

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

In the *Inter Partes* Review of:

U.S. Patent No. 8,527,591

For: METHOD AND APPARATUS  
FOR THE IMPLEMENTATION OF A  
REAL-TIME, SHARABLE BROWSING  
EXPERIENCE ON A GUEST DEVICE

Mail Stop Patent Board  
Patent Trial and Appeal Board  
P.O. Box 1450  
Alexandria, VA 22313-1450

**DECLARATION OF HENRY A. LIEBERMAN IN SUPPORT OF  
PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO  
AMEND FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,527,591**

I, Henry A. Lieberman, declare as follows:

## **I. INTRODUCTION**

1. I have been asked by the party requesting this review, Intuit Inc. (“Petitioner”), to provide my expert opinions in support of Petitioner’s Opposition to Patent Owner’s Motion to Amend for *Inter Partes* Review of U.S. Patent No. 8,527,591 (“’591 patent”), challenging the patentability of the proposed substitute claims 19-36.

2. I currently hold the opinions set forth in this declaration, which supplements my prior declaration, filed as Ex. 1003 in this case.

3. In summary, it is my opinion that the references cited and discussed below render obvious proposed substitute claims 19-36. My detailed opinions on the claim are set forth below.

## **II. MATERIALS CONSIDERED**

4. I have reviewed and considered, in the preparation of this declaration, the following additional documents related to this case:

- a. Patent Owner’s Motion to Amend (Paper 23), and
- b. Exhibits 1031-1033, 1035 accompanying this Declaration.

It is my understanding that no expert declaration was submitted in support of Patent Owner’s Motion to Amend.

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

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

5. The specification does not disclose any synchronous sharing of the same web browsing experiences. According to FIG. 2(a) of the specification, establishing a synchronized browsing session does not require any content to be passed at all. Ex. 1001, 10:10-28. Rather, a host device transmits a request to the synchronization server, which the synchronization server responds to with a confirmation including a session identifier. *Id.*, 10:10-14. After the synchronized browsing session is established, a guest device can join. *Id.*, 10:19-28. Nothing in the claims recite, nor does the specification describe, **how** the synchronized browsing session is administered by the synchronization server, or how content is “synchronized” or the interactions independently replicated.

6. The plain and ordinary meaning of the term “synchronized” is “occurring at the same time.” *See* Ex, 1031, 506. This is the plain meaning of the term; it is how a POSITA would understand the term as used in the art, both in the '591 patent and in the Prajapat reference. This definition also is similar to that of another term used in both Lebrun and Prajapat, “dynamic,” which is defined as “occurring immediately and concurrently.” *See* Ex, 1031, 181.

7. Although the apparent intent of the patent is to allow users in a session to share "synchronized" internet browsing in real time, the specification

does not disclose a process that would clearly convey to a skilled artisan that the inventor had possession the full scope of what is claimed with respect to “real-time” or “synchronized” co-browsing. The specification does not disclose that the process shown in FIG. 5(a) is performed repeatedly, or even more than once, as would be required to “synchronize” the data as between the host and guest devices. Nor does the specification disclose how the information received at the guest device (Fig 5(a), communication message 64) would enable it to “independently replicate” the host interaction. The specification discloses only 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,” and that request results in content reply 67. Ex. 1001, 16:51-62, 17:27-29. 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.

8. Nor is there any disclosure in the specification for a communication message (e.g., 64) that includes both data that serves as the basis for the guest device obtaining the website content from a website server and that enables the guest device to independently replicate the host device interaction with that already-obtained content. The specification supports only a single content reply

(67) to the guest. The content reply 67 is also not described as containing both the content and the data for independently replicating the interaction with that content at the guest device.

9. The specification does not disclose, in the description of FIGS. 5(c) and 5(d), or anywhere else in my opinion, that the host device's *interaction* or *action* that was transmitted by the synchronization server being *displayed* or *depicted* on the guest device browser. Moreover, my reading of Mr. Friedman's attempts to distinguish 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* in related case IPR2023-00339 indicates 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.

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

10. My understanding from counsel is that the second step in the eligibility analysis considers whether the claims include additional elements, *i.e.*, an inventive concept, sufficient to transform the abstract nature of the claim into a patent-eligible application. It is my opinion that they do not. The further details of the limitations merely recite transmission of URLs and cookies, which were well-known concepts significantly before the critical date in this case.

