

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.
Petitioner,

v.

SAMESURF, INC.
Patent Owner.

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

**PATENT OWNER'S REPLY TO OPPOSITION TO CONTINGENT
MOTION TO AMEND**

Table of Contents

Table of Authorities	ii
List of Exhibits.....	iii
I. Introduction.....	1
II. Adequate written description exists to show possession.....	1
A. Claims 19 and 28.....	1
B. Claims 25, 33 and 35.....	3
III. Claims 19 and 28 are definite	3
IV. Unaddressed limitations and claims	3
A. Intuit fails to fully state its argument in its Opposition.....	4
V. Intuit’s failure with respect to Birnbaum dictates disregarding Intuit’s entire argument for Birnbaum	5
VI. Intuit fails to show how the prior art uses the second data as claimed	7
A. Failings of LeBrun/Wang Proof.....	7
B. Failings of Prajapat/Wang Proof.....	10
VII. The Board correctly found the claims eligible	12
VIII. Conclusion	12
Certificate of Service	14
Certificate of Compliance Pursuant to 37 C.F.R. § 42.24	15

Table of Authorities

Cases

<i>Aqua Prods., Inc. v. Matal</i> , 872 F.3d 1290 (Fed. Cir. 2017)	4
<i>Google LLC v. Hammond Dev. Intl., Inc.</i> , 54 F.4th 1377 (Fed. Cir. 2022)	12
<i>Parus Holdings, Inc. v. Google LLC</i> , 70 F.4th 1365 (Fed. Cir. 2023)	4, 5
<i>Pers. Web Techs., LLC v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017)	6

Rules

37 C.F.R. § 42.6(a)(3)	4, 5
37 C.F.R. § 42.104(b)(4)	5
37 C.F.R. § 42.104(b)(5)	5
37 C.F.R. § 42.121(d)(2)	4
37 C.F.R. § 42.22(a)(2)	3, 4, 5
37 C.F.R. § 42.23(a)	4
37 C.F.R. § 42.23(b)	4, 5

List of Exhibits

Exhibit No.	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-LLKSC; <i>Samesurf, Inv. V. Intuit Inc.</i> ; In the U.S. District Court, Southern District of California, San Diego Division.)

I. Introduction

Intuit's arguments fail to show how the original prior art renders the new claims obvious. Intuit also failed to adequately state the motivation to combine the original prior art. The Birnbaum combination lacks the requisite particularity, and similarly includes generic and deficient motivations to combine. Substitute claims 19-36 have adequate written description support, and the Board correctly found the §101 argument unpersuasive and the indefiniteness contentions unfounded. Entry of the contingent amendment is appropriate.

II. Adequate written description exists to show possession

PO non-exhaustively demonstrates possession of the claimed invention of claims 19-38, and specifically 19, 25, 28, 33 and 35 as required by 35 U.S.C. §112.

A. Claims 19 and 28

The Board found adequate support for “independently replicate” in claims 19 and 28 but required clarification on “operating a browser.” (PG, 5-6.)

The “second data” is distinct from URL or cookie data by dint of claim differentiation and “indicates” a “direct host interaction with content of the website.” Generally, the data passed from the host device, to the synchronization server, and ultimately to the guest device, can include “URL..., cookie..., form data, javascript or other user inputted information” input into the host device. (Ex.1001, 16:4-7.) A non-limiting example of this includes “form data” “passed

between browser clients.” (*Id.*, 5:15-19.) Specifically, “form data” input by a host may be “relayed” by the synch-server to the guest device. (*Id.*, 6:65-7:1, 7:56-59.) The data passed to the synchronization server is sent to the guest device. (*Id.*, 16:51-56.) The guest device then *uses* this information, which can include the claimed “second data,” to replicate an action of the host device, including, for example, “formulating” an “identical” request. (*Id.*, 16:56-63, 19:12-16.)

