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INTUIT INC.

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

SAN DIEGO DIVISION

Samesurf, Inc., Plaintiff, v. Intuit Inc., Defendant.	Case No.: 3:22-cv-00412-LL-KSC **DEFENDANT INTUIT INC.'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS PURSUANT TO RULE 12(b)(6)** Hearing Date: June 27, 2022 **PER CHAMBERS RULES, NO ORAL ARGUMENT UNLESS SEPARATELY ORDERED BY THE COURT** Judge: Hon. Linda Lopez Courtroom: 2B

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Like many before them, the asserted patents in this case recite nothing more than a computer-implemented mechanism for performing actions long performed by human beings outside the digital realm. Courts routinely find such patents invalid under § 101 of the Patent Act. Samesurf's Opposition identifies no convincing basis for any different outcome.

I. '591 Patent Claim 1 is Representative of all Asserted Claims

Contrary to Samesurf's assertion, Intuit has established that claim 1 of the '591 patent is representative of all asserted claims. Although Samesurf incorrectly argues that Intuit was required to "separately address each Asserted Claim with respect to patentable subject matter under § 101," Opp. at 12, Federal Circuit precedent contains no such requirement. Rather, a representative claim forms an appropriate basis for a § 101 analysis when all asserted claims are "substantially similar and linked to the same abstract idea." *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (citation omitted). The claims of related patents with "substantially the same specification"—such as those here—are representative across all of the patents and are therefore appropriate for subject-matter analysis based on a representative claim. *See Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1333 (Fed. Cir. 2017).

Following this precedent, Intuit has made a *prima facie* showing that claim 1 of the '591 patent is representative. In its opening brief, Intuit describes in detail how this claim is very similar in scope to the other asserted independent claims and recites the same basic, abstract steps as those claims: (1) sending a request by a first device to join a synchronized browsing session; (2) receiving information at a second device about the website content accessed; and (3) accessing the website content by the second device for synchronizing the session. *See* Mot. at 3-4. As for the asserted dependent claims, Samesurf effectively ignores an entire section of Intuit's opening brief explaining how those claims are directed to the same abstract idea and fail to add any inventive step. *See* Mot., § III(D) at 21-23.

Because Intuit has shown that claim 1 of the '591 patent is representative, "the burden shifts to the plaintiff to identify limitations that are present in the asserted claims but that are not represented by the allegedly representative claim." *PPS Data, LLC v. Jack Henry & Ass., Inc.*, 404 F. Supp. 3d 1021, 1031-32 (E.D. Tex. Sept. 2019). Samesurf fails to satisfy this burden because it presents no "meaningful argument for the distinctive significance of any claim limitations not found in the representative claim." *Quad City Pat., LLC v. Zoosk, Inc.*, 498 F. Supp. 3d 1178, 1184 (N.D. Cal. 2020) (quoting *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018)). Indeed, Samesurf has not identified *any* differences between claim 1 of the '591 patent and the remaining claims that would affect the § 101 analysis.

Instead, Samesurf makes the untenable argument that claim 1 of the '591 patent is not representative of *any* other asserted claim, even the other independent claim of the '591 patent. *See* Opp. at 11. This assertion strains credulity. The only differences between claim 1 of the '591 patent and the remaining asserted claims that Samesurf *does* raise are the addition of a "session identifier" and the distinction between "shared" and "non-shared" web browsing interactions. *See* Opp. at 11. But Intuit specifically addressed these purported differences—which are not meaningful—in Section III(D) of its opening brief, noting that session identifiers and web browser windows are conventional computer and Internet tools required to carry out the abstract sending and receiving of information for simultaneous interaction, and that such tools cannot save the claims from ineligibility. *See* Mot. at 22-23. Moreover, the abstract idea need not cover every claim limitation. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (although there were additional limitations in the claim, "the concept embodied by the majority of the limitations describes only" an abstract idea); *accord Trading Techs. Int'l, Inc. v. IBG LLC,* 921 F.3d 1084, 1092-93 (Fed. Cir. 2019). The shared specification of all three patents discloses that the purported invention does in fact include these requirements. For the session identifier, the specification describes in conjunction with FIG. 3 that the

request to join—which is recited in the second limitation of claim 1 of the '591 patent—*includes* the session identifier: "Finally, in step 306, guest device 14 transmits request to join 43 to synchronization server 13, *including session identifier* 19." '591 patent, 14:23-25 (emphasis added); FIG. 3 (step 306). Likewise, with respect to the shareability of the web browsing interaction,[1] claim 1 of the '591 patent recites "detecting an activation of a hyperlink associated with the synchronized browsing session." The hyperlink is only created for sharable browsing windows, so *the existence of the hyperlink associated with the synchronized browsing session* in the claim indicates that the content is shared. *See, e.g.,* '591 patent, 8:8-15 (describing shared browsing window). Thus, Samesurf's purported distinctions among the asserted claims are not distinctions at all. Accordingly, the patent-ineligibility of all asserted claims can be determined based on an analysis of claim 1 of the '591 patent.

