

Microsoft Corporation

Petitioner

v.

SurfCast, Inc.

Patent Owner

IPR2013-00292

Patent No. 6,724,403

Patent Owner SurfCast, Inc. – Exhibit 2093  
Microsoft Corporation v. SurfCast, Inc.  
IPR2013-00292

# Board's Construction of "Tile"

On this record, we determine that the broadest reasonable interpretation for "tile" in the context of the specification of the '403 patent is *"a graphical user interface element whose content may be refreshed and that, when selected, provides access to an information source."*

*Paper No. 19 (Institution Decision) at 9*

Tiles are selectable and live. When a tile is selected, 25  
whether by mouse click or otherwise, the tile instantly  
provides the user with access to the underlying information,

*Ex. 1001 ( '403 Patent) at 9:25-27,  
Cited in Institution Decision at 9-10*

41. Microsoft's expert does not allege that he reviewed the '403 Patent to determine which of the alternative interpretations of "when selected" are actually supported by the '403 Patent. He cites to nothing in the '403 Patent to support interpretation (ii). The '403 Patent clearly supports interpretation (i). For example, the '403 Patent states that "When a tile is selected, whether by mouse click or otherwise, the tile instantly provides the user with access to the underlying information." (Ex. 1001 at 9:25-27.)

42. It is my opinion that interpretation (ii), i.e., allowing the mere display of information in a tile as providing access to the information source, would render the "when selected, provide access to an information source" portion of the Board's claim construction meaningless because access would be provided without the tile being selected.

# Board's Construction of "Partitioning/Dividing"

On this record, we determine that the broadest reasonable interpretation for “partitioning a visual display of the device into an array of tiles” in the context of the specification of the '403 patent is “*dividing a display or window into two or more tiles.*”

*Paper No. 19 (Institution Decision) at 13*

Does not preclude overlapping tiles.

*Paper No. 19 (Institution Decision) at 13*

# Patent Owner's Construction Of "Tile"

“a graphical user interface element whose content may be refreshed, that is persistent, and that, when selected, provides access to an information source assigned to the tile.”

*Paper No. 27 (Patent Owner's Response) at 3*

needs and interests. The present invention comprises a grid of tiles that resides on the user's computer desktop. The grid

*Ex. 1001 ( '403 Patent) at 4:37-38; cited in Paper 27 (PO Resp) at 9*

browser". Therefore the application resides over existing applications without replacing any of them; rather it enables them to be called from the grid itself. The application, 25 therefore, becomes a graphical file manager in which the content of continuously changing files, i.e., datastreams, is being displayed in real-time or near real-time, depending on the assigned priority. Effectively, the application replaces the user's desktop with a more visually intuitive dynamic menu- 30 ing system.

*Ex. 1001 ( '403 Patent) at 11:23-31, cited in Paper 27 (PO Resp) at 9*

definition. There is ample support in the patent specification for concluding that tiles are persistent, i.e., across computing sessions.

*Ex. 2004 (Weadock Decl.) ¶ 45, cited in id. ¶ 49, cited in Paper 27 (PO Resp) at 11*

- Tiles permit “dynamic bookmarking” (Ex. 1001 ( ’403 Patent) at 8:30-34, 11:50-52)
- Tiles are “resident on the file system” (*Id.* at 9:58-66)
- Grid and Tiles comprise a “dynamic menuing system” (*Id.* at 11:29-31)
- “Items in the metabase are ‘persistent’, that is they are ... preserved from session to session” (*Id.* at 15:52-64)
- Content of tiles “for the previous session” stored in “content store” (*Id.* at 17:30-31)
- “[d]etails of a session, as defined by tile content and priorities can be held over from one session to another...” (*Id.* at 22:22-34)
- User’s current grid and tiles can be stored and queried by any device. (*Id.* at 23:63-24:2)
- Grid is a repository of passwords (*Id.* at 11:46-48)

*Ex. 2004 (Weadock Decl.) at ¶ 48, cited in Paper 27 (PO Resp) at 7*



persistence goes without saying. One of ordinary skill in the art would not design a graphical user interface in which a computer user would have to re-create each tile, tile configuration, position on the grid, associated information source, etc., at every reboot. The invention of Figure 1 of the '403 patent would have been completely impractical if it needed to be rebuilt from scratch at every restart or every time the operating system crashes.

*Ex. 2004 (Weadock Decl.) ¶ 46, cited in Paper 27 (PO Resp) at 7*

50. In my opinion, one of ordinary skill in the art at the time of filing of the patent application could not read the '403 patent and conclude that a window could be a tile, in any circumstance.

*Ex. 2004 (Weadock Decl.) ¶ 50, cited in id. at ¶ 57, cited in Paper 27 (PO Resp) at 5*

53. A way of thinking about one difference between a tile and a window is that a tile, is an *entry point* to an application for working with an underlying information source. It has a refreshable preview facility, but it is not, itself, a full-fledged application.

*Ex. 2004 (Weadock Decl.) ¶ 53, cited in Paper 27 (PO Resp) at 5*

# Patent Owner's Construction Of “Partitioning/Dividing”

Patent Owner has argued for the construction of “partitioning” a [visual] “display into an array of tiles” to mean “dividing some or all of a display into a non-overlapping array of tiles”. The Board agrees that the dividing may apply to

*Paper No. 27 (Patent Owner's Response) at 12*

45 windows such as title bar, menu bar and scroll bars. Therefore 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. Tiles are superior to icons because they

*Ex. 1001 at 8:46-49, cited in Paper 19 (Institution Decision) at 13*

**par·ti·tion** (pär-tīsh'ən) *n.* **1. a.** The act or process of dividing something into parts. **b.** The state of being so divided. **2. a.** Something that divides or separates, as a wall dividing one room or cubicle from another. **b.** A wall, septum, or other separating membrane in an organism. **3.** A part or section into which something has been divided. **4.** Division of a country into separate, autonomous nations. **5. Mathematics. a.** An expression of a

*Ex. 2001 (American Heritage Dictionary) at 1320, cited in Paper 27 (PO Resp) at 14-15*

10           Q.    So getting back to my question about  
11   dividing a room, if I say I'm going to divide  
12   the room into two rooms, doesn't that mean to  
13   you colloquially that the rooms are not  
14   overlapping?  
15           A.    Yes --

*Ex. 1084 (Karger Tr.) at 80:10-15, cited in Paper 27 (PO Resp) at 15*

65. I have been unable identify a single example, in the field of Information Technology or outside of it, in which “partitioning” leaves open the possibility of overlap of the partitioned segments. Therefore, in my opinion, even if one could identify isolated instances where “portioning” was used in a sense that could include overlapping, the meaning of “partitioning” excludes the possibility of overlap to a person of ordinary skill in the art, and no explicit disclaimer of overlap is necessary.

*Ex. 2004 (Weadock Decl.) ¶ 65, cited in Paper 27 (PO Resp) at 15*

Chen

759. If it is found that a tile must be “selectable to provide access to underlying information of the associated information source” as I understand Patent Owner has asserted, Chen shows that instruments may be selected. *See, e.g., Ex. 1015, Chen at FIG. 11 and 14:67-15:2.*

*Ex. 1003 (Karger Decl.) ¶ 759, cited in 292 Pet. at 29*

98. Moreover, I note that Chen also satisfies the “selectable to provide access to underlying information” language and also the “when selected, provides access to an information source” language in the disclosure found at column 88:13-46. That passage describes how a selected instrument in Chen may be put into a “marking mode” which permits the user to add marks to the data stream received from the information source assigned to that instrument. The process requires a

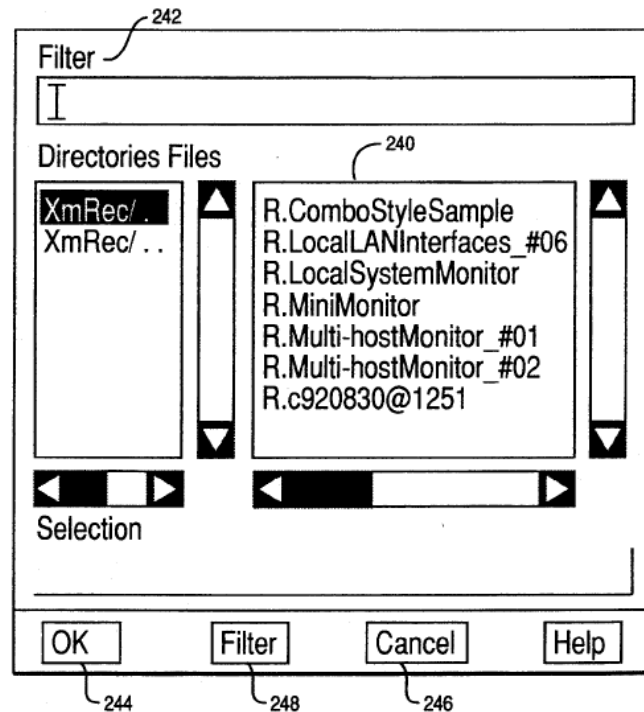
*Ex. 1110 (Karger Reply Decl.) ¶ 98, cited in Paper 45 (Pet. Reply) at 12*



		SOME INSTRUMENTS ARE RECORDING				
		ALL INSTRS ARE RECORD- ING	SELECT'D INSTR IS RECORD- ING	SELECT'D INSTR NOT RECORD- ING	NO INSTR IS SELECTED	NO INSTR IS RECORD- ING
CONSOLE MENU	SAVE BUFFER	-	-	-	-	+
CONSOLE MENU	BEGIN RECORDING	-	+	+	+	+
CONSOLE MENU	SAVE & BEGIN REC	-	-	-	-	+
CONSOLE MENU	END RECORDING	+	+	+	+	-
INSTRUMENT MENU	SAVE BUFFER	-	-	-	N/A	+
INSTRUMENT MENU	BEGIN RECORDING	-	-	+	N/A	+
INSTRUMENT MENU	SAVE & BEGIN REC	-	-	-	N/A	+
INSTRUMENT MENU	END RECORDING	+	+	-	N/A	-

