

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.
Petitioner

v.

SAMESURF, INC.
Patent Owner

Case IPR2023-00342
U.S. Patent No. 8,527,591

PATENT OWNER'S SUR-REPLY

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	SUR-REPLY ARGUMENTS.....	3
A.	A “Synchronized Browsing Session” Requires that the Host and Guest Device Synchronously Share the Same Web Browsing Experiences and in “Real-Time”	3
B.	“Page Sharing” is Distinguished from the Claimed Inventions and Lebrun and Prajapat Are Examples of “Page Sharing”	10
C.	Petitioner Has Not Met its Burden of Proving that LeBrun in Combination with Wang Renders Obvious Any Claim of the ’145 Patent (Ground 1).....	12
1.	All of the Limitations of the Claims of the ’145 Patent Are in Dispute	12
2.	Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.d].....	13
3.	Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.e].....	16
4.	Petitioner Has Not Met its Burden of Proving that a POSITA Would Have Been Motivated to Combine Lebrun with Wang	17
D.	Petitioner Has Not Met its Burden of Proving that Prajapat in Combination with Wang Renders Obvious Any Claim of the ’591 Patent (Ground 2).....	18
1.	Petitioner Has Not Met its Burden of Proving that Any of Prajapat’s Three Embodiments May be Combined With Each Other.....	19
2.	Prajapat’s “Peer-to-Peer Simple Web Page Sharing” Embodiment Does Not Disclose a “Synchronized Browsing Session” As Claimed.....	21

3.	Petitioner Has Not Met Its Burden of Proving that a POSITA Would Have Been Motivated to Combine Prajapat with Wang.....	22
III.	CONCLUSION.....	23

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Data Engine Techs. LLC v. Google LLC</i> , 10 F.4th 1375 (Fed. Cir. 2021)	8
<i>E.I. DuPont de Nemours & Co. v. Synvina C.V.</i> , 904 F.3d 996 (Fed. Cir. 2018).....	13
<i>Endo Pharms., Inc. v. Actavis LLC</i> , 922 F.3d 1365 (Fed. Cir. 2019).....	17, 23
<i>FanDuel, Inc. v. Interactive Games LLC</i> , 966 F.3d 1334 (Fed. Cir. 2020).....	12
<i>GE v. Raytheon Techs. Corp.</i> , 983 F.3d 1334 (Fed. Cir. 2020).....	12, 19
<i>In re Chaganti</i> , 554 F. App'x 917 (Fed. Cir. 2014)	18
<i>In re Fought</i> , 941 F.3d 1175 (Fed. Cir. 2019).....	8
<i>In re Stepan Co.</i> , 868 F.3d 1342 (Fed. Cir. 2017).....	20
<i>Teva Pharms. Int'l GmbH v. Eli Lilly & Co.</i> , 8 F.4th 1349 (Fed. Cir. 2021)	18
<i>TQ Delta, LLC v. Cisco Sys.</i> , 942 F.3d 1352 (Fed. Cir. 2019).....	18
<i>Verizon Servs. Corp. v. Vonage Holdings Corp.</i> , 503 F.3d 1295 (Fed. Cir. 2007).....	6
STATUTES	
35 U.S.C. § 316(e)	12

TABLE OF EXHIBITS

Exhibit	Description
2001	Saif Askar's Declaration
2002	Saif Askar's Biography
2003	Declaration of David S. Howell
2004	Declaration of Stacy Friedman
2005	Order Denying Defendant's Motion to Dismiss Pursuant to 35 U.S.C. § 101 (Case No. 3:22-cv-00412-LL-KSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)
2006	Defendant Intuit Inc.'s Memorandum of Points and Authorities in Support of Motion to Dismiss Pursuant to Fed.R.Civ.P. 12(b)(6) (Case No. 3:22-cv-00412-LL-KSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)
2007	Defendant Intuit Inc.'s Reply in Support of Motion to Dismiss Pursuant to Fed.R.Civ.P. 12(b)(6) (Case No. 3:22-cv-00412-LL-KSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)

I. INTRODUCTION

Petitioner has ***not*** met its burden of proving that claims 1-18 of the '591 Patent would have been obvious to a POSITA at the time of invention over Lebrun (Ex. 1005) in view of Wang (Ex. 1006) (Ground 1) or over Prajapat (Ex. 1007) in view of Wang (Ground 2).

