webpage server. *See generally* Ex. 1001. The '591 patent only distinguishes its disclosures from "screensharing" systems that rely on "broadcasting continuous screenshots of the host screen," which as noted above, is not part of Petitioner's prior art analysis.

The claims also do not recite any architecture that would solve any problems purportedly caused by "middleman" servers. Contrary to PO's assertions, challenged claims do not recite any limitation that requires that *all* "web content [be] served to the host device and the guest device by the web server" and the synchronization server *cannot* deliver web content to the guest device, as PO contends. POR, 11. Rather, the claims recite only that the guest device "operat[es]

an application ***based on*** said web browsing interaction data received from said synchronization server to access a website server.” Ex. 1001, claim 1. And the only thing the claims say about the host device is that it needs to be associated with a “session identifier” and that it “has initiated the session invitation.” *Id.*; Ex. 1034, ¶6.

### III. PO'S INCORRECT & UNSUPPORTED CLAIM CONSTRUCTION

#### A. Synchronized Browsing Session

Neither the claims nor the specification require any synchronous sharing, despite PO's arguments to the contrary. Throughout the POR, PO relies on the term “synchronized browsing session” (“SBS”) as the basis to assert that the claims require “the ‘host device’ and the ‘guest device’ [to be] synchronously sharing the same web browsing experiences and in real time.” POR, 1-2; *see also id.*, 15-16. Not so, for at least two reasons.

First, the claims do not require “synchronously sharing the same web browsing experiences.” As admitted by PO's expert Stacy Friedman, independent claims 1 and 10 only recite the SBS in the initial elements establishing the session and notifying the guest that it has joined (1[pre]-1[c] and 10[pre]-10[b.iii]). Ex. 1033, 193:19-20. The Board preliminarily found that both grounds rendered these claim limitations obvious, and the POR did not refute that finding. DI 16-21, 36-39. Nor did PO argue that the preamble is limiting. The challenged limitations (1[d]-1[e], 10[b.iv]-10[b.v]) do not recite the synchronized browsing session ***or any synchronous sharing*** between the host and guest, a fact that even Petitioner's expert

concedes. Ex. 1033, 193:24-194:8; *see also* Ex. 1034, ¶¶7-8. Indeed, during his deposition Mr. Friedman admitted that he had not evaluated whether “synchronized browsing session” and “real-time” were co-extensive and that he’d provided no claim construction of either term. *Id.*, 139:7-22, 197:9-198:19, 206:10-208:15.

Second, according to the specification, all that is required to “establish” a “synchronized browsing session” is that (1) the host device transmit a request to the synchronization server and (2) the synchronization server responds with a confirmation including a session identifier. Ex. 1001, 10:10-14. Establishing a SBS does not even require that the guest device has joined: “Once the synchronized browsing session *is established*,” the host can transmit a session invitation to prospective guest devices. *Id.*, 10:19-28 (emphasis added); FIG. 2(a). No synchronized transmission of data between the host and guest(s) is required. Ex. 1033, 229:23-230:8; Ex. 1034, ¶¶9-10. Mr. Friedman agreed that “in order to understand what claim terms mean, looking at the specification is an important source of information.” Ex. 1003, 115:18-20. Therefore, the claims do not require “the ‘host device’ and the ‘guest device’ [to be] *synchronously sharing the same web browsing experiences* and in real time” as PO alleges. POR, 1-2, 15-16.

#### **B. “Synchronized”**

There is no requirement in the claims that any content be “synchronized” as between the host and guest device, nor viewed “simultaneously” (or near

simultaneously), nor “coordinated” in any manner. PO’s expert admitted as much in his deposition. *See* Ex. 1033, 193:19-195:2; 159:3-160:22; 165:1-15. Indeed, while admitting that the internet is “laggy,” Mr. Friedman could not answer how a POSITA would be able to tell whether communications would be too laggy to be considered “synchronized.” Ex. 1033, 216:12-217:7, 220:14-19, 221:6-11.

Yet PO repeatedly criticizes the applied references as *not disclosing* synchronized browsing or an SBS, which it alleges “requires that the host and guest devices see similar pages at a *synchronized* timeframe.” POR, 47 (emphasis added). For example, the POR argues that in Lebrun when a second “web client is not *necessarily* viewing what the controlling web client is viewing, [] the browsing session is no longer synchronized.” POR, 48 (emphasis in original). Likewise, PO attempts to distinguish Prajapat by arguing “[t]here 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.” POR, 58 (emphasis added); *see also id.*, 63-64 (arguing Prajapat’s transmissions are not “‘simultaneous,’ in ‘real-time,’ or temporally coordinated in any manner”).

