Filed on behalf of Intuit Inc.

By:
JENNIFER R. BUSH, Reg. No. 50,784
MICHAEL J. SACKSTEDER (*pro hac vice*)
GEOFFREY R. MILLER (*pro hac vice*)
DANIEL LEDESMA (*pro hac vice*)
CHRISTOPHER L. LARSON, Reg. No. 68,243
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Telephone: 650.988.8500
Facsimile: 650.938.5200

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUIT INC.,
Petitioner

v.

SAMESURF, INC.,
Patent Owner.

Inter Partes Review No. IPR2023-00342
Patent 8,527,591 B2

PETITIONER'S MOTION TO EXCLUDE EXHIBITS 2005 – 2007

I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c), Petitioner Intuit Inc. ("Petitioner") respectfully submits this motion in accordance with Due Date 5 of the Scheduling Order (Paper 13), and hereby requests exclusion of Exhibits 2005-2007.

The table below shows each exhibit or portion thereof for which Petitioner requests exclusion, a description of the exhibit, and the grounds for exclusion.

Exhibit	Description	Grounds for Objection/ Exclusion
2005	Order Denying Defendant's Motion to Dismiss Pursuant to 35 U.S.C. § 101 and Denying Defendant's Request for Oral Argument, entered in *Samesurf, Inc. v. Intuit, Inc*., USDC, Southern District of California, Case No. 22-cv-00412-RSH-DDL [Dkt. 27]	FRE 402, 403; 37 C.F.R. § 42.61
2006	Defendant Intuit, Inc.'s Notice of Motion and Motion to Dismiss Pursuant to Rule 12(b)(6), filed on May 23, 2022 in the case titled, *Samesurf, Inc. v. Intuit Inc.*, USDC, Southern District of California, Case No. 22-cv-00412-LL-KSC [Dkt. 16].	FRE 402, 403
2007	Defendant Intuit, Inc.'s Reply in Support of Its Motion to Dismiss Pursuant to Rule 12(b)(6), filed on June 17, 2022 in the case titled, *Samesurf, Inc. v. Intuit Inc*., USDC, Southern District of California, Case No. 22-cv-00412-LL-KSC [Dkt. 22].	FRE 402, 403

II. LEGAL STANDARDS

The Federal Rules of Evidence govern the admissibility of evidence and expert testimony in an *inter partes* review. 37 C.F.R. § 42.62(a). Irrelevant evidence is not admissible, and relevant evidence may be excluded "if its probative value is substantially outweighed by a danger of . . . unfair prejudice [or] confusing the issues." FRE 402, 403.

New arguments or evidence introduced in Sur-reply are inadmissible under 37 C.F.R. § 42.23(b) and thus subject to exclusion. *See Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1366, 1369-70 (Fed. Cir. 2016). The sur-reply may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness. Consolidated Trial Practice Guide ("Trial Practice Guide") at 74 (Nov. 2019), *available at* https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

It is not enough for the Board to find that this Motion is moot if the Board does not rely on the inadmissible evidence in reaching its Final Written Decision. If the exhibit and paragraphs identified herein remain in the record, Petitioner could continue to rely upon them on appeal, and Petitioner would be unfairly forced to address them again.

Accordingly, the Board should exclude the objected-to exhibits for the reasons that follow.

III. COMPLIANCE WITH 37 C.F.R. § 42.64(C)

Petitioner timely objected to Exhibits 2005-2007 by filing Petitioner's Objections to Evidence Submitted with Patent Owner's Response pursuant to 37 C.F.R. § 42.64 on October 4, 2023 (Paper 25) and to Patent Owner's Sur-Reply to Petitioner's Reply filed on February 6, 2024 (Paper 35).[1]

IV. EXHIBITS 2005-2007 SHOULD BE EXCLUDED AS IRRELEVANT AND/OR UNFAIRLY PREJUDICIAL OR CONFUSING

Petitioner objected to Exhibits 2005-2007 as irrelevant. Papers 25, 35.

Each of these papers relates to a district court proceeding involving the subject patent, but related to Motion to Dismiss Pursuant to 35 U.S.C. § 101, patentable subject matter, as it relates to the subject patent. Since patentable subject matter is not a ground that can be raised in an IPR, the order is irrelevant.

