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Petitioner's Opposition to Motion to Amend

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner

v.

SAMESURF, INC.,
Patent Owner.

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

PETITIONER'S OPPOSITION TO MOTION TO AMEND

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Exhibit	Description
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: https://www.ncsa.illinois.edu/research/project-highlights/ncsa-mosaic/)
1009	"Netscape Communications Corp.," Henry R. Norr, August 28, 2017, Encyclopedia Britannica, Inc. (available at: https://www.britannica.com/topic/Netscape-Communications-Corp)
1010	"50 Years of Email," cloudHQ, April 6, 2021 (available at: https://www.prnewswire.com/news-releases/50-years-of-email-301262676.html)
1011	"The History of Email: Major Milestones from 50 Years," Kasey Steinbrinck, January 28, 2021, Email on Acid Ina Fried, (available at: https://www.emailonacid.com/blog/article/email-marketing/history-of-email/)
1012	"10 Instant Messaging Services that Used to Be Popular," Elise Moreau, May 3, 2021, Lifewire Tech for Humans (available at: https://www.lifewire.com/once-popular-old-instant-messaging-services-3486135)

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1013	"Timeline of Social Media," Wikipedia (available at: https://en.wikipedia.org/wiki/Timeline_of_social_media)
1014	"Hyperlink," Wikipedia (available at: https://en.wikipedia.org/wiki/Hyperlink)
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: https://www.w3.org/TR/WD-session-id.html)
1017	"Giving Web a Memory Cost Its Users Privacy," John Schartz, September 4, 2001, New York Times (available at: https://www.nytimes.com/2001/09/04/business/giving-web-a-memory-cost-its-users-privacy.html)
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: https://dl.acm.org/doi/pdf/10.1145/257089.257317)
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: https://dl.acm.org/doi/10.1145/291080.291092)
1020	"Letizia: An Agent that Assists Web Browsing," Henry Lieberman, <i>International Joint Conference on Artificial Intelligence</i> , 1995 (available at: https://web.media.mit.edu/~lieber/Lieberary/Letizia/Letizia-AAAI/Letizia.html)
1021	U.S. Patent No. 6,353,822 to Lieberman
1022	"Google Docs," Wikipedia (available at: https://en.wikipedia.org/wiki/Google_Docs)

Exhibit	Description
1023	“Google Announces Google Docs & Spreadsheets,” October 11, 2006, Google Press Release, (available at: http://googlepress.blogspot.com/2006/10/google-announces-google-docs_11.html)
1024	“The History of JavaScript: Everything You Need to Know,” T.J. DeGroat, August 19, 2019, Springboard (available at: https://www.springboard.com/blog/data-science/history-of-javascript/)
1025	“Adobe Flash,” Wikipedia (available at: https://en.wikipedia.org/wiki/Adobe_Flash)
1026	“What Does AJAX Even Stand For?,” Jay Hoffman, March 4, 2019, The History of The Web (available at: https://thehistoryoftheweb.com/what-does-ajax-even-stand-for/)
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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

Exhibit	Description
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, Inc.'s ("PO") Contingent Motion to Amend ("MTA"; Paper 23), should be denied because proposed substitute claims 19-36 are rendered obvious by prior art under 35 U.S.C. §103, lack written description support under 35 U.S.C. §112, and are unpatentable under 35 U.S.C. §101.

II. PO'S SUBSTITUTE CLAIMS 19-36 ARE NOT PATENTABLE

A. Summary of PO's Arguments and Proposed Amendments

The Petition establishes that claims 1-18 of the '591 patent are unpatentable under 35 U.S.C. §103 over: (i) International Patent Pub. No. WO00/48110 ("Lebrun") in view of U.S. Patent Appl. Pub. No. 2005/0033656 ("Wang"), and (ii) U.S. Patent Appl. Pub. No. 2005/0021626 ("Prajapat") in view of Wang. PO now proposes amendments in independent substitute claims 19 and 28, which are respectively based on original claims 1 and 10.

B. PO's Proposed Claims 19 and 28 Lack Written Description Support

None of the specification portions cited by PO provide adequate written description for the newly added limitations of claims 19 and 28. PO contends on pages 7-8 and 10-11 of the MTA that the amended limitations are supported at least by paragraphs [0011]-[0013], [0042]-[0044], [0048], [0049], [0053], [0056], [0058], [0066], [0113], [0115], [0116], [0118], [0130], and [0131] of the U.S. Application Serial No. 12/783,743 corresponding to the '591 patent. Not so, for several reasons.

