

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 TOM DECHAENE

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I, Tom Dechaene declare and state as follows:

1. I am currently a Director of SurfCast, Inc. and am providing services in connection with this *Inter Partes* Review.

2. I 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.

3. 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.

4. 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.

5. I understand that the inventors assert they conceived 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 they worked diligently to reduce the Inventions to practice from June 29, 1999 to October 29, 1999, I am submitting this declaration to antedate U.S. Patent No. 6,456,334 to Duhault.

6. Prior to June 29, 1999, I joined Ovid Santoro and Klaus Lagermann to help them form SurfCast as a company to commercialize the Inventions. I acted as a Founder and the CFO. My work in the time frame of June 29, 1999 to October 29, 1999, with regard to SurfCast was, in addition to my work for Deutsche Bank, to act as CFO and in-house counsel of SurfCast. I followed progress of the preparation of the application closely because I believed it was a pre-condition to raising financing for SurfCast.

7. The inventions of the '403 patent were 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 the work of the inventors, the provisional application was being prepared by outside counsel, reviewed by the inventors, and approved by the inventors for filing.

8. On August 3, 1999, I met with Paul DeStefano of Pennie & Edmonds, and we discussed the status of work on the patent application. Exhibit 2011 is a true and correct copy of an email I sent to Ovid Santoro the day I met with Paul DeStefano, informing Ovid of our meeting and discussion regarding the patent application.

9. 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 United Kingdom or the United States.

10. 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 Dec 2014

By


Tom Dechaene