FIG. 11

*Ex. 1015 (Chen) Fig. 11, cited in Paper 27 (PO Resp) at 44-45*



*Ex. 1015 (Chen) Fig. 12b, cited in Paper 27 (PO Resp) at 45*

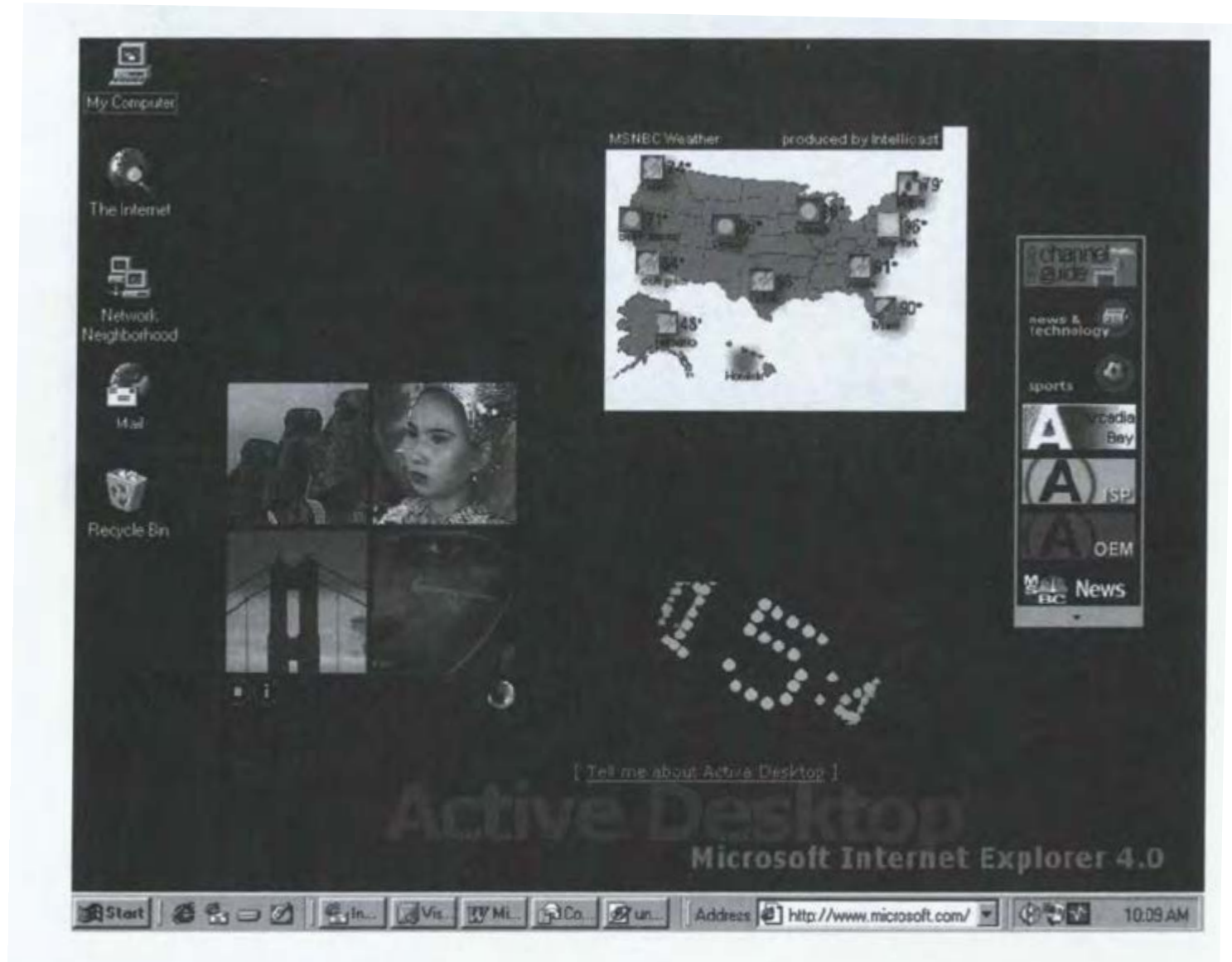
46. That passage describes how a selected instrument in Chen may be put into a “marking mode” which permits the user to add marks to the data stream received from the information source assigned to that instrument. The process requires a
- (1) user to begin recording an instrument in the normal way, which would comprise selecting that instrument. Ex. 1015, Chen at 88:16-18. The process then requires
- (2) the user to select a control called a “Marking On button.” *Id.* at 88:19-21.

- According to Chen, “[t]his puts the selected instruments in a marking mode, in
- (3) which mouse-clicks on the instrument are interpreted as requests to insert marker tokens.” *Id.* at 88:21-24. The ability to insert marker tokens is yet another form of access.

*Ex. 1110 (Karger Decl.) ¶ 98, cited in Paper 45 (Pet. Reply) at 12*

# MSIE Kit

# MSIE Kit



*Ex. 1007 (MSIE Kit) at xxx, cited in 295 Petition at 20*

# MSIE Kit

content. Desktop items are typically designed to provide summary information in a small amount of screen space. Therefore, information in desktop items often includes hyperlinks or hot spots, so users can click a designated area to open a browser window and obtain the details they want.

*Ex. 1007 (MSIE Kit) at 177, cited in Paper 27 (PO Resp) at 48*

- **Avoid using in-place navigation controls.** Active Desktop items are meant to be lightweight and therefore have no navigation controls available for the user to move backward and forward. By default, clicking a link inside an Active Desktop item creates a new browser window. The intended purpose of an

*Ex. 1007 (MSIE Kit) at 183, cited in Paper 27 (PO Resp) at 48*

# MSIE Kit

16 Q. Okay. So if a user were to create an -- or add an  
17 Active Desktop item to his desktop and have that --  
18 configure that Active Desktop item to display a nonspecially  
19 designed website and size the Active Desktop items so it  
20 covered most of the screen, he could do so; correct?

21 A. Yes.

22 Q. Okay. If a user were to do that, would the -- what  
23 would happen if the user were to click on that Active  
24 Desktop item?

25 A. It depends what is in the HTML they're clicking on.

1 JOSEPH BELFIORE

2 Q. Okay. If they were at a -- on a portion of a web  
3 page in which no links were present, would anything happen?

4 A. No.

*Ex. 2088 (Belfiore Tr.) at 172:16-173:4, cited in Paper 62 (PO Reply) at 4*

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<TD><A HREF="tile2 target.htm"
  TARGET="new"
  ONMOUSEOVER=action1(arg3)
  ONMOUSEOUT=action2(arg4)
  REFRESH=timeout(500)
  SOURCE=http://www.camelot.castle/swords/excalibur.til
  CLICKMAP=      { 0, 0,50,50, clickfunction1( clickargument1),
                    51, 0,50,50, clickfunction2( clickargument2),
                    0,51,50,10, clickfunction3( clickargument3) }
  TOOLBAR={ "local/toolbars/radio.tool" PLACEMENT="bottom" }
  ALARM="alarms/condition_rain=TRUE, condition_weekend=FALSE,
        alarmaction=blow_the_horn">

</TD>

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*Ex. 1001 ( '403 Patent) Fig. 6, cited in Paper 27 (PO Resp) at 4*

# MSIE Kit

122. Active Desktop items are also not the same as the “tiles” of the ’403 because Active Desktop items can overlap, not only with other Active Desktop items but also with traditional icons, which reside in a layer superimposed over the Active Desktop item layer. See, for example, the following figure from MSIE Kit,

*Ex. 2004 (Weadock Decl.) ¶ 122, cited in Paper 27 (PO Resp) at 52*

**As more items are added to the desktop, they will start to overlap each other.**

*Ex. 1007 (MSIE Kit) at 183, cited in Paper 27 (PO Resp) at 52*



# Duhault II

# Conception

# Conception

F.3d 1572, 1577 (Fed. Cir. 1996). Priority of invention goes to the first party to reduce the claimed invention to practice, such as by filing a patent application, unless the other party can show that it was the first to conceive the invention and that it exercised reasonable diligence in later reducing that invention to practice. *Brown v. Barbacid*, 276 F.3d 1327, 1337 (Fed. Cir. 2002); *Mahurkar*, 79 F.3d at 1577. Both conception and diligence must be established by relation to factual evidence. However, an inventor's testimony, standing alone, is insufficient to prove conception, as some form of corroboration is required. *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993). And a rule of reason applies to determine whether the inventor's testimony has been corroborated. *Id.* at 1194.

# Conception

Moreover, as discussed in Exhibit 2005 ¶ 17, a letter [Ex. 2009] from one of SurfCast's attorneys at the law firm of Pennie & Edmonds LLP ("Pennie") indicates that Mr. Santoro made a presentation regarding a potential patent application on a date after the email of Exhibit 2067 but prior to June 28, 1999. Among the information provided to Pennie was the white paper attachment to Ex. 2067. [Ex. 2005 ¶ 17]. This is consistent with the statement in the email of Ex. 2067 in which Mr. Santoro states that he wanted to "get something to pennie." This additional corroboration is more than sufficient under the rule of reason.

*Paper No. 27 (Patent Owner's Response) at 32*

# Diligence

# Diligence

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

*Ex. 2008 (Bone Decl.) at 9, cited in Paper 27 (PO Resp) at 33*

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 invoices for services that were sent to SurfCast during the relevant period of time. (See, e.g., Exhibit 2010.)

*Ex. 2008 (Bone Decl.) at 8, cited in Paper 27 (PO Resp) at 33*

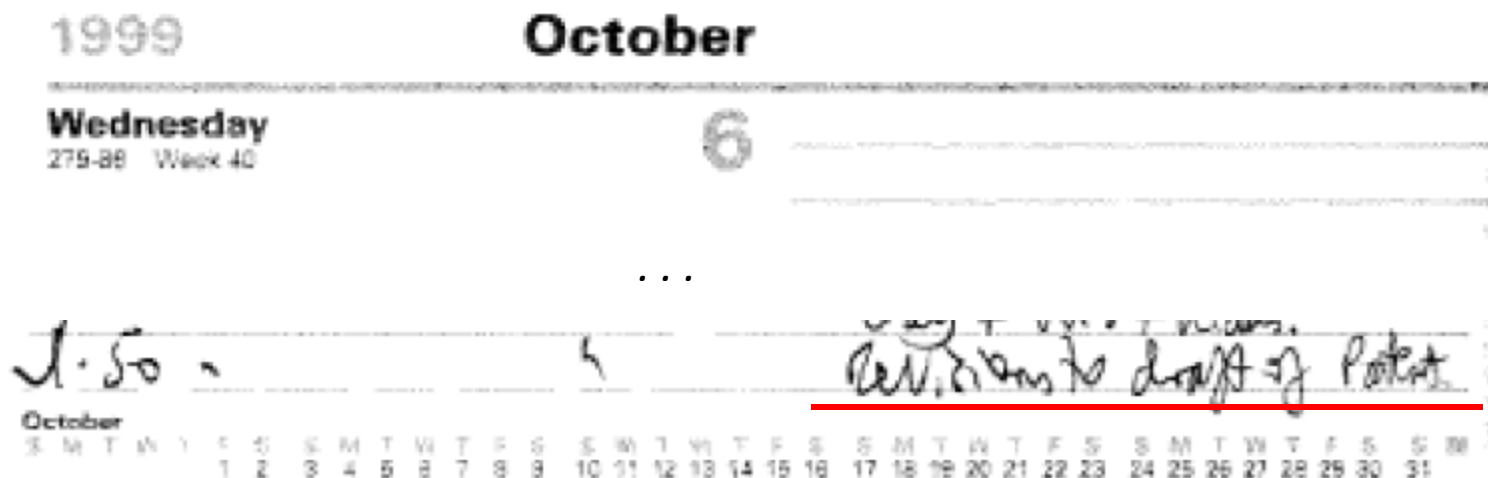
# Diligence

## PENNIE & EDMONDS LLP

SURFCAST, INC.  
November 16, 1999  
Invoice 296240

10/06/99	Richard Bone	1.50
	<u>Revisions to draft of patent.</u>	
10/07/99	Richard Bone	2.50
	Revised draft <u>patent</u> application; printed and read Surfcast White Paper.	

*Ex. 2010 at 10, cited in Ex. 2008 at 8, cited in Paper 27 (PO Resp) at 33*



*Ex. 2035 at 111, cited in Ex. 2008 at 8, cited in Paper 27 (PO Resp) at 33*

# Diligence

## PENNIE & EDMONDS LLP

SURFCAST, INC.  
November 16, 1999  
Invoice 296240

10/06/99	Richard Bone	1.50
	Revisions to draft of patent.	
10/07/99	Richard Bone	2.50
	<u>Revised draft patent application; printed and read</u> <u>Surfcast White Paper.</u>	

*Ex. 2010 at 10, cited in Ex. 2008 at 8, cited in Paper 27 (PO Resp) at 33*

1999 **October**

Thursday  
290-85 Week 40

7

...