There is no written description support for the claim term “independently replicate.” Also, because the claims require that the “second data” is included in the “first data” received by the guest device, there is no written description support for the guest device independently replicating the host device interaction with the content of the website, *obtained by the guest device from a website server based on at least the first data.*

1. The proposed term “independently replicate” in claims 19 and 28 lacks written description support

The ‘591 specification does not contain even one instance of the phrase “independently replicate” or any variations thereof. While the subject matter of a claim need not be disclosed verbatim, written description under 35 U.S.C. §112 requires that an application provide sufficient detail for a person of ordinary skill in the art (“POSITA”) to reasonably conclude that the inventor had possession of the claimed invention on the filing date. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010); *see also Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972). In the absence of verbatim disclosure, PO made no effort to identify written description support for “independently replicate.” The MTA merely provides a list of 18 paragraphs that purportedly support the amendments, without any indication as to which it believes corresponds to what claim language. MTA, 7-8 (claim 19), 10-11 (claim 28). This improperly forces the reader to sift through evidence to locate the specific language allegedly supporting

PO's amendments and "to play archeologist with the record." *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 10 (P.T.A.B. Aug. 29, 2014).

Nevertheless, having done so, Petitioner can find no support for this claim term.

2. The proposed limitation "operating a browser by the guest device based on at least the second data...to independently replicate the host device interaction with the content of the website, obtained by the guest device from a website server based on at least the first data" of claim 19 (& similar in claim 28) lacks written description support

There is no specification support for this limitation, which requires that the guest device: (1) *obtain content* from a website server *based on the first data*; and (2) operate the browser *based on the second data* to independently replicate the [at least one] host device interaction with/on the *obtained* content. The first amended limitation recites that the first data, received from the synchronization server, *comprises* the second data, i.e., first and second data are received by the guest device at the same time. It is unclear how the guest device could replicate the interaction on the *content obtained* (past tense) from the website server based on the first data when the first data for obtaining that content was received at the same time as the *second data*. The content for the interaction replication to occur has not yet been "obtained" when the second data is received.

The specification does not support this process as recited in the claim, for several reasons. First, the specification does not provide any information about *how* the information received at the guest device would enable it to "independently

replicate” the host interaction. As with the term “independently replicate” above, the MTA only provides a list of 18 different paragraphs as allegedly supporting this claim amendment. MTA, 7-8 (claim 19), 10-11 (claim 28). None of these paragraphs describe how the independent replication would work. Ex. 1036, ¶¶5-7.

At best, the specification discloses that the guest device 14 may use the “[c]ommunication message 64 ...to formulate website request 65 to be sent from guest device 14 to website server 12,” and that “website request 65 should be similar or identical to website request 60.” ‘743 application, [0115]. That request results in content reply 67. *Id.* It is not clear how the formulation of the *website request* 65 by the guest device 14 would cause the guest device 14 to perform an *independent replication of the “host device interaction”* with the content of the website as recited in the proposed claims. Ex. 1036, ¶7.

Second, there is no specification support for a single message including (1) first data that serves as the basis for the guest device obtaining the website content from a website server and (2) second data that enables the guest device to independently replicate the host device interaction with that “obtained” content. The specification supports only a single *content* reply (67) to the guest. ‘743 application, [0115]. The content reply 67 is not described as containing the content *and* data for independently replicating the host device interaction with that content. Ex. 1036, ¶8.

Nor does the specification support the “first data” being received by the guest device continuously, at intervals, or prior to the “second data.” Indeed, the specification only discloses information being transmitted to/received by the guest device *once*. None of the disclosure regarding the communication message 64, the website request 65, or the website content reply 67 points to the process being performed *repeatedly* or points to *two separate steps* performed by the guest device based on the message 64 to obtain the content and then perform the interaction on the obtained content. Indeed, PO's expert Dr. Friedman could not point to where in the specification discloses that the process shown in FIG. 5(a) is performed repeatedly, or even more than once. Ex. 1033, 95:2-12, 159:3-160:22. Ex. 1036, ¶7.

3. Dependent claims 25, 33, and 35 lack written description support

Petitioner disagrees that the amended limitations of claims 25, 33, and 35 are supported by paragraphs [0042]-[0044], [0065], [0066], [0131] of the '743 application. MTA, 9, 11-12. Nowhere does the '743 application disclose the concept of *displaying* or *depicting* on the guest device browser, the host device's *interaction* or *action* that was transmitted by the synch server at step 508 of FIG. 5(c) or that was received at step 601 of FIG. 5(d) by the guest device. Ex.1002 at 196, '743 application, [0131]. Indeed, in distinguishing the content of the webpage *received* from the website server from the webpage interaction information sent to the website server in the guest device's *request*, Dr. Friedman implies that what is displayed or

depicted on the guest device browser is the webpage received from the website server, ***not the webpage interaction information*** sent to the website server in the guest device's request. *See* IPR2023-00339, Ex. 2004, ¶¶15-16; Ex. 1036, ¶9.