Nothing in the claim recites *how* the synchronized browsing session is administered by the synchronization server. Patent Owner does not even attempt to tie this purported “simultaneous,” or “real time sharing,” to any particular claim limitation, tacitly conceding there is no such requirement. These arguments attempt

to distract attention from the fact that the claims recite *none of* these terms. The term “synchronized” appears in the claims only in the context of a “synchronized browsing session,” as discussed above. Ex. 1034, ¶¶11-12.

Even if the claims required content to be synchronized – which they do not – the plain and ordinary meaning of that term is “occurring at the same time,” a definition supported by both Dr. Lieberman’s testimony and The Microsoft Computer Dictionary, 5<sup>th</sup> Edition. See Ex. 1031, 506; Ex. 1034, ¶10. Despite the term “synchronized” being the basis for PO’s argument, PO’s expert admitted he did not construe the term. Ex. 1033, 61:22-62:4. Indeed, Mr. Friedman refused to define “synchronized” when questioned and refused to provide an opinion whether the dictionary definition was a reasonable definition. *Id.*, 36:11-21, 56:9-60:12, discussing Ex. 1031, 506. Mr. Friedman’s position during his deposition was only that a POSITA would understand the term’s meaning, without proposing any definition. Ex. 1033, 36:11-21.

PO provides no reason that a POSITA would construe the term “synchronized” in Prajapat differently from the term’s meaning in the ’591 patent specification. Ex. 1034, ¶11. Nevertheless, Mr. Friedman would not take a position on whether the meaning of the term would be the same as between the two:

Q. Does the disclosure of synchronization in paragraph 30 of Prajapat disclose the kind of synchronization that is recited in the claims of the three Samesurf patents?

## Petitioner's Reply to Patent Owner's Response

A: That's an interesting question. So Prajapat uses the terms or the words "synchronization" or "sync," and it also uses the words "co-browse," or word "co-browse," and so do the specifications of the three same Samesurf patents. But it's not entirely clear whether those two uses of those two terms are coextensive. And I haven't, in my – in my opinion, I haven't endeavored to provide a sort of comparison of the two sets of terms from one reference to the other to examine whether they are, in fact, coextensive. So the short answer is I can't answer your question yet because I haven't done that analysis.

Ex. 1033, 125:6-126:23 (objection omitted); *see also id.*, 210:24-211:1 (testifying that he did not compare the uses).

Notably, the dictionary definition of "synchronized" as "occurring at the same time" is very similar to that of the term "dynamic" as "occurring immediately *and concurrently*." *See* Ex. 1031, 181 (emphasis added). This similarity is important because the term "dynamic" appears throughout both the Lebrun and Prajapat references. Ex. 1034, ¶10. *Indeed, when asked whether there are other ways to synchronize* users' web browsing, Mr. Friedman replied that "there are several other examples in the background of the patent." Ex. 1033, 51:19-52:6. Thus, even PO's own expert admits that the examples in the background – which it says are similar to the asserted references – are other ways to *synchronize* users' web browsing.

PO relies on its own implied, incorrect construction throughout the POR. As a result, if the Board agrees with Petitioner's construction, PO will have presented no challenge to Petitioner's analysis that applies the correct construction.

#### **IV. LEBRUN AND WANG RENDER THE CLAIMS OBVIOUS (GROUND 1)**

##### **A. That Ground 1 Discloses Limitations [1.pre]-[1.c] Is Not In Dispute**

Only limitations [1.d] and [1.e] are in dispute.<sup>1</sup> PO did not challenge Petitioner's arguments for any other claim limitations, thus arguments about other limitations should be deemed waived. Paper 13, 10 ("Patent Owner is cautioned that any arguments not raised in the response may be deemed waived."); *see also* Ex. 1033, 70:22-71:9.

##### **B. Lebrun Discloses [1.d]**

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

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<sup>1</sup> With respect to independent claim 10, the POR says only that it applies to an apparatus and "[t]he arguments presented regarding independent claim 1 also apply to independent claim 10." POR, 12.

