

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

Declaration of Klaus Lagermann

DECLARATION OF KLAUS LAGERMANN

I, Klaus Lagermann declare and state as follows:

1. I am one of the inventors of the inventions described and claimed in U.S. Patent No. 6,724,403 ("the '403 patent") which is currently the subject of the above captioned *Inter Partes* Review.

2. I am currently providing services to SurfCast, Inc. in connection with this *Inter Partes* Review.

3. I re-affirm my duty of candor and good faith in dealing with the United States Patent and Trademark Office ("USPTO"), including the duty to disclose to the USPTO all information known to be material to the patentability of the invention, as defined in 37 C.F.R. § 1.56.

4. I have read and I am familiar with the '403 patent, and the Decision by the Patent Trial and Appeal Board instituting *inter partes* review, dated November 19, 2013.

5. I understand that grounds for the *inter partes* review included anticipation of claims 1-13, 17-28, 30-33, 35-37, 39-43 and 46-50 by U.S. Patent No. 6,456,334 to Duhault ("Duhault II"), which was filed on June 29, 1999.

6. Because my coinventor, Ovid Santoro, and I conceived of the inventions recited in at least independent claims 1, 22, and 46, and also dependent claims 2, 3, 5-9, 12, 17-21, 23-28, 30, 32-33, 35-37, 39-41, 47, and 48 of the '403

patent (“the Inventions”) prior to June 29, 1999, and because we worked diligently to reduce the Inventions to practice, I am submitting this declaration to antedate U.S. Patent No. 6,456,334 to Duhault.

7. Since 1995, I was the CEO of a data broadcast technology company, called Cebra Technology situated in Copenhagen, Denmark. My primary responsibilities were to oversee the software and hardware development efforts as well as general management. In 1999 Cebra merged with CoCom, a Danish company, and was subsequently sold to Cisco, but they did not acquire our teletext products, and I continued on in 1999 with the teletext technology products, teletext receiver, application and teletext broadcast technology as Lagermann Invest operating as Cebra Teletext and Data Broadcast.

8. Prior to June 29, 1999, my coinventor emailed me about an idea for a new user interface. He told me he was frustrated he could not get everything he wanted from one view on one screen. At the time, a user had to open a variety of programs to view different kinds of information, such as a web browser for stock quotes, another web browser for news, a word processing program for documents, and a media player for music or video. Mr. Santoro sent me an email about the idea for a single screen to access all of the information he wanted in one place, and we exchanged a number of emails to develop the idea.

9. Exhibits 2024 – 2029 and 2036 are true and correct copies of the emails exchanged between myself and Ovid Santoro prior to June 29, 1999 and accurately reflect my thoughts and ideas from that time frame.

10. Prior to June 29, 1999, my coinventor and I developed an idea for a graphical user interface which would allow a user to have his entire online and offline experience managed in one and the same framework. We thought of it as a mosaic of all things important with visual feedback of the status and/or content of each component. These features are shown in Exhibits 2024 – 2029 and 2036.

11. As described in the emails at Exhibits 2024 – 2029 and 2036, each dynamic mosaic, or mini-screen, could display any kind of content, such as from websites or realtime streaming channels of content, and could be associated with any kind of source of information or datastream. At the time, the user typically had to “click” on each window to view updated information from the information source. But each mosaic, or mini-screen, on our new user interface would be updated without the user having to intervene. The user could therefore see simultaneously, in one screen, updated information from all the information sources he wanted, regardless of the type of information source. One embodiment of our user interface included storing the user’s “screen” on a

server such that the user could get their chosen information faster and from anywhere. These features are shown in Exhibits 2024 – 2029 and 2036.

12. Prior to June 29, 1999, I met with my coinventor in London to discuss how we were going to implement our idea for a new user interface. Mr. Dixon Chan Dick joined us because he was experienced with server and networking technology that we thought would be helpful to implement our idea. During this brainstorming session, we wrote on a series of whiteboard “flip charts” to document our ideas for implementing the new user interface. Photographs of these flip charts, taken during our meeting, are reproduced at Exhibit 2041.

