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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

SURFCAST, INC.
Patent Owner

Case IPR2013-00292
Patent 6,724,403

SURFCAST, INC.'S
PATENT OWNER PRELIMINARY RESPONSE TO
PETITION FOR *INTER PARTES* REVIEW OF U.S. PAT. NO. 6,724,403
UNDER 35 USC §§ 311–319 AND 37 C.F.R. § 42.100 *et seq.*

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- Ex. 2001 *American Heritage Dictionary* (3d ed. 1992).
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Pursuant to 37 C.F.R. § 42.107(a), Patent Owner, SurfCast, Inc. hereby submits the instant Preliminary Response to the Petition For *Inter Partes* Review (“Petition”) filed on behalf of Petitioner, Microsoft Corporation (“Microsoft”), May 22, 2013. The Preliminary Response is timely filed under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, as it is being filed no later than (the first business day after) three months of the May 24, 2013 date of the Notice granting the Petition a filing date.

This Preliminary Response sets forth reasons why no *Inter Partes* Review of claims 1–13 and 15–21 (the “challenged claims”) of U.S. Patent 6,724,403 (“the ’403 Patent”) (Microsoft Ex. 1001) should be instituted under 35 U.S.C. § 314. As discussed herein, the reasons include at least three grounds set forth by the Office as reasonable grounds for not instituting *Inter Partes* Review: the prior art lacks a material limitation in all of the independent claims; the prior art teaches or suggests away from a combination that the petitioner is advocating; and the petitioner’s claim interpretation for the challenged claims is unreasonable. (“Office Patent Trial Practice Guide” Fed. Reg. 77: 48756, 48764).

1. Introduction

The Board should not institute *Inter Partes* Review of the ’403 Patent because Petitioner has not met the high standard required by United States Patent and Trademark Office (“Office”) regulations to demonstrate a reasonable

likelihood that at least one of the claims challenged in the petition is unpatentable. 37 C.F.R. § 42.108(c). The “reasonable likelihood” standard was intended by Congress to be a substantially higher barrier to patent validity challenges than the former “substantial new question of patentability” test used for inter partes reexaminations. See 157 Cong. Rec. S.1375 (Mar. 8, 2011). (“Among the most important protections for patent owners added by the present bill are its elevated thresholds for instituting inter partes ... reviews.”).

2. Overview of U.S. Patent No. 6,724,403

The ’403 Patent issued from U.S. Patent Application Serial No. 09/702,325 (“the ’325 Application”), filed on October 30, 2000. The ’325 Application claims benefit of priority under 35 U.S.C. § 119(e) (*i.e.*, is the “nonprovisional of”)¹ U.S. Provisional Patent Application No. 60/162,522 (Microsoft Ex. 1005), which was filed on October 29, 1999.

¹ Microsoft has characterized the priority claim as one of a “continuation-in-part” (Petition, Section III. A., at page 4). However, the term “continuation-in-part” should only be used in the context of priority claims under 35 U.S.C. § 120. *Cf.* MPEP § 201.08 (“An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a “continuation-in-part” of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.”)

The '403 Patent describes systems and methods for simultaneous display of multiple information sources of different types, such as e-mail, Internet web-sites, application programs, and video streams. *See, e.g.,* '403 Patent, 4:33-52, and at Abstract. The inventors recognized the shortcomings of conventional graphical user interfaces as of the filing date of the '403 Patent, specifically those containing windows and icons, to present the user automatically with up-to-date information about the multiple information sources of interest to the user. *See, e.g., id.* at 1:51-59, 3:25-51.

A “window typically displays the current content or output of only a single program,” *id.* 3:27–29, and if a user wants to view updated information from two or more information sources, such as two different web pages, the user must manually refresh the content of each web page separately. *Id.* at 1:56–2:3, 3:25–34. While icons provide user access to underlying programs and data, “they do not permit viewing ... of the underlying program or data represented thereby.” *Id.* at 3:41–44. “Consequently, the user’s viewing options are limited to a choice between one presenting very limited information about a multitude of programs and information and one presenting full information, but of only a single program or data source.” *Id.* at 3:47-51. “In the present art, there is no intermediate between a window or an icon.” *Id.* at 3:33-34.

To address the limitations of the prior art, the '403 Patent describes

partitioning a computer display into an array of “tiles” each of which presents an updating view of an information source. *Id.* at 4:55-59. The frequency of update of a tile depends on the nature of the information it displays, the available bandwidth, and a refresh rate, which can be configured by the user.

Each tile displays dynamic content from an information source that is automatically updated in accordance with a refresh rate assigned to the tile. The information source may be a program, a locally stored file (*e.g.*, a user document), an Internet website, or a video or music stream. *Id.* at 4:44-64; 8:29-37; 8:41-44; 10:54-56. While each tile is updated with different content according to its own refresh rate, the array of tiles presents a uniform appearance and consistent method of interacting with the information the user wants, regardless of information source or type. *See Id.* at 4:37-51; 6:52-59; 8:52-56; 9:24-32. Therefore, tiles are more than simply glorified icons.

FIG. 1 of the '403 Patent illustrates one embodiment of the inventive “tiles” interface and shows an example of this array of tiles organized into “[a] grid 1 consisting of a 3 by 3 matrix of nine tiles.” *Id.* at 6:39-42. Tiles “facilitate[] the organization and management of multiple data sources corresponding to a user’s needs and interests.” *Id.* at 4:34-37.

Consequently, an array of tiles is more than simply an orderly arrangement of windows of the prior art. A user can gain access to the underlying content or

source of a given tile by selecting it. And, a user can establish a customized array of tiles that maintains its appearance from session to session, *i.e.*, is persistent. The totality of features that are present in a tile make a tile different from the user interface objects of the prior art, and provide a tile-based interface with many attractive advantages and benefits not associated with the prior art.

3. Legal Principles Governing Claim Construction

In this proceeding, each claim is “given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b). As noted by the PTO, this is akin to the “broadest reasonable interpretation, as understood by one of ordinary skill in the art and consistent with the disclosure”. Fed. Reg. 77, 48764, August 14, 2012; see also MPEP § 2111. Microsoft has argued that, “if Patent Owner contends terms in the claims should be to have [*sic*] a special meaning in this proceeding, those contentions should be disregarded unless Patent Owner presents amendments to the claims ... to expressly correspond to its contentions.”² Patent Owner disagrees. The broadest reasonable interpretation standard is perfectly consistent with advancing a meaning for a claim term based on the specification without requiring that the claim be

² Microsoft cites to *In re Youman*, 679 F.3d 1335 in support of this principle. However, *In re Youman* is not relevant to the BRI standard, because it concerns the recapture rule and the effect of amendments made in the context of reissue.

amended to explicitly incorporate that meaning. “[R]eading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ.2d 1320, 1322 (Fed. Cir.1989). The plain meaning of a term means the ordinary and customary meaning given to the term by those of ordinary skill in the art at the time of the invention. MPEP § 2111.01 ¶ III. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (*en banc*). Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. MPEP § 2111.01 ¶ I.

In some instances, the meaning of a term is apparent with “little more than the application of the widely accepted meaning of commonly understood words.” MPEP § 2111.01 ¶ III, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*). However, in many circumstances, consulting the intrinsic record (the claims, the patent specification and the prosecution history), is necessary to

understand the meaning of the claim terms. *Id.* In particular, “[t]he specification ‘is ... [u]sually ... dispositive; it is the single best guide to the meaning of a disputed term.’” *Id.* at 1315 citing to *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

In particular, if a claim term does not have an accepted meaning in the art, the meaning of the term must be found in the specification. *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004). The meaning may be explicit or implicit. *Id.* (“Even when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.”) (citations omitted). MPEP § 2111.01 III. See *Phillips v. AWHCorp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*). Microsoft’s construction of many claim terms actually fly in the face of this guidance because they ignore teachings of the specification and thereby arrive at a construction that is unreasonably broad.

Furthermore, a claim construction “that excludes a preferred embodiment from the scope of a claim is rarely, if ever, correct.” *Accent Packaging, Inc. v. Leggett & Platt, Inc.*, 707 F.3d 1318, 1326 (Fed. Cir. 2013). Thus, “[t]he construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.”

Phillips, 415 F.3d at 1316 (citations omitted).

Where the specification and claims provide insufficient guidance for a construction of a term, extrinsic evidence may be brought to bear. Extrinsic evidence is information external to the patent and its prosecution history, and may include testimony from experts, dictionaries and other published treatises. *Phillips v. AWH Corp.*, 415 F.3d 1303. Expert testimony may be helpful “to provide background on the technology at issue, to explain how an invention works, to ensure that the court’s understanding of the technical aspects of the patent is consistent with that of a person of skill in the art.” *Id.*, at 1318. However, “[U]ndue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims in derogation of the ‘indisputable public records consisting of the claims, the specification and the prosecution history,’ thereby undermining the public notice function of patents.” *Id.* at 1319.