Patent Owner argues in its Sur-reply that Petitioner's articulation of the abstract idea it argued in district court should be considered in claim construction in this proceeding, despite the term argued by Patent Owner therein ("simultaneous interactions") not being present in the claims. Paper 33. Since this term is not recited in the claims, the discussion thereof in Exhibits 2005-2007 – in the context of patentable subject matter – is both irrelevant and "its probative value is substantially

[1] Petitioner also filed, with the Board's authorization, a Motion to Strike Exhibits 2006 and 2007 on February 14, 2024 (Paper 37).

outweighed by a danger of . . . unfair prejudice [or] confusing the issues." *See* FRE 402, 403. Accordingly, Exhibits 2005-2007 should be excluded.

If these portions are not excluded and Petitioner relies on them in their demonstratives or otherwise at the hearing, they would be considered new evidence. *See St. Jude Med., Cardiology Div., Inc. v. Bd. of Regents Univ. of Mich*., IPR2013-00041, Paper 65 at 2-3 (P.T.A.B. Jan. 27, 2014) (demonstratives may not present new arguments nor "evidence that, although it is in the record, was never specifically discussed in any paper").

V. EXHIBITS 2006 AND 2007 SHOULD BE EXCLUDED AS BEYOND THE SCOPE OF A PROPER SUR-REPLY

Petitioner objected to Exhibits 2006 and 2007 as prejudicial, misleading, confusing, and/or a waste of time under FRE 403 and improper under new evidence 37 C.F.R. § 42.23(b). Paper 35. Petitioner also filed, with the Board's permission, a Motion to Strike Exhibits 2006 and 2007 on February 14, 2024 due to each being improper new evidence in a Sur-reply. Paper 37.

37 C.F.R. § 42.23(b) states that "a sur-reply may only respond to arguments raised in the corresponding reply and ***may not be accompanied by new evidence*** other than deposition transcripts of the cross-examination of any reply witness." 37 C.F.R. § 42.23(b) (emphasis added). Neither Exhibits 2006 nor 2007 are deposition transcripts. Nor were Exhibits 2006 or 2007 of record before Patent Owner submitted them with its Sur-reply, which is what defines exhibits as new

evidence. *Satco Products, Inc. v. Seoul Semiconductor Co., Ltd.*, IPR2020- 00836, Paper 45 at 76 (P.T.A.B. Oct. 22, 2021) (exhibits considered new evidence because they were not of record prior to Patent Owner filing them with its Sur-reply), cited at Paper 30 (Motion to Strike), 3-4. Thus, Exhibits 2006 and 2007 should be excluded as improper under 37 C.F.R. § 42.23(b).

Should the Board deny the Motion to Strike Exhibits 2006 and 2007, it should exclude Exhibits 2006 and 2007 for the above reasons.

Furthermore, if these exhibits are not excluded and Petitioner relies on them in its demonstratives or otherwise at the hearing, they would be improper new evidence. *See St. Jude Med.,* IPR2013-00041, Paper 65 at 2-3.

VI. CONCLUSION

For the reasons presented above, Exhibits 2005-2007 fail to comply with the Federal Rules of Evidence and 37 C.F.R. § 42.23(b) and should be excluded.

Dated: March 6, 2024

FENWICK & WEST LLP

/Jennifer R. Bush/
Jennifer R. Bush
Reg. No. 50,784

Attorneys for Petitioner
Intuit Inc.

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on March 6, 2024, I caused a true and correct copy of the foregoing PETITIONER'S MOTION TO EXCLUDE EXHIBITS 2006, 2006, AND 2007 to be electronically served on Petitioner's lead and backup counsel at the following addresses:

Bernard P. Tomsa
Alan B. Turner
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
btomsa@brookskushman.com
aturner@brookskushman.com
SSRF0101IPR@brookskushman.com

Scott W. Hejny
Alan P. Bo
McKool Smith, P.C.
300 Crescent Court, Suite 1500
Dallas, TX 74201
shejny@mckoolsmith.com
Samesurf_IPR@mckoolsmith.com

Ryan B. McBeth
Archis (Neil) V. Ozarkar
Saif Askar
McKool Smith, P.C.
600 Travis Street, Suite 7000
Houston, TX 77002
rmcbeth@mckoolsmith.com
nozarkar@mckoolsmith.com
saskar@mckoolsmith.com

Alan P. Block
McKool Smith, P.C.
300 South Grand Avenue, Suite 2900
Los Angeles, CA 90071
ablock@mckoolsmith.com

FENWICK & WEST LLP

/Jennifer R. Bush/
Jennifer R. Bush
Reg. No. 50,784

Attorneys for Petitioner
Intuit Inc.

Date: March 6, 2024
Fenwick & West LLP
801 California Street
Mountain View, CA 94041