13. As shown in Exhibit 2041, prior to June 29, 1999, my coinventor and I had in mind a graphical user interface with elements called tiles. These are what we had called the “mosaics” or “mini-screens” in our earlier emails. The tiles were arranged in grids. Grids would have certain properties and methods to manage the tiles. A grid was a rows-columns grid of cells, where each tile would occupy one or more cells. This would allow not only overview grids, where each cell was occupied by one tile giving total overview of all information sources in use, but also work grids, where e.g. a tile occupied several cells in order to provide a work area, for example for editing a document. Each tile in itself would

have its own properties and methods, depending on the tile type. These features are shown in Exhibits 2023 and 2041.

14. According to the invention we had in mind prior to June 29, 1999, each tile was capable of being animated to refresh its displayed content such that the displayed information was “active” or “alive”. A tile would have a refresh rate for updates, ranging from hours or days (e.g. meteorological data) to seconds or minutes (news or stockmarket information). These features are shown in Exhibit 2041.

15. Each tile in the user interface was also selectable such that in its unselected state, the tile would provide refreshed contents according to its properties, and in its selected state the tile would provide access to the underlying data or information source. One embodiment of our invention included a server which would provide functions for users such as secure storing of grids and tile settings and caching or prefetching of information. This enabled the user to access his grids even away from his primary work computer. These features are shown in Exhibit 2041.

16. Prior to June 29, 1999, my coinventor and I collaborated to build a company and a product based on our tile user interface idea. The company and the product were called “SurfCast.” On several occasions prior to June 29, 1999, my coinventor and I collaborated to draft and revise written summaries of our

work on the SurfCast software product to implement our invention. Certain of these summaries that are relevant to the claims of the '403 patent are at Exhibits 2037 and 2038. These written summaries are dated prior to June 29, 1999. Features of the invention of the '403 patent to be implemented in the SurfCast software included a dynamic graphical user interface comprising a PC screen divided into a grid of tiles that covered the entire screen. Each of the tiles had configurable properties, which could be configured by the user, including a refresh rate and various “clickable” properties, and also the size of the grid. The grid of tiles had some features in common with wallpaper, except the tiles resided on top of the typical windows based operating system, replacing the desktop. The tiles had some attributes similar to a desktop shortcut or bookmark, but tiles are different because they are animated to display refreshed information. The SurfCast tile user interface could service multiple different types of content and networks, including files, applications, web sites, TV channels, and broadband channels. The SurfCast software was envisioned to be device independent, although it was initially designed to run on a PC. These features are shown in Exhibit 2037.

17. On several occasions prior to June 29, 1999, I consulted with attorneys at Pennie and Edmonds in preparation for filing a patent application on the tile user interface invention. I also consulted on several occasions with

attorneys at Pennie and Edmonds between June 29, 1999 and the filing on October 29, 1999 of the provisional application to which the '403 patent claims priority.

18. Based on my own first-hand knowledge, the present invention was diligently reduced to practice from at least the period starting June 29, 1999 until October 29, 1999, the filing date of the provisional application to which the '403 patent claims the benefit. I am informed that filing the provisional application constituted a constructive reduction to practice of the invention. During that time period, in addition to my work and that of my coinventor, the provisional application was being prepared by outside counsel, reviewed by the inventors, and approved by the inventors for filing, as described in greater detail below.

19. My work in the time frame June 29, 1999 to October 29, 1999 with regard to SurfCast generally encompassed two responsibilities. My coinventor and I divided the duties in developing the SurfCast business and product based on our user interface inventions such that I was primarily responsible for developing the technology. Also, my coinventor and I worked together with attorneys at Pennie & Edmonds to obtain a patent for our inventions.

