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 OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE EXHIBITS 2005 – 2007

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I. INTRODUCTION

Petitioner's inconsistent contentions on claim scope, and the District's Court's inconsistent finding, as expressed in Exhibits 2005-2007, are plainly ***relevant*** to the Board's determination of the parties' dispute regarding whether the challenged claims require a "synchronized browsing session" in which browsing occurs simultaneously (Patent Owner's ("PO") contention) or not (Petitioner's contention). Petitioner fails to show any evidence that the probative value of their own inconsistent statements, as expressed in Exhibits 2005-2007, would be outweighed by the danger of "unfair prejudice [or] confusing the issues." FRE 402, 403.

Thus, the Board should deny Petitioner's Motion to Exclude Exhibits 2005 – 2007 ("Motion") in its entirety, because Petitioner has failed to satisfy its "burden of proof to establish that it is entitled to the requested relief." 37 C.F.R. § 42.20(c).

II. RELEVANT BACKGROUND FACTS

On May 23, 2022, seven months before filing its Petition, Petitioner filed a Motion to Dismiss ("Motion") in the District Court action, contending that the challenged claims are invalid under Section 101. Ex. 2006. In its Motion, Petitioner identified the preamble, step 2, and step 3 of claim 1 of the '445 patent as the "claim language [that] makes clear that sending and receiving information for ***simultaneous interactions*** is the focus of the Asserted Claims." Ex. 2006, 7:11-12; fn 2 at 7:17-21; *see also* Ex. 2006, 3:26-4:3; Ex. 2007, 1:20-25; 4:2-6. The Court also agreed that

the claims require a "synchronized browsing session." Ex. 2005, 10:4-7.

Despite having clearly contended in its Motion that the challenged claims require simultaneous interactions in a "synchronized browsing session," Petitioner contended for the first time in its Reply that "[t]here is no requirement in the claims that any content be 'synchronized'… viewed 'simultaneously' (or near simultaneously), nor 'coordinated' in any manner." Petitioner's Reply, 2-3. Petitioner's expert concurred, opining that: "None of the claim limitations requires any synchronous sharing of the same web browsing experiences." Ex. 1034, ¶7.

In its Sur-Reply, PO demonstrated the inconsistencies between Petitioner's current IPR contentions and its District Court contentions, pointing to, among other things, Petitioner's Motion (Exs. 2006 and 2007) and the District Court's findings in its Order (Ex. 2005). *See* PO's Sur-Reply, 6-8.

III. THE BOARD SHOULD DENY PETITIONER'S MOTION

A. Petitioner Has Not Met its Burden of Demonstrating that Exs. 2005 – 2007 Are Irrelevant

F.R.E. Rule 402 provides that "[r]elevant evidence is admissible unless any of the following provides otherwise: the United States Constitution, a federal statute, these rules, or other rules prescribed by the Supreme Court." F.R.E. Rule 401 defines relevant evidence as evidence that "has any tendency to make a fact more or less probable than it would be without the evidence" and "the fact is of consequence in determining the action."

Petitioner fails to meet its burden of proving that Exs. 2005 – 2007 are irrelevant. Petitioner contends that Exs. 2005 – 2007 relate to validity under Section 101, and thus, "[s]ince patentable subject matter is not a ground that can be raised in an IPR, the order is irrelevant." Mot., 3. Petitioner ignores the fact that validity under both Sections 101 and 103 depend on the scope of the claims and ignores the fact that Petitioner's District Court contentions, and the Court's findings, regarding claim scope are ***inconsistent*** with Petitioner's current PTAB contentions. Plainly, Exs. 2005 – 2007 are relevant to the Board's consideration of Petitioner's current contentions regarding claim scope.