Microsoft has—improperly—placed undue reliance on expert testimony (*i.e.*, extrinsic evidence) to contradict the meaning of claim terms that would be obtained from a consideration of the specification of the ’403 Patent. Throughout the Petition, Microsoft cites principally and heavily to the Declaration of David A. Karger (Microsoft Ex. 1003) for the meaning of claim terms, even where, as Patent Owner shows and the law requires, the meaning is properly obtained from the specification of the ’403 Patent. In turn, Karger relies on a combination of

intrinsic evidence, extrinsic evidence, and his own opinion to construe the claims.

4. Claim Terms Requiring Construction

A. General Observations

Claims 1–13, and 15–21 are challenged in the Petition. Claim 1 is independent; claims 2–9, 11–13, and 15–21 depend directly from claim 1. Claim 10 depends from claim 9. The following terms each appear in one or more of Patent Owner’s challenged claims. For clarity of review, Patent Owner presents constructions of these terms in a different order from the order presented by Microsoft in the Petition (Paper No. 1, at pages 5–20).

B. Preamble to Claim 1

The preamble to claim 1 recites “A method executed by a device under the control of a program, said device including a memory for storing said program”. The terms in the preamble can be construed according to their respective plain and ordinary meanings.

C. “information source”

The term “information source” is recited in claim 1, and further delineated in dependent claim 21. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. The broadest reasonable construction of the term “information source” that is consistent with the specification is: “any ... analog signal, digital data, or electronically stored information”. *Cf.* ’403 Patent, Col. 4,

lines 47–48, and Col. 6, lines 52–55. This construction is also consistent with the plain and ordinary meaning of the term, as would be understood by one of ordinary skill in the art.

Microsoft argues for a construction of “information source” that includes a “local or remote source of information” (Microsoft Petition, at page 6). While Patent Owner does not disagree that an information source can be “local or remote”, its actual location is irrelevant to the construction of the term.

D. “tile”

The term “tile” is recited in claim 1 of the ’403 Patent. Patent Owner’s construction of the term properly finds its support in the claims and the specification of the ’403 Patent. This is because the term “tile”, as an element of a graphical user interface, had no plain and ordinary meaning in the art at the time of the ’403 Patent. When a claim term has no plain and ordinary meaning in the art, the meaning must be found in the patent specification. MPEP § 2173.01; *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300. Petitioner has advanced no argument or evidence in the Petition and accompanying exhibits that the term “tile” had a plain and ordinary meaning in the art at the time of Patent Owner’s invention.

In any event, the specification of the ’403 Patent makes clear that the term “tile” does have a special meaning within the context of the ’403 Patent. For

example, according to the '403 Patent, “[i]n the present invention, a third graphical representation of programs and files, herein called a tile, is *introduced*.” ’403 Patent at 8:29-30. *See also, id.* at 7:62–65. Where the specification reveals a special definition given to a claim term, the inventor’s lexicography governs. *Phillips v. AWH Corp.*, 415 F.3d at 1316; *Irdeto*, 383 F.3d at 1300 (“Even when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.”) One of ordinary skill in the art would understand that a tile is not the same as a window because the specification of the '403 Patent has introduced a tile as a graphical user interface object that is new and different from a window. ’403 Patent at 8:36–41.

Patent Owner asserts that the broadest reasonable construction of “tile” is:

“a graphical representation of an associated information source capable of displaying refreshed content, the graphical representation being persistent, and selectable to provide access to underlying information of the associated information source.”

Microsoft states that “[c]laim 1 contains no language restricting the form, number or manner of presentation of tiles on a display other than to specify ‘tiles’ are displayed as part of an “array.” This ignores the plain language of Claim 1, wherein each tile results from the partitioning of a display, but is not simply part of an array. A tile is also “associated with an information source” whose content is

displayed in the tile, and wherein each tile has an “assign[ed] ... refresh rate” at which information displayed in the tile from its associated information source is updated. These features serve to refine the definition of a tile as well as to distinguish a tile from both the window and the icon of the prior art.

Furthermore, the '403 Patent specification also makes clear to one of ordinary skill in the art that a tile is persistent, wherein its structure is not saved explicitly but “preserved from session to session.” *Id.* at 15:54-64. This is different from a window, which does not persist between user sessions, but rather must be launched each time the operating system is initiated. The notion of persistence from session to session aligns with the '403 Patent specification's Summary of the Invention that states “[t]he present invention comprises a grid of tiles that resides on a user's desktop.” *Id.* at 4:37-38. This description of tiles as residing on a user's desktop indicates that the tiles are permanent because “reside” means, for example, “to live in a place permanently or for an extended period” (Ex. 2001, American Heritage Dictionary (3d ed. 1992)).

In the context of a computer invention, one of ordinary skill in the art would understand the concept of permanence to mean that tiles are not lost when a computer is restarted. The desktop metaphor was well known at the time of invention to act as a repository for persistent items such as shortcuts to application programs. This also is consistent with the specification's description of a grid of

tiles as a repository for passwords and identifiers to subscription services. '403 Patent, 11:46-48. One of ordinary skill in the art would understand such a repository to be suited for cross-session usage.

The '403 patent specification also states that “[t]iles are selectable” so as to “instantly provide[] the user with access to the underlying information” when the tile is selected. *Id.* at 9:25-27. As an example, the '403 specification describes that, unlike a window, user selection of a tile may provide access to a “hierarchical menuing system leading the user to a different level or tiles, a word processing file stored on a local area network, a spreadsheet stored locally on a user’s computer, HTML file on the Internet, or a television signal.” *Id.* at 9:25-32. A person of ordinary skill in the art would therefore appreciate that the “selectable” feature of the claimed tile is among the many features of a tile that make it different from a conventional window. Patent Owner’s construction is aligned with this understanding.

The selectability of a tile is consistent with an underlying difference between a tile and a window. A window is created when an application program is launched, or from within a specific application program (for example, by opening or creating a new document), and therefore does not need to be selectable in order to display the current content of the application program.

Accordingly, the Patent Owner’s construction is consistent with the

attributes of a “tile” as defined in the specification and as instructed by the claim language. Namely, the specification of the ’403 Patent states that “a tile presents content from any information source” (’403 Patent, 7:64-65), and the claim language likewise instructs that “each tile ... is associated with an information source.” See, e.g., *id.* at claim 1 at 24:20-21. The ’403 Patent is wholly consistent with the view that tiles are persistent (a user’s password(s) can be associated with a tile, as in, e.g., FIG. 12). The ’403 Patent is also consistent with tiles being selectable. See e.g., *id.* at 9:27–30. Accordingly, a person of ordinary skill in the art would understand that a tile is as Patent Owner proposes in its construction.

Patent Owner has been careful to include in its construction of “tile”, just those attributes that permeate the ’403 Patent specification and are not contradicted by individual exemplary embodiments. This is in contrast to Petitioner’s arguments, which tend to seek out inconsistencies within the ’403 Patent specification and use the existence of optional embodiments to conclude that a tile has practically no essential features. Thus, there are no embodiments in the specification and claims of the ’403 Patent that require—or even permit—a tile to be not persistent. Similarly, there are no descriptions in the ’403 Patent of tiles that are not selectable.

But not every statement in the specification becomes a requirement of a tile. Thus a tile need not be always “smaller than a window” (e.g., ’403 Patent

specification at col. 8, lines 39–41). A tile also is not required to have e.g., a toolbar function (*see, e.g.*, '403 Patent at 10:14–19) when it is apparent that most depictions of, and descriptions of, tiles in the '403 Patent lack such features. Similarly, despite statements in the specification that a tile provides a real-time or near-real-time view of the underlying information (*see, e.g.*, '403 Patent at 8:35–37), no such requirement is part of the proper construction of “tile.” This is because the specification includes examples of tiles—such as a tile for infrequently updated HTML content that is refreshed at a certain time each day (12:56–58)—that do not provide a real-time or near-real-time view of the underlying information.

Microsoft argues merely that “a ‘tile’ is a visual element (including a window or an icon) that occupies less than the entire display, and *may* contain active areas or control elements.” (emphasis added). Petition at pages 6–7. Patent Owner disagrees. Contrary to the well-established tenets of claim construction, Microsoft’s proposed construction is divorced from the intrinsic record and ignores the patentee’s repeated and consistent descriptions in the specification of the '403 Patent of what a tile *is* as well as what a tile is not. In essence, Microsoft’s construction of the term “tile” is overly and unreasonably broad because it broadens the meaning of the term to cover exactly those user interface objects that the '403 Patent instructs the reader are distinct from a tile. Microsoft has essentially argued that a tile is indistinct from a “window” (as found in the prior

art) in direct contradiction to the specification of the '403 Patent which states repeatedly that a tile is different from a window. Therefore Microsoft's construction ignores aspects that one of ordinary skill in the art would understand to be features of a tile from reading the specification and claims of the '403 Patent. In effect, Microsoft's construction guts the meaning of the term tile so that it becomes no more than a portion of a display and is required to have no other distinguishing features. Furthermore, Microsoft's suggestion that a tile "*may* contain active areas or control elements", i.e., that active areas and control elements are actually optional features of a tile, is irrelevant to the features of a tile that are necessary and sufficient to define what it is. In this aspect, at least, Petitioner's construction relies unduly on extrinsic evidence (Declaration of David A. Karger, Ex. 1003), which is improper where a meaning for the term can be found within the patent specification.