The Board noted that Lebrun's multiple group-surfing sessions embodiment (beginning at Ex. 1005, 43) explicitly discloses the second web client receiving URLs, and that PO wrongly conflated this embodiment with the single group-surfing session embodiment (Ex. 1005, 35:10-15) in Lebrun to reach the conclusion that this (multiple) embodiment does not disclose sending cookies. DI, 25-26. The POR's several strawman arguments do not refute this finding.

First, PO misconstrues Lebrun's use of the word "only" in this embodiment, and incorrectly concludes the Board "failed to realize" it said "only." POR, 41-42; *see also id.*, 47-48. The Board specifically quoted the same sentence as PO with the word "only" in it in forming its conclusion:

Lebrun also details that "[i]n alternative embodiments, the second web client 110 can receive **only** a list of pointers (such as URLs) to those pages presented during the group-surfing session, dynamically updated when a new page is added." *Id.* at 43:20–22. Unlike the alternative, "no cookies" embodiment discussed above, Lebrun does not provide any indication that this alternative embodiment is used only in the absence of cookies. *See id.* (making no mention of the presence or absence of cookies).

DI, 25 (emphasis added). Moreover, read in context, it is clear that "only" pointer/URLs being received by does not mean that URLs are received **to the exclusion of** any other information – PO has manufactured that reading of this sentence. Rather, pointers/URLs are received at the second web client **instead of**

*the pages themselves* as in the preferred embodiment. *See* Ex. 1005, 43:13-22; Ex. 1034, ¶13.

Second, PO's selective reading of this embodiment ignores that the "system operation" (method) of FIG. 4 – which is not limited to one embodiment – specifically discloses the controlling web client sending the group-surfing server website cookies. Ex. 1005, 49:1-3; Ex. 1034, ¶13. PO cites only to Ex. 1005, 46:7-11, of *the same figure description* (of FIG. 4), ignoring the later text about cookies. *See* POR, 37-39.

Next, PO's strawman argument fails that the devices must be viewing the same content. POR, 47-48. PO argues that the (added) web client is "not *necessarily* viewing what the controlling web client is viewing" and "the browsing session is no longer synchronized." *Id.* As discussed *supra* regarding the construction of synchronized, *nothing in the claims* recites or requires the web clients to be *viewing the same content*. *See supra* Section III.B. Moreover, even if the claims had recited "synchronized" content, Lebrun shows it. PO left out the final clause of the sentence quoted (without citation), which says that the pointers are "*dynamically* updated when a new page is added." Ex. 1005, 43:22 (emphasis added). As discussed above, "dynamically" is known in the art to mean "occurring immediately and concurrently," which is nearly synonymous with "synchronous," which means "occurring at the same time." *See* Ex. 1031; *supra* Section III.B. In other words,

“dynamically” updating pages as they are added renders obvious *synchronously* updating them. Ex. 1034, ¶14. Conclusory attorney-argument [is] insufficient in response to expert testimony. *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, IPR2016-00393, Paper 62, 36-37 (P.T.A.B. June 23, 2017), citing *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

PO sets up several other strawman arguments, all of which fail. Regarding cookies, the POR argues that cookies, disclosed as “stored by the group-surfing server 140 at each participating web client 110” really means “storing in the database for each entry associated with the participating web client—not at the web client itself.” POR, 40-41 (quoting Ex. 1005, 35:11-15). Not so. Indeed, Lebrun describes that the web site 130 sends a cookie directly to the web client 110, and that cookie is made available to the personalization server 140. Ex. 1005, 26:8-18; *see also id.*, 2:2-4, 7-9, 5:30-32, 41:9-11, 49:1-3, 58:6-10 (cookie stored at the web client 110). Likewise, PO’s argument that Lebrun doesn’t show a single set of cookies received by each of the participating web clients also fails, since this is not a requirement of the claims. POR, 39; Ex. 1034, ¶15.

Other arguments that PO makes about Lebrun lacking unclaimed features similarly are irrelevant. The claims do not require that the URL “relates to a website being accessed in real-time by a host device” (POR, 43), only that “the data” so relates; the URL is only required to be a URL “of the website.” Ex. 1001, claim 1.

Nor would it matter if Lebrun's web clients did not, as PO argues, "directly access the website server" (POR, 44), because doing so *is not claimed*. Ex. 1001, claim 1. Regardless, Lebrun's web clients do. *See* Ex. 1005, 46:1-2.

Even under PO's incorrect construction, Lebrun discloses this limitation. In Lebrun, the host device may cause the synchronization server to send a webpage to the guest device "without any multimedia elements (such as embedded sound, images, or program fragments)," which is later populated directly from the website. Ex. 1005, 45:31-46:2.