11. Further, in my opinion, there is no detail spelling out how the guest device would allegedly “replicate” the interaction of the host device, such as specifying *how* the computer software is programmed to perform the recited steps. The claims do not recite a mechanism for doing so. My understanding is that the “synchronization server” is only described as a generic server device. *See* Ex. 1001, 9:20-10:2, FIG. 1(e). This does not provide an inventive concept.

#### **IV. 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**

12. As I discussed in related case IPR2023-00341, Lebrun discloses a similar step wherein a synchronization server transmits the information related to the shared web browsing interaction to the invitee (guest) device in response to receiving the information related to the shared web browsing interaction from the host device.

13. Lebrun discloses each web client having a “program fragment” that affects the operations of a web client and is controlled by the group-surfing server. *See* Ex. 1005, 36:21-25. When the “controlling web client” chooses the “next page,” this information is captured by the “program fragment” and sent to the “group-surfing server,” which then causes the “next page” to be presented to the other web clients in the session. *See* Ex. 1005, 45:13-17; 45:21-46:5.

14. Lebrun further discloses transmitting the information in response to receiving the information related to the shared web browsing interaction from the host device. The user sends a “next-page message” to the “group-surfing server,” which indicates the next page in the progression can be shared to other web clients. *See* Ex. 1005, 45:21-29.

15. In addition, even if Lebrun did not disclose this limitation, Wang discloses that the “server apparatus” comprises means for “providing a group session formed by integrating communication sessions among the plurality of client devices,” as well as means for “synchronizing the client devices in the collaboration environment.” Ex. 1006, ¶[0023]. The page navigation means “includes initiative transfer means 28, and allows the client device 12*a* to access the server apparatus 14 directly and to acquire a web page when the client device 12*a* has ownership of the initiative of web page operation.” *See* Ex. 1006, ¶[0041]. Wang further discloses that in response to an instruction from a customer, “the initiative transfer means” can transmit a request to the server “to transfer ownership of the initiative of the web page operation to another client device.” *Id.*, ¶[0041]. Once ownership 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.” *Id.* A POSITA would have been motivated to combine Wang’s teachings of a “server

apparatus” with integration and synchronization functionality to Lebrun’s “group-surfing server.” Incorporating standard web software functionality, as disclosed in Wang, such as transmitting information from a server (i.e., a URL) to a web browser that would receive and process that information to request a web page, into Lebrun’s disclosed “web client” would allow Lebrun to perform the functions described in Lebrun’s disclosure.

16. 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. A POSITA would have understood Lebrun’s disclosure regarding the controlling web client 110 entering information to complete the HTML form as corresponding to the “direct host device interaction with the content of the website” as recited in claim 19, and the similar limitation in claim 28. Further, a POSITA would have understood Lebrun’s group-serving server presenting HTML form information to each participating web client 110 as disclosing the guest device “receiving” the second data from the synchronization server as claimed. Ex. 1005, 39:4-10. It would further be obvious to a POSITA that Lebrun’s web clients (guest device) independently replicate the host device interaction with the content of the website. *See also id.*, 37:16-17, 45:31-46:2.

**B. Lebrun Contemplates Combining Embodiments**

17. Lebrun contemplates that the processes of its various disclosed embodiments are compatible. Lebrun describes several “*variations on the group-surfing session*,” which includes a subsection of “multiple group surfing channels.” Ex. 1005, 37:19, 43:5). A POSITA would understand “multiple group surfing channels” would be one example/scenario of the “variations on the group-surfing session,” and the latter encompasses the former and the two embodiments are compatible and combinable.

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

18. As I discussed in related case IPR2023-00341, Prajapat discloses wherein the synchronization server transmits the information related to the shared web browsing interaction to the invitee (host) device. The browser may include a “computer program or other suitable software for automatically communicating with one or more other users of other browsers 12.” See Ex. 1007, ¶[0015]. Specifically, “browser 12a” may communicate “suitable information regarding the requested web page to web media server 14a,” which in turn may communicate to “browser 12b.” Ex. 1007, ¶[0043].

19. A POSITA would have understood that the web page form content or the content tree of Prajapat corresponds to the “at least one direct host device interaction with content of the website performed by the host device,” as recited in

claim 19 and the similar language in claim 28. This user input is received by the guest browser 12b via the web media server 14 as the claimed “second data.”

Prajapat at [0012], [0030], [0031]. It further 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 in 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 as recited in claim 19 (and similar language in claim 28). *See* Prajapat, [0012], [0030], [0031], [0043].