As noted above, this may include relay and usage of “form data” that is “information inputted by a user in pre-defined fields.” (*Id.*, 16:63-64, 19:15-16.) The guest device “formulation” is an example of the guest device using the forwarded “form data” to “replicate” a host device interaction. All of the preceding can be done using software that includes, for example, standard browsers, plug-ins and/or software that operates the browser or includes browser capability, any of which constitute “operating a browser.” (*Id.*, 7:32-55, 19:21-28.)

The '591 Patent also lists other examples of replication that include host input being “formatted, forwarded and inputted into other devices.” (*Id.*, 5:26-35.) This enables “all” session attendees to “view[] and fully interact in a shared browsing experience” and “with the same internet content.” (*Id.*, 5:41-47.) “Fully interact” includes “filling in form data” as well as activities such as “drawing on the screen,” both of which are examples of content interaction that can be “inputted” into the other devices. (*Id.*, 5:48-50.) Ultimately, “webpage interactions

of the host ... are relayed to following devices,” which allows for “identical” “visual output of shared browsing window ...” (*Id.*, 7:56-62.)

The preceding examples show possession of a guest device receiving information including the “second data” as claimed. (*Id.*, 6:65-7:1, 16:31-40.) The information is relayed from the synchronization server. (*Id.*) The information is *independently used* by software of the guest device, as claimed, to replicate the host interaction. (*Id.*, 5:26-35, 16:51-17:11, 17:31-34, 7:56-62.) The software of the guest device may be a standard browser, plugin, or standalone software that can operate a browser or that includes browser capabilities. (*Id.*, 7:32-55, 19:21-28.)

B. Claims 25, 33 and 35

Intuit contends that the application does not show display of “the host device’s interaction.” That is not what is claimed. With regards to displaying the *replicated* interaction, PO notes that the host data input may be “forwarded and inputted into the other devices ...” and that forwarding of webpage interactions of the host device allows for identical visual output. (*Id.*, 5:32-36, 7:56-62.)

III. Claims 19 and 28 are definite

The Board correctly found that the claims are not indefinite. (PG, 7-8.) Relayed messages may include URLs, cookies or form data. (Ex.1001, 16:4-7.)

IV. Unaddressed limitations and claims

In its Opposition (hereinafter “OPP”) Intuit failed to address the first three

independent claim limitations in contravention of at least 37 C.F.R. § 42.22(a)(2) and 37 C.F.R. §42.23(b). Intuit also fails to independently argue obviousness of the new limitations in claim 25, 33 and 35, relying on its 35 U.S.C. § 112 arguments.

A. Intuit fails to fully state its argument in its Opposition

Intuit's burden pursuant to 37 C.F.R. §42.121(d)(2) is to "*show... that any proposed substitute claims are unpatentable.*" *See* 37 C.F.R. §42.121(d)(2); *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1325 (Fed. Cir. 2017). This includes compliance with the 37 C.F.R. §42.22(a)(2) "motions"¹ requirement: "*a full statement of the reasons for the relief requested*" and the 37 C.F.R. §42.23(b) requirement: "*all arguments for the relief requested ... must be made in the motion.*" (37 C.F.R. §42.22(a)(2); 37 C.F.R. §42.23(b).) PO asks the Board to consider whether Intuit even fully satisfied the statutory requirement to include "all arguments... in the motion," when Intuit failed to even request application of its prior argument for claim elements 1.a-1.c. (*See* 37 C.F.R. § 42.23(b).) A similar problem arises where Intuit seeks to incorporate its motivation to combine various references via reference to its Petition (OPP, 24.) That is an example of impermissible incorporation of an argument by reference in contravention of 37 C.F.R. § 42.6(a)(3) and Intel is limited to the motivations stated in the OPP.

¹ Rules for "motions" apply to "oppositions" as well. *See* 37 C.F.R. §42.23(a).

