

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner,

v.

SAMESURF, INC.,
Patent Owner.

IPR2023-00342
Patent 8,527,591 B2

Before KARL D. EASTHOM, BARBARA A. BENOIT, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On June 28, 2023, we instituted trial as to claims 1–18 of U.S. Patent No. 8,527,591 B2. Paper 12 (“Institution Decision” or “Dec.”). After institution, Patent Owner filed a Contingent Motion to Amend in which it proposes substitute claims 19–36 to replace original claims 1–18. Paper 23 (“Motion” or “Mot.”). Specifically, Patent Owner requests “[i]f the Board finds any of the original independent claims 1 or 10 unpatentable . . . amend and issue substitute claims herein that respectively correspond to any of claims 1 or 10 found unpatentable.” *Id.* at 1. Petitioner filed an opposition on December 20, 2023. Paper 30 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the

parties about the [motion to amend]”); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121 (regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend) (“Lectrosonics”).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties’ other substantive papers on the underlying merits of Petitioner’s challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims?
(35 U.S.C. § 316(d)(1)(B))

Yes. Patent Owner proposes no more than one substitute claim for each challenged claim. There is a rebuttable presumption that one substitute claim is reasonable. 37 C.F.R. § 42.121(a)(3). Petitioner does not argue that the number of proposed substitute claims is unreasonable. *See* Opp. Thus, Patent Owner proposes a reasonable number of substitute claims.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes. We are persuaded that Patent Owner responds to a ground of unpatentability, namely, Ground 1 (obviousness over Lebrun in view of Wang) and Ground 2 (obviousness over Prajapat in view of Wang) because Patent Owner adds additional limitations to both independent claims to address Petitioner’s arguments. Mot. 3, 4, 14–23, App. A. Petitioner does not address this issue. *See* Opp.

Accordingly, at this stage in the proceeding, we determine that the proposed substitute claims respond to a ground of unpatentability involved in the trial.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No. Patent Owner contends the proposed substitute independent claims retain all of the original independent claims’ features and add narrowing elements. Mot. 5.¹ Petitioner does not address this issue. *See* Opp.

Proposed substitute claims 19 and 28 appear to include narrowing limitations as compared to original claims 1 and 10. Regarding the “operating a browser by the guest device” limitations in original claim 1 and proposed substitute claim 19, proposed substitute claim 19 recites “operating a browser by the guest device based on at least the second data received from the synchronization server to independently replicate the host device interaction with the content of the website, obtained by the

¹ The independent claim numbers referenced by Patent Owner on page 5 are incorrect. *See* Mot. 5. The correct substitute independent claims are claims 19 and 28, corresponding to original claims 1 and 10. Mot. App. A.

guest device from a website server based on at least the first data.” Mot. App. A. Claim 1, however, recites “operating a browser by the guest device based on the data received from the synchronization server” that includes a URL of the website and cookie information associated with the website and host device. Ex. 1001, 22:63–23:2. Proposed substitute claim 19 also requires “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,” which is obtained by the guest device from a website server based on at least the first data that includes the URL of the website and cookie information associated with the website and host device. Mot. App. A. Thus, proposed substitute claim 19 requires operating a browser by the guest device in a more specific manner than required by original claim 1 by using additional recited data (“second data”) to independently replicate the host device interaction with the content of the website. Proposed substitute claim 19 requires that the more specific manner of operating the guest device browser requires having obtained the content of the website based on the first data that includes the URL of the website and cookie information associated with the website and host device. Proposed substitute claim 28 for original claim 10 has similar limitations.

Accordingly, at this stage in the proceeding, we determine that the proposed substitute claims do not seek to enlarge the scope of the claims.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

Yes. At this preliminary stage, for the reasons set forth in detail below, we determine that Patent Owner has not shown adequate written description support for proposed substitute claims 19–36.

Patent Owner cites paragraphs of the application from which the ’591 patent issued, which Patent Owner contends support the proposed substitute claims. Mot. 6–12.

Petitioner contends that the term “independently replicate,” recited in proposed substitute independent claims 19 and 28, lacks written description support. Opp. 1–3. At this stage of the proceeding, we preliminarily find that the paragraphs cited by Patent Owner provide

adequate written description support for the terminology “independently replicate.” For example, paragraph 118 describes that the visual and audio output of host device 10 and guest device 14 may be identical. Ex. 1002, 193. Paragraph 56 describes that the user of guest device 14 views the same display of internet content as displayed to the user of host device 10. *Id.* at 174. Paragraph 43 describes that all users are allowed to view and fully interact with the same internet content. *Id.* at 168–69. Paragraph 48 describes that guest devices 14 and 15 receive the same data response from website server as that received by host device 10. *Id.* at 171. For similar reasons, we determine, on the current record, that the specification otherwise provides sufficient support for added limitations recited in proposed substitute dependent claims 25, 33, and 35, but these claims depend from claims 19 or 28, which lack written description support, as noted below.