PO has provided no credible rationale or evidence to refute the Board's preliminary finding that Lebrun discloses this limitation. These arguments apply equally to claim 10.

### **C. Lebrun Discloses [1.e]**

PO's attempt to construe this claim limitation with more specificity than is recited fails. PO argues that the article "the" that precedes "data received" means that *all of* the data received – e.g., the URL and the cookie information – must be used to operate the browser. POR, 48. This reading does not follow from the plain language of the claims. PO then returns to its failed argument from [1.d] that Lebrun's "only" pointers embodiment excludes sending cookies. *See supra* Section IV.B; DI, 25.

PO's position does not reflect the limitation as claimed or any reasonable reading thereof. The limitation recites: "operating a browser by the guest device ***based on the data received*** from the synchronization server." Ex. 1001, claim 1 (emphasis added). "Based on" provides substantial breadth to the possible use of the data; it certainly does not require that ***all of*** the data received be used. Ex. 1034, ¶16. Even assuming PO's reading were correct – which it is not – Lebrun meets it, for the same reasons described *supra* regarding limitation [1.d]. Again, PO has provided no credible rationale or evidence to refute the Board's preliminary finding that Lebrun discloses this limitation. These arguments apply equally to claim 10.

#### **D. Lebrun Contemplates Combining Embodiments**

Contrary to PO's argument that Lebrun's embodiments should not be combined, Lebrun explicitly contemplates considering variations of the different embodiments. As a preliminary matter, PO ***does not address*** that it made this argument in its POPR, but the Board found Petitioner's showing sufficient for institution. DI 22-23, 26.

PO misunderstands the motivation to combine inquiry. PO's contention that a POSITA would not be motivated to combine Lebrun and Wang is based on an incorrect legal analysis. PO contends that Lebrun "teaches away" from Wang because an embodiment of Lebrun sends a webpage without multimedia features, whereas Wang purportedly is "designed to store a snapshot of page data locally."

POR, 70. “Teaching away” refers to criticizing or generally discouraging an approach. *In re Chaganti*, 554 F. App'x 917, 921 (Fed. Cir. 2014). Not, as PO and its expert contend, describing or teaching different approaches in the same field. Thus, to the extent Lebrun and Wang teach different methods of storing data, that does not show “teaching away” nor any reason a POSITA would not be motivated to combine their disclosures. *See* POR, 77.

In the Summary section, Lebrun contemplates “an improved technique for group access to web sites,” prior to delving into the various embodiments thereof. Ex. 1005, 7:3-16; *see also* Ex. 1003, ¶277 (p. 107). Lebrun explicitly notes that “Although preferred embodiments are disclosed herein, many variations are possible which remain within the concept, scope, and spirit of the invention, and *these variations would become clear to those skilled in the art after perusal of this application.*” Ex. 1005, 75:18-20 (emphasis added); *see also id.* 37:21-25 (“many variations”), 44:1-3 (“could be performed in a different sequence or some combination thereof”). Indeed, the “multiple group surfing channels” (Ex. 1005, 43:5) that PO calls out as a discrete embodiment is actually a sub-heading under the heading “*variations on* the group-serving session.” Ex. 1005, 37:19 (emphasis added). Ex. 1034, ¶17. Moreover, the Federal Circuit has held that “[c]ombining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness.” *Boston Scientific v. Cordis*, 554 F.3d 982, 991 (Fed.

Cir. 2009). Since Lebrun *explicitly contemplates variations* of the different embodiments, the case law PO cited – finding that a motivation is required to combine embodiments within a single reference – is rendered moot. POR, 49-52.

In addition, the POR does not provide any support from Mr. Friedman for its position that the embodiments are allegedly “incompatible.” See POR, 49-52 (no cites to Ex. 2004); see also *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965) (mere attorney argument cannot take the place of evidence in the record, nor can it rebut contrary expert testimony); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). During his deposition, Mr. Friedman admitted that different embodiments can be combined if it makes sense. Ex. 1033, 145:15-23.