Parus Holdings permits the Board to disregard “evidence and issues introduced by a party in violation of its rules, or not introduced at all.” *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1372 (Fed. Cir. 2023). If the Board finds that Intuit has contravened § 42.22(a)(2), § 42.23(b), or § 42.6(a)(3), the Board is urged to disregard any incomplete arguments and/or limit referentially-incorporated argument to the argument in the OPP. *See* 37 C.F.R. § 42.22(a)(2); 37 C.F.R. § 42.23(b); 37 C.F.R. § 42.6(a)(3); *see also Parus Holdings* at 1372.

V. Intuit’s failure with respect to Birnbaum dictates disregarding Intuit’s entire argument for Birnbaum

Intuit’s most excessive failings are with respect to Birnbaum combinations. The argument lodged with respect to Birnbaum is woefully insufficient in its failures to address limitations 1.a-1.c, define actual combinations, explain modifications to the art, or provide a motivation to combine. (OPP, 19-23.)

If Intuit wanted to modify Birnbaum in view of “Wang and LeBrun” or “Wang and Prajapat,” it had an obligation to particularly identify *which* aspects are being combined as well as which aspects of Birnbaum are being modified, so that PO had notice and could refute those *particular* combinations. In this regard, Intuit’s duties were no less than those in the Petition. *See* 37 C.F.R. §§ 42.104(b)(4) and 42.104(b)(5). Instead of explaining the combinations, Intuit submits: “Birnbaum likewise is combinable with Lebrun and/or Wang ...” and

Intuit does not even mention the combination of Birnbaum and Prajapat in its Motivation section. (OPP, 24.) Intuit impermissibly incorporates-by-reference a great deal of argument about combining LeBrun, Prajapat and Wang and then seems to be applying this to Birnbaum by extension. (*Id.*) The motivation to combine even the original references is markedly deficient, amounting to nothing more than a comment that they “are combinable” because they all solve problems (not even the same problems) related to collaborative browsing. (*Id.*) There is not even an allegation that they *would* be combined, merely that they can be. (*Id.*) See also, *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993 (Fed. Cir. 2017).

The “likewise combinable” argument presented for Birnbaum has several additional problems. First, it is not clear if Intuit is proposing to rely on LeBrun or Wang, a combination of both, “and/or” Prajapat. (OPP, 19, 23-24.) There is no motivation for the combination with Prajapat whatsoever. The combination with regards to LeBrun is insufficiently particular in that it does not identify what teachings of Birnbaum are modified by the combination, as well as why or how such modification would occur. (*Id.*, 24.) In fact, the original proposition was “Birnbaum in view of ...” (*Id.*, 19), implying modification of Birnbaum, but the later explanation seems to be using Birnbaum to modify the prior art “Birnbaum ... combinable with ... LeBrun and/or Wang.” (*Id.*, 24.)

Intuit’s *motivations* to “combine Birnbaum” are likewise deficient,

constituting a generalized motivation to seek out “various available solutions,” and contentions that the references are related to the same technical field with the same generalized goals and architectures. (*Id.*) Intuit misidentifies a *goal* of Birnbaum as a teaching, and then suggests that this goal is “combinable” with “collaborative web browsing” in general. (*Id.*) None of the *argued* teachings are explained as combined, nor does Intuit explain how those particular teachings are used to modify prior-art *teachings* or how the prior art modifies Birnbaum. (*Id.*, 23-24.)

VI. Intuit fails to show how the prior art uses the second data as claimed

“Operating a guest browser” based on received “second data” to “independently replicate” an interaction is *not* the same as displaying a page-copy, received from an intermediate server, of an already-modified page modified by the intermediate server. Assuming *arguendo* that anything in the latter instance is “replicating” the host device interaction based on the “second data,” it is the intermediate server that is doing so. Intuit’s proofs fail to make this distinction.

A. Failings of LeBrun/Wang Proof

Intuit’s proof misrepresents what the group server distributes to the clients and how the clients behave based on what they receive, and inadequately explains why the client would duplicate certain functions reserved for the group server.