First, the '591 Patent claims require a “synchronization server,” which as shown by PO throughout its submissions herein, is vastly different in terms of form, function, and purpose than Lebrun’s “Group Surfing Server,” Prajapat’s “Web Media Server” and Wang’s “Server Apparatus.” Session participants in Lebrun, Prajapat and Wang engage in a resource intensive “page sharing” process that requires that a “middleman” server continuously request, receive, reassemble, and deliver *webpage content* to the participants via the middleman server’s interactions with the web server. In the '591 Patent claims, the guest devices in PO’s system engage in a resource efficient “synchronized browsing session” wherein *URL and cookie information are received* from the “synchronization server,” thereby allowing the guest device to make its own request to the web server to thereby independently replicate the host’s web browsing interactions in real time. These fundamental differences in components, topology and flows would not have been obvious to a POSITA at the time of the '591 Patent, and Petitioner has not met its burden of proving otherwise.

Second, Petitioner incorrectly contends that the '591 Patent claims do not require “two browsers [that] are simultaneously, or nearly simultaneously, sharing internet browsing of the same webpage in real time” by *ignoring its own contentions* before the District Court that the Asserted Claims (including the '591 Patent) “make clear that sending and receiving information for simultaneous interactions is the focus of the Asserted Claims.” Exs. 2006, 7:11-12 and 2007. The District Court adopted a more detailed description of the claims, finding that the claims are “directed to performing a synchronized browsing session between two electronic devices (a host device and a guest/invitee device) via a synchronization server.” Ex. 2005, 10:4-21 (emphasis added). Petitioners own prior arguments, and their adoption by the District Court, demonstrates that the '591 Patent does in fact require a “synchronized browsing session,” *i.e.*, two browsers that are simultaneously, or nearly simultaneously, sharing internet browsing of the same webpage in real time.

Third, Petitioner fails to prove that Lebrun and Prajapat disclose at least limitations [1.d] and [1.e] and that a POSITA would have been motivated to combine either reference with Wang. Petitioner cannot prove that Lebrun or Prajapat disclose limitations [1.d] and [1.e] because both references require a “middleman” server, which, contrary to limitations [1.d] and [1.e], does not send both a URL of a website and cookie information associated with the website, where the website is being accessed in “real-time” by a host device. Thus, Lebrun and Prajapat fail to meet all

elements of the independent claims and fail to administer a “synchronized browsing session” between a host and guest device.

II. SUR-REPLY ARGUMENTS

A. A “Synchronized Browsing Session” Requires that the Host and Guest Device Synchronously Share the Same Web Browsing Experiences and in “Real-Time”

PO contends that a POSITA reading the claims in light of the specification would have understood that the term “synchronized browsing session” requires that the host and guest device synchronously share the same web browsing experiences and in real time. Patent Owner’s Response (“POR”), 11-12; 15-25. Petitioner contends that the claims of the ’591 Patent do not require “two browsers [that] are simultaneously, or nearly simultaneously, sharing internet browsing of the same webpage in real time,” *i.e.*, “[t]here is no requirement in the claims that any content be such ‘simultaneous’ or ‘real time sharing’ of the same webpage in real time.” Pet. Reply at 4-6. Defendants’ contention is incorrect.

First, the claims require a “**synchronized** browsing session,” which, of course, requires that the host and guest device synchronously share the same web browsing experiences and in real time. *See* Ex. 1001, 2:37-47; 5:11-22. Limitation [1.d] further recites that the guest device receives data from the synchronization server, where the data relates to “a website **being accessed in real-time by a host device**.” A website “being accessed in real-time” is one where the access by the host device is occurring

simultaneously, or nearly simultaneously, to when the data is being received at the guest device through the synchronization server. If that is not the case, then the host device's access to the website will not satisfy "being accessed in real-time" and the browsing session between the host device and the guest device will not be "synchronized."

Second, the specification and prosecution history support this understanding. In a claim amendment and office action response dated May 6, 2013, the applicant stated that the claims, as amended, were distinguished from the prior art because they are directed to synchronous browsing, due to the cookie being shared and thus involves "Internet browsing involving *real-time, simultaneous passing of the various data types* (i.e., *URLs, and cookies*) *related to user input action by a host device on a webpage*." Ex. 1002 (Office Action Response dated May 6, 2013), 57. The Applicant also explained why the passing of cookie information (along with the URL) from the host device to the guest device through the synchronization server is critical to allow the guest device to access the website separately from the host device and still see similar information:

Cookie information has been included in order to help clarify that this particular website interaction information is being sent between devices. Websites are modified based on cookie information of the requesting devices, and in order to have a successful synchronization session, cookie information is passed between a host device and one or more guest devices. *Without such passing of the cookie information*

related to the host device the one or more guest devices may not see the same website as the host device.