Finally, the Federal Circuit has made clear that the motivation to combine analysis is not so rigid such that a POSITA would not be able to use common sense to apply the teachings of one prior disclosure in a different architecture. Indeed, “[t]he inquiry into the existence of a motivation to combine assumes that a skilled artisan is a person of ordinary creativity with common sense, common wisdom, and common knowledge.” *Elekta Ltd. v. ZAP Surgical Sys., Inc.*, 81 F.4th 1368, 1374 (Fed. Cir. 2023) (citing *Fleming v. Cirrus Design Corp.*, 28 F.4th 1214, 1223 (Fed. Cir. 2022)). Thus, an obviousness determination does not always require prior art to expressly state a motivation for every obvious combination. *Id.* Nor does an obviousness showing “require that a particular combination must be the preferred,

or the most desirable, combination described in the prior art in order to provide motivation for the current invention.” *Novartis Pharms. Corp. v. West-Ward Pharms. Int'l Ltd.*, 923 F.3d 1051, 1059 (Fed. Cir. 2019) (citation omitted).

PO has provided no reason why the Board should reconsider its preliminary finding that Ground 1 renders obvious limitations [1.d] and [1.e]. Nor has the POR provided any reasonable explanation why a POSITA would not consider all of the various embodiments in Lebrun when considering the reference as a whole.

**V. PRAJAPAT AND WANG RENDER THE CLAIMS OBVIOUS (GROUND 2)**

**A. That Ground 2 Discloses Limitations [1.pre]-[1.c], [1.e] Is Not In Dispute**

Only limitation [1.d] is in dispute in this Ground. POR, 64-67. PO thus has waived arguments about other limitations or claims.<sup>2</sup> See Paper 13, 10.

**B. Prajapat Discloses Limitation [1.d]**

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

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<sup>2</sup> With respect to independent claim 10, the POR says only that it applies to an apparatus and “[t]he arguments presented regarding independent claim 1 also apply to independent claim 10.” POR, 12.

Prajapat teaches the guest device receiving both URL and cookie information, despite PO's incorrect statements to the contrary. POR, 65-67. Prajapat at [0043] specifically discloses browser 12a sending a request to web content server 18 using, e.g., an HTTP link (URL) and "other suitable information," which information is communicated to web media server 14a, then to web media server 14b, which in turn communicates it to browser 12b. *See* Ex. 1007, [0043]; Pet., 53-54. Throughout Prajapat it is explained that "suitable information" in such a request also may include cookies. *See* Ex. 1007, [0017], [0022], [0036]; *see also* Ex. 1034, ¶18.

PO's arguments to the contrary ignore these clear disclosures and do not provide any rationale for why the Board should reconsider its preliminary finding that Prajapat discloses this limitation. These arguments apply equally to claim 10.

Moreover, Mr. Friedman admitted that he did not dispute in his declaration that Prajapat in combination with Wang discloses all of the claim elements. Ex. 1033, 146:6-21; 147:8-16; 148:14-25.

### **C. Prajapat Contemplates Combining Embodiments**

Similar to in Ground 1, PO repeats its failed argument that Prajapat's embodiments should not be combined. The Board explicitly addressed this argument at institution, disagreeing with PO: "Prajapat expressly indicates that the web page sharing of Figure 3 is the same as that described in the dynamic web page

sharing embodiment of Figures 1 and 2.” DI, 40, citing Ex. 1007, [0047]. PO did not address this finding nor [0047] in its POR.

Additional portions of Prajapat also contemplate that similar processes can be used among the various embodiments. *See, e.g.*, Ex. 1007, [0041] ((regarding FIG. 3) “in a substantially similar manner to that described above with reference to FIGS. 1 and 2.”); [0045]((regarding FIG. 4) “in substantially the same manner as described above with reference to FIGS. 1, 2, and 3.”); Ex. 1034, ¶19. Thus, Prajapat *explicitly ties together* the processes of the various embodiments. *See also Boston Scientific*, 554 F.3d at 991. As noted *supra*, this fact renders moot the case law PO relied upon. *See supra* Section V.C; POR, 67-68. PO has done nothing to undermine the motivation of a POSITA to combine Prajapat and Wang.

## **VI. PO'S EXHIBIT 2005**

PO's unexplained reference to a district court denial of Intuit's motion to dismiss under 35 U.S.C. §101 (POR, 26-27) is irrelevant because that order pertained to a different issue (abstract idea as opposed to obviousness), with different evidence (a question of law on the pleadings as opposed to a factual inquiry on prior art), under a different standard (clear and convincing as opposed to preponderance of the evidence).

## **VII. PO HAS WAIVED ISSUES NOT ADDRESSED IN THE POR**

The Scheduling Order in this case has the usual statement that “Patent Owner is cautioned that any arguments not raised in the response may be deemed waived.”