09/982-0009-999

$\frac{1}{2}$ hour.	} <u>Revising draft patent</u>		
+ $\frac{1}{2}$ hour.		} <u>application.</u>	
+ $\frac{3}{4}$ "			
+ $\frac{3}{4}$ "			
	Printed +		
	Read <u>Surfcast White Paper</u>		

*Ex. 2035 at 112, cited in Ex. 2008 at 8, cited in Paper 27 (PO Resp) at 33*



Date (1999)	Person	Description
June 21 (Mon)	R. Bone	Web searching for software patents. Ex. 2035 at p. 7
June 22 (Tues)	R. Bone	Writing and Web searching Talk with Brett about 9982-0005-999 Talk with Brett + Andrew Gray on 9982-0005-999 More writing/Web searching Ex. 2035 at p. 8
June 23 (Weds)	R. Bone	Writing/Web searching Writing/Reading/Web searching Ex. 2035 at p. 9
June 24 (Thurs)	R. Bone	Reading Writing background to 9982-0009-999 Ditto Ex. 2035 at p. 10
June 25 (Fri)	R. Bone	Meeting with Brett 9982-0009 Ex. 2035 at p. 11
June 26 (Sat)		Non-weekday
June 27 (Sun)	R. Bone	Amending Background Ex. 2035 at p. 12
June 28 (Mon)	R. Bone	Structuring SurfCast patent Meeting with Brett (SurfCast) Description & figures of SurfCast patent Ex. 2035 at p. 13
June 29 (Tues)		
June 30 (Wed)		
July 1 (Thurs)		
July 2 (Fri)	R. Bone	SurfCast Reviewing SurfCast patent, rewriting intro/background (portions thereof) Ex. 2035 at p. 17
July 3 (Sat)		Non-weekday
July 4-5 (Sun-Mon)	R. Bone	4th of July Holiday Ex. 2035 at pp. 19-20
	O. Santoro	Collaborated with coinventor to draft business plan documents, etc. regarding implementation of invention Ex. 2045
July 6 (Tues)		
July 7 (Wed)	O. Santoro K. Lagermann	Draft SurfCast product planning documents Ex. 2043--metadata creation date of July 7, 1999 Ex. 2044 metadata creation date of July 7, 1999
July 8 (Thurs)	O. Santoro K. Lagermann	Draft SurfCast product planning documents Ex. 2047 metadata creation date of July 8, 1999
July 9 (Fri)	R. Bone	Misc. activity for SurfCast SurfCast patent download Ex. 2035 at p. 24
July 10 (Sat)		Non-weekday

Date (1999)	Person	Description
July 11 (Sun)	K. Lagermann	Draft drawings and description of SurfCast product Ex. 2030 (email to Santoro re working on these documents)
July 12 (Mon)	R. Bone	SurfCast. Download patent + printed/read application Ex. 2035 at p. 27
July 13 (Tues)	R. Bone	SurfCast - filing + reading Drafting objects of invention + preliminary work on claims Ex. 2035 at p. 28
July 14 (Weds)	R. Bone	SurfCast claim drafting Talk with Brett/Andrew (SurfCast) SurfCast- searching on set top boxes, GUIs, phones, etc. Ex. 2035 at p. 29
July 15 (Thurs)	R. Bone	SurfCast: patent download, etc. SurfCast reading, etc. Ex. 2035 at p. 30
	O. Santoro	Drafted business plan document including description of SurfCast User Interface product Ex. 2046
July 16 (Fri)	R. Bone	Get book from Stacy's for SurfCast Expense form for SurfCast Ex. 2035 at p. 31
	O. Santoro	Discuss with Andrew Gray of Pennie & Edmonds patent application. Ex. 2049
July 17 (Sat)		Non-weekday
July 18 (Sun)		Non-weekday
July 19 (Mon)	R. Bone	Prepared search strategies SurfCast: claims/print out patents Ex. 2035 at p. 34
July 20 (Tues)	R. Bone	Meeting with WSG (SurfCast) Further SurfCast reading/prep Meeting with AJG & WSG SurfCast Claims discussion SurfCast reading More SurfCast reading Meeting with AJG, Ovid Ex. 2035 at p. 35
July 21 (Weds)	R. Bone	Meeting with AJG + Ovid (SurfCast) + Klaus Lagermann (speakerphone) Talking with AJG (SurfCast) Organizing trip to NYC Ex. 2035 at p. 36
July 22 (Thurs)	R. Bone	Travel arrangements SurfCast patent downloading Ex. 2035 at p. 37
July 23 (Fri)	R. Bone	Downloading sample patent for SurfCast- emailing Klaus

Date (1999)	Person	Description
		Ex. 2035 at p. 38
July 24 (Sat)		<i>Non-weekday</i>
July 25 (Sun)		<i>Non-weekday</i>
July 26 (Mon)	R. Bone	Talked with BXL about case – SurfCast 9982-0009-999 Ex. 2035 at p. 39
July 27 (Tues)	R. Bone	Reviewed materials for SurfCast to take to NY Ex. 2035 at p. 40
July 28 (Weds)	R. Bone	Preparing for meeting on SurfCast Meeting on SurfCast w/ Ovid, Klaus, Tom, AJG and P DeStefano Ex. 2035 at p. 41
July 29 (Thurs)	R. Bone	Breakfast with Ovid, Tom, Paul, etc. Meeting with Klaus, etc. Ex. 2035 at p. 42
July 30 (Fri)	R. Bone	Tidying notes from SurfCast meeting Ex. 2035 at p. 43
July 31 (Sat)		<i>Non-weekday</i>
August 1 (Sun)		<i>Non-weekday</i>
Aug 2 (Mon)	R. Bone	Talk with Brett about SurfCast Ex. 2035 at p. 46
Aug 3 (Tues)	R. Bone	Drawing figures + listening to SurfCast tape Drawing SurfCast figures/listening to tapes Ditto Ex. 2035 at p. 47
	T. Dechaene	Met with Destefano (Pennie & Edmonds) regarding preparation and filing of patent application Ex. 2011
Aug 4 (Weds)	R. Bone	Figures fax to Klaus, listen to tapes Ex. 2035 at p. 48
Aug 5 (Thurs)		
Aug 6 (Fri)		
Aug 7 (Sat)		<i>Non-weekday</i>
Aug 8 (Sun)		<i>Non-weekday</i>
Aug 9 (Mon)	O. Santoro	Communication with A. Gray regarding SurfCast product and communication of prior art in connection with patent application Ex. 2012
Aug 10 (Tues)	R. Bone K. Lagermann	Communication between Bone and Lagermann regarding patent document review Ex. 2018

Date (1999)	Person	Description
Aug 11 (Weds)	R. Bone	SurfCast claims Ex. 2035 at p. 55
	K. Lagermann	Draft and email description of <i>SurfCast product</i> to O. Santoro Ex. 2042
Aug 12 (Thurs)	R. Bone	SurfCast claims Conf. call with Ovid + Klaus setting it up Ex. 2035 at p. 56
Aug 13 (Fri)	R. Bone	SurfCast claims Ex. 2035 at p. 57
Aug 14 (Sat)		<i>Non-weekday</i>
Aug 15 (Sun)		<i>Non-weekday</i>
Aug 16 (Mon)	R. Bone	Read through SurfCast claims Met with Bill Galliani to discuss claims. SurfCast Met with AJG to discuss SurfCast Fax to SurfCast SurfCast claims Ex. 2035 at p. 60
Aug 17 (Tues)	R. Bone	SurfCast claims Ex. 2035 at p. 61
Aug 18 (Weds)	R. Bone	SurfCast claims SurfCast claims Meet with AJG (SurfCast claims) Ex. 2035 at p. 62
Aug 19 (Thurs)	R. Bone	SurfCast (Klaus email+ print) Ex. 2035 at p. 63
	K. Lagermann	Prepare and send to R. Bone comments on draft patent figures and specification Ex. 2019, Ex. 2020, Ex. 2021
Aug 20 (Fri)		
Aug 21 (Sat)		<i>Non-weekday</i>
Aug 22 (Sun)	O. Santoro	Email to P. Destefano re SurfCast product development Ex. 2034
Aug 23 (Mon)	K. Lagermann	Review documentation for the patent application
Aug 24 (Tues)	R. Bone	Talked w/ Andrew Gray re: timing of SurfCast application Ex. 2035 at p. 68
	K. Lagermann	Review documentation for the patent application; email to R. Bone regarding SurfCast product development and patent documents Ex. 2022
Aug 25 (Wed)	O. Santoro	Email with Lagermann re SurfCast user interface features Ex. 2031
	K. Lagermann	Email with Santoro re SurfCast user interface features Ex. 2031
Aug 26 (Thurs)	O. Santoro	Confer regarding SurfCast product description document

Date (1999)	Person	Description
	K. Lagermann	Ex. 2013
Aug 27 (Fri)		
Aug 28 (Sat)		Non-weekday
Aug 29 (Sun)		Non-weekday
Aug 30 (Mon)		
Aug 31 (Tues)	R. Bone	Background materials for SurfCast patent Ex. 2035 at p. 75
Sept 1 (Weds)	R. Bone	Revised background section for patent + talked w/ AJG Ex. 2035 at p. 76
Sept 2 (Thurs)	R. Bone	Reviewed materials prior to writing specification Wrote specification of patent Writing specification of patent grid + tiles Ex. 2035 at p. 77
Sept 3 (Fri)	R. Bone	Revised specification of patent Reviewed materials for client-server aspect of specification Talked w/ AJG about patent draft. Ex. 2035 at p. 78
Sept 4 (Sat)		Non-weekday
Sept 5 (Sun)		Non-weekday
Sept 6 (Mon)	R. Bone	Labor Day Holiday Ex. 2035 at p. 81
Sept 7 (Tues)	O. Santoro	Send description of SurfCast product to P. Destefano at Pennie & Edmonds, Tom Dechaene, and Klaus Lagermann Ex. 2014
Sept 8 (Wed)		
Sept 9 (Thurs)	O. Santoro	Send email to K. Lagermann regarding SurfCast product in view of products on the market Ex. 2032
Sept 10 (Fri)		
Sept 11 (Sat)		Non-weekday
Sept 12 (Sun)	R. Bone	SurfCast. Read about XML Ex. 2035 at p. 87
Sept 13 (Mon)	R. Bone	Talked with Mr. Gray about SurfCast Read further about XML Ex. 2035 at p. 88
Sept 14 (Tues)	R. Bone	Read more XML Talked to Mr. Gray about US 5,918,237 Retrieved + read about US 5,918,237 Ex. 2035 at p. 89
Sept 15 (Wed)		
Sept 16 (Thurs)		
Sept 17 (Fri)	R. Bone	Arrange for transfer documents to be prepared Ex. 2035 at p. 92
Sept 18 (Sat)		Non-weekday