Regarding the operating a browser step of proposed substitute claim 19 (and similar limitations of proposed substitute claim 28), Petitioner contends the limitations “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” lack written description support. Opp. 3–5. Petitioner further contends “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.” *Id.* at 4.

At this preliminary stage, we find that Patent Owner has not established written description support for the operating a browser step of proposed substitute claim 19 (and similar portions of proposed substitute claim 28). To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail such that one skilled in the art can reasonably conclude that the inventor *had possession of the claimed invention*. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003).

As support for the browser step, Patent Owner cites approximately seventeen paragraphs of the application without identifying or stating what in the application corresponds to the newly claimed “second data.” See Mot. 7–8. At this preliminary stage and based on a review of cited paragraphs and the information presented, we find that Patent Owner has

not established that the application evidences possession of the invention of proposed substitute claim 19 (and similar portions of proposed substitute claim 28).

Consequently, it appears that Patent Owner’s Motion does not satisfy the requirement to show adequate written description support for proposed substitute claims 19–36.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record,² it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 19 and 28 are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

35 U.S.C. § 112(b) — Definiteness

No, not unpatentable as to proposed substitute independent claims 19 and 28.

Petitioner contends:

“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.”

Opp. 6 (italics added).

We are not persuaded by this argument at this stage because we understand proposed substitute claim 19 to require that the website content is obtained before the host device interaction with the content of the website is replicated (“operating a browser . . . to independently replicate

² We express no view on the patentability of original claims 1–18 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in the Patent Owner’s Motion to Amend.

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”). That the first data received from the synchronization server includes both the first data and the second data does not preclude the use of the data at different times for different purposes, as claimed.

Accordingly, Petitioner does not persuade us that the proposed substitute claims are indefinite under 35 U.S.C. § 112(b).

35 U.S.C. § 101 — Patent Eligible Subject Matter

No, not unpatentable as to proposed substitute independent claims 19 and 28.

Petitioner contends that the proposed substitute claims are unpatentable because they claim patent ineligible subject matter, and in support, Petitioner analyzes both steps of *Alice*. Opp. 6–10; *see Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208 (2014); *see also* Manual of Patent Examining Procedure (“MPEP”) Ninth Edition, Revision 07.2022 (published February 2023) § 2106.³

Alice/Mayo First Step; USPTO Guidance Step 2A, Prongs One & Two

Petitioner contends the proposed substitute independent claims are directed to an abstract idea, namely, “sending and receiving information for replicating interactions.” Opp. 7–9.

Petitioner further argues:

³ We note the USPTO current eligibility guidance (“Guidance”) is found in the Ninth Edition, Revision 07.2022 (published February 2023) of the Manual of Patent Examining Procedure (“MPEP”), and particularly within Sections 2103 through 2106. Therefore, we refer to the MPEP for the Eligibility Guidance originally published in the Federal Register. Although our analysis refers to the Guidance (*see, e.g.*, 2019 Revised Guidance 84 Fed. Reg. 50, 51 (Jan. 7, 2019) (“All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance.”)), our determinations herein are based upon governing precedent of the United States Supreme Court and our reviewing court’s interpretation and application thereof (*see In re Rudy*, 956 F.3d 1379, 1382 (Fed. Cir. 2020) (stating that “the Office Guidance is not, itself, the law of patent eligibility” and “does not carry the force of law”)).

“PO’s unexplained reference to a [Southern District of California] 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. . . . Each of the issue presented, (amended) claims, analysis, and evidentiary standard at issue here is different.”

Opp. 10.

Under MPEP § 2106.04(a)(2), for *Step 2A, Prong One* the enumerated groupings of abstract ideas are defined as follows:

- (1) Mathematical concepts — mathematical relationships, mathematical formulas or equations, mathematical calculations (*see* MPEP § 2106.04(a)(2), subsection I);
- (2) Certain methods of organizing human activity — fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions) (*see* MPEP § 2106.04(a)(2), subsection II); and
- (3) Mental processes — concepts performed in the human mind (including an observation, evaluation, judgment, opinion) (*see* MPEP § 2106.04(a)(2), subsection III).