C. PO's Proposed Claims 19 and 28 Are Indefinite

The proposed “operating a browser” limitation of claim 19 (& similar in claim 28) is indefinite. As discussed *supra*, it is unclear how the guest device could replicate the interaction on the ***content obtained*** (past tense) from the website server based on the first data when the first data for obtaining that content was received at the same time as the ***second data***, since the content for the interaction replication to occur has not yet been “obtained” when the second data is received. *See supra* Section II.B.2; Ex. 1036, ¶7-8. This lack of clarity “fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention,” when the claims are read in light of the intrinsic record. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

D. The proposed claims are unpatentable under 35 U.S.C. §101

The proposed amended claims are a classic example of a category of patent claims – now recognized as hostile to the very purpose of the U.S. patent system – that “simply describe a problem, ***announce purely functional steps that purport to solve the problem***, and recite standard computer operations to perform some of those steps” under the “argot of invention.” *Loyalty Conversion Sys. Corp. v. Am. Airlines, Inc.*, 66 F. Supp. 3d 829, 845 (E.D. Tex. 2014) (emphasis added). Indeed, even the

Board pointed out that the issued claims of the '591 patent "presents high-level functional descriptions of web-based software with flow charts and diagrams between server components." DI, 10; *accord id.*, 44. The amended claims fare no better and are invalid under 35 U.S.C. §101.

Indeed, claim 1 distills down to just a few functional steps: (1) detecting link selection by a user, (2) sending a request to join a browsing session based on the selection, (3) receiving a notification that the session was joined, (4) receiving data about a website and a device's interaction with the website, and (5) operating a browser based on the received data to perform the same interaction. Despite the recitations of the session established being a "synchronized browsing session" ("SBS") in the initial steps, the remaining steps do not require *any synchronous sharing* between the host and guest nor tie back to the SBS. Ex. 1036, ¶¶5-8, 10. Nor is there a requirement that the devices view the same content "simultaneously" or in any "coordinated" manner. Rather, the claims only recite that the guest device receives information about the content the host accessed and its interactions therewith and performs those interactions on the same content. Ex. 1036, ¶¶5-8, 11.

1. The proposed claims are ineligible as being directed to the abstract idea of "sending and receiving information for replicating interactions"

The first step in the eligibility analysis is to determine whether the claims at issue are directed to an abstract idea. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). Where software claims are involved, the inquiry is whether

the claims are “directed to a *specific improvement* [in] computer functionality,” or whether the claims merely recite “generalized steps to be performed on a computer using conventional computer activity.” *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1338 (Fed. Cir. 2016) (emphasis added); *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 612 (Fed. Cir. 2016). Here they are the latter.

A recent case had similar facts. In *Hawk Technology Systems, LLC v. Castle Retail, LLC*, 60 F.4th 1349 (Fed. Cir. 2023), the abstract idea was storing and displaying video, and the court focused on their belief that the claims used “result-based functional language,” not unlike the “high-level functional descriptions of web-based software” that the Board recognized in this case upon institution. DI, 10. Similarly, in *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3D 1329 (Fed. Cir. 2017), the court recognized that the claims utilized result-oriented functional language without adequately detailing how to realize these outcomes in a non-abstract manner. *See also Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348 (Fed. Cir. 2015) (abstract idea of retaining information in the navigation of online forms, with “no restriction on how the result is accomplished”). The present claims are similarly directed to the abstract idea of “sending and receiving information for replicating interactions,” described only in “high-level functional” terms. Moreover, the purported improvement over prior art (synchronizing

browsing) is not captured in the claim language. *Berkheimer v. HP Inc.*, Appeal 2017-1437, 2018 WL 774096 at *6 (Fed. Cir. Feb. 8, 2018).

2. The proposed claims do not add an inventive concept

If a patent claims an abstract idea, the second step considers whether the claims include additional elements, *i.e.*, an inventive concept, sufficient to “transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2350. The claims here do not. The sole step outside of “sending and receiving information for replicating interactions” merely recites selection of a link. The further details of the limitations merely recite well-known concepts like transmission of URLs and cookies. Ex. 1036, ¶10. “Simply appending conventional steps, specified at a high level of generality, [is] not *enough* to supply an inventive concept.” *Alice*, 134 S. Ct. at 2357 (emphasis in original; internal quotations omitted). Nothing in the claim amounts to an inventive concept.