Date (1999)	Person	Description
Sept 19 (Sun)	O. Santoro	Email to Pennie & Edmonds attorneys, coinventor, and Tom Dechaene regarding patent application Ex. 2015
Sept 20 (Mon)	O. Santoro	Email to Pennie & Edmonds attorneys, coinventor, and Tom Dechaene regarding prior art. Ex. 2016
Sept 21 (Tues)		
Sept 22 (Weds)	R. Bone	Amended patent application Ex. 2035 at p. 97
Sept 23 (Thurs)	R. Bone	Wrote introductory section to patent Talk to Andrew Gray about timetable Ex. 2035 at p. 98
Sept 24 (Fri)		
Sept 25 (Sat)		
Sept 26 (Sun)	R. Bone	Preparation of figures + draft for review by Andrew Gray Ex. 2035 at p. 101
Sept 27 (Mon)	R. Bone	Prep of figures Reviewed patent application in current state Ex. 2035 at p. 102
Sept 28 (Tues)		
Sept 29 (Weds)	R. Bone	Talk to Andrew Gray about patent progress Talked to Gary Williams about current status Ex. 2035 at p. 104
Sept 30 (Thurs)	R. Bone	Reviewed Mr. Gray's comments on draft of patent application Ex. 2035 at p. 105
	O. Santoro	Draft description of SurfCast product to implement the invention Ex. 2039 (dated Sept. 1999) Ex. 2040 (p. 17 states "plan to complete the current round of financing by September 1999")
Oct 1 (Fri)		
Oct 2 (Sat)		Non-weekday
Oct 3 (Sun)		Non-weekday
Oct 4 (Mon)	R. Bone	Talked to Andrew Gray about SurfCast Ex. 2035 at p. 109
Oct 5 (Tues)	R. Bone	Discussed draft of patent with Andrew Gray and Brett Lovejoy Ex. 2035 at p. 110
Oct 6 (Weds)	R. Bone	Talked to Brett Lovejoy about status of patent. Meeting with Ovid Santoro, Gabrielle, Brett Lovejoy (Klaus Lagermann via speaker phone). Print out copy of patent. Follow-up conversation with Brett Lovejoy about timeline. Drew up timeline, arranged for e-mail of encrypted document to Ovid + Klaus, telephone call with Andrew

Ex. 2052 (Diligence Calendar) at 5-6, cited in Paper 27 (PO Resp) at 35

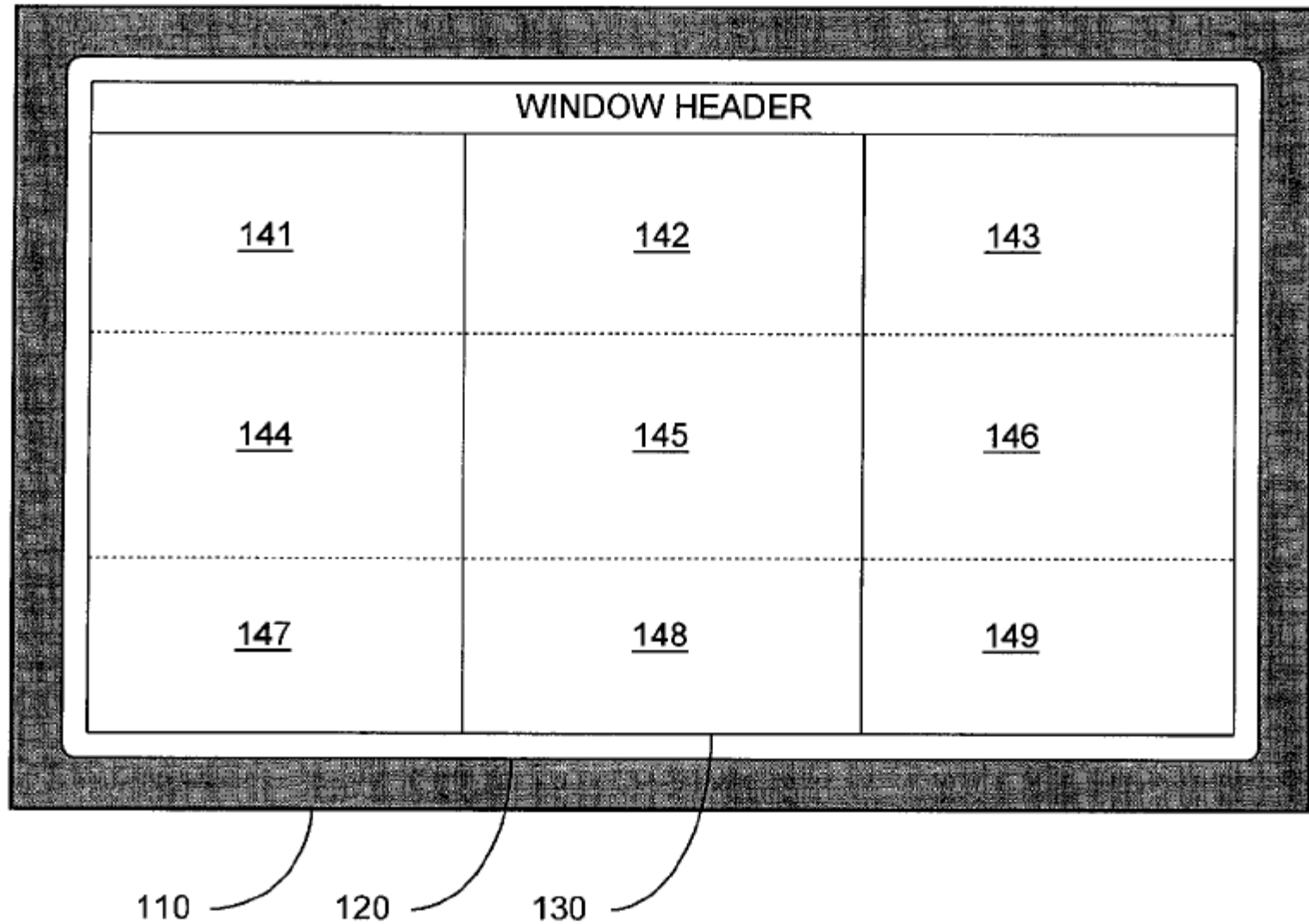
Date (1999)	Person	Description
		Gray. E-mailed timeline to Andrew Gray + Ovid+Klaus. Revisions to draft of patent. Ex. 2035 at p. 111
Oct 7 (Thurs)	R. Bone	Revising draft patent application Printed + read SurfCast White paper & Q&A's. Ex. 2035 at p. 112
Oct 8 (Fri)	R. Bone	Updated Andrew Gray about current timetable Ex. 2035 at p. 113
Oct 9 (Sat)		Non-weekday
Oct 10 (Sun)		Non-weekday
Oct 11 (Mon)	R. Bone	Columbus Day Holiday Ex. 2035 at p. 116
Oct 12 (Tues)	R. Bone	Teleconference w/ Ovid Santoro, Klaus Lagermann, Paul DeStefano + Brett Lovejoy Ex. 2035 at p. 117
Oct 13 (Weds)	R. Bone	Teleconference w/ Brett Lovejoy, Ovid Santoro, Klaus Lagermann about patent; follow-up discussion w/ Brett Lovejoy + Andrew Gray Ex. 2035 at p. 118
Oct 14 (Thurs)	O. Santoro	October bill from Pennie & Edmonds indicates Andrew Gray had a discussion with Richard Bone regarding the patent application Ex. 2010 at p. 10
Oct 15 (Fri)		
Oct 16 (Sat)		Non-weekday
Oct 17 (Sun)	K. Lagermann	Draft description of SurfCast invention Ex. 2048
Oct 18 (Mon)	R. Bone	Talked to Brett Lovejoy about TCP/IP. Ex. 2035 at p. 123
Oct 19 (Tues)	R. Bone	Attend meeting w/ Mr. Carberry. Talk with Brett Lovejoy about TCP/IP. Prep for meeting w/ Mr. Carberry Meeting with Mr. Carberry, Andrew Gray & Brett Lovejoy. Ex. 2035 at p. 124
	O. Santoro	Coordinate review of patent documents by Carberry at Pennie & Edmonds office Ex. 2017
Oct 20 (Wed)		
Oct 21 (Thurs)	R. Bone	Carried out revisions to figures to bring them into PTO guidelines; talked with Dr. Lovejoy and Mr. Gray about specification of patent. Ex. 2035 at p. 126
Oct 22 (Fri)	R. Bone	Revised draft of patent application & figures. Ex. 2035 at p. 127
Oct 23 (Sat)		Non-weekday

Date (1999)	Person	Description
Oct 24 (Sun)	R. Bone	Revised draft patent application & figures Ex. 2035 at p. 129
Oct 25 (Mon)	R. Bone	Revised specification & figures & claims Ex. 2035 at p. 130
Oct 26 (Tues)	R. Bone	Revised figures & streamlined claims; spoke with Mr. Galliani. Met with Mr. Dechaene, Dr. Lovejoy to discuss current status of patent filing. Reviewed prior art. Ex. 2035 at p. 131
Oct 27 (Wed)		
Oct 28 (Thurs)	R. Bone	Reviewed prior art & attention to docket. Ex. 2035 at p. 133
Oct 29 (Fri)	R. Bone	Attention to preparation of filing papers. Small entity status, etc. Ex. 2035 at p. 134

# No Anticipation



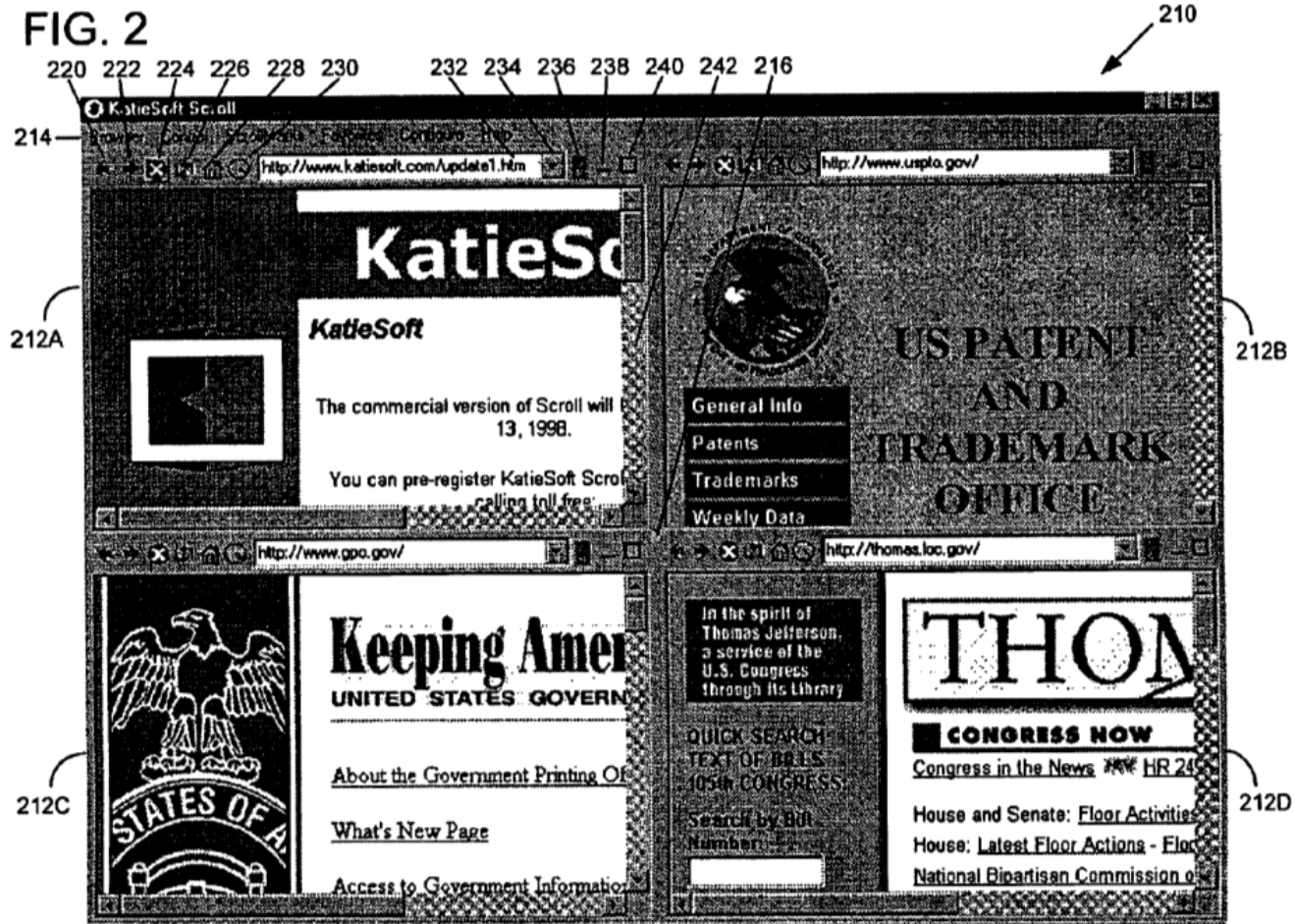
# No Anticipation



*Ex. 1014 (Duhault II) Fig. 1, cited in 292 Pet. at 26*

# Duperrouzel

# Duperrouzel



*Ex. 1011 (Duperrouzel) Fig. 2, cited in Karger Report (Ex. 1003) ¶ 418, cited in 295 Pet. at 41*