In sum, Microsoft's proposed construction fails to reflect *any* features of a tile recited explicitly in the specification of the '403 Patent. Instead, Microsoft's construction improperly reads the term in isolation without any consultation to the intrinsic record, which the person of ordinary skill in the art *must* do when, as here, there is no plain and ordinary meaning in the art for this term. In addition, Microsoft's construction, which broadly equates a tile with a portion (less than all) of a display, is devoid of any useful meaning, and essentially operates to read the

patentee's chosen definition for "tile" out of the claim. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316; *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300.

E. "array of tiles"

The term "array of tiles" is recited in claim 1 of the '403 Patent. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term "array of tiles" that is consistent with the specification is: "multiple tiles displayed in an orderly fashion".

Patent Owner's construction of an "array of tiles" is consistent with the '403 Patent specification's use of the term. The use of the phrase "array of tiles" in the claims and the patent specification refers consistently to "an arrangement" of tiles and, from context, the arrangement is ordered in some way. Furthermore, the common dictionary definition of "array" is "place in an orderly arrangement," and the common dictionary definition of "arrange" is "to put into a specific order or relation." (Patent Owner Ex. 2001).

For example, the '403 Patent specification states that "[t]he missing capability is a visual categorization in which an area of the display unit itself becomes the bookmark and the arrangement on the display becomes the categorization, independent of the type of content." *Id.* 4:3–7. This description

connotes order, not the free form nature of “collection”, as in Microsoft’s proposed construction.

Furthermore, other references to arrays of tiles make explicit the idea that their arrangement is defined or organized, not random. For example, FIGs. 8–11 show several arrangements. The description of FIG. 8 refers to an “array comprising M rows and N columns [of tiles]” as having an “arrangement”. The descriptions of FIGs. 9–11 refer to the respective arrays of tiles as “arrangements” due to the particular way in each instance that the tiles are ordered. *Id.* 11:63–12:29.

Additionally, in the context of a grid of tiles, the word arrangement suggests the layout of the grid. *Id.* at 11:9–12; 12:13–29; and 15:4–6.

All of these aspects of the ’403 Patent’s specification indicate that the term array of tiles implies some presentation of order.

Microsoft’s proposed construction (“any arrangement on a display of one or more tiles”) relies on a looser meaning of “arrangement”—“a collection of data items.” However, Microsoft’s examples that are advanced as being consistent with their construction do not require any order to their presentation. Thus, although Microsoft utilizes “arrangement” in its construction of “array of tiles”, Petitioner’s explained meaning of the term does not require any order and would read on a randomly presented set of tiles, thereby effectively reading the term “array” out of

the claim. Microsoft's proposal therefore cannot be correct and Patent Owner's construction should be adopted.

F. “partitioning a visual display of the device into an array of tiles”

The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term “partitioning a visual display of the device into an array of tiles” that is consistent with the specification is: “dividing some or all of a display into a non-overlapping array of tiles”.

Patent Owner's construction correctly reflects the plain meaning of the disputed terms and, in particular, reflects the plain and ordinary meaning of the term “partitioning,” as used in the '403 Patent because it includes “dividing” or “divide”. A person of ordinary skill in the art would understand that the '403 Patent specification uses the term “partitioning” consistent with its normal meaning to divide space, and that here the “space” is a display, or part of a display. *Id.* 4:57–58; and 13:59–60. This concept is supported by the dictionary definition of the term “partitioning” as “to divide into parts, pieces, or sections.” (Patent Owner Ex. 2001). There is no possibility of interpreting “divide into parts” as encompassing overlapping parts—either other tiles or other graphical user interface elements such as icons or windows.

In contrast, Microsoft's proposed construction (“presentation of two or more

tiles within a portion or region of the display”) would remove any meaning imputed by the term “partitioning” from the claim because Microsoft’s proposal only requires showing a collection of tiles on the display with no particular order or arrangement. Such a construction therefore leaves open the possibility that the tiles could overlap with one another. This attempt to eliminate a term from the claim is consistently recognized as improper and should accordingly be rejected here. *See Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1119 (Fed. Cir. 2004) (“all claim terms are presumed to have meaning in a claim”) (reaffirmed in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)). Patent Owner’s construction should be adopted because it is consistent with the plain and ordinary meaning of the terms and the intrinsic record.

Microsoft has argued that the language of claim 3 of the ’403 Patent (“ ... partitioning said array of tiles in a non-overlapping configuration ...”) requires that the term partitioning in claim 1 encompass arrays of both overlapping and non-overlapping tiles. Petition at page 7. This interpretation ignores the fact that claim 3 additionally recites “wherein each tile of said array of tiles is a uniform size and shape.” This limitation is not found in claim 1 and therefore claim differentiation is not implicated. *See, e.g., Anderson Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1370 (claim differentiation held inapplicable because each claim presented to support application of the doctrine has more than one distinguishing feature);

see also Athletic Alternatives Inc. v. Prince Manufacturing Inc., 73 F.3d 1581, 37 USPQ2d 1365, 1372 (Fed. Cir. 1996) (claim differentiation not applicable because interpreting broader claim to include contested limitation still leaves differences from narrower claim). Furthermore, there are no embodiments of overlapping tiles in the specification or drawings of the '403 Patent, and the specification states that “tiles lead to a reduction in clutter on the display screen because many tiles may be displayed simultaneously without overlapping with one another in the way that windows must necessarily do.” '403 Patent at 8:46–49.

Microsoft also argues that a region of the display that can be partitioned includes a “window” because “claim 14 specifies the array of tiles is to be presented in a ‘web-browser’” and that “web-browsers may present multiple overlapping windows that occupy a portion of a display.” Patent Owner respectfully disagrees. To the extent that a single instance of a web-browser has been configured to display an array of tiles, then that portion of the display that is covered by the web browser has itself been partitioned. As one of ordinary skill in the art would understand, it is not correct to generalize that any window on a display may be so partitioned. Additionally, the fact that multiple instances of web-browsers, open in respective windows, may overlap with one another is irrelevant to the consideration of partitioning a single web-browser window (or the display itself) into an array of tiles. Similarly, simply because two or more

overlapping web-browsers could each independently be partitioned into an array of tiles, one of ordinary skill in the art would not conclude that partitioning therefore allows for an overlapping arrangement of tiles.

G. “user-defined array size”

The term “user-defined array size” appears in dependent claim 2. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term “user-defined array size” that is consistent with the specification is: “the number and arrangement of tile positions in the array as specified by the user”.

The Patent Owner’s proposal reflects the understanding of a person of ordinary skill in the art that “user-defined array size” means that the user can define something more than the number of elements in the array because an array itself admits of more than one dimension for its proper definition. See, for example, ’403 Patent specification at 11:9—11 (“a user may specify a presentation of the grid, consisting of its dimensions, (i.e., the number of tiles to display and their *arrangement*)” (emphasis added)). Thus an array of size 4 (tiles) is not properly defined until the user specifies whether the arrangement is in two rows of 2 tiles, or as a single row (or column) of 4 tiles. This definition is correctly reflected in Patent Owner’s proposal of “the number and arrangement of tile positions in the array”

The user's contribution is further explained, for example, in the file history, where the patent owner distinguished a user-defined array size" from simply the number of open windows on a conventional user interface. Microsoft Ex. 1002, File History of U.S. Patent 6,724,403, October 15, 2003 Amendment and Response, at p. 14. The Patent Owner explained that "the number of panels in McFedries' array is simply the number of open windows at the time they are tiled. The number will be the same whether the windows are tiled horizontally or vertically, but has nothing to do with an array size defined by a user." *Id.*

The term "user-defined array size" therefore means more than "an amount of space determined to be necessary to present a user-defined number of tiles in a display", as has been proposed by Microsoft.

H. "uniform size and shape"

The term "uniform size and shape" appears in dependent claim 3. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term "uniform size and shape" that is consistent with the specification is: "having the same size and shape as one another."

The specification of the '403 Patent supports this construction, at least at 11:63–65, referring to FIGs. 8–11, in which FIGs. 8, 10, and 11 show grids of tiles wherein the tiles are all of the same size and shape as one another.