Ex. 1002, 56-57 (emphasis in original and emphasis added). In the same Response, the inventors amended the independent claims to add the phrase: “where the data relates to a website being accessed in real-time.” Ex. 1002, 50-52. The examiner found that this limitation distinguished the amended claims over the prior art and thus issued a notice of allowance. Ex. 1002, 21.

The specification of the '591 Patent also explains that:

- (1) “The *present invention* describes a method and apparatus for the implementation of a *real-time, sharable web browsing experience* on a guest device, utilizing the transfer of URL and form data information. Ex. 1001, Abstract¹;
- (2) “The *present invention* relates in general to a sharable browsing experience, and more specifically, to a method and apparatus for the implementation of a *synchronized browsing session* on a guest device utilizing the transfer of URL, form data, script, and other information.” Ex. 1001, 5:8-12;
- (3) “The present invention allows two or more persons browsing the internet to share their internet browsing experience and have all users

¹ All emphasis in quotations has been added unless otherwise noted.

simultaneously browse and fully interact with web sites, games, virtual worlds, or other online applications in *real time*.” Ex. 1001, 5:11-15; *see Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007) (“When a patent thus describes the features of the ‘present invention’ as a whole, this description limits the scope of the invention.”).

Third, the Board should disregard Petitioner’s current contentions that the claims do not require any content to be synchronized, viewed simultaneously or near simultaneously, or be coordinated, as they are *contrary* to Petitioner’s own prior contentions before the District Court in its Motion to Dismiss re non-patentable subject matter pursuant to Section 101 (which the District Court denied). Exs. 2005, 2006, 2007. In their Motion, Petitioner understood that the claims of the ’591 Patent “make clear that *sending and receiving information for simultaneous interactions* is the focus of the Asserted Claims,” which includes the ’591 Patent. Ex. 2006, 7:11-12; *see also* 2:16-21; 3:26-4:3; 6:12-14; Ex. 2007, 1:20-25; 3:16-17; 4:2-6; 5:2-4.

The District Court denied Petitioner’s Motion, and, in so doing, held that the claims, as supported by the specification, are “directed to performing *a synchronized browsing session* between two electronic devices (a host device and a guest/invitee device) via a synchronization server.” Ex. 2005, 10:4-11:21. The Court thus concluded that “the claims are directed to a specific solution that is rooted in

computer technology to overcome a problem specifically arising in the realm of computer networks—*using a synchronization server to administer synchronized browsing sessions* in order to overcome the bandwidth and processing issues of the prior art.” Ex. 2005, 11:23-27.²

Petitioner further contends that “[n]othing in the claim recites *how* the synchronized browsing session is administered by the synchronization server” Pet. Reply, 6. Petitioner ignores the District Court’s findings that (1) the claims “are specifically directed to performing a synchronized browsing session between two electronic devices (a host device and a guest/invitee device) via a synchronization server;” (2) that the preamble provides that “the [representative] claim is directed to a method for ‘performing a synchronized browsing session administered by a synchronization server;” and (3) that the body of the claim provides the method steps

² The Board should give no weight to Petitioner’s expert’s opinion that “[n]one of the claim limitations requires any synchronous sharing of the same web browsing experiences, despite PO trying to read this limitation” (Ex. 1034, ¶ 7), because that alleged opinion *contradicts* Petitioner’s own prior contentions before the District Court and Petitioner’s expert never states that he considered Petitioner’s prior Motion to Dismiss contentions or the District Court’s findings. Ex. 2006, 7:11-12; Ex. 2005, 11:23-27.

for performing the “synchronized browsing session via a synchronization server, a host device, and a guest device.” Ex. 2005, 10:5-15.