Moreover, the claim does not specify *how* the computer software is programmed to perform the steps; *e.g.*, how does a URL, cookie information, and information related to a shared user input web browsing interaction at the host device allow the guest device to replicate the interaction? What is the mechanism? None is described in the specification. *See supra* Section II.B. Nor can the “synchronization server” – a generic server device – save the claims. *See* Ex. 1001, 9:20-23 (comprises a processor, a network interface, and two databases), FIG. 1(e); *see generally id.*, 9:20-10:2. Finally, that the prior art applied herein renders obvious the claims is

evidence that the additional elements are well-understood, routine, and conventional.

The claims are not patent eligible. Ex. 1036, ¶11.

3. Petitioner's Exhibit 2005

PO's unexplained reference to a district court denial of Intuit's motion to dismiss under 35 U.S.C. §101 is irrelevant and should be ignored. The inquiry in that decision was a question of law as to whether the claims are directed to an abstract idea or a mechanism that is "rooted in computer technology," under the clear and convincing evidence standard. Ex. 2005 at 16 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)). Each of the issue presented, (amended) claims, analysis, and evidentiary standard at issue here is different.

III. THE PROPOSED SUBSTITUTE CLAIMS ARE OBVIOUS OVER THE ASSERTED REFERENCES

A. Proposed substitute claims 19 and 28 remain obvious over Lebrun in view of Wang

1. Lebrun discloses the "receiving first data" limitation of claim 19¹

a. Lebrun discloses [1.d] of the '591 patent as issued.

As explained in the Petition, Lebrun discloses limitation 1[d] of claim 1. Pet., 28-31; Ex. 1005, 32:9-13, 32:26-31, 32:30-31, 35:5-28, 43:5-22. The Board preliminarily agreed and noted "[w]e find Petitioner's showing as to claim limitation

¹ Claim 28 recites "at least one action performed by the host device on content" instead of "at least one direct host device interaction with content," but is otherwise the same. The comments in this section apply to both claims.

[1d] sufficient for institution.” DI, 23-26; *see also* Ex. 1003, ¶¶162-168.

- b. **Lebrun discloses the newly amended in language: “first” data, and that the first data further comprises “information related to a shared user input web browsing interaction that includes second data indicating at least one direct host device interaction with content of the website performed by the host device.”**

Lebrun discloses the first data, including (1) information related to a shared user input web browsing interaction; and (2) second data indicating at least one direct host device interaction with content of the website performed by the host device, despite PO's conclusory, contrary statements. MTA, 16-17.

Petitioner notes that the first clause of the added portion is very similar to a limitation in claim 1 of related U.S. patent 9,483,448 ('448), which is the subject of co-pending IPR2023-00341. In particular, the similar language is shown side-by-side below.

Relevant Portion of Proposed Amended Claim 19	'448 Patent Limitation [1.f.ii]
receiving first data from the synchronization server ...wherein the first data comprises... and information related to a shared user input web browsing interaction	wherein the synchronization server transmits the information related to the shared web browsing interaction to the invitee device

Upon institution of IPR2023-00341, the Board preliminarily found that Petitioner correctly relied on Lebrun's *unambiguous description* to show that it

meets '448 limitation [1.f.ii]. IPR2023-00341, Paper 13 (DI), 27-33; Pet. 30 (citing Ex. 1005, 35:17-19); *see* Ex. 1036, ¶¶12-15. In particular, when Lebrun's controlling web client chooses the "next page," this information (related to a shared user input web browsing interaction) is captured by the program fragment and sent to the group-surfing server (synchronization server), which causes the "next page" to be presented to the other web clients (guests). *See* Ex. 1005, 45:15-16; 45:21-46:5; *see also* IPR2023-00341, Paper 2, 31; Ex. 1036, ¶13.

In addition, Lebrun discloses the information including second data indicating *at least one direct host device interaction* with content of the website performed by the host device. Lebrun discloses web page automatic form completion: "when the controlling web client 110 *enters information to complete the HTML form*, and sends that information to the group-surfing server 140, the group-surfing server 140 may *present that information on the HTML form at each participating web client 110* ... as each field of the form is completed, or when the entire form is completed, or at other times." Ex. 1005, 39:4-10 (emphases added). A POSITA would have understood from this disclosure that the controlling web client 110 entering information to complete the HTML form discloses the "direct host device interaction with the content of the website" and the group-serving server presenting that information to each participating web client 110 is the guest device "receiving" the second data from the synchronization server. Thus, Lebrun discloses or renders

obvious this limitation. Ex. 1036, ¶16.