The initial teachings cited by Intuit demonstrate the function of the group-

surfing server 140 as one of distributing webpages. (OPP, 11-12.) That is, *the group server* sends or instructs sending of *copies* of formatted pages to clients 110. (Ex.1005, 35:5-12.) In such an instance, the client receiving the formatted copy will not “operate a browser” “based on the second data.” Assuming *arguendo* that the second data is reflected in the page copy, the client does not use that data as claimed. In alternative embodiments, whether the client *receives* the page from the website server, those are embodiments where “no cookies ... are involved” and that receipt would still be pursuant to an instruction *from the group server* for the website server to deliver the page or acting in other page-distribution capacity. (*Id.*, 35:10-24.) All examples involve distribution of pages, none involve independent action taken by the guest device based on receipt of particular data by the guest device, or even that the device would receive such data. (*Id.*)

Intuit presents a teaching about form-completion but fails to account for how “group-surfing” is *taught* to function. (OPP, 12.) Citing: “the group-surfing server 140 may *present that information on the HTML form at each ... client*,” Intuit immediately misconstrues this as “the controlling web client ... *entering* information to complete the HTML form.” (*Id.*) That is not what LeBrun says.

The group server is the acting “presenting” agent, not the client. (Ex.1005, 39:4-10.) The *way* that the group server “presents” pages is by sending copies of pages to the client. (*Id.*, 35:7-24.) This includes instances of form-completion by

the host. (*Id.*, 38:31-39:2.) LeBrun’s mention of “seeing the form being filled in” can be achieved through distributions of formatted copies of the webpage, which would comport with the *taught function* of how the group server provides pages for presentation at the guest clients. (*Id.*, 39:4-10, 35:7-24.) When stating that this equates to “independently replicating the interaction,” Intuit ignores the claim requirements that the browser operates “based on the second data” to “independently replicate” the interaction, and instead presents a results-oriented analysis focused on the display of a copy. (OPP, 13.)

Further, Intuit’s cited portion about “intercepting” literally teaches that the group-surfing server “processes” the intercepted information. (*Id.*, 14, *citing* Ex.1005, 37:8-10.) And Intuit admits that the group server is able to “assure” pages “are presented” to the clients. (*Id.*, 14.) Under this explanation, the group server, not the client, would be doing any purported “replication” based on “second data.” (*Id.*) Never does Intuit show that the *client* performs such “replication” by operating a browser based on the second data, and “receipt” of a page (from either server) does not show any action taken by the client browser as claimed. (*Id.*)

Intuit briefly cites teachings about receiving pointers to URLs, but that teaching is expressly limited to “only” pointers. (Ex.1005, 43:20-22.) Further, a client requesting a webpage based on a URL pointer, does not constitute evidence that form data would be received and handled by the client using “processing”

functions that Lebrun only imparts to the group server. (*Id.*, 37:5-6.) At no point does Intuit even *attempt* to explain how a URL-based page retrieval process would be replaced with the client completing a form or receiving form data to do so, other than apparently relying on generally combining embodiments as “teaching” to move any function from the group server to the client server. (OPP, 14-15.)

B. Failings of Prajapat/Wang Proof

The Prajapat proof similarly focuses on the *result* while ignoring *how* Prajapat achieves the result. Intuit proffers evidence of “web form content” being “sent to a media server” and the media server “generating events [] to the browsers 12 to update the web page form content,” implying that the “event” causes a content “update” meeting “independent replication.” (OPP, 16; Ex.1007, [0031].)

“Generating an event to the browsers 12 to update the web page form content” does not teach the claim. Prajapat explains *exactly* what happens when it “generates an *event* to the browser 12” and how that browser responsively “updates” the form content. (*Id.*, [0025]-[0026].) Prajapat uses “events” to cause the browser 12a to *retrieve a renderable form from the media server 14*. (*Id.*) The “renderable form” is a *copy* of a page that the media server *obtained from the website server, already transformed by server 14 to be renderable by browser 12*. (*Id.*) Thus, when Prajapat “generates events” for the “browser 12 to update the webpage” in [0031], the “event” *causes the browser 12 to retrieve the renderable*

page from the media server 14. The “update” is the obtaining/displaying of the *copy*. Even if that copy includes form data input by server 14, the browser 12 does not use that data to replicate a host action. (*Id.*, [0025]-[0026], [0031].)