# Conditional Amendment

Cites to Paper No. 28 also refer to corresponding sections of Paper Nos. 75 and 76

53 (substitute for claim 46): A system for facilitating the organization and management of multiple data sources, comprising:

a device that includes a processor configured to execute instructions, a memory connected to said processor to store at least one program that includes a graphical user interface, and an input device, wherein said processor executes instructions to:

control simultaneous communication with a plurality of information sources;

arrange a display into a grid-an array of tiles that are not permitted to overlap, said tiles being persistent from session to session;

associate a first information source of said plurality of information sources to a first tile of said grid-array of tiles and a second information source of said plurality of information sources to a second tile of said grid-array of tiles;

retrieve information from said first information source in accordance with a first retrieval rate and retrieve information from said second information source in accordance with a second retrieval rate; and

present information to said first tile in accordance with said first retrieval rate and present information to said second tile in accordance with said second retrieval rate;

wherein the tiles are selectable by a user, and wherein selecting a tile calls an assigned application program to provide access to information, the assigned application program being different from a program that arranges the display into the grid of tiles that are not permitted to overlap;

wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

# Conditional Amendment

Claim Language: a grid~~-an array~~ of tiles

user's needs and interests. The present invention comprises a grid of tiles that resides on the user's computer desktop. The grid of tiles provides a uniform, graphical environment in which a user can access, operate, and/or control multiple data sources on electronic devices.

*Ex. 1002 ('325 App.) at 13, cited in Paper No. 28 (Mot Con Am) at 4*

~~Fig. 1~~ shows a representative embodiment of the user interface of the present invention comprising a grid of tiles as might be depicted on a display screen.

*Ex. 1002 ('325 App.) at 14, cited in Paper No. 28 (Mot Con Am) at 4*

# Conditional Amendment

Claim Language: a grid~~an array~~ of tiles

**The present invention comprises a grid of tiles which resides on the user's computer desktop, Figure 1. Tiles permit “dynamic bookmarking” of information in that each tile is a**

*Ex. 2066 ('522 App.) at 9, cited in Paper No. 28 (Mot Con Am) at 4*

**Fig. 1 shows a representative embodiment of the Application comprising a grid of tiles as might be depicted on a display screen.**

*Ex. 2066 ('522 App.) at 11, cited in Paper No. 28 (Mot Con Am) at 4*

# Conditional Amendment

Claim Language: a grid~~an array~~ of tiles that are not permitted to overlap

the bottom row are 802-M-1, 802-M-2, 802-M-3 and so on to 802-M-N. There are no gaps between the tiles, the tiles are not permitted to overlap and the whole grid is covered by tiles. Figure 8 shows one embodiment in which all tiles are the same size and are presented

*Ex. 1002 ('325 App.) at 23, cited in Paper No. 28 (Mot Con Am) at 4*

display screen, as depicted in figures 6(a) - (d). There are no gaps between the tiles, the tiles are not permitted to overlap and the whole grid is covered by tiles. Figure 6(a) shows one

*Ex. 2066 ('522 App.) at 16, cited in Paper No. 28 (Mot Con Am) at 4*

45. First, the requirement “not permitted” speaks to an active process, or a positive feature, not to a negative limitation as Dr. Karger supposes. This is because any software that implements a grid of tiles in which the tiles are constrained from overlapping must have the requisite code in place to test for overlap and to reject it when it occurs, for example, when a user attempts to relocate a tile in an overlapping position. It is true that there are some display systems, as Dr.

*Ex. 2081 (Weadock Decl.) ¶ 45, cited in Paper 62 (PO Reply) at 1*

in an overlapping position. It is true that there are some display systems, as Dr. Karger points out in deposition (Ex. 1113 at p.17 line 15, to p. 18, line 5) that use boundary lines to separate windows from one another. A boundary line acts as an edge shared between two windows in these systems; nevertheless the properties of a boundary line that define the edges of pairs of windows are themselves positive features, coded in such a way that the two abutting windows do not encroach upon one another. And, as Dr. Karger states, there are other ways of implementing a

*Ex. 2081 (Weadock Decl.) ¶ 45, cited in Paper 62 (PO Reply) at 1*

one another. And, as Dr. Karger states, there are other ways of implementing a tiled user interface than a system with the boundary lines that he describes, in which case “the system itself just takes care of re-laying out the windows” which is a positive limitation performed by “the system” (Ex. 1113, 28:17-24).

*Ex. 2081 (Weadock Decl.) ¶ 45, cited in Paper 62 (PO Reply) at 1*



Q Right. But we're not just saying that we're putting them into a nonoverlapping configuration. We're saying we're going to arrange them into a grid of tiles that are not permitted to overlap. That means they cannot overlap.

And don't you have to add something to a covered windows system beyond what is required in the simplest sense to implement such a system to prevent the tiles from overlapping?

MR. MICALLEF: Object to form; relevance, incomplete hypothetical.

THE WITNESS: And if I build a covered windows system and every time I try to put one tile on top of another one, it crashes, wouldn't that be a covered windows system in which the tiles are not permitted to overlap?

*Ex. 1113 (Karger Tr.) at 31:22-32:13, cited in Ex. 2081 ¶ 46, cited in Paper 62 (PO Reply) at 1*

# Conditional Amendment

Claim Language: said grid being persistent  
from session to session

The grid object stores the number of rows 1212 and the number of columns 1214 of tiles that are present. The grid also stores a tile list 1216 containing attributes of each respective tile. In particular, the address of each tile, its priority and its refresh rate are stored by the grid program. The grid also stores other attributes of tiles such as their respective positions on the grid as given by their column and row number. The priority of a tile may be used to determine its refresh rate in one embodiment of the present invention. A tile can have a password feature built into it if it is desired to restrict access to the tile's content. The grid itself can have a toolbar by which its attributes may be accessed and modified.

*Ex. 1002 ('325 App.) at 24, cited in Paper 28 (Mot Con Am) at 4-5*

# Conditional Amendment

Claim Language: said grid being persistent  
from session to session

The metabase 1506, Figure 17, is a local store for platform-specific implementations of the descriptions of tiles, grids and other objects. Tiles, grids and content are created, saved and restored via the metabase. The metabase contains tile type and content type registries such as tile registry 1732, and a local database of grids and content such as content store 1734 and grid store 1736. Unknown tile and content types can be obtained from remote servers. Tile types are abstracted so that if a grid contains a particular type of tile, for example an e-mail tile, the metabase provides whatever is appropriate for the device the application is running on. Items in the metabase are “persistent”, that is they are not saved explicitly but are preserved from session to session.

*Ex. 1002 ('325 App.) at 24, cited in Paper 28 (Mot Con Am) at 4-5*

# Conditional Amendment

Claim Language: said grid being persistent  
from session to session

Figure 7 shows a schematic data structure of the attributes of one embodiment of grid object 400. The grid may have a parent grid whose parent grid address 402 is known. (For example, grid 400 may be the grid associated with Tile 302-N-1 of Figure 6(c), in which case its parent is Grid 300.) The grid itself has an address 404 that specifies its location within the file system of the system's main memory. The grid has associated with it several utility programs: a configuration wizard 406 that may be called by the user when setting up a new grid; a tile creation function 408 utilised by the configuration wizard when initialising new tiles; a tile annihilation function 410 utilised in case of error or when resizing the grid. Additionally, the grid object stores the number of rows 412 and the number of columns 414 of tiles that are present. The grid also stores a tile list 416 containing attributes of each respective tile. In particular, the address of each tile, its priority and its refresh rate are stored by the grid program. The grid also stores other attributes of tiles such as their respective positions on the grid as given by their column and row number. The priority of a tile may be used to determine its refresh rate in one embodiment of the present invention. A password feature may be built into each tile where permitted to access the tile's content.

*Ex. 2066 ('522 App.) at 17, cited in Paper 28 (Mot Con Am) at 4-5*

# Conditional Amendment

Claim Language: said grid being persistent  
from session to session

- d. Lines 12:66-13:1 state that "The grid itself has an address 1024 that specifies its location within the file system of the device in which the application program runs." This indicates that the grid address is stored in a non-volatile memory such as a hard drive.

*Ex. 2063 (Weadock Decl.) ¶ 33d, cited in Paper 28 (Mot Con Am) at 4-5*

# Conditional Amendment

Claim Language: said grid being persistent  
from session to session

- f. Lines 13:16-17 state that "A tile can have a password feature built into it if it is desired to restrict access to the tile's content." Storing a password only makes sense in the context of a persistent structure, such as (for example) a user account.