20. In addition, even if Prajapat did not disclose this limitation, Wang does. Wang discloses that the “server apparatus” comprises means for “providing a group session formed by integrating communication sessions among the plurality of client devices,” as well as means for “synchronizing the client devices in the collaboration environment.” Ex. 1006, ¶[0023]. The page navigation means “includes initiative transfer means 28, and allows the client device 12a to access the server apparatus 14 *directly* and to acquire a web page when the client device 12a has ownership of the initiative of web page operation.” *See* Ex. 1006, ¶[0041]. Wang discloses that in response to an instruction from a customer, “the initiative transfer means” can transmit a request to the server “to transfer ownership of the initiative of the web page operation to another client device.” Ex. 1006, ¶[0041]. Once ownership 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.”

*Id.* A POSITA would have been motivated to combine Wang’s teachings of a “page navigation means” to Prajapat’s “group-surfing server.” Incorporating standard web software functionality, as disclosed in Wang, such as transmitting information from a server (i.e., a URL) to a web browser that would receive and process that information to request a web page, into Prajapat’s disclosed “browser” would allow Prajapat to perform the functions described in Prajapat’s disclosure.

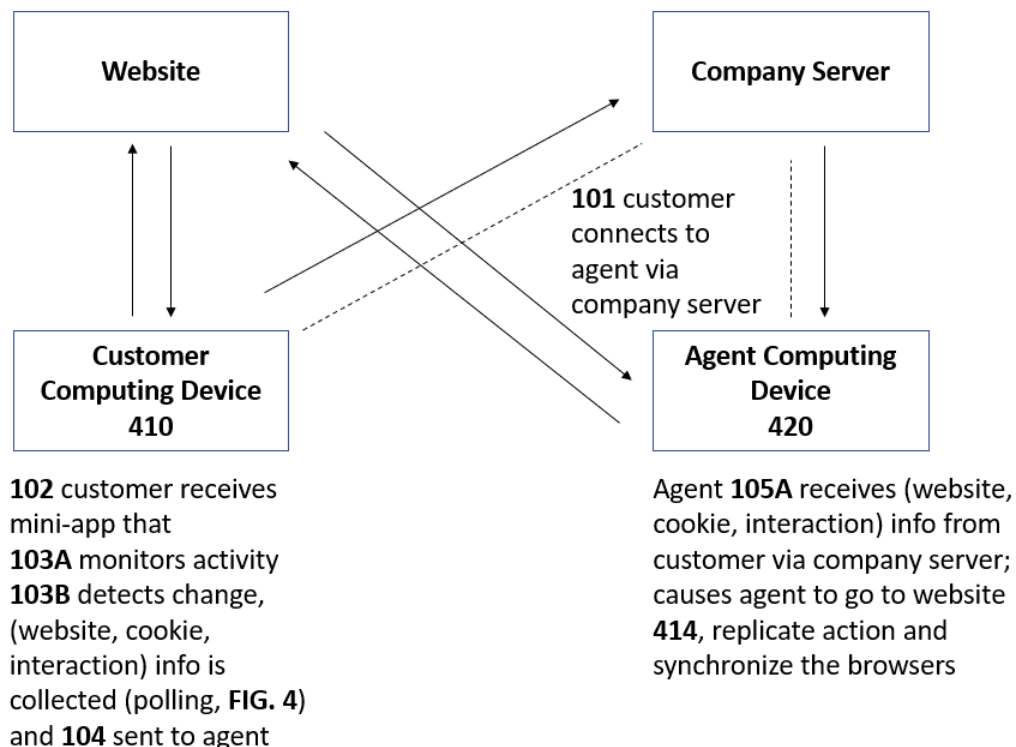
#### **D. Prajapat Contemplates Combining Embodiments**

21. Despite PO’s arguments about the supposed impropriety of combining embodiments, Prajapat explicitly ties together the processes of its various disclosed embodiments. For example, in Prajapat’s description of its peer-to-peer “simple” web page sharing embodiment (FIG. 3), it describes the process that the web media server 14a uses to locate the web media server associated with browser 12b as being “in a substantially similar manner to that described above with reference to FIGS. 1 and 2” (peer-to-peer “dynamic” web page sharing embodiment). Ex. 1007, [0041]. Similarly, in Prajapat’s description of its peer-to-peer web page sharing embodiment using two phones (FIG. 4), it discloses that “for purposes of web page sharing, UA and media controller 54a may locate UA and media controller 54b in substantially the same manner as described above with

reference to FIGS. 1, 2, and 3” (all the other embodiments). *Id.*, [0045]. Finally, upon institution the Board cited [0047] and stated “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, p. 40, citing Ex. 1007, [0047]. Thus, Prajapat explicitly ties together the processes of its various disclosed embodiments in at least three different places in its specification.