Since Petitioner and the District Court relied on the preamble of claim 1 of the representative claim which states that the method is directed to a “synchronized browsing session” in their Section 101 analysis, the recitation of the “synchronized browsing session” in the preamble is *limiting*. See *Data Engine Techs. LLC v. Google LLC*, 10 F.4th 1375, 1381 (Fed. Cir. 2021) (holding that reliance on the preamble as a limitation to show patentable subject matter under Section 101 renders the preamble limiting for purposes of infringement and validity). Further, the reference to a “synchronized browsing session” and “synchronization server” in the preamble provide antecedent basis for the same terms in limitations [1.a] and [1.b] of the claims and therefore, for this reason as well, the preamble is limiting, thereby limiting the claims to “a synchronized browsing session administered by a synchronization server.” *In re Fought*, 941 F.3d 1175, 1178 (Fed. Cir. 2019).

As PO discussed in its POR, a “synchronized browsing session” requires shared internet browsing “in real time” and in a “simultaneous fashion from different devices and/or locations” (POR, 15-16). Therefore the claims, being limited to “synchronized browsing sessions,” similarly require shared internet browsing “in real time” and in a “simultaneous fashion from different devices and/or locations.” See POR, 15-26.

Fourth, Petitioner’s citation to PO’s expert’s deposition testimony at Ex. 1033, 193:19-20 and 193:24-194:8 does not support its contention that the claims do not require “synchronously sharing the same web browsing experiences.” PO’s expert (Mr. Friedman) was merely asked whether elements [1.d] and [1.e] recite the term “synchronized browsing session,” to which he answered “[b]y itself, no, it does not.” Ex. 1033, 193:19-23. Petitioner carefully avoided asking about similar terms that do appear in elements [1.d] and [1.e], including “real-time” and “synchronization server.” Regardless, Petitioner does not address Mr. Friedman’s opinion that a POSITA would understand “the plain and ordinary meaning of ‘synchronized browsing session’ [to] necessarily exclude[] any ‘browsing session’ that is not ‘synchronized.’” Ex. 2004, ¶68. Similarly, Petitioner’s citations to its own expert’s declaration is of no support, as this merely constitutes Petitioner’s expert’s declaration statements regarding whether the certain terms appear in claim elements. *E.g.*, Ex. 1034, ¶10. Notably, as discussed, *supra* FN2, Petitioner’s expert did not consider Petitioner’s admission in its prior Motion to Dismiss that the claims of the ’591 do require synchronous browsing. Similarly, Petitioner’s expert ignores the term “real-time” in element [1.d].

B. “Page Sharing” is Distinguished from the Claimed Inventions and Lebrun and Prajapat Are Examples of “Page Sharing”

Petitioner’s objections to PO’s discussion of “page sharing” are meritless. Pet. Reply, 1-2.

First, Petitioner contends that PO asserted that “the ’591 Patent specification disparages ‘page sharing’ as too ‘resource intensive.’” Pet. Reply, 1. PO *never* stated that the ’591 Patent mentions “page sharing.” POR, 1-11. Instead, PO explained that “page sharing” was a technique for sharing webpages that was known in May 2010. POR, 7-8; Ex. 2004, ¶40.

Second, Petitioner contends that “[t]he ’591 Patent does not identify or describe any ‘middleman’ server or disparage the use of a server to relay webpage information to or from a webpage server.” Pet. Reply, 3. A “middleman” server is a server that: (1) receives website pages from a website server; and (2) transmits the received website pages to the web clients participating in the session. POR, 3, n 2. The use of a “middleman” server was a known method, like “desktop or screen sharing,” that “allow[s] users to simply view the same internet content.” Similar to “desktop or screen sharing,” page sharing does not “coordinate users’ browsing activity in any meaningful way” while also adding “additional resource usage.” Ex. 2004, ¶40. Methods that use a “middleman” server are therefore distinguished from the claims of the ’591 Patent, because they transmit webpage data between a

“middleman” server and a web browser. In other terms, methods using a “middleman server” do not disclose sending a “URL” and “cookie information” of a “website being accessed in real-time by a host device” from a “synchronization server” to a “guest device.” The Lebrun and Prajapat references each rely on the use of a “middleman” server. POR, 2-7.

Third, Petitioner contends that “[t]he claims also do not recite any architecture that would solve any problems purportedly caused by ‘middleman’ servers.” Pet. Reply, 3. This is incorrect. The specification expressly states that “[t]he present invention allows two or more persons browsing the internet to share their internet browsing experience and have all users simultaneously browse and fully interact with web sites, games, virtual worlds, or other online applications in real time,” **without** “materially impos[ing] more bandwidth or processing power requirements than simply browsing the internet using standard, conventional methods” by “utiliz[ing] the passing of certain data such as URL information, form data, scripts (including java script), cookies, or other types of data information between browser clients” via instruction from the “synchronization server.” Ex. 1001, 5:11-25.