I. “assigning a [first/second] refresh rate to a [first/second] tile of said array of tiles”

Microsoft has offered no construction of this phrase, as recited in claim 1 of the '403 Patent. Patent Owner proposes that the term receive its plain and ordinary meaning.

There is no indication in the intrinsic record that the '403 Patent uses this phrase, or in particular the word “assigning”, in any way that is inconsistent with its plain and ordinary meaning. Nor is there any reason why one of ordinary skill in the art would seek an alternative definition of the term “assigning.” In fact, Microsoft’s proposed construction of the term “refresh rate is assigned automatically”, uses the term “assigning” without further explanation, thus admitting that “assigning” is not in itself ambiguous or in need of special construction.

J. “wherein said assigning includes attributing a selected state or an unselected state to said first tile and said second tile”

The phrase “assigning includes attributing a selected state or an unselected state to said first tile” appears in dependent claim 5. Patent Owner believes this term can be construed consistent with its plain meaning. Therefore, the broadest reasonable construction of the term “attributing a selected state or an unselected state to a tile” that is consistent with the specification is: “causing a tile to be either selected or unselected.” Microsoft proposes that the definition includes “by direct

or indirect user action” but does not define what is meant, or what could reasonably be meant, by “indirect user action.”

K. “wherein at least one attribute of each tile in said array of tiles is assigned uniformly”

The phrase “at least one attribute of each tile in said array of tiles is assigned uniformly” appears in dependent claim 9. The Patent Owner believes this term can be construed consistent with its plain meaning. Therefore, the broadest reasonable construction of the term “at least one attribute of each tile ... is assigned uniformly” that is consistent with the specification is: “assigning the same value of an attribute to each tile in the array.” An attribute is a property of a tile, such as its size, its position, its priority, and its refresh rate, as well as other aspects of its appearance. Cf. ’403 Patent at: 13:7—19.

It should be noted that the windows of the prior art arise from launching different programs, so that the windows on a display that arise from different application programs appear different from one another depending on what program they come from. Thus, even if windows of the prior art are displayed in a “tiled” manner, they would lack the uniformity of appearance that is a property of the claimed array of tiles.

L. “grid”

The term “grid” appears in dependent claim 12. The best source for

determining the meaning of a claim is the specification. MPEP § 2173.01.

Therefore, the broadest reasonable construction of the term “grid” that is consistent with the specification is: “a regular layout of rows and columns where a single tile may occupy more than one row and/or column.” ’403 Patent at 6:39—41 and 13:7—8 and 13:12—14. Furthermore, as is shown in the ’403 Patent, a single tile may occupy more than one row and/or column, i.e., two or more consecutive positions in the grid.

M. “tile ... has a fixed size that is equal to a unit tile size, or a multiple thereof”

Microsoft has offered no construction of this term, as recited in claim 13 of the ’403 Patent. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term “tile ... has a fixed size that is equal to a unit tile size, or a multiple thereof” that is consistent with the specification is: “a single tile has a size that may occupy more than one row and/or column in an array of rows and columns.” ’403 Patent at FIG. 9, and at 12:13–19.

The ’403 Patent states that a grid “permits a regular layout of tiles on the display such that the tiles are uniform in size and shape, as depicted in Figs. 8-11.” ’403 Patent at 11:63-65. For example, the ’403 Patent explains that the grid 700 of FIG. 9 includes “an arrangement of tiles in which there is a unit tile size, that of tile

802-1-1, but tile 802-1-2 and tile 802-N-1 (*sic*, 802-M-1) have been configured to occupy regions of the grid equal to exact multiples of the unit tile size.” *Id.* at 12:13-16.

As shown, tile 802-1-2 occupies more than one row (*i.e.*, rows 1 and 2) and more than one column (*i.e.*, columns 2 and 3). On the other hand, tile 802-M-1 occupies a single row (row M) and two columns (columns 1 and 2). Thus, the ’403 Patent makes clear that a single tile can occupy more than one column and/or row as stated in Patent Owner’s proposed construction. Patent Owner’s proposed construction is therefore in harmony with the specification and should be adopted.

N. “wherein each of said tiles occupies a fixed position on said grid”

The term “wherein each of said tiles occupies a fixed position on said grid” appears in dependent claim 12. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term “wherein each of said tiles occupies a fixed position on said grid” that is consistent with the specification is: “wherein each tile occupies a particular position in the regular layout of rows and columns.” ’403 Patent at 11:63—12:19 and FIGs. 8–9.

As discussed above, the ’403 Patent recognizes that a tile may occupy more than one column and/or row of a grid. Thus, the correct construction of “wherein each of said tiles occupies a fixed position on said grid” must account for this

possibility. Patent Owner's construction requires only that each tile occupy a particular position in the regular layout of rows and columns, which might be, for example, the first two columns of the bottom row which are shown occupied by tile 802-N-1 in FIG. 9 of the '403 Patent.

Microsoft's construction should be rejected because it restricts the "fixed position" of a tile to be at a *single* row and a *single* column and thus would exclude embodiments that are clearly described in the patent. See *Accent Packaging, Inc. v. Leggett & Platt, Inc.*, 707 F.3d 1318, 1326 (a construction "that excludes a preferred embodiment from the scope of a claim is rarely, if ever, correct.").

Furthermore, the term "fixed position" connotes persistence, since there is no disclosure of a user being able to move a tile from one position in the array to another. It is consistent with the premise that a user will establish a preferred layout for an array of tiles that they will save from one session to another that a given tile's position must therefore be fixed in the array.

Microsoft has also stated that the term "[fixed position on the grid] does not require the tile to remain in the identical location on the display" if, for example, "the location of the grid varies on the display". Petition, in Section 17 at page 18. Regardless of the correctness of the assertion that an array may be moved around a display, it is irrelevant to the actual construction of this term because the "fixed position" is defined relative to the grid or array, wherever the grid happens to be

located.

O. “refresh rate”

The term “refresh rate” appears in independent claim 1. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. The broadest reasonable construction of the term “refresh rate” that is consistent with the specification is: “criteria for updating”.

As discussed hereinabove, each tile is assigned its own refresh rate. See, *e.g.*, ’403 Patent at Abstract; 10:4-5; 12:53-65; FIG. 12 (“Refresh rate”); and FIG. 6 (“Refresh”). This provides a user the ability to monitor updated information from many sources of information of different types at the same time. See, *e.g.*, *id.* at 12:50-65. The ’403 Patent discloses a wide variety of ways to choose a refresh rate.

For example, for locally stored word processing or spreadsheet files, the user might configure the tiles to refresh only when the underlying data is written to the local hard drive. Similarly, a user might configure the tiles containing infrequently updated HTML data from the Internet to refresh at a certain time each day. At the other extreme, a user might configure an active tile to display a television channel at a refresh rate of 29 frames per second, while at the same time configuring inactive tiles to display different channels at a refresh rate of once every five seconds. In this way, a user could

monitor many channels until program content of interest appeared in one of the tiles without the burden of actively refreshing each tile.

Id. at 12:53-65. Different types of refresh rates, or criteria for updating, can be applied according to the type of information source associated with a tile. Thus, a person of ordinary skill in the art would understand that configuring a tile to refresh when an associated file is written to a local drive would be appropriate, for example, for locally stored files such as spreadsheets or word processing documents, whereas configuring a tile to refresh at a certain number of times per second or minute would be appropriate for other types of associated information source.

Patent Owner's proposed claim construction therefore stays true to the '403 Patent's description of "refresh rate", while Microsoft's proposal improperly excludes at least one embodiment.

In contrast to the clear teachings of the patent, Microsoft's proposal unduly narrows the term to "a recurring time interval." This is incorrect for at least two reasons. First, a person of ordinary skill in the art would understand the claimed "refresh rate" to encompass the '403 Patent's example of "when the underlying data is written to the local hard drive." 12:52-56. Microsoft's proposal of "a recurring time interval," excludes this described embodiment and is therefore incorrect. The record is devoid of any indication that the patent owner intended the

term “refresh rate” to be limited to “a recurring time interval” and exclude, for example, the writing to disk embodiment described in the ’403 Patent.

Second, the plain and ordinary meaning of “rate” is not limited to “a recurring time interval.” The understood meaning of rate is, for example, “a quantity measured with respect to another quantity.” Ex. 2001. The quantity used for such comparison is not limited to time as Microsoft proposes. Indeed, rates that do not involve time are familiar in everyday life: a car owner changing his engine oil every 3,000 miles, a restaurant giving a free lunch to a customer every tenth visit, or an inclined road that climbs at a rate of 500 ft. / mile. There is nothing in the claims or the specification that provides any reason to narrow this plain and ordinary meaning to Microsoft’s proposed construction.