II. Intuit Met its Burden to Show the Claims are Abstract

Samesurf spends almost 10 pages of its opposition attempting to rebut Intuit's showing that the asserted claims are directed to an abstract idea. In that space, Samesurf never really disputes the abstract idea embodied in the claims—sending and receiving information for simultaneous interaction—and never mentions it beyond merely reciting it one time. *See* Opp. at 12. Instead, Samesurf attempts to downplay Intuit's analogies and goes on at length about the purported benefits of the claimed technique. *See, e.g., id.* at 13, 15, 17-20. But the proper focus of *Alice* Step 1 is the invention *as claimed*. *ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 769 (Fed. Cir. 2019). That language shows that the claims are not patent-eligible.

Intuit's proposed abstract idea closely tracks the claims' text. The claim language repeatedly recites "sending" and "receiving" information, and simultaneously interacting via a "synchronized browsing session," and other

[1] This limitation is recited only in claim 1 of the '448 patent; it is not recited in claim 1 of the '145 patent.

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formulations of the same ideas. *See, e.g.,* Mot. at 7 n. 2 (identifying the sending, receiving, and simultaneous interaction focus in the claims). These are the core steps required to practice the invention as claimed (*e.g.*: (1) sending a request by a first device to join a synchronized browsing session; (2) receiving information at a second device about the website content accessed; and (3) accessing the website content by the second device for synchronizing the session). *See* Mot. at 7-16.

As discussed in Intuit's Motion, courts have correctly found claims directed to analogous techniques for collaborative web browsing and screen sharing to be abstract. *See* Mot. at 7-10 (discussing *Pragmatus, Williamson,* and other cases). Lacking a substantive basis to rebut these cases, Samesurf instead belittles them on procedural grounds. *See* Opp. at 17-18. But district court cases such as *Pragmatus* are still persuasive, and the Federal Circuit's affirmance of *Williamson* without opinion is meaningful even if not precedential. Rule 36 of the Federal Circuit's Rules of Practice permits a *per curiam* judgment of affirmance without opinion when "the record supports summary judgment…." Fed. Cir. R. App. Proc. 36(a)(3). In *Williamson*, the only issue the district court addressed on summary judgment was ineligibility under § 101, and since the district court found the claims ineligible, there can be no question that they were found to be directed to an abstract idea as a matter of law. In order to affirm, the Federal Circuit must have agreed.[2]

The cases upon which Samesurf relies, by contrast, relate to improvements

[2] Samesurf also complains fruitlessly about Intuit's reliance on "unpublished, non-precedential opinions" of the Federal Circuit. *See* Opp. at 18. But the Federal Circuit's rules do not prohibit citation to such opinions. *See* Fed. Cir. R. App. Proc. 32.1(c). While the Federal Circuit treats such opinions as persuasive, rather than binding, it does not restrict other courts in their treatment of them. *See id.* at Rule 32.1(d). Regardless of whether their precedential value is binding or precedential, these opinions reveal the thinking of the Federal Circuit on a relevant issue.

made directly to physical devices or to ephemeral objects that could only be used by computers. Here, assuming the claims improve information exchange and security, these improvements are only tethered to the human activity of exchanging and simultaneously sharing information. *See Trading Techs. Int'l, Inc.*, 921 F.3d at 1090 (finding the alleged efficiency improvements only made the user's actions more efficient). And the mere use of computers in this process does not make the claim patent eligible. *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017); *see Univ. of Fla. Rsch. Found., Inc. v. Gen. Elec. Co.*, 916 F.3d 1363, 1367 (Fed. Cir. 2019) (holding that "automation" of "pen and paper methodologies" is a "quintessential 'do it on a computer' patent" and does not make an idea less abstract under *Alice* Step 1 (citation omitted)). The asserted claims do not improve the generic server or computer devices themselves.

Samesurf cannot overcome Intuit's precedent or bolster its own by relying on the claimed "synchronization server." At best, this server constitutes a device in the middle to facilitate the simultaneous interaction in which information is sent and received. Use of a computerized intermediary has repeatedly been found to be abstract. *See Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 573 U.S. 208, 221-26 (2014); *see also Credit Acceptance Corp.*, 859 F.3d at 1055; *Univ. of Fla. Rsch. Found., Inc.*, 916 F.3d at 1367. Here, the synchronization server is nothing more than the overhead projector that allows multiple individuals to collaborate on the same content.