Consistent with this description from the specification, claim 1 of the ’591 Patent describes how, in a “synchronized browsing session,” the “guest device” receives, from the “synchronization server,” the “URL of the website” and “cookie information associated with the website and the host device” where the data relates

to a “website being accessed in real-time by a host device.” It also requires that a browser on the “guest device” be operated “based on the data received from the synchronization server.”

C. Petitioner Has Not Met its Burden of Proving that LeBrun in Combination with Wang Renders Obvious Any Claim of the ’145 Patent (Ground 1)

1. All of the Limitations of the Claims of the ’145 Patent Are in Dispute

Petitioner contends that Ground 1 discloses limitations [1.pre]-[1.c] and therefore “[o]nly limitations [1.d], and [1.e] are in dispute.” Pet. Reply, 9. Petitioner is wrong. A determination of obviousness pursuant to Section 103 requires an examination of the claims “as a whole” and therefore *all* claim limitations are always in dispute. *GE v. Raytheon Techs. Corp.*, 983 F.3d 1334, 1352 (Fed. Cir. 2020). (“[t]he claimed invention and an invention in the prior art must both be analyzed as a whole for the same reason: an invention is more than the sum of its individual elements.”)

Further and pursuant to 35 U.S.C. § 316(e), Petitioner bears the burden of proving invalidity throughout the entire IPR proceeding, *i.e.*, that the claims of the ’145 patent, *as a whole*, would have been obvious to a POSITA. *FanDuel, Inc. v. Interactive Games LLC*, 966 F.3d 1334, 1342 (Fed. Cir. 2020). Indeed, “[a] patentee technically has no ‘burden’ to do anything to defend the validity of its patent other

than hold the patent challenger to its own burden of persuasion.” *E.I. DuPont de Nemours & Co. v. Synvina C.V.*, 904 F.3d 996, 1008 (Fed. Cir. 2018); 37 C.F.R. §§ 42.107(a).

2. Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.d]

Petitioner has not met its burden of proving that Lebrun discloses limitation [1.d], *i.e.*, that the “guest device” “receiv[es] data from the synchronization server, where the data relates to a website being accessed in real-time by a host device; and wherein the data comprises a URL of the website and cookie information associated with the website and the host device.”

First, Petitioner now contends that limitation [1.d] is met because the use of the word “only” does not mean that URLs are received to the exclusion of any other information, but that the term “only” excludes *just* webpages. Pet. Reply, 10-11. There is no basis for Petitioner’s read—if Lebrun recites that the web client receives “**only** a list of pointers,” then only pointers are received. Ex. 1005, 43:30-22. There is no disclosure of what else, besides pointers, may be received. If the drafter of Lebrun had wanted to state that information in addition to pointers is received, then they could have done so, but they did not. Petitioner offers no support to its proposal to rely on a guess or speculation as to what else Lebrun intended to be included.

Second, Petitioner further contends that the “system operation” of Figure 4 “specifically discloses the controlling web client sending the group-surfing server website cookies.” Pet. Reply, 11, citing Ex. 1005, 49:1-3. Here, critically, Petitioner misreads element [1.d]. The claim element does not recite that a web client *sends* the group-surfing server website cookies; rather, element [1.d] recites “*receiving* data from the synchronization server,” where the data includes “cookie information associated with the website and host device.” Lebrun does not disclose that any web client ever *receives* cookie information associated with the website and host device.

Petitioner also cites to Lebrun’s Fig. 4, but that figure—which is largely unreadable—appears to state at element 236: “cookie recorded.” Ex. 1005, Fig. 4. Petitioner does not offer any further explanation of the significance of the figure. As explained in PO’s Response (POR, 31; Ex. 2004, ¶44), element 236 from Figure 4 relates to Lebrun’s disclosure at 46:7-11 which states that the group-surfing server—*not the web clients*—“records the ‘cookie’ in a cookie database relatively local to the group-surfing server 140 and session.” Ex. 1005, 46:8-9. The disclosures to Lebrun cited by Petitioner are consistent in that each explains that the group-surfing server browses webpages on behalf of the web clients, and then re-sends the webpage to the clients participating in the session. POR, 44-45; Ex. 2004, ¶44.