2. Lebrun discloses the “operating a browser” limitation of claim 19²

As with the above limitation, the Board preliminarily agreed with the Petition that Lebrun discloses limitation 1[e] of issued claim 1 of the '591 patent. DI, 26-28. As the Petition argued, a POSITA would have understood the second web client 110 receiving the page or the URLs of the page from the group-surfing server 140 to comprise a guest device operating a browser based on the data received from the synchronization server. Pet., 31-32; *see also* Ex. 1003, ¶¶ 169-171. PO has not argued that the Board's preliminary finding that Lebrun discloses this limitation should not apply to the amended claims. MTA, 15-18 (no mention of Decision).

PO's argument is that this limitation is not met because the second data is never received per the prior limitation; no further arguments are made except the bald conclusion that Lebrun doesn't show it. MTA, 17. Thus, if the above limitation is shown by Lebrun, PO admits this one is shown as well.

As explained above, in the web page automatic form completion embodiment, Lebrun teaches that “the group-surfing server 140 may present that information on the HTML form at each participating web client 110, so that each *participating web*

² Claim 28 further recites that the independently replicating the at least one action is “in the guest browser.” The arguments in this section apply to both claims.

client 110 can see the HTML form being filled in.” Ex. 1005, 39:4-10 (emphasis added). Thus, the guest device (other participating web client) browser is independently replicating the host device interaction (filling in the form). Ex. 1036, ¶¶12-15.

Further, Lebrun also discloses using a “program fragment loaded at each web client 110” to “intercept ‘submit’ selections by the web client 110 during posting of HTML forms, and direct the information in those ‘submit’ selections to the group surfing server 140 for processing.” Ex. 1005, 36:21-25, 37:8-10. Thus “[t]he group-surfing server 140 is thus able to determine which next pages 153 are selected, and to *assure that such next pages 153 are presented to all participating web clients 110.*” *Id.*, 44:33-45:2 (emphasis added). “[E]ach web client 110 can [independently] receive the next page 153 directly from the web site 130.” *Id.*, 35:17-18; 43:20-22. It would be obvious to a POSITA that Lebrun’s web clients (guest devices) independently replicate the host device interaction with the content of the website. Ex. 1036, ¶16.

3. Lebrun contemplates combining embodiments.

Lebrun explicitly contemplates considering different variations of the disclosed embodiments. The Board primarily agreed upon institution. DI, 22-23, 26.

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); *see also* Ex. 1005, 37:21-25,

44:1-3, 75:18-20. 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. 1036, ¶17.

B. Proposed substitute claims 19 and 28 remain obvious over Prajapat in view of Wang

1. Prajapat, alone or in combination with Wang, discloses the “receiving first data” limitation of claims 19 and 28

a. Prajapat discloses [1.d] of the ‘591 patent as issued.

As explained in the Petition, Prajapat discloses limitation 1[d] of claim 1. Pet., 2, 53-54. The Board preliminarily agreed. DI, 40; *see also* Ex. 1003, ¶¶228-231.

b. Prajapat, alone or in combination with Wang, discloses the newly amended in language: “first” data, and that the first data further comprises “information related to a shared user input web browsing interaction that includes second data indicating at least one direct host device interaction with content of the website performed by the host device.”

As noted *supra* in the discussion of the Lebrun combination, the first portion of the added limitation is very similar to a limitation ([1.f.ii]) found in claim 1 of related co-pending IPR2023-00341. *See supra* Section III.A.1.b. As with Lebrun, for Ground 2 the Board preliminarily found that both Prajapat and Wang disclose limitation [1.f.ii]. IPR2023-00341, Paper 13, 50-56; Pet. 56-57 (citing Ex. 1007, [0043]). IPR2023-00341, Ex. 1003, ¶247; Ex. 1036, ¶18. In particular, the Board pointed to Prajapat’s “‘simple web page sharing’ system in which browser 12b

receives 'URL and any other suitable information' from the web media server, which received the information from browser 12a." IPR2023-00341, Paper 13, 55, citing Pet., 58; *see also* Ex. 1007, [0043]; Pet., 54.

Prajapat describes a "user associated with browser 12a may also desire to co-browse or share the one or more web pages or other web content with another user," where "co-browse" includes "browser 12a and browser 12b display the same web pages at substantially the same time." Ex. 1007, [0012]. Further, according to Prajapat, "***web page form content, such as fields in web page forms*** for example, are kept in sync on web pages in browsers 12 involved in a web page sharing session by ... send[ing] a command to the appropriate web media server 14" and generating "events [] to the browsers 12 to update the web page form content." *Id.*, [0031] (emphasis added); *see also id.*, [0030] ("changes to the content tree in browser 12a may then be synchronized with other browsers 12 in a web page sharing session"). A POSITA would have understood web page form content or the content tree of Prajapat to correspond to the "at least one direct host device interaction with content of the website performed by the host device." This user input is received by the guest browser 12b via the web media server 14 as the claimed "second data." Ex. 1036, ¶19.