Samesurf effectively concedes this fact when it asserts that "communications by a host and a guest device are managed by the synchronization server, such that the same data ... is shared with the guest device so that the host device and the guest device can engage in a 'synchronized browsing session.'" Opp. at 21. That management function merely facilitates sending and receiving information to permit simultaneous interaction.

Nor can Samesurf rely on the specification's discussion of the synchronization server. The specification discloses that the synchronization server merely processes

data and "takes information from the host device and informs the guest device so that it may interact directly with" a website. Opp. at 14. In other words, it sends and receives data to facilitate human interaction on a page. This is, of course, the claims' abstract idea. The Supreme Court and Federal Circuit have repeatedly held that claims cannot merely take an abstract idea (here sharing and collaborating on information) and use a computer to carry out the abstract idea (here the synchronization server). *See Alice*, 573 U.S. at 221-26; *Credit Acceptance Corp.*, 859 F.3d at 1055; *Univ. of Fla. Rsch. Found., Inc.*, 916 F.3d at 1367.

Left without a mechanism within the claims themselves for preserving them, Samesurf tries to refocus on the purported benefits of the recited technique in bandwidth and security.[3] But again, Samesurf's opposition contains no real explanation for how the claims create these effects. For example, regarding security, Samesurf does little more than mention a distinction between "shared" and "non-shared" interactions and browser windows. *See* Opp. at 15-16. But the claims purported to implement this shared vs. non-shared distinction merely recite tautologies in which, for example, "shared user input web browsing interactions" are depicted in "a shared web browsing window," while "non-shared web browsing interactions are depicted in a non-shared web browser window." *See, e.g.*, '145 patent, claims 14, 18. They could just have easily said that shared documents are shown on the overhead projector, while non-shared documents are kept in a sealed envelope.

Even assuming the claims solved issues with bandwidth usage and security,

[3] Samesurf admits only certain claims are directed to improved security. *See* Opp. at 15 ("Asserted Claims 6, and 15-16 of the '591 Patent; Asserted Claims 5, 14, and 16-17 of the '145 Patent; and Asserted Claims 1-4, 6-8, 11-14, and 16 of the '448 Patent."). Arguments regarding improved security do not apply to the other claims.

these are only the claims' desired results, not their focus. Such hoped-for results cannot rescue a claim's eligibility separate from the claims. *See ChargePoint, Inc., Inc.*, 920 F.3d at 769; *cf. Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1356 (Fed. Cir. 2016) ("the essentially result-focused, functional character of claim language has been a frequent feature of claims held ineligible under § 101."). Nowhere does the claim language recite the words "bandwidth" or "security." Samesurf's alleged focus is far from the actual claim language; and the focus cannot be imported from the specification. *See The Chamberlain Grp., Inc. v. Techtronic Indus. Co.,* 935 F.3d 1341, 1346 (Fed. Cir. 2019). Furthermore, "even if the idea is novel and non-obvious—[it] is not enough to save it from ineligibility." *Solutran, Inc. v. Elavon, Inc.*, 931 F.3d 1161, 1169 (Fed. Cir. 2019).

Finally, Samesurf asserts without proper support that the synchronization server's use of a URL and cookie information, and "operating a browser by the guest device based on the data received from the synchronization server," is how claim 1 of the '591 patent reduces the use of bandwidth. Opp. at 21 (citing '591 patent at 2:23-36). But this argument is unavailing for multiple reasons. First, this use of URL and cookies limitation is not recited in the independent claims of the '448 or '145 patents. Therefore, the '448 and '145 patents receive no benefit from this argument. Second, the claims' text, which guides the inquiry, makes no mention of reduced bandwidth or improved operation, or how the use of a URL and cookies, and "operating a browser by the guest device based on the data received from the synchronization server" could achieve this alleged improvement. Third, the passage from the specification upon which Samesurf relies ('591 patent at 2:23-36) describes only the drawbacks in bandwidth usage and security in the prior art. It makes no mention of the patented technique's use of URLs, cookies, browsers, guest devices, host devices, synchronization servers, or anything else relevant to the claims. Accordingly, Samesurf's alleged "how" is still lacking.

III. The Asserted Claims Do Not Recite an Inventive Step

The asserted claims do not include any inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application. *Alice*, 573 U.S. at 221. Samesurf alleges three possibilities, none of which rises to the level of an inventive concept: (1) URL and cookie information associated with the website and the host device (Opp. at 23); (2) operating a browser by the guest device based on the data received from the synchronization server (Opp. at 23); and (3) a synchronization server that takes web interaction data from the host device and applies it at the guest device (Opp. at 24). Nor are these concepts recited in all asserted independent claims. Concepts (1) and (2) are recited only in the claims of the '591 patent. Thus, the first two have no bearing on the analysis regarding the '145 or '448 patents.