Microsoft’s proposal should also be rejected because it introduces redundancy. For example, claim 1 already recites “updating information ... presented to said first tile in accordance with said first refresh rate.” Microsoft’s proposed construction for “refresh rate”—“at which information displayed in a tile is refreshed”—essentially just repeats this language. For at least these reasons Microsoft’s proposals should be rejected and the Board should adopt the Patent Owner’s constructions.

P. “updating information from a [first/second] information source in said plurality of information sources presented to said [first/second] tile in accordance with said [first/second] refresh rate”

The term “updating information from a first information source . . . presented to said first tile in accordance with said first refresh rate” appears in independent claim 1. The Patent Owner believes this term can be construed in a manner consistent with its plain meaning, in context with other claim terms construed elsewhere herein.

In particular, a tile has associated with it an information source and a refresh rate. The content of the tile is updated with new or current data from the information source at a rate consistent with the refresh rate assigned to the tile.

Q. “simultaneously updating information from a second information source . . . in accordance with said second refresh rate”

The term “simultaneously updating information from a second information source . . . in accordance with said second refresh rate” appears in independent claim 1. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01.

The broadest reasonable construction of this term that is consistent with the specification is: “performing the repetitive process of updating information presented to the second tile and waiting for the next time at which the update is to occur as set by the refresh rate assigned to the second tile at the same time or nearly the same time as said updating information from said first information source.” This construction does not require that any instances of presenting

information to the first and second tiles occur at the same exact moment in time.

This construction of “simultaneously updating information from a second information source in accordance with said second refresh rate” is proper because it aligns with the description of this step in the specification of the ’403 Patent and clarifies for the Board both (i) whether this step must be performed simultaneously with the step of “updating information from a first information source” or some other step of claim 1, and (ii) what “simultaneously updating” means in the context of a repetitive process that occurs over a window of time.

The ’403 Patent describes the process of updating information from an information source presented to a tile as an on-going, repetitive process. For example, the ’403 Patent discusses, as one example, refreshing a tile associated with infrequently changed HTML content at a certain time each day. ’403 Patent at 12:56-58. This update process continues day to day over a window of time on a computer on which the tile resides. This process is repetitive in that there will be periods of time in this window during which data to be presented to the tile associated with the HTML content is being transferred, and other periods of time in this window during which no data transfer will occur, and these periods of time repeat according to the scheduled time for update.

The ’403 Patent also makes clear that multiple update processes for multiple tiles may be running at the same time, and those update processes may have

different rates. For example, the '403 Patent describes updating a tile associated with a stored word processing file when underlying data is written to a local hard drive. '403 Patent at 12:56-58. One of ordinary skill in the art would understand that such underlying data would be written to a local hard drive, and thus information would be presented to the tile, a few times each hour and only while the user was working on the document.

One of ordinary skill in the art would understand that the data transfer portions of the first and second update processes may not ever occur at exactly the same point in time, such as if the first update process for the tile associated with the HTML content were scheduled for 3 am when a company's network was not busy, and the word processing file associated with the second tile were only edited by a user between 9am–5pm. One of ordinary skill in the art would also understand these two updating processes (including both the data transfer periods and the periods during which no data transfer occurs) to be simultaneous because both update processes are occurring during the same time window, even though the data transfer operations for the two processes do not occur at the same time.

Patent Owner's construction therefore encompasses two processes that overlap at any point during their continuous execution regardless of when individual instances of data being presented to the respective tiles may occur, and would be understood as such by one of ordinary skill in the art.

Finally, one of ordinary skill in the art would understand from the specification that “simultaneously updating information from a second information source in said plurality of information sources presented to said second tile in accordance with said second refresh rate” means that such updating is to occur simultaneously (during the same time window) with respect to the step of “updating information from a first information source”. Construing claim 1 to require the step of updating information from a second information source at the same time as any other step of claim 1 would not make sense to a person of ordinary skill in the art. For example, it would be impossible to perform the first step of “selecting a plurality of information sources” simultaneously with “updating information from a second information source” because the result of the former step is necessary to perform the latter. The other steps of the claim (other than “updating information from a first information source”) must also be performed prior to the “simultaneously updating step” for similar reasons.

R. “assigning said first [second] refresh rate in accordance with a first [second] priority value of a first [second] information source associated with said first [second] tile”

The term “assigning said first refresh rate in accordance with a first priority value of a first information source associated with said first tile” appears in dependent claim 4. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction

of the term “assigning said first refresh rate in accordance with a first priority value of a first information source associated with said first tile” that is consistent with the specification is that the “refresh rate is assigned to a tile based on a priority scheme such that a tile’s refresh rate is higher than the refresh rates of other tiles that have lower priority values”. Support for this construction can be found in the specification of the ’403 Patent at least at 13:14–15; 21:10–20; 21:36–45.; and 22:43–50.

This meaning is also consistent with the plain and ordinary meaning of “priority”, as stated in Ex. 2001: “Precedence, especially established by order of importance or urgency.”

S. “refresh rate is assigned automatically”

The term “refresh rate is assigned automatically” appears in dependent claim 11. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term “refresh rate is assigned automatically” that is consistent with the specification is that the “refresh rate is assigned without direct user input”. Support for this construction can be found in the specification of the ’403 Patent at least at 12:36–43.

T. “storing said array of tiles on a second device”

The term “storing said array of tiles on a second device” appears in

dependent claim 15. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term “storing said array of tiles on a second device” that is consistent with the specification is: “transmitting to, and saving on, a second device, a specification of an array of tiles that includes, for each tile, its position in the array, its refresh rate, and its assigned information source.” ’403 Patent at 22:1–38 and FIG. 24.

This construction is consistent with Patent Owner’s construction of the term “array of tiles”, as well as “tile” itself.

U. “wherein said array of tiles is retrieved from a second device”

The term “wherein said array of tiles is retrieved from a second device” appears in dependent claim 16. The best source for determining the meaning of a claim is the specification. MPEP § 2173.01. Therefore, the broadest reasonable construction of the term “wherein said array of tiles is retrieved from a second device” that is consistent with the specification is: “retrieving from a second device, a specification of an array of tiles that includes, for each tile, its position in the array, its refresh rate, and its assigned information source.” ’403 Patent at 22:1–38 and FIG. 24.

This construction is consistent with Patent Owner’s construction of the term “array of tiles”, as well as “tile” itself.

5. Argument

A. The Petition Fails to Establish a Reasonable Likelihood that at Least One of Claims 1, 3-5, 7-13, 18, 19, and 21 are Anticipated by Duhault I

The Petition alleges that claims 1, 3–5, 7–13, 18, 19, and 21 are anticipated by U.S. patent No. 6,118,493 to Duhault *et al.* (“Duhault I”; Microsoft Ex. 1013) under 35 U.S.C. § 102(e). Petition at pp. 20 *et seq.* Petitioner misreads the disclosure of Duhault I; Patent Owner respectfully submits that Duhault I does not disclose each and every element of the claims.

i. General Observations

Patent Owner argues that the disclosure of Duhault I is redundant in the face of the disclosure of Duhault II (described further hereinbelow). Duhault I and Duhault II list an inventor in common, and are commonly assigned. The disclosure of Duhault II lists Duhault I as a “related application”, and during the examination of Duhault II the examiner cited Duhault I. Furthermore, Petitioner has applied Duhault II to the same claims as Duhault I, with the addition of certain claims (2, 6, 17, and 20), to which Duhault I is not applied. This implies that Duhault II has much disclosure in common with Duhault I as well as a broader level of disclosure than Duhault I.³

³ This is notwithstanding the fact that, as described in Section 6 of the instant Response, alternative grounds of anticipation of the claims of the ’403 Patent have

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Duhault I describes the presentation, on a computer monitor or a television, of a grid of rectangular “channel display areas”, each of which shows content from an audio or video channel. (Duhault I at Abstract, and FIG. 2). In Duhault I, the system comprises a single tuner (Duhault I, at FIG. 1), which cycles around each of the channels so that each displays a still (“thumbnail”) of recent content in one of the channel display areas. When a user wishes to view one of the channels (s)he selects one of the channel display areas, which then causes that display area to be sampled and displayed at a rate consistent with the display of ‘live’ audio and video, while the remaining display areas remain frozen.

ii. The claims

Petitioner argues that the channel display areas of Duhault I are tiles, and that Duhault I discloses assigning first and second refresh rates to, respectively, first and second tiles, because “each video viewing area will be updated or refreshed at a periodic rate.” (Petition, at page 20–21.)

Petitioner further argues that Duhault I discloses “updating information from a first information source ... presented to said first tile in accordance with said first refresh rate; and simultaneously updating information from a second information

been alleged over still other references, in concurrently filed petitions for *Inter Partes* Review (IPR2013-00293, IPR2013-00294, and IPR2013-00295).

source ... presented to said second tile in accordance with said second refresh rate” because “the tuner of Duhault I updates video information from the television video source associated with each video viewing area.” Petition, page 22.