With respect to Wang, PO only says it was "never presented by Petitioner as being relevant to this sort of teaching in any event, does not cure the deficiencies [sic] of Prajapat." MTA, 23. However, for the similar limitation [1.f.ii] in IPR2023-

00341, Wang was asserted as also disclosing the similar limitation. IPR2023-00341, Paper 2, 57, citing Ex. 1006, [0023]. Wang's "page navigation means" allows a user to take control of what web pages are shared, and once control is transferred, a "snapshot data of the web page changed by the other client device is transmitted from the server apparatus 14 to the client device which has lost the initiative, thus making it possible to share the web page." Ex. 1006, [0041]. A POSITA would have been motivated to combine Wang's "page navigation control unit" with Prajapat's "web media server" to receive information from a user about which web pages are shared to other users in a session. *See* IPR2023-00341, Pet., 57; *see also* IPR2023-00341, Paper 13, 56; *see* Ex. 1036, ¶20.

2. Prajapat discloses the "operating a browser" limitation of claims 19 and 28

As with the above limitation, the Board preliminarily agreed with the Petition that Prajapat discloses limitation 1[e] of issued claim 1 of the '591 patent. DI, 41. As explained in the Petition, a POSITA would have understood the browser 12b displaying, altering, or viewing web pages and its alterations during co-browsing through web media server 14b comprises a guest device operating a browser based on the data received from the synchronization server. Pet., 55; Ex. 1003, ¶¶232-233.

Further, as explained above, Prajapat discloses web page form field content synchronization and content tree synchronization between browsers 12, so that "browser 12a and browser 12b display the *same web pages at substantially the same*

time.” Ex. 1007, [0012], [0030], [0031] (emphasis added). Moreover, Prajapat discloses that “[b]rowser 12a may communicate the URL *or other suitable information regarding the requested web page* to web media server 14 a... [which] may communicate the URL and any *other suitable information* to web media server 14 b... [which] may communicate the URL and any *other suitable information* to browser 12 b... [which] may use the URL and any *other suitable information* to request from web content server 18 the web page that browser 12a requested.” *Id.*, [0043] (emphases added). It would have been obvious to a POSITA that the “URL” and any “other suitable information” received by the browser 12b from the web media server 14b may be utilized by the browser 12b of Prajapat to “independently replicate the host device interaction with content of the website” performed by the host device. Ex. 1036, ¶19.

3. Prajapat contemplates combining embodiments.

In the MTA, PO rehashes its failed pre-institution argument that Prajapat’s peer-to-peer dynamic and simple web page sharing embodiments are not combinable. MTA, 18-23. The Board explicitly addressed this argument at institution, disagreeing with PO. *See* DI, 40, citing Ex. 1007, [0047]. PO did not address this finding nor [0047]. Additional portions of Prajapat also contemplate that similar processes can be used among the various embodiments. *See, e.g.*, [0041], [0045]; *see also* Ex. 1036, ¶21.

C. Proposed substitute claims 19 and 28 are also obvious over Birnbaum in view of Wang and Lebrun and/or Prajapat

U.S. Patent Publication No. 2002/0143878 to Birnbaum et al. (“Birnbaum”; Ex. 1035) also discloses the newly added limitations, and Birnbaum in view of Wang and Lebrun or Wang and Prajapat also render claims 19 and 28 obvious.³