Thus, there is no disclosure in Lebrun that shows that both a “URL of the website and cookie information associated with the website and the host device” are

sent *from* the “group-surfing server” (*i.e.*, the “synchronization server”) *to* the web client (*i.e.*, the “guest device”).

Third, Petitioner contends that the “claims do not require that the URL ‘relates to a website being accessed in real-time by a host device.’” Element [1.d] clearly sets out that the guest device: (a) “receiv[es] data from the synchronization server”; (b) “the data *relates to a website being accessed in real-time by a host device*”; and (c) “the *data comprises a URL* of the website *and cookie information* associated with the website and the host device.” Ex. 1001, 22:63-67. The plain language of the claims requires that the URL and cookie information must be the data that relates to a website being accessed in real-time by a host device. This understanding is further supported by the ’591 Patent prosecution history wherein the Applicant explained in an Office Action Response that the “Applicant’s claimed invention” is “Internet browsing involving *real-time, simultaneous passing of the various data types (i.e., URLs, and cookies)* related to user input action by a host device on a webpage.” Ex. 1002, 56; *see also supra* Section II.A.

Fourth, Petitioner now contends that limitation [1.d] is also met because Lebrun’s disclosure includes the webpage “‘without any multimedia elements (such as embedded sound, images, or program fragments),’ which is later populated directly from the website.” Pet. Reply, 13. Petitioner did *not* include this disclosure in its Petition or its expert’s declaration, and therefore it is waived. Petition, 28-30;

Ex. 1003, ¶¶162-171. Regardless of the omission, these webpages do not meet limitation [1.d] or [1.e] as they do not relate to webpages that are the result of a guest device “operating a browser by the guest device based on the data received from the synchronization server.”

3. Petitioner Has Not Met its Burden of Proving that Lebrun Discloses Limitation [1.e]

Petitioner has not met its burden of proving that Lebrun discloses limitation [1.e], *i.e.*, “operating a browser by the guest device ***based on the data received*** from the synchronization server.”

Petitioner contends that the URL *and* cookie information do not both need to be used to operate the browser. Pet. Reply, 13. Petitioner must now take this position because its Petition failed to allege that Lebrun disclosed operating a browser based on cookie information—cookie information was not even mentioned with respect to element [1.e]. *See* Petition, 31-32.

Contrary to this position, and similar to the argument in Section II.C.2 *supra*, a reading that requires use of both the URL and cookie information *does* follow from the plain language of the claims. The claims recite that “the data [that is received from the synchronization server] comprises ***a URL of the website and cookie information*** associated with the website and the host device” ([1.d]) and that the guest device “operat[es] a browser ... ***based on the data received*** from the

synchronization server” ([1.e]). Simple substitution of the term thus requires that “the data received” is both the URL and the cookie information received from the synchronization server, and that the guest device must operate a browser “based on” the URL and the cookie information received from the synchronization server. *See also* Ex. 2004, ¶67.

Petitioner’s selective preference of operating a browser based only on partial data is unsupported by the law or a plain reading. Petitioner has cited no case law that says that antecedent basis for a term may be ignored. Consequently, Petitioner’s expert’s opinion is also inconsistent with the law, notwithstanding that the opinion is not stated to be in the context of a POSITA at the time of the invention. It is therefore irrelevant and should be given little to no weight.

4. Petitioner Has Not Met its Burden of Proving that a POSITA Would Have Been Motivated to Combine Lebrun with Wang

Petitioner has not met its burden of showing that a POSITA would have been motivated at the time of the ’591 Patent (*i.e.*, without hindsight) to combine Lebrun with Wang to arrive at the inventions claimed in the ’591 Patent. *Endo Pharms., Inc. v. Actavis LLC*, 922 F.3d 1365, 1373 (Fed. Cir. 2019).

Petitioner *ignores* PO’s contention that Petitioner failed to “discuss what obviousness-related modifications to Lebrun . . . should be made with the disclosure of Wang” (POR, 69). Instead, Petitioner only criticizes PO’s expert for using the

term “teaches away” as part of his multi-paragraph testimony. Pet. Reply, 14-15. In so doing, Petitioner misstates the meaning of teaching away: “[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Chaganti*, 554 F. App’x 917, 921 (Fed. Cir. 2014). Indeed, the obviousness analysis must account for “reasons not to combine,” which are facts relevant to the overall consideration of obviousness. *Teva Pharms. Int’l GmbH v. Eli Lilly & Co.*, 8 F.4th 1349, 1358 (Fed. Cir. 2021).