Patent Owner respectfully disagrees. The channel display areas of Duhault I are not “tiles” within the meaning of Patent Owner’s claims at least because they are not assigned individual refresh rates. In Duhault I, each individual channel display area is updated at the same rate, determined by the rate at which the tuner cycles around the channels. The refresh rate is then not individually assigned to each channel display area, but rather is a property of the tuner. (See, *e.g.*, Duhault I at col. 3, lines 14–18 (“the tuner 12 is constantly changed or retuned, to retrieve samples of live broadcasts of the various channels to be displayed.”).) One skilled in the art would not interpret Duhault I as assigning individual refresh rates to individual channel display areas because there is only a single tuner, which itself must be configured to control a single rate at which the various video signals are refreshed. Petitioner implicitly acknowledges this fact by presenting no argument that Duhault I anticipates Patent Owner’s claim 6, which recites that the first and second refresh rates are different from one another.

Accordingly, claim 1 is not anticipated by Duhault I. Claims 3–5, 7–13, 18, 19, and 21, depending from claim 1, are therefore not anticipated by Duhault I.

Nevertheless, there are additional and specific reasons why other of Patent

Owner's claims are not anticipated by Duhault I, as follows.

Claim 4 is not anticipated by Duhault I because there is no disclosure in Duhault I of priority values being assigned to channel display areas. According to Petitioner, a “selected viewing area in Duhault I has a higher priority than other viewing areas that are not selected.” (Petition, page 23). However, this is an incorrect construction of claim 4. A priority value and a refresh rate are different from one another: for example a priority value may be used to distinguish between two tiles that, because of their contents, might be automatically assigned the same refresh rates. Furthermore, Petitioner's construction of priority, in claim 4, renders it indistinguishable from “select”, as recited in claim 5.

Claim 7 is not anticipated by Duhault I because the reference does not disclose a user choosing a refresh rate for a tile. The only relevant passage of Duhault I states: “The periodic rate, while it may be user controlled to be at any rate, is generally dictated by how fast the tuner can sample the plurality of channels.” (Duhault I, at col. 4, lines 23–26). Thus, in Duhault I, the only relevant factor that a user can control is the rate at which the tuner cycles around the various channels, which is not a property of individual channel display areas. Similar considerations apply to claims 9 and 10.

Claim 10 is not anticipated by Duhault I because there is no disclosure in Duhault I of assigning refresh rates uniformly to all of the channel display areas;

instead, as discussed hereinabove, the refresh rate is defined by the tuner.

B. The Petition Fails to Establish a Reasonable Likelihood that at Least One of Claims 1-13 and 17-21 is Anticipated by Duhault II

The Petition alleges that claims 1–13 and 17–21 are anticipated by U.S. patent No. 6,456,334 to Duhault (“Duhault II”; Microsoft Ex. 1014) under 35 U.S.C. § 102(e). See, Petition at p. 25 *et seq.* Patent Owner respectfully submits that Petitioner misreads the disclosure of Duhault II, and that Duhault II does not disclose each and every element of Patent Owner’s claims. Furthermore, in the event that the Board institutes an *Inter Partes* Review, Patent Owner intends to establish, by Declaration under 37 C.F.R. § 1.131, inventive acts prior to the effective date of Duhault II showing that it is not prior art to the ’403 Patent.

i. General Observations

Patent Owner maintains that Duhault I is, in large part, cumulative over Duhault II. In fact, Petitioner states that “[t]he scheme of Duhault II is similar to the scheme of Duhault I, and discloses each of the elements of claims 1, 3–5, 7–13 and 18–21 as set forth above with respect to Duhault I”.⁴ Petition at p. 26. See also, Declaration of David R. Karger (“Karger Declaration”; Microsoft Ex. 1003)

⁴ This is despite the fact that Duhault II does not incorporate by reference the disclosure of Duhault I. Therefore, Petitioner must be relying on the explicit disclosure of Duhault II when offering comparisons with Duhault I.

at ¶ 672 (“Similar to Duhault I, Duhault II describes a system for watching multiple television video broadcasts at the same time”). Petitioner then presents only scant argumentation in favor of Duhault II’s alleged anticipation of Patent Owner’s claims, making specific comments only on claims 2, 6, 17, and 20, and relying on the arguments presented for Duhault I for the remainder of Patent Owner’s challenged claims.

Like Duhault I, Duhault II describes the presentation, within a window of a computer monitor, or on a television display, of a number of video images, each of which shows content from a video channel. (Duhault II at 1:65–67) Unlike Duhault I, in Duhault II the system comprises two or more tuners (Duhault II, at 7:53–55), each of which cycles around a group of one or more of the video channels so that each displays recent content. When a user wishes to view one of the channels in real time, (s)he selects one of the video images, which then causes that video source to be sampled and displayed at a rate consistent with the display of ‘live’ video, while the images on the remaining display areas are frozen (Duhault II at 3:10–33).

ii. Claims

Petitioner makes no specific argument that the areas of the display that present video streams in Duhault II are “tiles”, other than to rely on statements made regarding Duhault I and a single paragraph of the Karger Declaration (“the

display area is partitioned into an array of ‘video images’ (141-149), which correspond to the ‘tiles’ of the ’403 Patent.”) Karger Declaration at ¶ 675.

Patent Owner responds as follows. The video images of Duhault II are not “tiles” within the meaning of Patent Owner’s claims at least because, according to Duhault II, they are simply a video image displayed within a “scaleable first window”. Furthermore, the video images are not assigned individual refresh rates. In Duhault II, each individual video image associated with one of the tuners is updated at the same rate, determined by the rate at which the tuner cycles around the channels. The refresh rate is then not assigned to the video image, but rather is a property of the tuner. See, *e.g.*, Duhault II at col. 3, lines 9–21 (“a first portion of the plurality of video images is periodically refreshed using a first tuner.”). One skilled in the art would not interpret Duhault II as assigning individual refresh rates to individual video images because each image is part of a group of images associated with a single tuner, which itself must be configured to control the (single) rate at which its various associated video signals are refreshed. This applies even where groups of video images are assigned to each of multiple tuners. The refresh rates of each image are determined by the rate at which the tuner cycles around the various images and the number of such images assigned to the particular tuner.

Additionally, the displays of Duhault II are not persistent and therefore lack

an attribute of the tiles of the '403 Patent claims. There is no disclosure in Duhault II that suggests that a user has selected or ordered particular content in such a manner that (s)he will expect to view it in the same way on a subsequent occasion. Furthermore, there is no disclosure in Duhault II of attaching user-specific attributes, such as passwords or access codes, to video viewing areas, and there is no disclosure of saving particular configurations of viewing areas (such as laid out in FIGs. 1–4) for future use. In fact, there is nothing in Duhault II to suggest that the video viewing areas are populated from a predefined list, or selection of, video channels. For all intents and purposes, the system will display a fresh selection and arrangement of video viewing areas each time it is started.

Accordingly, claim 1 is not anticipated by “Duhault II”. Claims 2–13 and 17–21, depending from claim 1 are therefore not anticipated by Duhault II.

C. The Petition Fails to Establish a Reasonable Likelihood that at Least One of Claims 1-3, 6-13 and 19 is are Anticipated by Chen

The Petition alleges that claims 1–3, 6–13, and 19 are anticipated by U.S. patent No. 5,432,932 to Chen *et al.* (“Chen”; Microsoft Ex. 1015) under 35 U.S.C. § 102(a, b, e). See, *e.g.*, Petition at p. 27 *et seq.* Petitioner misreads the disclosure of Chen, and Chen does not disclose each and every element of Patent Owner’s claims.

i. General Observations

Patent Owner argues that Chen is cumulative over at least Duhault I and Duhault II. There are no claims to which Chen is individually applied that Duhault II is not also applied to. As discussed further hereinbelow, Petitioner has argued that certain claims are not anticipated by Chen but are merely obvious over a combination of Chen with some other reference. Therefore, the disclosure of Chen is, in total, less than that of Duhault II. Petitioner has not, however, emphasized in any way why separate and duplicate grounds of unpatentability are warranted.

Chen describes a system for monitoring remote computers and presenting information, particularly performance statistics, about those computers on a display. (Chen, Abstract, and 2:6–3:4) In one embodiment (Chen, FIG. 12c), Chen shows how a display can be configured to show performance data from several computers, in different rectangular panels.⁵

ii. Claims

Patent Owner submits that Chen cannot anticipate any of the claims of the '403 patent at least because Chen does not disclose the claimed tiles and any

⁵ Chen does contain the term “tile” (Chen at 23:65 – 24:2) but, as used, the term refers to the pattern of a background image on the display and not a graphical user interface object. The use of the term is therefore irrelevant to considerations of patentability of the claims of the '403 Patent.

limitation requiring a tile.