*Ex. 2063 (Weadock Decl.) ¶ 33f, cited in Paper 28 (Mot Con Am) at 4-5*

# Conditional Amendment

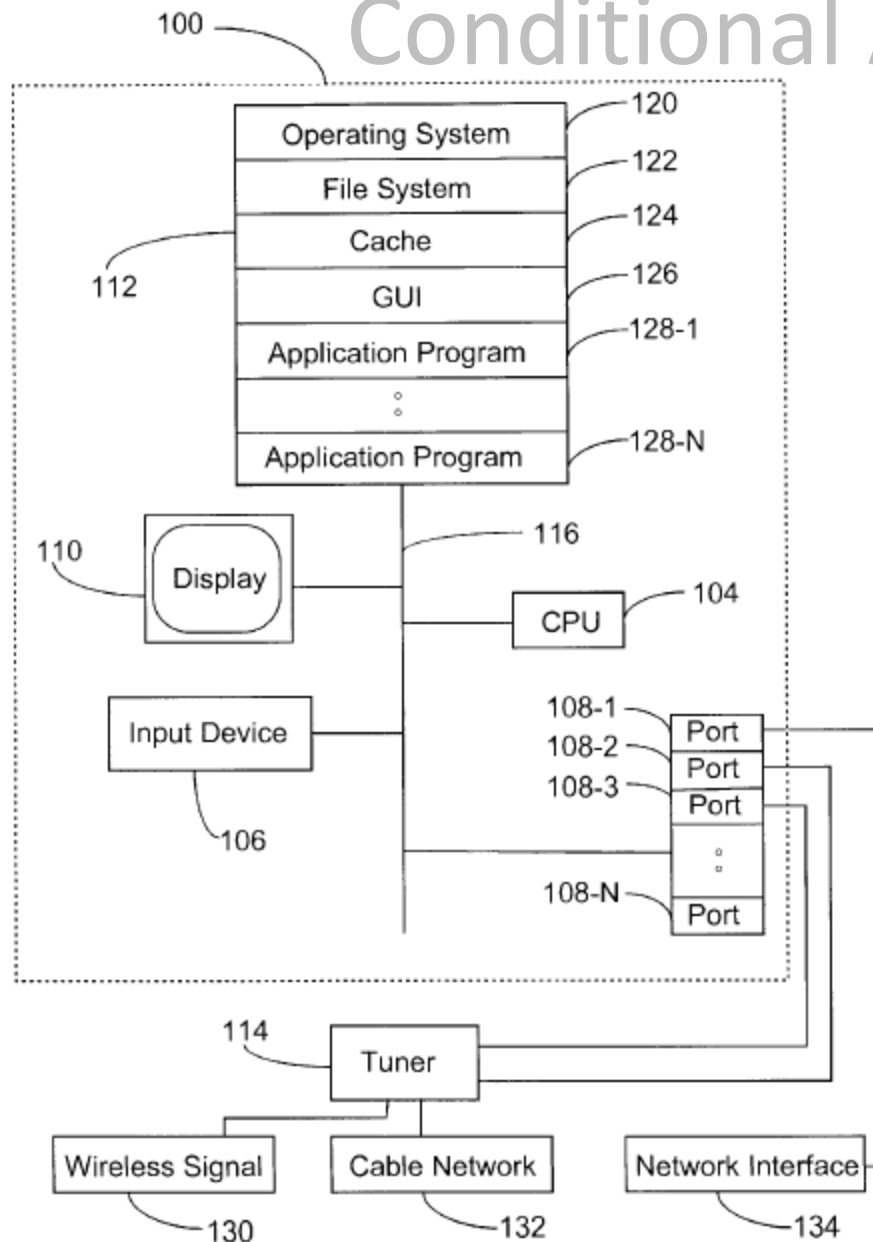


Fig. 2

Ex. 1001 ( '403 Patent) Fig. 2,  
cited in Ex, 2081 ¶ 18, cited in  
Paper 62 (PO Reply) at 1

# Conditional Amendment

Q Back on the record. So, Dr. Karger, again referring to figure 2 of the '403 patent, the file system that's referenced by numeral 122, is that something that typically resides in RAM, in a hard disk or in both places?

MR. MICALLEF: Object to form; incomplete hypothetical.

THE WITNESS: So again, I would say that it is typically on a hard disk, but that it is well understood that it can be in a RAM.

*Ex. 1113 (Karger Tr.) at 124:17-125:2, cited in Ex, 2081 (Weadock Decl.) ¶ 56, cited in Paper 62 (PO Reply) at 1*



# Conditional Amendment

**file system** In an operating system, the overall structure in which files are named, stored, and organized. A file system consists of files, directories, and the information needed to locate and access these items. The term can also refer to the portion of an operating system that translates requests for file operations from an application program into low-level, sector-oriented tasks that can be understood by the drivers that control the disk drives. *See also* driver.

*Ex. 2084 (Microsoft Press Computer Dictionary) at 3-4, cited in Ex. 2081 (Weadock Decl.) ¶ 19, cited in Paper 62 (PO Reply) at 1*

# Conditional Amendment

**PCT**

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
International Bureau



INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(51) International Patent Classification <sup>6</sup> :  H04R 27/00	A1	(11) International Publication Number: <b>WO 96/01032</b>  (43) International Publication Date: 11 January 1996 (11.01.96)
(21) International Application Number: PCT/EP95/02522  (22) International Filing Date: <u>28 June 1995 (28.06.95)</u>  (30) Priority Data: 9401076                      28 June 1994 (28.06.94)                      NL 9401990                      28 November 1994 (28.11.94)                      NL		(81) Designated States: AM, AT, AU, BB, BG, BR, BY, CA, CH, CN, CZ, DE, DK, EE, ES, FI, GB, GE, HU, JP, KE, KG, KP, KR, KZ, LK, LR, LT, LU, LV, MD, MG, MN, MW, MX, NO, NZ, PL, PT, RO, RU, SD, SE, SI, SK, TJ, TT, UA, US, UZ, VN, European patent (AT, BE, CH, DE, DK, ES, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, ML, MR, NE, SN, TD, TG), ARIPO patent (KE, MW, SD, SZ, UG).

15. A central unit suitable for application in a communication system according to one of the claims 1 - 11, or a node according to claim 14, wherein said main memory includes a hard disk or a read and/or write memory or a compact disc.

*Ex. 2086 at 17, cited in Ex, 2081 (Weadock Decl.) ¶ 25, cited in Paper 62 (PO Reply) at 1*

# Conditional Amendment

(19) **United States**

(12) **Reissued Patent**

**Chu**

(10) **Patent Number:** **US RE43,119 E**

(45) **Date of Reissued Patent:** **\*Jan. 17, 2012**

(54) **PASSWORD PROTECTED MODULAR  
COMPUTER METHOD AND DEVICE**

(75) Inventor: **William W. Y. Chu**, Los Altos, CA (US)

(73) Assignee: **ACQIS LLC**, McKinney, TX (US)

(\*) Notice: This patent is subject to a terminal disclaimer.

(21) Appl. No.: **12/577,074**

(22) Filed: **Oct. 9, 2009**

## **Related U.S. Patent Documents**

Reissue of:

(64) Patent No.: **6,321,335**  
Issued: **Nov. 20, 2001**  
Appl. No.: **09/183,493**  
Filed: **Oct. 30, 1998**

4,760,276	A	7/1988	Lethellier
4,769,764	A	9/1988	Levanon
4,791,524	A	12/1988	Teigen et al.
4,799,258	A	1/1989	Davies
4,872,091	A	10/1989	Maniwa et al.
4,890,282	A	12/1989	Lambert et al.
4,918,572	A	4/1990	Tarver et al.
4,939,735	A	7/1990	Fredericks et al.
5,056,141	A	10/1991	Dyke
5,086,499	A	2/1992	Mutone
5,103,446	A	4/1992	Fischer
5,187,645	A	2/1993	Spalding et al.

(Continued)

## **FOREIGN PATENT DOCUMENTS**

EP 722138 A1 7/1996

(Continued)

## **OTHER PUBLICATIONS**

Agerwala, T., "SP2 System Architecture," IBM Systems Journal, vol. 34, No. 2, pp. 152-184 (1995).

The attached computer module also includes a primary  
20 hard disk drive that serves as a main memory unit for programs and the like. The hard disk can be any suitable drive

*Ex. 2085 at 8:19-21, cited in Ex. 2081 (Weadock Decl.) ¶ 25, cited in Paper 62 (PO Reply) at 1*

# Conditional Amendment

Claim Language: wherein said tiles are selectable by a user,  
and wherein selecting a tile calls an  
assigned application program to  
provide access to information

On this record, we determine that the broadest reasonable interpretation for “tile” in the context of the specification of the ’403 patent is “*a graphical user interface element whose content may be refreshed and that, when selected, provides access to an information source.*”

*Paper No. 19 at 9*

# Conditional Amendment

Claim Language: wherein said tiles are selectable by a user,  
and wherein selecting a tile calls an  
assigned application program to  
provide access to information

of the tiles. Each tile is associated with a data stream or application program and allows a choice of displayed images. In particular, different tiles can be associated with different

*Ex. 1002 ('325 App.) at 21, cited in Paper 28 (Mot Con Am) at 5*

# Conditional Amendment

Claim Language: wherein said tiles are selectable by a user,  
and wherein selecting a tile calls an  
assigned application program to  
provide access to information

a “borderless browser”. Therefore the application resides over existing applications without replacing any of them; rather it enables them to be called from the grid itself. The

*Ex. 1002 (‘325 App.) at 22, cited in Paper 28 (Mot Con Am) at 5*

# Conditional Amendment

Claim Language: wherein said tiles are selectable by a user,  
and wherein selecting a tile calls an  
assigned application program to  
provide access to information

**The present invention provides a simple, easy to use graphical interface facilitating the organization and management of multiple data sources corresponding to a user's needs and interests. The invention comprises a uniform, graphical environment in which a user can access, operate, and/or control multiple data sources on electronic devices. According to the**

*Ex. 2066 ('522 App.) at 8, cited in Paper 28 (Mot Con Am) at 5*

# Conditional Amendment

Claim Language: wherein said tiles are selectable by a user,  
and wherein selecting a tile calls an  
assigned application program to  
provide access to information

**Therefore the Application resides over existing applications without replacing any of them;  
rather it enables them to be called from the grid itself. The Application, therefore, becomes a**

*Ex. 2066 ('522 App.) at 10, cited in Paper 28 (Mot Con Am) at 5*



# Conditional Amendment

Claim Language: wherein said tiles are selectable by a user,  
and wherein selecting a tile calls an  
assigned application program to  
provide access to information

**a grid object 300 divided up into a number of rectilinear tiles 302. Each tile is associated with**  
**a separate application program or file 128, any one of which may be another grid object 300.**

*Ex. 2066 ('522 App.) at 16, cited in Paper 28 (Mot Con Am) at 5*

# Conditional Amendment

Claim Language: the assigned application program  
being different from a program that  
arranges the display into the grid of tiles . . .

a “borderless browser”. Therefore the application resides over existing applications without replacing any of them; rather it enables them to be called from the grid itself. The

*Ex. 1002 ('325 App.) at 22, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

Claim Language: the assigned application program  
being different from a program that  
arranges the display into the grid of tiles . . .

Therefore the Application resides over existing applications without replacing any of them;  
rather it enables them to be called from the grid itself. The Application, therefore, becomes a

*Ex. 2066 ('522 App.) at 10, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

present invention. A grid 1 consisting of a 3 by 3 matrix of nine tiles demonstrates some of the different contents that tiles can display. Tile 10 points to a database of stock quotes. Tile 20 displays the active folders in an electronic mail utility. Tile 30 displays a portion of an alphabetical list of quoted companies. Tiles 40, 50, 60, 70 and 80 point to websites displaying, respectively, high technology news, electronic goods for sale, categories of business news, items available by auction and the Wall Street Journal. Tile 90 points to the

*Ex. 1002 ('325 App.) at 16, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

For example, for locally stored word processing or spread sheet files, the user might configure the tiles to refresh only when the underlying data is written to the local hard drive.

*Ex. 1002 ('325 App.) at 24, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

present invention. A grid 1 consisting of a 3 by 3 matrix of nine tiles demonstrates some of the different contents that tiles can display. Tile 10 points to a database of stock quotes. Tile 20 displays the active folders in an electronic mail utility. Tile 30 displays a portion of an alphabetical list of quoted companies. Tiles 40, 50, 60, 70 and 80 point to websites displaying, respectively, high technology news, electronic goods for sale, categories of business news, items available by auction and the Wall Street Journal. Tile 90 points to the

*Ex. 1002 ('325 App.) at 16, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

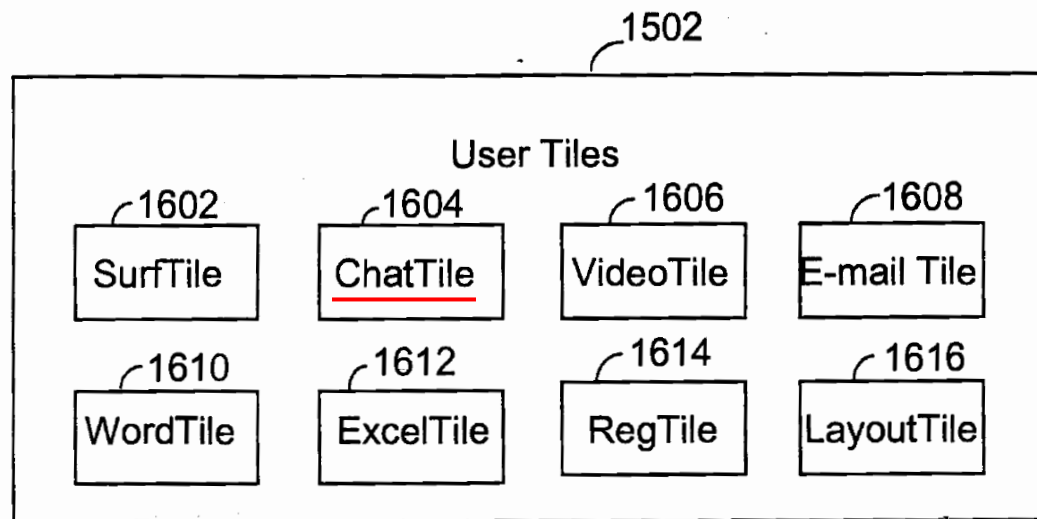
Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

The graphical environment is uniform with respect to the source of accessed information and can manage multiple streams of content, entirely of the user's choice. For example, the invention presents video clips, e-mail messages, television shows, Internet sites, application programs, data files and folders, live video streams, music, radio shows, and any other form

*Ex. 1002 ('325 App.) at 13, cited in Paper 28 (Mot Con Am) at 6-7*

# Conditional Amendment

Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.