20. On or about July 7 and July 8, 1999, I collaborated with my coinventor to draft product description, product development schedule, and planning and development process documents for the SurfCast product that we

intended to implement features of our tile user interface invention. Exhibit 2043 is a true and correct copy of the product description document, which included metadata information regarding a creation date of July 7, 1999. Exhibit 2044 is a true and correct copy of a draft product development schedule, which included metadata information regarding a creation date of July 7, 1999. Exhibit 2047 is a true and correct copy of the overview document, which included metadata information regarding a creation date of July 8, 1999.

21. On or about July 11, 1999 I drafted a description of an implementation of our tile user interface invention. Exhibit 2030 is a true and correct copy of an email I sent to my coinventor on July 11, 1999 informing him that I was finishing my drafting of the drawings and grid/tile examples of this implementation.

22. During the period July 11 through July 19, 1999, my coinventor and I revised a document describing of the SurfCast product that we intended to implement an embodiment of our tile user interface invention, which included revisions to the product description, product schedule, and planning documents created on or about July 7 and July 8, discussed above. Exhibit 2046 is a true and correct copy of this document, which I understand has metadata identifying the date last modified as July 15, 1999.]

23. On or about August 4, 1999 I received a draft description of our tile user interface for the patent application in a fax from Richard Bone. On August 10, 1999 I communicated in return with Richard Bone that I had received the fax, and from then until August 19th I reviewed the patent documents from Mr. Bone and drafted comments and notes. Exhibit 2018 is a true and correct copy of the email chain, dated August 10, 1999, showing the email I received from Richard Bone and my responsive email. I understand this document has been redacted to remove attorney-client privileged communications.

24. On August 9 and August 10 and August 11, 1999, I exchanged emails with my coinventor Ovid Santoro regarding obtaining a patent on our tile user interface inventions. Attached as Exhibit 2012 is a true and correct copy of these emails. I understand this document has been redacted to remove attorney-client privileged communications.

25. On or about August 11, 1999 I drafted a description of our tile user interface technology at the request of my coinventor to write a layman's description of our technology. I sent this description in an email to my coinventor on August 11, 1999. Exhibit 2042 is a true and correct copy of this email including the description.

26. On August 19, 1999 I revised a description of our tile user interface invention and sent it to Richard Bone at Pennie & Edmonds for preparation of our patent application. Exhibit 2020 is a true and correct copy of an email, dated August 19, 1999, I sent to Richard Bone with my notes and comments on the in an attachment. Exhibit 2021 is the attachment to the email I sent to Richard Bone on August 19, 1999. Exhibit 2019 is a true and correct copy of an email I sent to my coinventor, Ovid Santoro, on August 19, 1999 informing him that I had sent comments for the patent application to Richard Bone. I understand these documents have been redacted to remove attorney-client privileged communications.

27. On or about August 24, 1999, I spent several days reviewing the documentation for the patent application on our tile user interface invention, and sent an email to Richard Bone regarding the status of this review on August 24, 1999. Exhibit 2022 is a true and correct copy of the email I sent to Richard Bone on August 24, 1999. I understand this document has been redacted to remove attorney-client privileged communications.

28. On or about August 25, 1999, I reviewed a description of the SurfCast product that my coinventor and I were developing to implement an embodiment of our tile user interface invention, drafted by my coinventor Ovid

Santoro. Exhibit 2031 is a true and correct copy of the email including this description as sent by Mr. Santoro and my response.

29. In September 1999, my coinventor and I drafted and revised a description of the SurfCast product that was going to include an implementation of our user interface invention. Exhibit 2040 is a true and correct copy of a version of this document that references financing would be completed through September 1999. Exhibit 2039, dated Sept. 1999, is a true and correct copy of a later, revised version of this document..

30. On or about October 17, 1999 I drafted a description of our tile user interface invention for preparation of the patent application which was a further revision of earlier descriptions. Exhibit 2048 is a true and correct copy of this description, which included metadata information regarding a creation date of October 17, 1999.

31. Based on information and belief, and my own knowledge after reviewing all of the available evidence, all of the above actions took place in either the Denmark, United Kingdom or the United States.

32. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 23 JAN 2014

By: 

Klaus Lagermann