Furthermore, Petitioner’s statement—“to the extent Lebrun and Wang teach different methods of storing data, that does not show ‘teaching away’ nor any reason a POSITA would not be motivated to combine their disclosures” (Pet. Reply, 15; Ex. 1034, ¶23)—is not supported by its expert’s testimony and is thus insufficient to meet Petitioner’s burden of showing a motivation to combine Lebrun and Wang. *See TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1357-1361 (Fed. Cir. 2019) (rejecting obviousness determinations based on conclusory and unsupported expert testimony).

D. Petitioner Has Not Met its Burden of Proving that Prajapat in Combination with Wang Renders Obvious Any Claim of the ’591 Patent (Ground 2)

With Ground 2, Petitioner contends that only limitation [1.d] is in dispute. This not only misreads PO’s Response (*see, e.g.*, POR, 53, 65-67), it again misreads

that limitation [1.e] cannot be met if both URL and cookie information are not used by the guest device to operate a browser. Further, as noted above, a determination of obviousness pursuant to Section 103 requires an examination of the claims “as a whole” and therefore *all* claim limitations are always in dispute. *GE*, 983 F.3d at 1352.

PO addressed numerous other deficiencies of Prajapat with respect to limitation [1.d]. For example, PO set forth that (1) in Prajapat, browsers 12a and 12b do not communicate with a website server, but rather communicate with web media servers 14a or 14b (POR, 66-67); and (2) in Prajapat’s “peer-to-peer simple web sharing embodiment,” there is no teaching or suggestion that browser 12a and browser 12b simultaneously, or nearly simultaneously, and in real time share internet browsing on the same webpage (POR, 65-66).

1. Petitioner Has Not Met its Burden of Proving that Any of Prajapat’s Three Embodiments May be Combined With Each Other

Petitioner acknowledges that Prajapat discloses multiple, distinct embodiments but contends that “similar processes can be used among the various embodiments.” Petitioner argues that if statements with respect to two of the embodiments of that one feature are similar to that feature in the other embodiment, then a POSITA would have combined disclosures from the various embodiments. Pet. Reply, 19. This is incorrect.

Prajapat discloses a first, “peer-to-peer dynamic web page sharing” embodiment at Ex. 1007, [0012]-[0040]. However, it is essential to note that Prajapat does not state anywhere that the description of that embodiment applies to any other embodiment.

Prajapat discloses a second, “peer-to-peer simple web page sharing” embodiment at Ex. 1007, [0041]-[0043]. In this description, Prajapat states that the web media server 14a locates the web media server associated with browser 12b to operate in a substantially similar manner to the first embodiment. Ex. 1007, [0041]. Prajapat does *not* state that any other feature of this second embodiment operates in a similar fashion to a feature in the first embodiment.

Prajapat discloses a third, “peer-to-peer web sharing using at least two phones” embodiment at Ex. 1007, [0044]-[0048]. Prajapat states that UA and media controller 54a can locate UA and media controller 54b to operate in a substantially similar manner to that in the first and second embodiments. Ex. 1007, [0045].

It is clear that the implication of these single, limited, and explicit disclosures is that all *other* aspects of these second and third embodiments operate differently from the first embodiment. *In re Stepan Co.*, 868 F.3d 1342, 1346 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references, *combining multiple embodiments from a single reference*, or selecting from large lists of elements in a single reference, there must be a motivation to make the

combination and a reasonable expectation that such a combination would be successful, otherwise a skilled artisan would not arrive at the claimed combination.”)

2. Prajapat’s “Peer-to-Peer Simple Web Page Sharing” Embodiment Does Not Disclose a “Synchronized Browsing Session” As Claimed

As discussed at Section II.A, *supra*, the claims require the existence of “synchronized browsing sessions,” *i.e.*, shared internet browsing that occurs “in real time” and in a “simultaneous fashion from different devices and/or locations.” Petitioner contends that in Prajapat’s “peer-to-peer dynamic web page sharing” embodiment, Prajapat discloses “the retrieval and display of the requested content on each browser,” citing Ex. 1007, [0012]. Pet. Reply, 2.