B. Petitioner Has Not Met its Burden of Demonstrating that the Probative Value of Admitting Exs. 2005 – 2007 is Outweighed by a Danger of Undue Prejudice or Confusing the Issues

F.R.E. 403 provides that "[t]he court may exclude relevant evidence if its probative value is substantially outweighed by a danger of one or more of the following: unfair prejudice, confusing the issues, misleading the jury, undue delay, wasting time, or needlessly presenting cumulative evidence." F.R.E. 403 is primarily intended to exclude prejudicial evidence from a jury's purview. *Tome v. United States*, 513 U.S. 150, 174 (1995). Concerns of prejudice are reduced when, as here, the fact finder is a judge rather than a jury. *Seaboard Lumber Co. v. United States*, 308 F.3d 1283, 1302 (Fed. Cir. 2002).

Petitioner fails to meet its burden of proving that the probative value of

admitting Exs. 2005 – 2007 is outweighed by a danger of undue prejudice to Petitioner or of confusion to the Board. Petitioner incorrectly contends that PO relies on Exs. 2005 – 2007 regarding Petitioner's "articulation of the abstract idea it argued in district court" "despite the term argued by Patent Owner therein ('simultaneous interactions') not being present in the claims." Mot., 3. Contrary to its current contention (*see* Section II, *supra*), Petitioner contended in its Motion that "the claim language ["synchronized browsing session"] makes clear that sending and receiving information for ***simultaneous interactions*** is the focus of the Asserted Claims." Ex. 2006, 7:11-12. The District Court agreed that the claims "are specifically directed to performing a synchronized browsing session." Ex. 2005, 10:5-6.

Plainly, Petitioner cannot (and should not) claim prejudice by its ***own*** prior contention that "sending and receiving information for ***simultaneous interactions*** is the focus of the Asserted Claims" (Ex., 2006, 7:11-12) or by the District Court's finding on Petitioner's Motion (Ex. 2005, 10:5-7). On the other hand, PO would suffer severe prejudice if the Court were to exclude Exs. 2005 – 2007. PO should be permitted to show, and the Board to weigh, the fact that Petitioner previously asserted, and the District Court found, the exact opposite with regard to claim scope of what Petitioner now contends. Otherwise, parties will feel free to play fast and loose by deliberately changing positions according to the exigencies of the moment. *See e.g.*, *United States v. McCaskey*, 9 F.3d 368, 378 (5th Cir. 1993).

C. Petitioner Has Not Met its Burden of Demonstrating that Exs. 2005 – 2007 Are "New Evidence"

Petitioner has not met its burden of establishing that Exs. 2005 – 2007 are "new evidence" to Petitioner pursuant to 37 C.F.R. § 42.23 (b). This is the second time that Petitioner has raised this contention (Paper 37) and the second time that PO has addressed this contention (Paper 38). As discussed, Petitioner has not explained why its own pleadings constitute "new evidence" to it. *Popsockets LLC v. Flygrip, Inc.*, IPR2022-00937, Paper 29 at 8-9 (PTAB Oct. 30, 2023).

Further, to comply with its duty of candor and good faith, PO is obligated to submit Petitioner's briefs containing Petitioner's inconsistent contentions. Moving to strike its own briefs, which contain its inconsistent contentions regarding claim scope, is not consistent with Petitioner's own duty of candor and good faith.

Lastly, the Board may take official notice of "a fact that is not subject to reasonable dispute." 37 C.F.R. § 42.62(a) and (c) ("*Judicial notice* means official notice"); Fed. R. Evid. 201; *see also, e.g.*, *Assa Abloy AB et al v. CPC Patent Technologies Pty Ltd*, IPR2022-01045, Paper 42 at 13-14, FN20 (PTAB Dec. 23, 2023).

IV. CONCLUSION

The Board should deny Petitioner's Motion to Exclude in its entirety or take official notice of Petitioner's inconsistent statements.

Date: March 13, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE EXHIBITS 2005-2007** is being served on counsel for petitioner via electronic mail on, in its entirety on the following counsel of record for Petitioner on this 13th day of March 2024:

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