Petitioner argues that the rectangular panels in Chen are “tiles”. Karger Declaration at ¶ 758. However, this argument appears to be driven by a superficial similarity between the layout of panels in FIG. 12c of Chen, and Patent Owner’s array of tiles. Patent Owner points out that the panels of Chen are not tiles within the meaning of Patent Owner’s claims, at least because the panels are not “selectable to provide access to the underlying information.” The individual panels of Chen cannot be maximized independently of one another; it’s only possible to maximize the entire “console”, and there is no disclosure of any different or additional access to information when the consoles are maximized. Furthermore, the portion of Chen cited by Petitioner (Chen, at 14:67–15:2) in support of selectability in fact refers to optional settings on menu options in the console, and not for the individual panels.

The layout in FIG. 12c of Chen is of a “playback console”. (Chen at 22:16—23, and FIG. 13. See also Chen at 18:54–19:4). The individual panels of FIG. 12c only provide the ability to play back information from a recording file.

Furthermore, Petitioner contends that Chen discloses individually refreshable tiles. However, the passage of Chen alleged by Petitioner to disclose “user configurable” sampling of performance information only refers to the console, and not to “instrument subwindows” (Chen at 8:38–40). Thus, there is no

disclosure of tiles as claimed in the '403 Patent.

Accordingly, claim 1 is not anticipated by Chen. Claims 2–3, 6–13, and 19, depending from claim 1, are therefore not anticipated by Chen.

D. The Petition Fails to Establish a Reasonable Likelihood that Claim 4 is Unpatentable over Chen in view of Haddock

The Petition alleges that claim 4 is obvious over Chen in view of U.S. Patent No. 6,104,700 to Haddock et al. (“Haddock”; Microsoft Ex. 1024). Petition at pp. 33–35. Petitioner misreads the combined teachings of Chen and Haddock.

Patent owner’s claim 4 depends from claim 1 and recites the additional limitation of assigning refresh rates to tiles in accordance with priority values.

Haddock discloses quality of service (QoS) tags in the context of policy-based internet protocols. Haddock is silent in matters of graphical user interfaces except in a general reference to interfaces being provided with the disclosed technology. (Haddock at 5:1–10).

Therefore, Haddock does not disclose the items missing from Chen, and the combination of Haddock and Chen falls short of making Patent Owner’s claim 4 unpatentable in light thereof.

E. The Petition Fails to Establish a Reasonable Likelihood that at Least One of Claims 15 and 16 is Unpatentable over Chen in view of MSIE Kit

The Petition alleges that claims 15 and 16 are obvious over Chen in view of

the book Microsoft Internet Explorer Resource Kit (“MSIE Kit”; Microsoft Ex. 1007). See, e.g., Petition at pp. 35–36. Petitioner misreads the combined teachings of Chen and MSIE Kit.

Patent owner’s claims 15 and 16 both depend from claim 1 and recite an additional limitation of storing or retrieving an array of tiles from a second device.

MSIE Kit discloses an Active Desktop user manual but does not disclose the features of tiles missing from Chen, such as selectability.

Therefore, the combination of Chen and MSIE Kit falls short of making Patent Owner’s claims 15 and 16 unpatentable in light thereof.

F. The Petition Fails to Establish a Reasonable Likelihood that at Least One of Claims 15 and 16 is Unpatentable over Chen in view of Crawford

The Petition alleges that claims 15 and 16 are obvious over Chen in view of U.S. Patent No. 5,901,228 to Crawford (“Crawford”; Microsoft Ex. 1029). See, e.g., Petition at pp. 36–37. Petitioner misreads the combined teachings of Chen and Crawford. Patent owner’s claims 15 and 16 both depend from claim 1 and recite an additional limitation of storing or retrieving an array of tiles from a second device.

Crawford discloses a telecommunication connection for a personal computer. Crawford is silent in matters of graphical user interfaces. Therefore, Crawford does not disclose the items missing from Chen, and the combination of

Crawford and Chen falls short of making Patent Owner's claims 15 and 16 unpatentable in light thereof.

G. The Petition Fails to Establish a Reasonable Likelihood that Claim 18 is Unpatentable over Chen in view of DorEl

The Petition alleges that claim 18 is obvious over Chen in view of U.S. Patent No. 5,721,951 to DorEl ("DorEl"; Microsoft Ex. 1025). See, e.g., Petition at page 38. Petitioner misreads the combined teachings of Chen and DorEl.

Patent owner's claim 18 depends from claim 1 and recites and additional limitation of displaying an array of tiles on a television.

DorEl discloses a home entertainment system. DorEl is silent in matters of graphical user interfaces except in a general reference to interfaces being provided with the disclosed technology. (DorEl at 4:50–5:4.)

Therefore, DorEl does not disclose the items missing from Chen, and the combination of DorEl and Chen falls short of making Patent Owner's claim 18 unpatentable in light thereof.

H. The Petition Fails to Establish a Reasonable Likelihood that Claim 21 is Unpatentable over Chen

The Petition alleges that claim 21 is obvious over Chen. See, e.g., Petition at page 38. Petitioner misreads the teachings of Chen, when combined with what was known by one of ordinary skill in the art.

Patent owner's claim 21 depends from claim 1 and recites an additional

limitation wherein two of the plurality of information sources are selected from a group of data types. Chen only discloses signals comprising data from monitored resources. Chen omits disclosures of aspects of tiles, as discussed elsewhere herein.

As noted hereinabove, claim 1 is not anticipated by Chen. Claims depending from claim 1 are therefore not anticipated by Chen. Because Chen does not teach or suggest the claimed tiles, Chen cannot render claim 1 or any of its dependent claims unpatentable.

I. The Petition Fails to Establish a Reasonable Likelihood that at Least One of Claims 1, 17 and 20 is Anticipated by Farber

The Petition alleges that claims 1, 17, and 20 are anticipated by U.S. patent No. 5,819,284 to Farber et al. (“Farber”; Microsoft Ex. 1016) under 35 U.S.C. § 102(a, b, e). See, e.g., Petition at pp. 38 et seq. Petitioner misreads Farber.

i. General Observations

Patent Owner argues that the disclosure of Farber is redundant in the face of the disclosures of other references cited by Petitioner. Farber is applied to no single claim that Petitioner does not also argue is unpatentable over at least one other reference. For example, Petitioner has applied Duhault II to every claim to which Farber is applied. Yet, Duhault II has been applied to many other claims to which Farber has not. This implies that Duhault II has much disclosure in common

with Farber as well as a broader level of disclosure than Farber. The fact that Petitioner can only apply Farber to claim 1 and two dependent claims that recite specific types of display devices is further indication that Farber does not disclose key features, such as tiles, of Patent Owner's claims.

Furthermore, Farber is applied under separate grounds of both anticipation, and obviousness in connection with one or more other references, for each claim to which it is applied.

Farber describes a screen-saver, for use on a display such as a computer monitor or a television, and in which float a series of "screen areas", each of which shows content from an information source. (Farber at 6:48–50, and FIG. 4). In Farber, the screen saver activates after a preset amount of time of computer inactivity, and connects via a "service node" to one or more remote sources of information (Farber, at FIG. 1). The user can configure the screen-saver to refresh the screen areas at designated intervals after the initial activation of the screen-saver.

ii. The claims

Petitioner argues that the screen areas of Farber are tiles, and that Farber discloses assigning first and second refresh rates to, respectively, first and second tiles, because "users can specify the time intervals between scheduled updates." (Petition, at pp. 39–40.)

Patent Owner respectfully disagrees. The screen areas of Farber are not “tiles” within the meaning of Patent Owner’s claims at least because they are not assigned individual refresh rates. In Farber, each screen area is updated at the same rate, determined by a “user-specified time interval” (Farber, Abstract). The refresh rate is then not a property of each screen area, but a property of the screen saver. One skilled in the art would not interpret Farber as assigning individual refresh rates to individual screen areas because there is only a single interface, which accepts feeds from the various information sources. Petitioner implicitly acknowledges this fact by presenting no argument that Farber anticipates Patent Owner’s claim 6, which recites that the first and second refresh rates are different from one another.

Furthermore, a screen area of Farber cannot be ‘selected’ by a user. Petitioner implicitly acknowledges this fact by presenting no argument that Farber anticipates Patent Owner’s claim 5, which recites attributing a selected or an unselected state to a tile. For this additional reason, the screen areas of Farber do not correspond to tiles, as defined by Patent Owner.

Farber also does not show an array of tiles, according to Applicant’s definition, at least because the screen areas of Farber float randomly around (Farber, at 6:48–50), and are therefore not arranged in an orderly fashion.