We determine that Petitioner’s characterization of the proposed substitute claims as being directed to the abstract idea of “sending and receiving information for replicating interactions” to be overly broad in light of the substitute claims reciting a particular arrangement of data (first data comprising a URL, cookie information associated with a website and host device, and 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 well as a particular usage of such data (operating a browser by the guest device based on at least the second data received from the synchronization server 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).

Further, applying the Guidance, we determine proposed substitute independent claims 19 and 28 do not implicate the mathematical concepts or mental processes categories of abstract ideas. Further, proposed substitute independent claims 19 and 28 do not fall within the certain methods of organizing human activity sub-groupings. Accordingly, we determine that proposed substitute independent claims 19 and 28 do not recite an abstract idea under Step 2A, Prong One, of the Guidance. *See* MPEP § 2106.04(a)(2). Further, we determine even if the proposed substitute claims did recite an abstract idea, the claims include limitations that integrate any abstract idea into a practical application. *See* MPEP § 2106.04(d). Namely, as discussed *supra*, the amended limitations recite a particular arrangement of data and a particular usage of such data and are directed to an improvement to the functioning of a computer system in the technical context of a synchronized browsing session administered by a synchronization server. *See* MPEP §§ 2106.04(d)(1), 2106.05(a).

Accordingly, we determine that the proposed substitute independent claims are not directed to an abstract idea under the first step of the *Alice/Mayo* test and under Step 2A, Prongs One and Two, of the Guidance. In light of this determination, there is no need to proceed to the second step of the *Alice/Mayo* test and Step 2B of the Guidance.

Our determination is consistent with the Southern District of California decision, wherein the court concluded:

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

Ex. 2005, 7, 16, 17.

We are not persuaded by Petitioner's contention that the decision is irrelevant because patent eligibility is a question of law, *see PersonalWeb Techs. LLC v. Google LLC*, 8 F.4th 1310, 1314 (Fed. Cir. 2021), and

Petitioner does not identify disputed underlying questions of fact that implicate the evidentiary standard. *See* Opp. 10.

35 U.S.C. § 103 — Obviousness

Yes, on the current record, Petitioner has established a reasonable likelihood that proposed substitute claims 19 and 28 are unpatentable under 35 U.S.C. § 103.

In the Opposition, Petitioner advances the following grounds (*see* Opp. 10, 15, 19):

- (1) proposed substitute claims 19 and 28 remain obvious over Lebrun in view of Wang;
- (2) proposed substitute claims 19 and 28 remain obvious over Prajapat in view of Wang; and
- (3) proposed substitute claims 19 and 28 are also obvious over Birnbaum in view of Wang and Lebrun and/or Prajapat.

For the reasons below, on this record, Petitioner’s contentions based on grounds (1), (2), and (3) are sufficiently persuasive. We recognize that, at this stage in the proceeding, Patent Owner has not yet had an opportunity to respond. Patent Owner will have the opportunity to respond in a Reply or a Revised Motion to Amend.

Lebrun and Wang

Petitioner contends Lebrun discloses the newly amended 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.” *See* Opp. 11–13.

For the limitation that the first data (received from the synchronization server) includes “information related to a shared user input web browsing interaction” Petitioner relies on Lebrun 45:15–16 and 45:21–46:5. Opp. 12. We agree with Petitioner, at this stage of the proceeding, that Lebrun describes a shared user input web browsing interaction wherein a controlling client sends a next page message 151 to group-surfing server 140, which obtains the page, and re-sends the page to web clients participating in the session, such that the page is presented at each of the web clients participating in the session. Lebrun 45:15–16, 45:21–46:5. In this disclosure, we determine that at least the page(s) sent to web clients

participating in the session from server 140 correspond to the claimed “information related to a shared user input web browsing interaction.”

For the limitation that the first data (received from the synchronization server) includes “second data indicating at least one direct host device interaction with content of the website performed by the host device” Petitioner relies on Lebrun 39:4–10. Opp. 12. This portion of Lebrun describes that when a controlling client 110 enters information to complete an HTML form, the information is sent to the group-surfing server 140, and the group-surfing server 140 may present that information on the HTML form at each participating web client 110, so that each participating web client 110 can see the HTML form being filled in. Lebrun 39:4–10. On this record, we agree with Petitioner that 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 [sic] server presenting that information to each participating web client 110 is the guest device ‘receiving’ the second data from the synchronization server.”