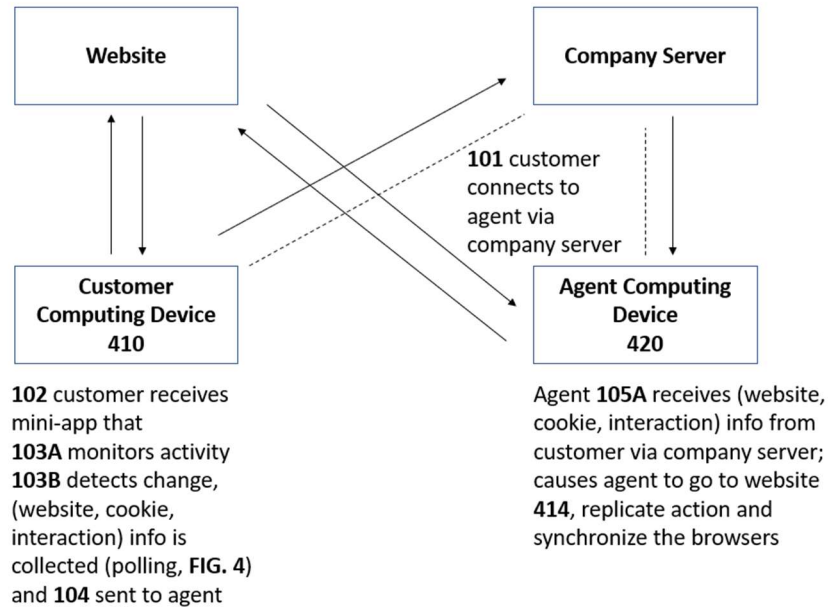
1. Birnbaum Overview

Birnbaum describes a “web collaboration 100 between a first computing device and a second computing device” in which “[t]he customer’s computing device may actually be connected to a company server that then interacts with an agent’s computing device.” Ex. 1035, [0050], [0060]. The “first computing device 410 is the computing device which is polled for a change in activity, such as the customer’s computing device.” *Id.*, [0088]. The second (agent) computing device may “receive and display predetermined information from the first computing device, such as new web addresses, text entries, messages and/or cookies.” *Id.*, [0037]. In Birnbaum, as a result of a polling operation, “any change occurring at the customer’s browser will also occur at the agent’s browser, so the agent’s browser will be synchronized to the customer’s browser.” *Id.*, [0080], [0089].

Shown below is a Petitioner created drawing that demonstrates the steps of Birnbaum’s process with reference numerals used therein, as described at Ex. 1035,

³ Birnbaum was published on October 3, 2002, and is prior art to the ‘591 patent at least under 35 U.S.C. §102(a)(1).

[0060]-[0061], [0065]-[0067], [0079]-[0080], [0088]-[0089], FIGS. 2A, 2B, 3A, 3B, 4. Ex. 1036, ¶22.



2. Birnbaum discloses the “receiving first data” limitation of claims 19 and 28

As explained above, Birnbaum discloses a guest device receiving first data from the synchronization server, in a process in which a first (customer's) computing device and a second (agent's) computing device perform “collaborative web browsing” via a “company server.” Ex. 1035, [0002], [0060], FIG. 3A. Birnbaum notes that “for ease of discussion the connection with the agent *through or not through a company server* shall be referred to as a connection to the agent's computing device.” *Id.*, [0060](emphasis added). A POSITA would have understood the company server of Birnbaum to correspond to the claimed synchronization server, the agent's computing device that receives the “information” to correspond

to the claimed guest device, and the customer's computing device to correspond to the claimed host device. Ex. 1036, ¶24.

Birnbaum's monitoring ensures that the data received by the agent (guest) device from the company server (synchronization server) is "relate[d] to a website being accessed in real-time by a host device." Birnbaum notes that "any change occurring at the customer's browser will also occur at the agent's browser, so the agent's browser will be synchronized to the customer's browser." *Id.*, [0080]. In Birnbaum, the "predetermined change may be any change in the browser program or related files which it is desired to detect" may include "a new web address (whether provided by the user or pushed down by the web site)." Ex. 1035, [0065]. Birnbaum discloses that "when the customer visits a web site, the server at that site will send a cookie to the customer's computing device. The present invention provides for forwarding that web address and that cookie to the agent's computing device." *Id.*, [0042]; *see also id.*, [0065], [0088]. It would have been obvious to a POSITA that the data received by the agent's device from the company server may include a URL of a website and cookie information associated with the website and the customer's device. Ex. 1036, ¶25.

Birnbaum also discloses that the first data includes second data indicating at least one direct host device interaction with content of the website performed by the host device by way of a polling operation, as noted above. In particular, FIG. 4 of

Birnbaum, copied below and discussed at [0088]-[0090], discloses an example of a polling operation involving filling out a form.