*Ex. 1002 ('325 App.) at Fig. 16, cited in Paper 28 (Mot Con Am) at 6-7*



# Conditional Amendment

Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

**different contents that tiles can display. Tile 10 points to a database of stock quotes. Tile 20 displays the active folders in an electronic mail utility. Tile 30 displays a portion of an alphabetical list of quoted companies. Tiles 40, 50, 60, 70 and 80 point to websites displaying,**

*Ex. 2066 ('522 App.) at 12, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

Tiles are selectable and live. When a tile is selected, whether by mouse click or otherwise, the tile instantly provides the user with access to the underlying data, whether that data be 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

*Ex. 2066 ('522 App.) at 9, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

Figure 6(d) shows an arrangement of tiles in which different application programs associated with three of the tiles are depicted. Tile 302-3-2 links to a file viewer displaying a specific file; tile 302-N-1 presents streaming video; Tile 302-N-M depicts a page of information on the world wide web.

*Ex. 2066 ('522 App.) at 17, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

Claim Language: wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player.

care to watch one of them closely. An Internet user may wish to be continually in touch with sources of data from audio, video, chat-room, video-conferencing and e-mail checker utilities

*Ex. 2066 ('522 App.) at 6, cited in Paper 28 (Mot Con Am) at 6*

# Conditional Amendment

Claim Language: said grid of tiles being persistent  
from session to session

password would not be useful. Exhibit 2063 ¶ 33f. As used herein, when used with respect to a tile, “persistent” means that at least the tile’s position in a grid or array, the tile’s refresh rate, and a source of information associated with the tile are maintained from session to session. Exhibit 2063 ¶ 33e.

*Paper No. 28 (Mot. Am.) at 5*

8. In my view, Patent Owner’s proposed construction that “persistent,” as used with respect to a tile, means that “at least the tile’s position in a grid or array, the tile’s refresh rate, and a source of information associated with the tile are maintained from session to session” (Paper No. 28, “Motion” at 5), is all that was required to understand the limitation “said grid of tiles being persistent from session to session”.

*Exhibit 2081 (Weadock Decl.) ¶ 8, cited in Paper 62 (PO Reply) at 1*

# Conditional Amendment

Claim Language: wherein said tiles are selectable by a user,  
and wherein selecting a tile calls an  
assigned application program to  
provide access to information

Below is a listing of amended claims. All claim terms added by the following amendments have their plain and ordinary meaning unless specifically addressed herein.

*Paper No. 28 at 1*

On this record, we determine that the broadest reasonable interpretation for “tile” in the context of the specification of the ’403 patent is “*a graphical user interface element whose content may be refreshed and that, when selected, provides access to an information source.*”

*Paper No. 19 at 9*

# Conditional Amendment

## References Specifically Addressed in the Motion:

MSIE Kit	Nadan
Duperouzzel	Nawaz
Duhault II	Hasset
Chen	Kostes
Duhault I	Ultrix Windows Manager
Farber	Motorola Envoy
Brown	Nokia

*Paper No. 28 (Mot Con Am) at 7-13*

# Conditional Amendment

## References Cited in Microsoft's Opposition:

A) Myers (cited for failure to analyze)

B) MSIE Kit

A) Kostas

*Paper No. 46 at 4-5 and 9-15*



# Conditional Amendment

Myers Does Not Disclose “wherein selecting a tile calls an assigned application program to provide access to information”

*Paper 62 (PO Reply) at 3*

Q Okay. Now, one thing that's clear, and particularly from the passage at page 4 we discussed, which states that the Sapphire icons and windows exist at the same time, is that you can't use the icons to call an application program; isn't that correct?

MR. MICALLEF: Object to form; incomplete hypothetical.

THE WITNESS: That gets to the ambiguity of "call." All right. So if I click on an icon in order to turn that window into the listener, you can certainly see that as a -- as a step towards calling that application program, right. So again, if I make a particular window a listener and now I start typing, that application program is now going to be called to receive the typing that I'm doing.

BY MR. HEINTZ: Q You can't use an icon to launch an application, could you? A Sapphire icon?

A Correct.

*Ex. 1113 (Karger Tr.) at 170:7-171:3, cited in Paper 62 (PO Reply) at 3*

# Conditional Amendment

Myers Does Not Disclose “said tiles being persistent from session to session”

*Paper 62 (PO Reply) at 3*

The icons in the icon window are not rearranged except on user command. Thus, when a window is deleted, its icon is deleted, but the hole is not filled until another window is created.

*Ex. 1066 (Myers) at 7, col. 2,  
cited in Ex. 2081 (Weadock Decl.) at ¶ 97,  
cited in Paper 62 (PO Reply) at 3*

# Conditional Amendment

Myers Does Not Disclose “said tiles being persistent from session to session”

*Paper 62 (PO Reply) at 3*

Q Were there icons in the prior art that were not persistent?

A Sapphire, right, as -- again, ambiguity about persistence. But if I turned off a Sapphire machine and turned it back on, those icons are probably gone.

*Ex. 1113 (Karger Tr.) at 197:14-19, cited in Paper 62 (PO Reply) at 3*

# Conditional Amendment

## Myers Is Less Relevant Because It Is Not Alleged to be Anticipatory

*Paper 62 (PO Reply) at 3*

Q And so in any event, your opinion is that Myers, Exhibit 1066, renders claim 53 obvious, not anticipated; correct?

A That's correct. My assertion is that the claims are obvious, not anticipated.

*Ex. 1113 (Karger Tr.) at 182:20-24,  
cited in Paper 62 (PO Reply) at 3*

# Conditional Amendment

content. Desktop items are typically designed to provide summary information in a small amount of screen space. Therefore, information in desktop items often includes hyperlinks or hot spots, so users can click a designated area to open a browser window and obtain the details they want.

*Ex. 1007 (MSIE Kit) at 177, cited in Paper 27 (PO Resp) at 48*

- **Avoid using in-place navigation controls.** Active Desktop items are meant to be lightweight and therefore have no navigation controls available for the user to move backward and forward. By default, clicking a link inside an Active Desktop item creates a new browser window. The intended purpose of an

*Ex. 1007 (MSIE Kit) at 183, cited in Paper 27 (PO Resp) at 48*

## Conditional Amendment

16 Q. Okay. So if a user were to create an -- or add an  
17 Active Desktop item to his desktop and have that --  
18 configure that Active Desktop item to display a nonspecially  
19 designed website and size the Active Desktop items so it  
20 covered most of the screen, he could do so; correct?

21 A. Yes.

22 Q. Okay. If a user were to do that, would the -- what  
23 would happen if the user were to click on that Active  
24 Desktop item?

25 A. It depends what is in the HTML they're clicking on.

1 JOSEPH BELFIORE

2 Q. Okay. If they were at a -- on a portion of a web  
3 page in which no links were present, would anything happen?

4 A. No.

*Ex. 2088 (Belfiore Tr.) at 172:16-173:4, cited in Paper 62 at 4*

“wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player”

*Paper No. 28 (Mot Con Am) at 3*

62. The same problem affects the various “helper” applications that Dr. Karger discusses in ¶¶219-231 of Ex. 1110. The helper applications, be they Microsoft Chat, VDO Live Player, RealPlayer, Outlook Express, NetShow, NetMeeting, etc. – are not Active Desktop items. They may be invocable from within the Active Desktop items, but they are not themselves Active Desktop items, and the basic problem is the same as with Dr. Karger’s attempt to characterize a link within an Active Desktop item as the same thing as the Active Desktop item itself. Again, Dr. Karger glosses over the issue with wording such as

*Ex. 2081 (Weadock Decl. ) ¶ 62, cited in Paper 62 (PO Reply) at 4*

“wherein the assigned application program for the first tile and the assigned application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, and a streaming video player”

*Paper No. 28 (Mot Con Am) at 3*

63. Furthermore, the “helper” applications are not assigned to the Active Desktop item. They may be said, instead, to be assigned to the link (or other object) *inside* the Active Desktop item. So these examples of helper applications fail the “assigned” limitation as well as the “selecting” limitation, and statements such as Dr. Karger makes in Ex. 1110 at ¶ 225 (“...the Netshow streaming video application would be ‘assigned’ to a Desktop Item ...”) are incorrect on their face. If an Active Desktop item displays a website without making any hot spots, links, or controls visible within it, then such an item could not be used in any way to call any application. In contrast, a tile according to Substitute Claim 53 is a significant

*Ex. 2081 (Weadock Decl. ) ¶ 63, cited in Paper 62 (PO Reply) at 4*



## Kostes Does Not Disclose “wherein selecting a tile calls an assigned application program to provide access to information”

*Paper No. 62 at 5*

Q Sure. In paragraph 270 of your report, where you say "Each rectangular region can display content from a different information source," what are the rectangular regions you are referring to?

A This is referring to the panes of the montage view.

Q So those are what's indicated by reference numerals 508 in figure 5?