Petitioner further contends Lebrun discloses the “operating a browser” limitation of proposed substitute claim 19. *See* Opp. 13–14. We agree with Petitioner that Lebrun’s form completion (discussed *supra*) describes usage of the second data “to independently replicate the host device interaction.” *Id.* We further agree with Petitioner that Lebrun describes a second web client 110 receiving pointers (such as URLs) to those pages presented during a group-surfing session. Lebrun 43:20–22. On this record, we consider this portion of Lebrun teaches “the content of the website [is] obtained by the guest device from a website server based on at least the first data.”

Petitioner further contends Lebrun contemplates combining embodiments. *See* Opp. 14–15. On this record, we agree with Petitioner and observe that Lebrun 37:21–25 teaches variations of techniques in the context of web page automatic form completion described on pages 38 and 39. *See* Lebrun 37:24–25 (“[t]hese can include one or more of, or some combination of, the following”).

In general, Petitioner does not separately address claim 28. We note that proposed substitute claim 28 contains the narrowing limitation “at least one action performed by the host device on content of the website

displayed in a host browser of the host device.” On this record, this limitation does not distinguish over Lebrun. See, e.g., Lebrun 12:24–25.

Prajapat and Wang

Petitioner contends Prajapat, alone or in combination with Wang, discloses the proposed amended 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.” See Opp. 15–18.

For the limitation that the first data (received from the synchronization server) includes “information related to a shared user input web browsing interaction” Petitioner cites Prajapat paragraph 43. Opp. 15–16. At this preliminary stage, we agree with Petitioner that Prajapat describes a shared user input web browsing interaction wherein browser 12a in Figure 3 submits a request to web content server 18 for one or more web pages using an HTTP link or other suitable type of link. Prajapat ¶ 43. Web content server 18 returns the requested web page to browser 12a. *Id.* Browser 12a also communicates the URL or other suitable information regarding the requested web page to web media server 14a, which in turn communicates the URL and any other suitable information to web media server 14b, which in turn communicates the URL and any other suitable information to browser 12b. *Id.* Browser 12b uses the URL and any other suitable information to request from web content server 18 the web page that browser 12a requested. *Id.* In this disclosure, we preliminarily determine that at least the URL and any other suitable information sent to browser 12b from server 14b correspond to the claimed “information related to a shared user input web browsing interaction.”

For the limitation that the first data (received from the synchronization server) includes “second data indicating at least one direct host device interaction with content of the website performed by the host device” Petitioner cites Prajapat paragraphs 12, 30, and 31. Opp. 16. These portions of Prajapat describe, for example, “web page form content, such as fields in web page forms for example, [being] kept in sync on web pages in browsers 12 involved in a web page sharing session . . . events may be generated to the browsers 12 to update the web page form content if necessary (i.e. the originating browser 12 may not need the event).”

Prajapat ¶ 31. These portions further describe “changes to [a] content tree in browser 12a may [] be synchronized with other browsers 12 in a web page sharing session. As a content tree associated with a browser 12 is updated on the web media server 14 associated with the browser 12, multiple page load events may be generated from the web media server 14 to the browser 12 to cause full content synchronization.” Prajapat ¶ 30. At this preliminary stage, we agree with Petitioner’s contention that “[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.’” Opp. 16.

Petitioner makes additional contentions regarding Wang but does not clearly articulate how Wang discloses specific claim language. Opp. 16–17.

Petitioner further contends Prajapat discloses the “operating a browser” limitation of claims 19 and 28. *See* Opp. 17–18 (citing Prajapat ¶¶ 12, 30, 31, 43). As discussed *supra*, we determine Prajapat’s disclosure of maintaining web page form content in sync as set forth in paragraph 31 describes usage of second data “to independently replicate the host device interaction.” We further determine Prajapat’s description that “[w]eb media server 14b may communicate the URL and any other suitable information to browser 12b. Browser 12b may use the URL and any other suitable information to request from web content server 18 the web page that browser 12a requested” (Prajapat ¶ 43) describes “the content of the website [is] obtained by the guest device from a website server based on at least the first data.” Prajapat paragraphs 22 and 36 describe that a request for a webpage can include cookies.

Petitioner further contends Prajapat contemplates combining embodiments. *See* Opp. 18. On this record, we agree with Petitioner that Prajapat contemplates combining embodiments. *See* Dec. 40–41; Prajapat ¶¶ 41 (in the context of Figure 3, referring to aspects of the Figures 1 and 2 embodiments), 45 (collectively referring to aspects of Figures 1, 2, and 3), 47 (in the context of Figure 3, referring to aspects of the Figures 1 and 2 embodiments).