“Content of the content tree” is *rendering* of multiple *pages*. (*Id.*, [0030]). Updates to the content tree are “synchronized” through “events” to the various browsers, and “events” are again instructions to the respective browsers to obtain the renderable *copies* of the webpages *from the intermediate media servers*. (*Id.*)

Petitioner combines these teachings with the Fig. 3/4 embodiments under the logic that the teaching of “any other suitable information” will cover the claimed “second data.” (OPP, 18.) A URL or cookie is not “the second data” due to claim differentiation. (§V, *supra.*) The contention that “suitable information” constitutes the claimed “second data” is unsupported by substantial evidence. Figs. 3/4 are directed to “simple web page sharing.” When Prajapat wants to “duplicate” more complex host interactions using what it terms “co-browsing,” it uses the embodiments of Figs. 1/2. (Ex.1007, [0012].) Notable is the *complete lack* of the term “co-browsing” outside of the Fig. 1/2 descriptions. References to duplicating “alterations” or “form data” are limited to the Fig. 1/2 descriptions. Petitioner tries to overcome all of this by having its expert opine that “other suitable information” constitutes the claimed replication based on the second data. (OPP, 18.) In light of all the preceding evidence directly from Prajapat that this is *not* true, however,

some *explanation* must be provided at to *how* the “alterations” of [0012] or the “form data” of [0031] equates to “any other suitable data.” Also missing is any explanation of how or why the system of Figs. 3/4 would “replicate” form data.

The reference to Figs. 1-3 in [0045] is *specifically* in the context of *locating* a device. (Ex.1007, [0045]). This has nothing to do with the functions at issue. Paragraph [0047] of Prajapat relates to Fig. 4, an embodiment lacking a “synchronization server” of any sort. (*Id.*, [0047], Fig. 4.)

The Board also correctly found that Intuit failed to sufficiently articulate how Wang is linked to the claim language.

VII. The Board correctly found the claims eligible

The Board correctly found the claims eligible. (PG, 8-11.) Moreover, collateral estoppel applies with respect to the S.D. Cal Decision as the legal issue here, “eligibility,” is identical, it was litigated and determined by a valid and final judgment, the determination was essential to the judgment and is conclusive in this subsequent action between the [same] parties. (Ex.2005; *see also Google LLC v. Hammond Dev. Intl., Inc.*, 54 F.4th 1377, 6 (Fed. Cir. 2022).)

VIII. Conclusion

Intuit fails its burden to prove unpatentability of any proposed claim.

Respectfully submitted,

Dated: January 31, 2024

/ Bernard P. Tomsa /

Bernard P. Tomsa (Reg. No. 60,121)
Andrew B. Turner (Reg. No. 63,121)

Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner

Certificate of Service

The undersigned hereby certifies that the foregoing **REPLY TO OPPOSITION TO CONTINGENT MOTION TO AMEND**, is being served on counsel for via electronic mail on January 31, 2024, in its entirety on the following counsel of record:

LEAD COUNSEL	BACK-UP COUNSEL
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

Respectfully submitted,

Dated: January 31, 2024

/ Bernard P. Tomsa /
Bernard P. Tomsa (Reg. No. 60,121)
Andrew B. Turner (Reg. No. 63,121)

Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner

Certificate of Compliance Pursuant to 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24. The paper contains 12 pages, excluding the parts of the paper exempted by §42.24(a).

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

Respectfully submitted,

Dated: January 31, 2024

/ Bernard P. Tomsa /
Bernard P. Tomsa (Reg. No. 60,121)
Andrew B. Turner (Reg. No. 63,121)

Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner