Filed on behalf of SurfCast, Inc.
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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[1]
Patent 6,724,403

SURFCAST, INC.'S DECLARATION OF RICHARD G. A. BONE UNDER 35 USC §§ 316(a)(8)

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[1] Cases IPR2013-00293, IPR2013-00294, and IPR2013-00295 have been consolidated with the instant proceeding.

DECLARATION OF RICHARD G. A. BONE

I, Richard George Andrew Bone, declare and state as follows:

1. I am a citizen of both the United States and the United Kingdom, and I am more than twenty-one years of age.

2. I am currently an attorney of good standing, and licensed to practice in California, the District of Columbia, and am registered to practice before the USPTO.

3. I re-affirm my duty of candor and good faith in dealing with the USPTO, including the duty to disclose to the USPTO all information known to be material to the patentability of the invention(s) described and claimed in the '403 patent, as defined in 37 C.F.R. § 1.56.

4. From June 16, 1999, until the firm's dissolution on December 31, 2003, I was employed by the law firm of Pennie & Edmonds LLP (the "Pennie firm").

5. SurfCast, Inc. ("SurfCast"), the owner of U.S. Patent No. 6,724,403 ("the '403 patent") was a client of the Pennie firm during the time that I was employed there.

6. I drafted in large part the application that issued as the '403 patent, which is the subject of the above captioned *Inter Partes* Review, and U.S. Provisional Patent Application No. 60/162,522 ("the '522 provisional

application"), to which the '403 patent claims priority. The drafting was carried out with oversight from one or more other registered practitioners also employed by the Pennie firm. The patent application that I drafted for SurfCast in 1999 is referred to herein, at times, as "the SurfCast application".

7. I prosecuted the application that issued as the '403 patent before the United States Patent and Trademark Office ("USPTO"), at times under guidance from one or more registered practitioners.

8. I have read and I am familiar with the '403 patent, and the Decision by the Patent Trial and Appeal Board to institute *inter partes* review of claims 1 – 52 of the '403 patent, dated November 19, 2013 (Paper No. 20).

9. I understand that grounds for the *inter partes* review include alleged 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 has a filing date of June 29, 1999.

10. Exhibit 2035 shows true and correct copies of my bound time entry log-book in which I recorded daily handwritten entries of my time spent on the various client matters to which I was assigned at the Pennie firm during 1999.[2] It

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[2] A small number of entries are typed; these typically arose when I was away from the Palo Alto office and did not have the time entry book in my possession. I

was within my habit not to record time for a matter if it only occupied a few minutes of my time on a given day. For example, a simple response to an e-mail from a client or colleague may not have generated its own unique time entry if no other work was carried out on that project on the same day. The copies have been redacted to obscure the identity of other specific client matters that I worked on contemporaneously with my work on the SurfCast application. A secretarial assistant transcribed the entries into the Pennie firm's electronic time entry system (a dedicated software program known as DTE) on a weekly basis. I would review the entries in the software system and conform the narratives to the Pennie firm's guidelines, if necessary, and check the veracity of the entries before releasing them to the firm's billing system.

11. The time entry log-book was in my possession and control during the time that I was employed at the Pennie firm, and continued to be in my possession after the dissolution of the Pennie firm up until my involvement with a concurrent litigation (U.S. District Court for the District of Maine, Docket No. No. 2:12-cv-00333) when the book has been for periods of time in the offices of my own

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recall that, in those circumstances, I would record my time entries in an e-mail message that I would send to my secretarial assistant with an instruction to print them out and insert them into the book.

counsel, at Turner Boyd LLP, in Mountain View, CA. I can produce the book as a material exhibit, if requested to do so.

12. Based on my own first-hand knowledge, the invention described and claimed in the '403 patent was diligently reduced to practice from at least the period starting prior to June 29, 1999 and up until October 29, 1999, the filing date of the '522 provisional application. During that time period, I was working on preparation of the specification, claims, and drawings that constituted the '522 provisional application, a process that involved working with other registered practitioners and attorneys at the Pennie firm, including Mr. Andrew J. Gray IV, Dr. Brett A. Lovejoy, Mr. Paul R. DeStefano, and Mr. William S. Galliani, and with the inventors of the '403 patent, Mr. Ovid Santoro and Mr. Klaus Lagermann, as well as Mr. Tom Dechaene of SurfCast, as described in greater detail below.

13. From June 16, 1999 and throughout the relevant period, I was employed by the Pennie firm as a Law Clerk. My position involved working on preparation of U.S. patent applications (including both provisional and utility applications), preparation of documents in connection with prosecution of patent applications before the USPTO, preparation of correspondence with foreign counsel in connection with patent applications pending before foreign patent offices, preparing materials in connection with opinions of patentability, invalidity, non-infringement, and freedom to practice, searching and reviewing patent and

non-patent literature, preparing and transmitting letters to clients of the Pennie firm in connection with reporting matters associated with patent applications. All of these activities were carried out in conjunction and collaboration with other attorneys and law clerks at the Pennie firm.

14. The nature of the practice in the field of patent procurement and counselling is that a docket of cases assigned to a particular attorney or law clerk includes a number of due-dates by which work must be completed and/or by which documents must be filed at, for example, the USPTO or be communicated to a foreign counsel for filing at a foreign patent office. Other due-dates may also arise because a client demands completion of a project, such as an opinion or advisory project, in light of, for example, an upcoming product release. As a practical matter, therefore, work on a given project can often be interrupted by another project that has, for example, a sooner-arising and non-extendible or promised deadline that must be met.

15. Because my technical background is inter-disciplinary (involving a mix of scientific research in chemistry and life sciences, with experience in software development in academia and industry), I was called upon in the initial weeks and months of my tenure at the Pennie firm to work on a great variety of projects. Because, also, I was newly hired to the Pennie firm as of June 1999, there was an expectation that I would quickly fill my docket with cases, and, being

a self-starter, I obtained work from a number of different sources in those initial weeks at the Pennie firm. In some instances the work became available because an attorney announced his or her departure from the firm and it became necessary to transition into an entire portfolio. Since much of the work that I inherited was involved with active, ongoing portfolios of patent applications, many of the due-dates were imminent and outside of my control. Thus, when starting the process of populating my docket with a full load of work, it was not necessarily possible to take on work strictly chronologically in the sense of managing an initial influx of work according to the most immediate due-dates. In some instances, for example, where taking on a portfolio rather than a single project, it was necessary to address due-dates arising in the short and near term ahead of other work on my docket even if I had begun work on other projects at an earlier date.

16. Attached as Exhibit 2052 is a day-by-day timeline that itemizes some of the activities undertaken by myself and others at the Pennie firm toward preparing and filing the SurfCast application between June 16, 1999 and October 29, 1999. The entries listed in the timeline in the last (rightmost) column, labeled "Description" that describe work that I did are based on my contemporaneous time entry log entries (see Exhibit 2035), and/or e-mail sent to or from me, which I carefully reviewed to refresh my recollection of those events.

17. Entries in my time entry book for a given day take the form of a

period of time spent on a task (in hours or fractions of an hour), a brief narrative, and an annotation for the client matter in question, either by client name or by docket number. The narrative, and time allotted to the task, would normally appear on an invoice for services rendered that would be transmitted to a client each month, based on the prior month's entries. It is my understanding that, in some instances, an entry from my time entry book might not show up on an invoice if, for example, the time had been considered to be for training and therefore not billable to the client by the attorney reviewing the bill. Entries in my time entry book can therefore typically be corroborated with line items on inoivces for services that were sent to SurfCast during the relevant period of time. (*See, e.g.*, Exhibit 2010.)

18. Entries in my time entry book for SurfCast are normally designated either by client name ("Surfcast") or by docket number, next to a narrative.[3]

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[3] Up until late August, 1999, the handwritten entries are very brief because my docket had not become very densely populated, and it was easier to write a client name instead of identifying a specific project number, and to omit describing the nature of the work in more detail where a simple keyword would, at the time, suffice. Some of the earliest entries in the time entry book simply refer to a "software" matter, where I knew from that time that the SurfCast matter was

Docket numbers for SurfCast projects lead with 9982 (sometimes written as "09982"; the Pennie firm's unique client number for SurfCast). Preparation of the patent application was designated by docket number "9982-0009-999" or "9982-009-999". Later in the time period in question, when it was decided to file the patent application as a provisional, rather than a utility, the docket number "9982-0009-888" was used for the relevant narratives. The entries designated as "9982-0005-999" pertain to a separate matter number established for a patentability assessment and prior art search carried out for the invention described in the patent application. Time entries designated as "9982-0002-999" relate to a general billable matter for SurfCast. This number may have been used for non-patent-related activities such as reviewing corporate documents.

19. As evidenced by my time entry logs (Exhibit 2035), I worked diligently to constructively reduce the SurfCast invention to practice (i.e., by preparing the '522 provisional application) from June 18, 1999 (i.e., from before the filing date of Duhault II) to October 29, 1999 (i.e., the date on which the '522 provisional application was filed with the USPTO). This work included: several meetings with the inventors, and attorneys, at offices of the Pennie firm in New

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intended because it was, for a time, the only software patent application that I was involved with.

York, NY, and in Palo Alto, CA; research on the relevant technology and prior art; ongoing discussions and review with practitioners at the Pennie firm in Palo Alto, CA; and several rounds of preparing and revising the draft specification and figures for the ’522 provisional application.

20. It is also apparent from my time entry logs (Exhibit 2035) that I was engaged in working for other clients of the Pennie firm during the same period that I was working on the SurfCast application. The pages from my time entry log book (Exhibit 2035) show other narratives for most days on which I worked on the ’522 provisional application. (The client-specific information from these entries has been redacted to protect their confidential information). Nevertheless, I worked diligently on the preparation of the ’522 provisional application despite it being necessary to interleave work for other firm clients having intervening deadlines, and to prioritize tasks involving other complex subject matter and work during this same time period. On occasion, the complexity of the other work required me to devote periods of several consecutive days to that other work, after having reached a particular stage of the ’522 patent application and having left it with either a practitioner at the Pennie firm or with SurfCast, for review, during which time I was waiting for feedback. However, as is evidenced from the fact that there are very few periods of time when I did not actually work on the SurfCast application, the project was always in my mind as an active concern.

21. I started work at the Palo Alto office of the Pennie firm on June 16, 1999, one day after having arrived in California from the United Kingdom. For the remainder of June, and into July, 1999, some of my time was devoted to training and getting situated.

22. June 18 – 28, 1999: My initial meeting to discuss the SurfCast application took place on June 18, 1999 (a Friday)[4], i.e., prior to the effective date of Duhault II (Ex. 2035 at 4). I continued working on the SurfCast application from June 21, 1999 (Ex. 2035 at 7). The time entry book shows that I worked on the initial phase of the SurfCast patent application on each day in the period June 21 – June 28, 1999 except for Saturday June 26, but including a 3-hour period on Sunday, June 27 (Ex. 2035 at 12). The activities over this period of time mainly involved discussing the invention with Dr. Brett Lovejoy, and with Andrew Gray IV, Esq., carrying out searches for possible prior art, and writing initial drafts of the background, figures, and description of figures for the SurfCast application. See e.g., Ex. 2035, at 7 – 13; and Ex. 2052.

23. From June 29 – July 1, 1999, I worked principally on projects for two clients other than SurfCast: a patent invalidity opinion project for an Asian electronics company ("the Invalidity Opinion"), and familiarizing myself with a

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[4] The relevant entry on this page of Exhibit 2035 has been redacted.

portfolio of patent applications in the field of protein binding site determination for a California-based start-up company ("the Hydrogen Exchange Portfolio"). (Ex. 2035 at 14 – 16.)

24. On July 2, 1999, I worked again on the SurfCast application and spent further time rewriting portions of the background and description. (Ex. 2035 at 17.)

25. After the July 4 – 5th holiday, from July 6 – 8th, 1999, I worked mainly on the Invalidity Opinion. (Ex. 2035 at 21 – 23.)

26. July 9 – August 4, 1999: I spent some time working on the SurfCast application on each non-weekend day in this period. (Ex. 2035 at 24 – 48.) The work entailed: retrieving and reviewing relevant patents and other literature from the background art (July 9, 12, 13, 14, 15, 16, 19, 20, 22, 23, 27, 28, and August 3 and 4, 1999); drafting portions of the SurfCast application, including summary and objects of the invention, and claims, (July 13, 14, and 20, 1999); discussing the technology with colleagues at the Pennie firm, Messrs Gray, Lovejoy, and Galliani, (July 14, 20, 21, 26, 28, 29, and August 2, 1999); and meeting with SurfCast personnel and preparing for same (July 20, 21, 28, 29, and 30, 1999). Included in this time period in particular are: meetings with Mr. Santoro and Mr. Gray at the Palo Alto office of the Pennie firm on July 20 – 21, 1999 (Ex. 2035 at 35 – 36.), including a dinner meeting at Higashi West in Palo Alto; and a visit to the New

York City office of the Pennie firm to meet with Messrs Santoro, Lagermann, and Tom Dechaene of SurfCast, and with attorneys Andrew Gray and Paul DeStefano of the Pennie firm, to discuss the technology and formation of the company, on July 28 – 29, 1999. (Ex. 2035 at 41 – 42.) The period discussed in this paragraph culminated, on August 4, 1999, by sending to inventor Klaus Lagermann by facsimile a copy of an initial draft of figures for the patent application for his review. (Ex. 2035 at 47.)

27. During the period July 9 – August 4, 1999, I also engaged in further training and tutorials (in the use of legal industry software, legal research tools, and in patent drafting, etc.), and continued work on the Invalidity Opinion (Ex. 2035 at 31, 34, and 47) as well as various matters in connection with the Hydrogen Exchange Portfolio. (Ex. 2035 at 38, 39, and 40.) I also took on responsibility for a further patent portfolio for peptide-based antibiotic formulations ("the Anti-microbials Portfolio"), and devoted some time to matters that had active due-dates in that portfolio. (*e.g.*, Ex. 2035 at 38.) I additionally began assisting with the drafting of a utility patent application for a complex invention in computer simulated prediction of protein structure, for a European research laboratory ("the Macromolecular Design Application"); this application had a bar-date of August 31, 1999, and I worked with law clerks in the Palo Alto and New York offices of the Pennie firm, and one attorney in the New York office to complete the

application. (Ex. 2035 at 46 – 47.)

28. From August 5 – 10, 1999, I worked principally on the Macromolecular Design Application, and the Invalidity Opinion, and also familiarized myself with aspects of the Hydrogen Exchange Portfolio. (Ex. 2035 at 49 – 54.)

29. From August 11 – 19, 1999, I continued to work on the SurfCast application. As evidenced by my time entry logs, I devoted time to the SurfCast application on each non-weekend day in this period. (Ex. 2035 at 55 – 62.) My activities involved continuing to work on claim drafting (August 11, 12, 13, 16, 17, and 18, of 1999), and further communications with SurfCast inventors, Messrs Santoro and Lagermann (August 12, 16, and 19, 1999).

30. In the period August 11 – 31, 1999, I was also involved with other matters. In particular, on August 11, 1999, I started law school part-time, at Santa Clara University School of Law (Ex. 2035 at 55.), a program that required me to attend classes on campus from 6 – 9pm on 4 nights per week. I devoted further time over this period to: working on the Macromolecular Design Application, culminating with its filing on August 31, 1999 (Ex. 2035 at 75) as U.S. patent application no. 09/347,741; the Invalidity Opinion (*e.g.*, Ex. 2035 at 67 – 69); the Hydrogen Exchange Portfolio (*e.g.*, Ex. 2035 at 67 and 71); and some initial matters that required immediate attention in the Anti-microbials Portfolio (*e.g.*, Ex.

2035 at 70, 71, 74, and 75).

31. On August 24, 1999, I had a meeting with Andrew Gray to discuss the timing of completing a first draft of the SurfCast application. (Ex. 2035 at 68)

32. From September 1 – 3, 1999, I worked each day on drafting portions of the SurfCast application. (*e.g.*, Ex. 2035 at 76 – 78) This work included revising the background section that I had previously drafted, and writing portions of the detailed description of the invention, as well as reviewing materials in connection with the same. I conferred with patent attorney Andrew Gray on the draft.

33. From September 5 – 10, 1999, I worked principally on a utility patent application from within the Hydrogen Exchange Portfolio, in order to file that application by a statutory bar-date. (Ex. 2035 at 80 – 85) The application was filed on September 10, 1999, having serial no. 09/393,775, and claimed benefit of priority to a provisional application filed one year earlier, on September 10, 1998. This work could not be postponed any later than this period of time due to the statutory bar on claiming benefit of priority to a provisional application.