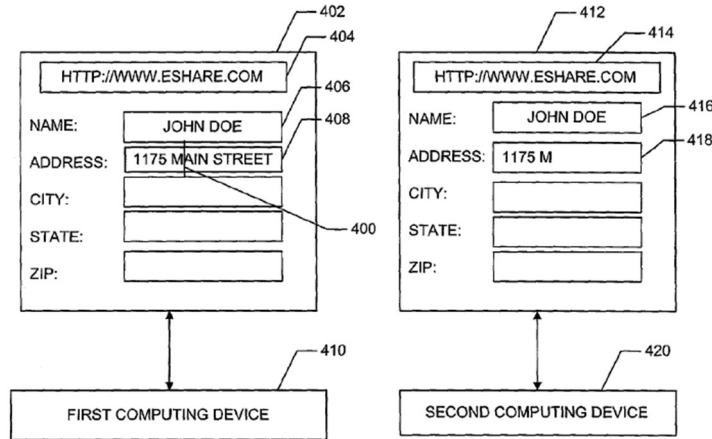


FIG. 4

Birnbaum describes “the display 402 indicates the web page, including a form, currently being viewed by the customer” on the first computing device 410 browser. Ex. 1035, [0088]. The user of the first device 410 operates the browser displayed on the display 402 to “go[] to a new web site, and has started completing a form present on that web page.” *Id.* After web address 404 is received by the second device 420, the “information is then automatically displayed [] at the second computing device 420. In the example shown, receipt of the new web address would cause the agent’s computing device to go that web site.” *Id.*, [0089]. Then, “the information entered on the form by the user, up to the polling point, would appear on the form on the agent’s computing device.” *Id.* A POSITA would have understood the user input in the name field 406 to correspond to the “at least one direct host device interaction

with content of the website performed by the host device.” This user input is received by the guest device 420 as “second data.” Ex. 1036, ¶27.

3. Birnbaum discloses the “operating a browser” limitation of claims 19 and 28

Birnbaum discloses “[i]f the customer has entered information into a form or into a particular field on a form, and that is the information that was sent, then the agent’s computing device will display the form and the information that has been entered in that field on the form.” Ex. 1035, [0080]. FIG. 4 shows the name form field 416 being updated and displayed on the guest device browser based on the information corresponding to the name form field 406 (i.e., the “second data”) received from the company server. Birnbaum further discloses “[i]f the information is a new web address, the browser on the agent’s computing device will go to that new web address.” *Id.*, [0080], [0072]. Thus, the guest device of Birnbaum obtains the content of the website from a website server based on at least the first data.

Further, Birnbaum discloses that its collaborative web browsing process allows “the agent and customer to independently ... receive[] the same information from the connected server.” *Id.*, [0042]. “[A]ny change occurring at the customer’s browser will also occur at the agent’s browser, so the agent’s browser will be synchronized to the customer’s browser.” *Id.*, [0080]. Thus, it would be obvious to a POSITA that Birnbaum independently replicates the host device interaction with the content of the website. Ex. 1036, ¶28.

4. Motivation to Combine the References

As described in the Petition, each of Lebrun and Prajapat are combinable with Wang because they each are directed to solving problems in the art regarding collaborative browsing of web pages by multiple users in a synchronized manner. Pet., 18-20; *see* Ex. 1005, 4:1-4, 39:4-10; Ex. 1007, [0005], [0030]-[0031] Fig. 2; Ex. 1006, [0009]-[0010], [0013]; Ex. 1003, ¶¶138-146. Birnbaum likewise is combinable with Lebrun and/or Wang as it is directed to “collaboration between two computing devices so that a person at one computing device sees the same information as a person at another computing device,” and is related to the same technical field. Ex. 1035, [0012], FIG. 4. Ex. 1036, ¶29.

Specific to the amended claim limitations, a POSITA would be motivated to combine Birnbaum's specific teachings of allowing “any change occurring at the customer's browser [to] also occur at the agent's browser, so the agent's browser will be synchronized to the customer's browser” (Ex. 1035, [0080]) with Lebrun and/or Wang's multi-user collaborative web browsing. A POSITA would have sought out various available solutions for enabling multiple users to browse web pages together in a collaborative, synchronized manner. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (identifying “a finite number of identified, predictable solutions”). Moreover, due to the similarities in the goals of these references and their system architectures, a POSITA also would have had a reasonable expectation of success in the combination. Ex. 1036, ¶30.

D. PO's Analysis Not Supported by Expert Testimony

PO's choice not to submit a declaration supporting the MTA *undermines every one of PO's arguments*. Mere conclusory statements in the form of attorney argument cannot take the place of evidence in the record. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016); *see also In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *Samsung Elecs. Co. v. Elm 3DS Innovations, LLC*, IPR2016-00393, Paper 62, 36-37 (P.T.A.B. June 23, 2017); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). Thus, to the extent that PO's arguments are contrary to those supported by Dr. Lieberman's testimony, there is no substantial evidence to support them, and thus they must fail.

IV. CONCLUSION

For the reasons presented herein, the applied references render obvious proposed substitute claims 19-36.

Dated: December 20, 2023

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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 OPPOSITION TO MOTION TO AMEND and Exhibits 1035 – 1036 to be electronically served on Petitioner's lead and backup counsel at the following addresses:

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