In general, Petitioner does not separately address claim 28. We note that claim 28 contains the narrowing limitation “at least one action performed by the host device on content of the website *displayed in a host browser of*

the host device.” On this record, however, this limitation does not distinguish over Prajapat. *See, e.g.,* Prajapat ¶ 12 (“browser 12a and browser 12b display the same web pages at substantially the same time”).

Birnbaum

Petitioner contends the claimed host device corresponds to the first (or customer) computing device 410 of Birnbaum (see Figure 4) and the claimed guest device corresponds to the second (or agent) computing device 420 of Birnbaum. *See* Opp. 20–21. On this record, we agree with Petitioner in this regard. Birnbaum describes device 410 is polled for a change of activity, such as entries in a form, and this information regarding the change is sent to the device 420 for display. *See* Birnbaum ¶¶ 67 (“[i]f . . . a change in browser activity on the customer computing device is detected then information regarding the change is collected and sent 104 to the agent's computing device”), 88, 89. Birnbaum further describes “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.” Birnbaum ¶ 80.

Birnbaum further describes “[t]he customer's computing device may actually be connected to a company server that then interacts with an agent's computing device. . . . 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.” Birnbaum ¶ 60. Petitioner contends the claimed synchronization server corresponds to the company server. Opp. 20–21. On this record, we agree with Petitioner in this regard. Petitioner contends the claimed first data corresponds to the information regarding the change that is received by device 420. *See* Opp. 20. We agree with Petitioner that the information regarding the change that is received by device 420 is “information related to a shared user input web browsing interaction.”

For the limitation that the first data (received from the synchronization server) includes “second data indicating at least one direct host device interaction with content of the website performed by the host device” Petitioner relies on Birnbaum Figure 4. *See* Opp. 21–23. In more detail, Petitioner contends “[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.’”

Opp. 22-23. On this record, we agree with Petitioner in this regard.

Petitioner further contends Birnbaum discloses the “operating a browser” limitation of claims 19 and 28. *See* Opp. 23. We agree with Petitioner that Birnbaum’s process, discussed *supra*, describes usage of the second data “to independently replicate the host device interaction.” For example, in Figure 4, the name in field 406 is independently replicated in field 416. Birnbaum Fig. 4, ¶¶ 80, 88, 89. Birnbaum discloses “[i]f the information [from the device 410] is a new web address, the browser on the agent's computing device [420] will go to that new web address.” Birnbaum ¶ 80; *see also* Birnbaum ¶ 72. On this record, we agree with Petitioner that at least this portion of Birnbaum teaches “the content of the website [is] obtained by the guest device from a website server based on at least the first data.”

On this preliminary record, we agree with Petitioner’s contentions that “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.” Opp. 24 (citing Birnbaum ¶ 12, Fig. 4); *see also* Lebrun 4:1–4, 39:4–10; Wang ¶¶ 9, 10, 13. Further, on this record, we agree with the motivation specific to the amended claim limitations on the lower half of page 24 of the Opposition. *See* Opp. 24.

In general, Petitioner does not separately address claim 28. We note that claim 28 contains the narrowing limitation “at least one action performed by the host device on content of the website *displayed in a host browser of the host device.*” On this record, however, this limitation does not distinguish over Birnbaum. *See, e.g.,* Birnbaum ¶ 38 (“the first computing device and the second computing device to display the same web pages on the browsers on both computing devices”).

III. CONCLUSION

This concludes the Preliminary Guidance, which is Patent Owner’s first option under the Board’s pilot program. Notice, 84 Fed. Reg. at 9,497. Patent

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Owner has an additional option under the Board's pilot program to file a revised MTA by DUE DATE 3. Paper 13, 10, 12; Paper 14, 1.

In addition to those two options under the Board's pilot program, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

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FOR PETITIONER:

Jennifer R. Bush
Christopher L. Larson
Fenwick & West LLP
jbush-ptab@fenwick.com
clarson@fenwick.com

FOR PATENT OWNER:

Bernard Tomsa
Scott W. Hejny
Ryan B. McBeth
Archis (Neil) V. Ozarkar
Andrew Turner
MCKOOL SMITH, P.C.
btomsa@brookskushman.com
shejny@mckoolsmith.com
rmcbeth@mckoolsmith.com
nozarkar@mckoolsmith.com
aturner@brookskushman.com