Petitioner’s reliance on Prajapat’s “dynamic web page sharing” embodiment of paragraph [0012] is misplaced and irrelevant since, as discussed in Section II.D.1., *supra*, Prajapat’s “dynamic web page sharing” embodiment is ***not*** descriptive of Prajapat’s other “peer-to-peer simple web page sharing” embodiment of Paragraphs [0041-0043]. As PO discussed in its POR at 63-64 as it relates to the “simple web page sharing embodiment,” Prajapat teaches the direct transmission through the “peer-to-peer” web media servers of a URL (or other suitable information regarding the requested webpage) from one browser to another browser, in an “any time” sequence, without any suggestion that the transmission is “simultaneous,” in “real-time,” or temporally coordinated in any fashion.

Petitioner has no response to PO's contention that there is no disclosure in Prajapat that the simple web-page sharing embodiment is performed synchronously. POR at 65-66. Prajapat's "peer-to-peer simple web page sharing" cannot disclose a "synchronized browsing session." This embodiment of Prajapat cannot also disclose limitation [1.d] because it does not "receiv[e] data from the synchronization server, *where the data relates to a website being accessed in real-time* by a host device."

Further, Petitioner's citations to PO's expert's deposition testimony at Ex. 1033, Ex. 1033, 146:6-21; 147:8-16; 148:14-25 do not support its contention that Mr. Friedman admitted that Prajapat in combination with Wang discloses all of the claim elements. Mr. Friedman was repeatedly asked whether Prajapat and Wang disclosed all of the limitations of Claim 1 of the '591 Patent, and multiple times Mr. Friedman responded that his declaration explains in paragraph 79 that the Petition fails to identify element 1.d and 1.e consistently in Prajapat. Ex. 1033 at 146:6-21; 147:18-148:12; 149:15-150:3; *see also* Ex. 2004, ¶¶74-80.

3. Petitioner Has Not Met Its Burden of Proving that a POSITA Would Have Been Motivated to Combine Prajapat with Wang

Petitioner has not met its burden of showing that a POSITA would have been motivated at the time of the '591 Patent (*i.e.*, without hindsight) to combine embodiments within Prajapat, or Prajapat with Wang to arrive at the inventions

claimed in the '591 Patent. *Endo Pharms., Inc. v. Actavis LLC*, 922 F.3d 1365, 1373 (Fed. Cir. 2019).

As with Ground 1, Petitioner ***ignores*** PO's contention that Petitioner failed to "discuss what obviousness-related modifications to . . . Prajapat . . . should be made with the disclosure of Wang" (POR, 69). PO's expert's testimony that a POSITA would not have been motivated to combine Wang with Prajapat stands unrebutted. Ex. 2004, ¶¶85, 87; *see generally* ¶¶81-87.

III. CONCLUSION

The arguments above apply equally to independent claims 1 and 10. Therefore, claims 1-18 are patentable over Lebrun in view of Wang (Ground 1) and over Prajapat in view of Wang (Ground 2).

Date: January 31, 2024

Respectfully submitted,

/ Scott W. Hejny /

Scott W. Hejny

Reg. No. 45,882

shejny@mckoolsmith.com

McKool Smith, P.C.

300 Crescent Court, Suite 1500

Dallas, Texas 75201

Telephone: 214-978-4000

Fax: 214-978-4044

Counsel for Patent Owner, Samesurf, Inc.

CERTIFICATION OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S SUR-REPLY** specified in 37 C.F.R. § 42.24 have 5,193 words, in compliance with the 5,600 word limit set forth in 37 C.F.R. § 42.24(c). This word count was prepared using Microsoft Word 2016.

Date: January 31, 2024

Respectfully submitted,

/Neil Ozarkar /

Neil Ozarkar

Reg. No. 71,265

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S SUR-REPLY** is being served on counsel for petitioner via electronic mail on, in its entirety on the following counsel of record for Petitioner on this 31st day of January 2024:

Jennifer R. Bush
jbush-ptab@fenwick.com

Michael J. Sacksteder
msacksteder@fenwick.com

Gregory R. Miller
gmiller@fenwick.com

Daniel Ledesma
dledesma@fenwick.com

Christopher L. Larson
clarson@fenwick.com

McKOOL SMITH, P.C.

/ Scott W. Hejny /

Scott W. Hejny
Reg. No. 45,882