Accordingly, claim 1 is not anticipated by Farber. Claims 17 and 20, which

depend from claim 1, are therefore also not anticipated by Farber.

J. The Petition Fails to Establish a Reasonable Likelihood that at Least One of Claims 1, 17, and 20 is Unpatentable over Farber in view of MSIE Kit

The Petition alleges that claims 1, 17 and 20 are obvious over Farber in view of MSIE Kit. See, e.g., Petition at pp. 41–42. Petitioner misreads the combined teachings of Farber and MSIE Kit.⁶

Petitioner argues that Farber discloses an array by negating the portion of Farber that describes FIG. 4. According to Petitioner, “that the tiles of Farber can float does not preclude them from being in an array for purposes of the ’403 patent, nor does that change the disclosure of FIG. 4 of Farber, that has no indication of float.” Petition at pages 41–42, citing to Ex. 1003 at para. 873. Patent Owner notes that the Petition quotes verbatim from Ex. 1003 without offering any additional argumentation. Patent Owner disagrees with the conclusion that FIG. 4 of Farber “has no indication of float”. The only description of FIG. 4, in Farber, states without limitation that “a series of screen areas 401—406 ‘float’ or

⁶ Additionally, Patent Owner points out that Petitioner has advanced separate grounds of unpatentability of claims 17 and 20 over the same combination of Farber and MSIE Kit in both the instant Petition and the concurrently filed Petition for IPR2013-00295. It is, of course, unduly burdensome on Patent Owner to face essentially identical grounds in separately-filed Petitions.

randomly move throughout the display area 400, preferably without interfering with or covering each other.” Farber at 6:48–50. Although Farber also states that “[n]umerous variations of the screen saver user presentation are possible” (Farber at 6:62–63), this does not by itself suggest a static format. FIG. 4 itself, by its very nature (a line drawing) can only convey a static ‘snap-shot’. Although Petitioner argues that “common sense dictates that the feature of Farber that causes the tiles to float could have been removed from Farber, making the claims obvious” (Ex. 1003 at para. 874), in fact the disclosure of Farber suggests the opposite. Farber discloses a “screen saver”. Typical of screen savers, and as acknowledged by Farber, is that they comprise “time-varying patterns ... thereby avoiding burn-in on the screen surface.” Farber at 1:22–24. Causing the tiles not to float would remove the time-varying variation in their position, which would undercut the desire to avoid “burn-in” that is implicit in screen-saver designs.

Petitioner further argues that “MSIE Kit discloses the display of tiles in a grid arrangement, and one of ordinary skill in the art would have considered the combination of Farber and MSIE kit obvious.” Patent Owner respectfully disagrees, at least because MSIE Kit does not provide the other limitations missing from Farber. In particular, the Active Desktop items described in MSIE Kit are not selectable. Instead, “clicking a link inside an Active Desktop item creates a new browser window” that displays what the link points to rather than what is displayed

in the Active Desktop items.

Accordingly, claims 1, 17 and 20 are not obvious over Farber in view of MSIE Kit. Furthermore, Petitioner has already advanced an argument that Farber is alone sufficient to anticipate claims 1, 17, and 20. It is unclear therefore, why additional reliance is placed on a combination of Farber and MSIE Kit to render obvious the same claims.

K. The Petition Fails to Establish a Reasonable Likelihood that Claim 17 is Unpatentable over Farber in view of Jambhekar

The Petition alleges that claim 17 is obvious over Farber in view of U.S. Patent No. 5,848,356 to Jambhekar (“Jambhekar”; Microsoft Ex. 1031). See, e.g., Petition at pages 42–43. Petitioner fails to appreciate that Jambhekar does not supply features of Patent Owner’s claims that are missing from Farber.

In order to establish obviousness of a claim, the prior art reference, or references when combined, must teach or suggest each and every limitation of the claimed invention. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As noted herein, Farber fails to teach or disclose a display partitioned into tiles, within the meaning of Patent Owner’s claims. Claim 17 depends from claim 1 and thereby includes each and every limitation of claim 1, but is further limited in that the claimed method is carried out on a “mobile telephone”.

Jambhekar discloses a “method for implementing icons in a radio

communication device” such as mobile telephone (Jambhekar at FIGs. 2 and 3). Jambhekar does not provide limitations that are absent from Farber. Jambhekar discloses a user interface for a mobile device (such as a mobile or cellular phone). The interface comprises only “icons”, however. Nothing in Jambhekar would lead one of ordinary skill in the art to create tiles, as recited in Applicant’s claims, even knowing of the disclosure of Farber. Accordingly, claim 17 is not obvious over Farber in view of Jambhekar.

Furthermore, Petitioner has already advanced an argument that Farber’s disclosure of a “screen phone” is sufficient to anticipate claim 17. It is unclear why additional reliance is placed on a combination of Farber and Jambhekar.

6. The Petition is horizontally and vertically redundant

Patent Owner requests that, if the Board were inclined to grant any of Microsoft’s petitions related to the ’403 Patent, the Board consolidate, or authorize a motion to consolidate, both the numerous grounds of unpatentability as well as the number of simultaneous petitions for *Inter Partes* Review (IPR) filed by Petitioner against the ’403 Patent. *See Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.* (CBM2012-00003, Paper 7; the Board discussed when a ground may be deemed redundant.)

Both within the instant Proceeding as well as drawn from the combination of parallel proceedings (*cf.* IPR2013-00293, IPR2013-00294, and IPR2013-00295)

brought by Petitioner against the '403 Patent, there are two types of redundancy: the application of a plurality of prior art references as distinct and separate alternatives; and the application of a plurality of prior art references in partial and full combination to support separate grounds of unpatentability. This militates in favor of both reducing the number of prior art references and the number of separate proceedings, to the extent that the Board believes that institution of *Inter Partes* Review of the '403 Patent on any of the asserted grounds is proper.

Petitioner has raised 226 grounds of unpatentability against the 52 claims of the '403 Patent in four separate IPR's (numbered IPR2013-00292, IPR2013-00293, IPR2013-00294 and IPR2013-00295). This averages more than four separate grounds of unpatentability for every claim in the '403 Patent. If the various grounds are truly redundant (*i.e.*, if one ground is not stronger than any other), then having to contest numerous such grounds represents a burden on Patent Owner, and could lead to delays in the Proceeding, despite the goal of 37 C.F.R. § 42.1(b), to "secure the just, speedy, and inexpensive resolution of every proceeding".

With respect to the challenged claims, the table in Exhibit 2002 summarizes the various grounds of unpatentability alleged by Petitioner.

The fact that there are multiple grounds of unpatentability for any given claim, and that all are given approximately equal weight by Petitioner, compels the conclusion that there must be a cumulative (*i.e.*, duplicative) effect to many, if not

all, of the cited references. Patent Owner requests that the Board either identify and remove duplicative grounds of unpatentability or mandate Petitioner to articulate a reasonable basis as to why a particular reference, or combination of references, presents a stronger ground of unpatentability for each of Patent Owner's claims. For example, with the exception of claim 29, every claim is alleged anticipated, and, of those claims that are allegedly anticipated, every claim except claims 44, 45, 51, and 52 is alleged anticipated on two or more separate grounds.

Thus, in the Petition, four separate references (Duhault I, Duhault II, Farber, and Chen) are relied on to assert independent grounds of anticipation of claim 1. Various subsets of those four references are used to allege separate grounds of anticipation of the various other claims challenged in the Petition. Furthermore, three of those references (Duhault I, Duhault II, and Farber) are used to establish obviousness of one or more of claims 1–21 in IPR2013-00295. The ways in which the various references are applied, are summarized in the table in Exhibit 2002.

Independent and separate grounds of anticipation of claims 1–3, 5–8, 11–16, and 19–21 (over MSIE Kit, and over U.S. Pat. No. 6,832,355, to Duperrouzel) are also presented in IPR2013-00295. Thus, each claim alleged as anticipated in the Petition, except for dependent claims 4, 9, 10, 17, and 18 has also simultaneously been alleged invalid as anticipated on one or two further separate and distinct

grounds in IPR2013-00295.

A further two references used in the Petition in support of obviousness only (U.S. Pat. No. 5,848,356 to Jambhekar, and MSIE Kit) are also used to support grounds of obviousness in IPR2013-00295.

In sum, all of the references relied on provide co-extensive disclosure. Petitioner has made no attempt to distinguish between them in their respective quality of teachings. The references are not identical and Petitioner should state why one reference better satisfies a particular claim limitation than another.

7. Conclusion

For at least the foregoing reasons, the Board should not institute *Inter Partes* Review of the '403 Patent on the grounds proposed by Petitioner.

Respectfully submitted by:

/Richard G. A. Bone/

Dated: August 26, 2013

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

It is hereby certified that on this 26 day of August, 2013, a copy of the foregoing

PATENT OWNER PRELIMINARY RESPONSE

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