Since these concepts are part of the asserted abstract idea of the claims, they are irrelevant to the *Alice* Step 2 analysis. As discussed in the previous section, Samesurf pointed to each of these limitations in its unsuccessful attempt to rebut Intuit's showing of an abstract idea in the Step 1 analysis. But such limitations are not relevant to step 2 of the *Alice* analysis. Step 2 considers whether elements *additional to* what a claim is "directed to" transform the nature of the claim into a patent-eligible application. *Alice*, 573 U.S. at 217-218. Thus, the Court should consider only any additional elements beyond those included in the abstract idea. *Id.*

Even when these additional limitations are fully considered in the context of the claim as a whole, they are nothing more than well-understood, routine, and conventional steps or components that fail to rescue the claims from ineligibility. Operating a browser based on information received and receipt of URL and cookie information have been ubiquitous since the dawn of Web browsing. *See, e.g.*, '591 patent at 1:47-49 (noting that browsing is common); see also prior art listed on the patents' faces, *e.g.,* U.S. Pat. Pub. 2006/0129641 at [0009] ("Cookies reside on each user's local computer to be used as personal identifiers sent together with a Uniform Resource Locator (URL) requests."); U.S. Pat. Pub. 2005/0097107 at [0005]

(disclosing use of URLs and cookies); U.S. Pat. Pub. 2005/0138122 at [0033] ("The device-session can be created by any prior art session handling procedure like URL rewriting or use of cookies."); U.S. Pat. Pub. 2009/0241037 at [0020] (using URLs and cookies in co-browsing). Likewise, the specification admits the synchronization server is conventional. *See* Mot. at 17 (citing '591 patent at 6:3-21, 9:20-31).

Nor can *Berkheimer* rescue the claims here. "[N]ot every § 101 determination contains genuine disputes over the underlying facts material to the § 101 inquiry." *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018). Although *Berkheimer* is often cited for the proposition that Step 2 of the *Alice* framework can sometimes raise a fact issue, the Federal Circuit held that some of the claims at issue did *not* raise such a fact question. The *Berkheimer* court found two conditions in which no genuine factual dispute may exist: when improvements in the specification are not captured in the claims and when the specification or patent owner admits that the alleged inventive concepts are conventional. 881 F.3d at 1367-69 (affirming finding of ineligibility as to claims 1-3 and 9). Both examples from *Berkheimer* showing a lack of factual dispute are present here. First, Samesurf admits, at minimum for the independent claims of the '145 and '448 patents, that the "improvements in the specification" are not "captured in the claims." *Berkheimer*, 881 F.3d at 1369. Further, as noted above, the specification admits that browsing is common and the synchronization server is a conventional device.

Nor can result-oriented functional claiming of activities performed by general purpose computers save the claims. *See Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1262 (Fed. Cir. 2016) ("The patent in this case is not directed to the solution of a 'technological problem'. . . . Instead, it claims the general concept of out-of-region delivery of broadcast content through the use of conventional devices, without offering any technological means of effecting that concept."). Samesurf argues that the synchronization server—an admitted generic computer—performs actions "that are required by the Asserted Claims to conduct a

synchronization browsing session between a guest and a host device." Opp. at 24. The Federal Circuit and Supreme Court have specifically rejected the idea that an otherwise ineligible algorithm or software could be made patent-eligible by merely adding a generic computer to the claim for the special purpose of executing the algorithm or software. *See, e.g., Eon Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 623 (Fed. Cir. 2015).

Samesurf's analogy to *BASCOM*'s "non-conventional and non-generic arrangement of known conventional pieces" (Opp. at 24-25) also is misplaced. In *BASCOM,* the Federal Circuit found that the claims at issue contained an inventive arrangement of elements through "the installation of a filtering tool *at a specific location*, remote from the end-users, with customizable filtering features specific to each end user," which solved a problem in the prior art. *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC,* 827 F.3d 1341, 1350 (Fed. Cir. 2016) (emphasis added). Here, the physical components are arranged in the conventional way a server communicates with generic (host and guest) devices.

Samesurf also conflates the different considerations of inventive concept and novelty in its analysis, arguing that because the synchronization server allegedly "provides a novel way of co-browsing the Internet," the claims "possess an inventive concept." Opp. at 24. But novelty is not dispositive; "even if the idea is novel and non-obvious—[it] is not enough to save it from ineligibility." *Solutran, Inc.*, 931 F.3d at 1169.

IV. CONCLUSION

Nothing in Samesurf's Opposition changes the relevant facts. The claims of the asserted patents are directed toward an abstract idea, and they contain no additional inventive concept to save them from invalidity. Accordingly, Intuit respectfully asks the Court to find the patents invalid and dismiss Samesurf's complaint.

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Respectfully submitted,

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Exhibit 2007
Case IPR2023-00342
U.S. Patent 8,527,591