34. From September 12 – 14, 1999, I continued to work on the SurfCast application. (Ex. 2035 at 87 – 89) In particular, I carried out further background reading (about XML) and discussed the same, and a patent reference, with Mr. Gray.

35. From September 15 – 21, 1999, I worked principally on preparing a first draft of the Invalidity Opinion (*e.g.*, Ex. 2035 at 90 – 96), as well as attended to a number of outstanding matters in the Anti-microbial Portfolio, and attended a client meeting with the inventor and management of the Hydrogen Exchange Portfolio. (Ex. 2035 at 91.)

36. During the periods September 22 – 23, 26 – 27, and 29 – 30, 1999, I carried out further revisions to the specification of the SurfCast application and presented the application to Mr. Gray for review. (Ex. 2035 at 97 – 105.) I further discussed the application with Mr. Gray and reviewed his proposed edits. During this period of back-and-forth with Mr. Gray I would return to other client projects while waiting for feedback from Mr. Gray.

37. Also, during the period September 22nd – 30th, 1999, I carried out further work on the Invalidity Opinion and attended to a number of outstanding matters in the Anti-microbial Portfolio. (Ex. 2035 at 97 – 105.)

38. Beginning after the weekend of October 2nd – 3rd, 1999, I worked on the final stages of the SurfCast application, in the period October 4th – 29th, 1999: (Ex. 2035 at 109 – 135.) During this period, I sought further feedback on the patent application both from practitioner reviewers at the Pennie firm and personnel in the SurfCast management and technical team. This month saw a number of refinements made to the SurfCast application, leading up to its filing at

the USPTO as the '522 provisional application on October 29, 1999. (Ex. 2035 at 135.) Also during this month, my work on the SurfCast application interleaved with work on other client projects that had contemporaneous deadlines. For example, I worked on the Invalidity Opinion up to its finalization on October 18, 1999. (Ex. 2035 at 124.) Details of my work on the SurfCast application during the period October 4th – 29th, 1999 are outlined in the following paragraphs.

39. During the week beginning October 4th, 1999, I met with Messrs Gray and Lovejoy to receive feedback on the draft patent application. (Ex. 2035 at 109.) I also met in person with Mr. Ovid Santoro and Ms. Isabelle Schoepflin of SurfCast, and Dr. Lovejoy, at the Palo Alto office of the Pennie firm, with Mr. Klaus Lagermann participating by speakerphone, to discuss the patent application and the development of the SurfCast technology. (Ex. 2035 at 111.) I carried out further revisions to the SurfCast application during that week. (*e.g.*, Ex. 2035 at 111.) On Friday of that week, I flew to New York City to attend the Pennie firm's annual dinner, and had further discussions with Mr. Gray regarding the application. (Ex. 2035 at 113.)

40. On October 12 – 13th, 1999, I attended further teleconferences with Messrs Santoro and Lagermann, and with persons from the Pennie firm, to discuss the development of the SurfCast technology and the SurfCast application. (Ex. 2035 at 117 – 118.) On October 13th, 1999, I sent a facsimile to Mr. Santoro for

review in connection with the draft application. (Ex. 2035 at 118.)[5]

41. During the week beginning October 18th, 1999, I consulted with Dr. Lovejoy on technical aspects of some embodiments described in the SurfCast application (in connection with TCP/IP), and continued work on drafting the application. I also prepared for, and attended a meeting with Mr. Robert Carberry, an investor in SurfCast, along with Messrs Gray and Lovejoy. (Ex. 2035 at 124.)

42. During the week of October 24th – 29th, 1999, and beginning on October 24th (a Sunday), I worked to finalize the SurfCast application and placed it in final form for filing on October 29th, 1999. (Ex. 2035 at 129 – 134.) This work included final revisions to the specification, drawings, and claims. I also had discussions with Dr. Lovejoy and Mr. Galliani about final aspects of the application. On October 26th, 1999, I also met with Mr. Dechaene to discuss the logistics of the patent filing. (Ex. 2035 at 131.)

43. All of the above-described actions took place in the United States.

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[5] This entry has been obscured from Ex. 2035 by imperfect redaction.

44. 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 '403 patent.

By: Richard G.A. Bone

Richard G. A. Bone

Dated: January 24, 2014