Paper 13, 10. In addition, arguments from the POPR cannot be incorporated by reference into the POR. *See* 37 CFR § 42.6(a)(3). In particular, PO has waived: (1) whether Dr. Lieberman qualifies as a POSITA<sup>3</sup>; (2) argument regarding Ground 2, element [1.e]; and (3) arguments pertaining to any of limitations [1.pre]-[1.c], [10.pre]-[10.b.iii] and/or *any of* dependent claims 2-9 and 11-18.<sup>4</sup>

### **VIII. PO'S ATTEMPTS TO INCORPORATE BY REFERENCE ARE IMPROPER**

PO repeatedly violates the rules by citing to swathes of its expert declaration to support conclusory statements made in the POR. Doing so is a violation of the rules for at least two reasons. First, PO should not ask Petitioner and the Board “to play archeologist with the record”; “a brief must make all arguments accessible to the judges.” *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 10 (P.T.A.B. Aug. 29, 2014), quoting *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999). Second, papers in an IPR also should not attempt to incorporate by reference arguments made in an expert report. 37 CFR § 42.6(a)(3); *Blackberry Corp. v. Mobilemedia Ideas LLC*, IPR2013-00016, Paper No. 32 at 21 (PTAB Feb. 25, 2014) (attempt to incorporate by reference expert testimony was prohibited);

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<sup>3</sup> Mr. Friedman verified during his deposition that he did not address this topic. Ex. 1033, 29:8-25.

<sup>4</sup> The dependent claims are not addressed at all in the POR.

*Cisco Sys.*, IPR2014-00454, Paper 12 at 9-10 (arguments not made in papers but only by reference to expert declaration not considered by Board).

The POR repeatedly cites to seven to 16 paragraphs of expert testimony as allegedly supporting an argument made in the POR, the most egregious of which cite to *the entire section* of the expert report corresponding to a reference. *See, e.g.*, POR, 43 (citing to ¶¶58-73, which is the entirety of the Lebrun “discussion”); 65 (citing to ¶¶49-54 and ¶¶74-80, the latter of which is the entirety of the Prajapat “discussion”), 69 (citing to ¶¶56-57 and ¶¶81-87, the latter of which is the entirety of the Wang and combination “discussion”). These citations improperly force the reader “to play archeologist with the record” to understand what in these large swaths of cited expert testimony pertain to the arguments in the POR for which they are cited. *Cisco Sys.*, IPR2014-00454, Paper 12 at 10. Moreover, such incorporation by reference “amounts to a self-help increase in the length of the [] brief[.]” *Id.* Thus, arguments not made in the papers, but only by reference to the expert declaration, should not be considered by Board. *Id.*

#### **IX. PO’S EXPERT TESTIMONY IS LIMITED AND NOT SUPPORTED BY EVIDENCE**

As called out in the analysis above, portions of the analysis in the POR are not supported by Mr. Friedman’s expert testimony or other evidence. Mere attorney argument cannot take the place of evidence in the record, nor can it rebut contrary expert testimony. *In re Schulze*, 346 F.2d at 602; *In re Geisler*, 116 F.3d at 1465.

Of the expert testimony relied upon in the POR, the vast majority of Mr. Friedman's opinions consist of only *conclusory assertions* without underlying factual support, and thus they should be given little weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 at 5 (P.T.A.B. Feb. 10, 2023). Indeed, aside from a patent describing cookies at Ex. 1003 ¶37, the relied upon testimony *cites to no authority or exhibits* and on the whole lacks evidentiary support. As a result, Mr. Friedman's testimony should be given little weight.

## **X. CONCLUSION**

For the reasons discussed herein, the Board should find the challenged claims unpatentable.

Dated: December 20, 2023

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**CERTIFICATE OF COMPLIANCE  
WITH TYPE-VOLUME LIMITATION**

Pursuant to 37 C.F.R. § 42.24 *et seq.*, the undersigned certifies that this **Petitioner's Reply to Patent Owner's Response** complies with the 5,600 word type-volume limitation. The Petition contains 5,007 words, excluding the parts of the Reply exempted from the type-volume limitation.

Dated: December 20, 2023

Respectfully submitted,

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**CERTIFICATION OF SERVICE**

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on December 20, 2023, I caused a true and correct copy of the foregoing PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE and Exhibits 1031 – 1034 to be electronically served on Petitioner's lead and backup counsel at the following addresses:

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