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

22. The steps of Birnbaum’s process are shown below in a Petitioner-created illustration, with reference numerals used, as described at Ex. 1035, [0060]-[0061], [0065]-[0067], [0079]-[0080], [0088]-[0089], FIGS. 2A, 2B, 3A, 3B, 4.



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

23. 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 then 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]. As shown in the above illustration, this process is very similar to that of the '591 patent at FIG. 5(a), and a POSITA would recognize those similarities.

24. 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). From this, 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, and thus this step performed as recited by Birnbaum.

25. 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." 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. In particular, 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]. 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] (emphasis added). A POSITA would understand a web address to include a URL and any cookies associated with the data received by the agent's device from the company server.

26. With respect to "second data indicating at least one direct host device interaction with content of the website" as recited in claim 19 (as similar language from claim 28), FIG. 4 of Birnbaum, copied below and discussed at [0088]-[0090], discloses an example of a polling operation involving filling out a form.

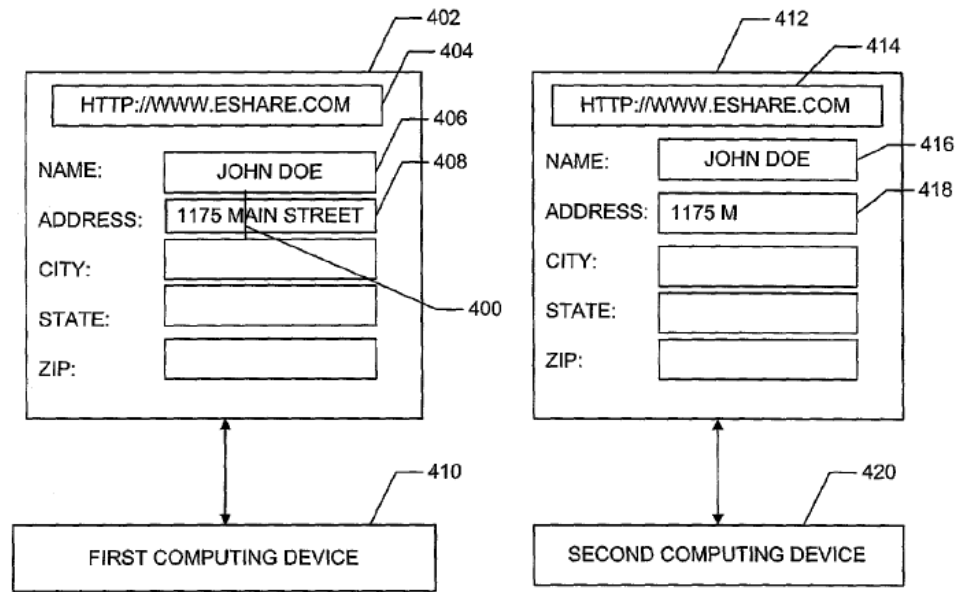


FIG. 4

27. 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 from this process that the user input in the name field 406 corresponds to the “at least one direct host device interaction with content

of the website performed by the host device” of claim 19, and the similar language from claim 28.

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

28. As shown in FIG. 4 and described above, “information is [] 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.” Ex. 1035, [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.* 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 from this description that Birnbaum independently replicates the host device interaction with the content of the website, as recited in claims 19 and 28.

**3. Motivation to Combine the References**

29. In my opinion, Birnbaum 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. Each of Lebrun and Prajapat were shown in my prior declaration as being 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, each predictably using their elements according to well-established functions. Ex. 1003, ¶¶138-146; *see also* Pet., 18-20; *see* Ex. 1005, 4:1-4, 39:4-10; Ex. 1007, ¶¶[0005], [0030]-[0031] Fig. 2; Ex. 1006, ¶¶[0009]-[0010], [0013]. Thus, a POSITA would consider these teachings together to yield the claimed combination, with a high expectation of success in that combination.

30. In particular, 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 to meet the amended claim limitations. Each of these are being used according to their established function in each reference. A POSITA would have sought out various available solutions for enabling multiple users to browse web pages together in a collaborative, synchronized manner. 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

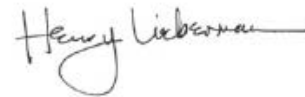
in the combination as a predictable use of prior art elements according to their established functions.

## **V. CONCLUSION**

31. For the reasons presented above, it is my opinion that the applied references render obvious proposed substitute claims 19-36.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Dated: December 20, 2023



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Henry A. Lieberman