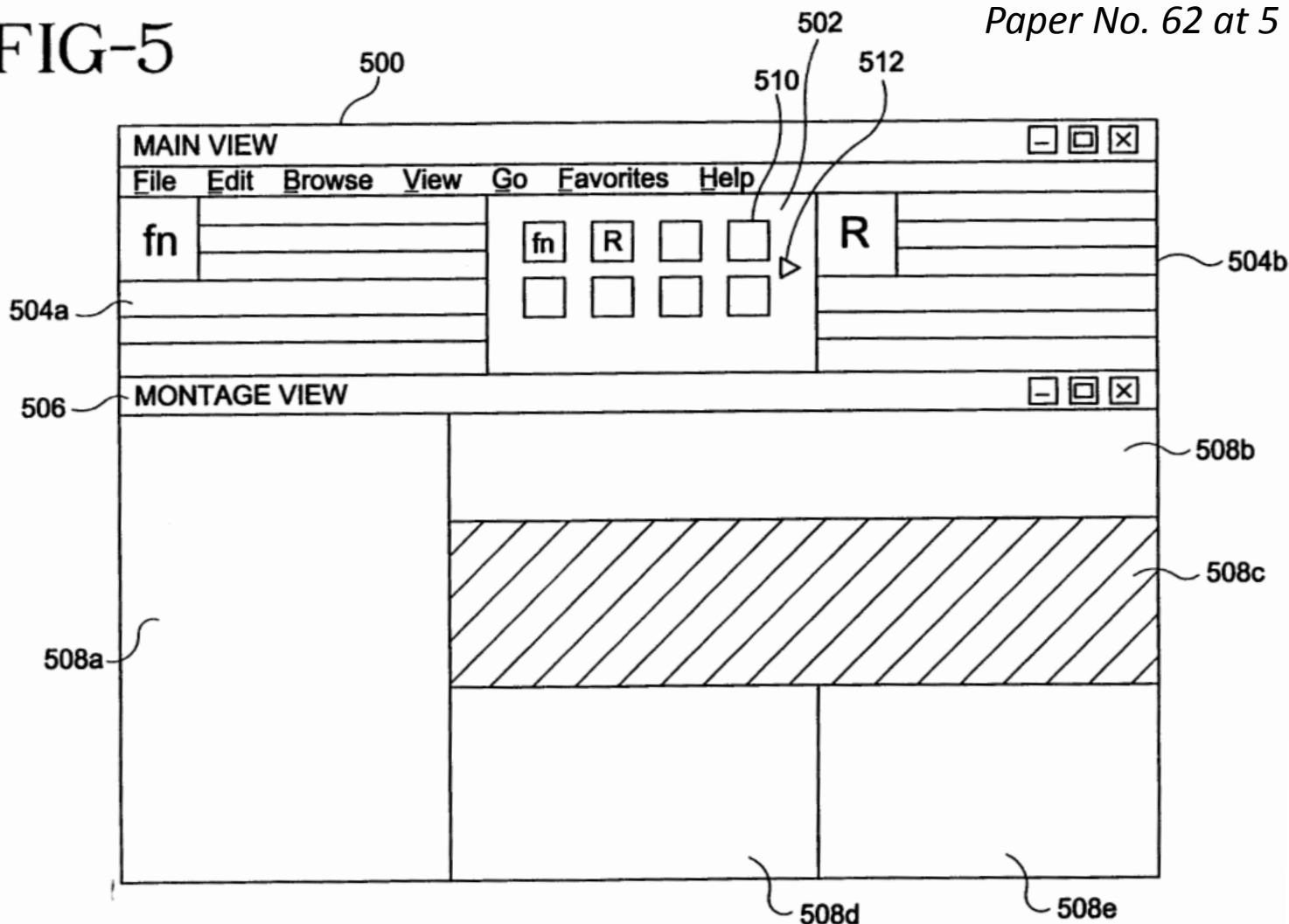
A Correct.

*Ex. 1113 (Karger Tr.) at 137:10-18, cited in Paper No. 62 at 5*

Kostes Does Not Disclose “wherein selecting a tile calls an assigned application program to provide access to information”

FIG-5

Paper No. 62 at 5



## Kostes Does Not Disclose “wherein selecting a tile calls an assigned application program to provide access to information”

*Paper No. 62 at 5*

87. I have already discussed that selecting a link within a netchannel is not the same as selecting a netchannel. As to the montage view, Kostes is silent on how the applications represented by its “rectangular regions” are invoked. This is most likely because the rectangular regions of the montage view are already activated, that is, launched and running. In other words, the montage view is essentially a collection of windows with applications running in them. See for

*Ex. 2081 (Weadock Decl. ) ¶ 87, cited in Paper No. 62 at 5*

Kostes Does Not Disclose “wherein selecting a tile calls an assigned application program to provide access to information”

*Paper No. 62 at 5*

placed.” The fact that montage view applications are already running would also explain why Kostes discloses nothing about updating the montage view applications according to a schedule; each pane is effectively a window, and the application window handles its own updates.

*Ex. 2081 (Weadock Decl. ) ¶ 87, cited in Paper No. 62 at 5*

## Kostes Does Not Disclose “wherein selecting a tile calls an assigned application program to provide access to information”

*Paper No. 62 at 5*

88. Therefore, Dr. Karger’s conclusion that one of ordinary skill in the art would understand that in order to interact with email a user must have selected the pane of Kostes, is not supported. Furthermore, Kostes cannot anticipate the substitute claims, because in Kostes there is no need to call an application assigned to the tile, given that the applications are already running and fully visible.

*Ex. 2081 (Weadock Decl. ) ¶ 88, cited in Paper No. 62 at 5*

## “None of the Additional References Alone Or In Combination Renders Claim 53 Obvious”

*Paper No. 28 at 13*

193. So, there is a fundamental distinction between operating systems and applications. Operating systems have GUIs, and whether one is using a Mac or a PC, it is generally expected that applications will adhere to the rules of the operating system’s GUI. As I wrote earlier in this declaration, and as is supported by the author which Dr. Karger repeatedly quotes, standardization and consistency are important forces in the design of user interfaces, and market forces provided (and still provide) a strong incentive for software developers to honor established standards unless substantial benefits would accrue to doing otherwise.

*Ex. 2063 (Weadock Decl. ) ¶ 193, cited in Paper 28 at 13*

# Applicable Claim Construction Standard

# Applicable Claim Construction Standard

The Office has justified the use of BRI based on the ability to amend the claims

Versata states that claim construction is a question of law and that claim terms should be accorded only one definition: that which is based on a district court interpretation standard. PO Resp. 62. There are, however, two claim construction standards: the Office's BRI construction and the district court standard set forth in *Phillips v. AWH*.<sup>3</sup> The difference in standards generally arises from the ability of an applicant or patent owner in Office proceedings to amend their claims, and the fact that there is no presumption of validity before the Office.<sup>4</sup> Through the use of the broadest reasonable interpretation standard, the Office is able to encourage inventors to amend their claims to remove uncertainties and over breadth of claim scope.

*CBM2012-00001, Paper No. 70 at 7-8*



# Applicable Claim Construction Standard

However, through the combination of the law and the rules, the ability to amend the claims in an *Inter Partes* Review has been so abrogated that it can no longer serve as justification for applicability of BRI

**(d) Amendment of the Patent.—**

**(1) In general.—** During an inter partes review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

(A) Cancel any challenged patent claim.

(B) For each challenged claim, propose a reasonable number of substitute claims.

**(2) Additional motions.—** Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317, or as permitted by regulations prescribed by the Director.

*35 U.S.C. § 316(d)*

# Applicable Claim Construction Standard

Surfcast stated that they are contemplating filing a motion to amend. The Board and Surfcast conferred on the requirements for a motion to amend. For example, a motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this proceeding, and clearly identify where the corresponding written description support in the original disclosure can be found for each claim added. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. 37 C.F.R. § 42.121. For further guidance regarding these requirements, the Board directed Surfcast to two decisions available on the Board’s website under “Representative Orders, Decisions, and Notices”: (1) IPR2012-00005, Paper 27 (June 3, 2013); and (2) IPR2012-00027, Paper 26 (June 11, 2013).

*Paper No. 25 (Order - Conduct of Proceedings) at 4*

# Applicable Claim Construction Standard

Subsection (a)(3) of 37 C.F.R. § 42.121 states that a motion to amend may cancel a challenged claim or propose a reasonable number of substitute claims, and then provides: “The presumption is that **only one substitute claim would be needed to replace each challenged claim**, and it may be rebutted by a demonstration of need.” (Emphasis added.) In addition, subsection (a)(2) of 37 C.F.R. § 42.121 states:

(2) *Scope*. A motion to amend may be denied where:

- (i) The amendment does not respond to a ground of unpatentability involved in the trial; or
- (ii) The amendment seeks to enlarge the scope of the claims of the patent or introduce new subject matter.

*IPR2012-00027, Paper No. 26 at 3-4*

# Applicable Claim Construction Standard

A patent owner should identify specifically the feature or features added to each substitute claim, as compared to the challenged claim it replaces, and come forward with technical facts and reasoning about those feature(s), including construction of new claim terms, sufficient to persuade the Board that the proposed substitute claim is patentable over the prior art of record, and over prior art not of record but known to the patent owner. The burden is not on the petitioner to show unpatentability, but on the patent owner to show patentable distinction over the prior art of record and also prior art known to the patent owner. Some representation should be made about the specific technical disclosure of the closest prior art known to the patent owner, and not just a conclusory remark that no prior art known to the patent owner renders obvious the proposed substitute claims.

*IPR2012-00027, Paper No. 26 at 7*

# Applicable Claim Construction Standard

Regarding patentability, however, it is insufficient for the movant, in a motion to amend claims, simply to explain why the proposed substitute claims are patentable on the basis of which the Board instituted review. See *Idle Free v. Bergstrom*, IPR2012-00027, Paper 26 at 7. Apart from the particular prior art references cited in a decision to institute, the movant must explain why it believes the claimed subject matter is patentable. It would not be persuasive simply to say that none of the prior art references of record discloses the combination claimed, or that no such specific combination is known to the movant. Similarly, it would not be persuasive simply to say that the prior art of record would not have rendered the subject matter of the substitute claims obvious.

*IPR2013-00318, Paper No. 22 at 4-5*

# Applicable Claim Construction Standard

The Board further discussed Patent Owner's stated intention of proposing substitute claims for two independent claims in each case. Paper 13/16. In this capacity, Patent Owner also referred to dependent claims that "will also be impacted by the proposed substitute" of independent claims. *Id.* In other words, Patent Owner suggested the possibility of detaching "claim trees" that hang from original independent claims and grafting those claim trees onto newly proposed substitute independent claims. *Id.* This strategy may cause Patent Owner difficulty in complying with the fifteen-page limit for a motion to amend. *See Idle Free*, IPR2012-00027, Paper 26 at 6-10, Paper 27 at 2. The Board, therefore, recommended that the Patent Owner carefully consider the number of proposed substitute claims it desires to pursue. *See also ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 at 3-4.

*IPR2013-00318, Paper No. 22 at 5-6*

# Applicable Claim Construction Standard

another proceeding before the Office. Because an *inter partes* review is more adjudicatory than examinational in nature, that review is not the proper place to pursue a complete remodeling of claim structure. Patent Owner has options to do so otherwise, such as by filing a request for *ex parte* reexamination or by filing a reissue application.

*IPR2013-00318, Paper No. 22 at 6*

# Applicable Claim Construction Standard

Only one motion to amend has been granted to date, and that motion was not opposed by the Petitioner.

Patent Owner did not file a Patent Owner Response, but only filed a Motion to Amend. Paper 10 (“Mot.”).<sup>1</sup> Petitioner did not file an Opposition to the Motion to Amend. In a conference call, held on February 3, 2014, both parties confirmed that they did not intend to file any additional substantive papers, and would not request an oral hearing. Paper 11.

*IPR2013-00124, Paper No. 12 at 2*

Even though unopposed, not all amendments were granted.

FURTHER ORDERED that Patent Owner’s Motion to Amend is *granted* as to substitute claims 27-44, but *denied* as to substitute claim 45;

*IPR2013-00124, Paper No. 12 at 19*



# Applicable Claim Construction Standard

Patent Owner appreciates and understands the need for a “just” and speedy resolution and that the Board’s time is limited.

We appreciate that the “just” resolution of the proceeding consideration supports allowing a patent owner an opportunity to propose a substitute claim for each challenged claim, and also recognize that every substitute claim to be briefed by the parties and analyzed by the Board adds to the cost of the review in terms of both time and expense. The Board seeks to streamline and converge issues at all phases of the proceeding. For example, at time of institution the Board analyzes

*IPR2012-00027, Paper No. 26 at 4*

# Applicable Claim Construction Standard

The arguments on the conditional amendment, however, highlight the severe restrictions placed on patentees when trying to amend, which makes applying the BRI unfair to the Patent Owner.

Accordingly, Patent Owner requests that the district court claim construction standard be applied. In parallel litigation, a district court issued a claim construction for the '403 patent as set forth in Exhibit 2082.