

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

SURFCAST, INC.
Patent Owner

Patent No. 6,724,403

Issued: April 20, 2004

Filed: October 30, 2000

Inventors: Ovid Santoro *et al.*

Title: SYSTEM AND METHOD FOR SIMULTANEOUS DISPLAY OF
INFORMATION SOURCES

Inter Partes Review Nos. IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295

Before MICHAEL P. TIERNEY, JONI Y. CHANG, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

PETITIONER'S LIST OF PROPOSED MOTIONS

I. PETITIONER’S PROPOSED MOTIONS

A. Motion 1 – Supplemental Information Under 37 C.F.R. § 42.123

Pursuant to 37 C.F.R. § 42.123(a)(1), Petitioner requests authorization to file a motion to submit the following supplemental information:

1. Non-Confidential Portions of the Transcript and Exhibits from the Deposition of Certain Witnesses in Case No. 2:12-CV-00333-JAW Taken After the Filing of the Present Petitions.¹

(1) The deposition transcript of Ovid Santoro, one of the named inventors of the ’403 patent, was taken on August 21, 2013 (after filing the Petition), and is relevant to the claims and grounds for which trial has been instituted and to Patent Owner’s asserted early invention date. For example, the non-confidential portions of Mr. Santoro’s deposition transcript contain admissions by the inventor about the teachings in and the relevance to the ’403 patent claims of prior art described in Ex. Nos. 1007 (“MSIE Kit”) and 1011 (“Duperrouzel”) each of which was relied upon by the Board to institute an *inter partes* review.

¹ Portions of these depositions are presently subject to a Confidentiality Order in the parallel Case No. 2:12-CV-00333-JAW, so Petitioner is not at liberty to submit the non-confidential portions at this time. Petitioner also asks below, however, for permission to move that Patent Owner be required to produce the complete transcripts with all exhibits in these proceedings.

(2) The deposition transcripts of Klaus Lagermann, taken on June 27, 2013 and August 20, 2013 (after filing the present Petitions), are relevant to the claims and grounds for which trial has been instituted and to Patent Owner's asserted early invention date. For example, the non-confidential portions of these deposition transcripts contain admissions by one of the inventors of the '403 patent on the teachings in and the relevance to the '403 patent claims of the prior art described in Ex. Nos. 1007 ("MSIE Kit") and 1011 ("Duperrouzel") each of which was relied upon by the Board to institute an *inter partes* review;

(3) The deposition of Richard Bone, taken on July 2, 2013 (after filing the present Petitions), is relevant to Patent Owner's asserted earlier invention date. Richard Bone was identified by Patent Owner as a custodian of evidence related to the alleged conception, diligence, and/or reduction to practice of the claimed invention, and his deposition testimony concerns such evidence.

(4) Deposition of Dixon Chan Dick, which was taken on July 19, 2013 (after filing the Petition), is relevant to Patent Owner's asserted earlier invention date. Dixon Chan Dick was identified by Patent Owner as a putative corroborating witness for the alleged conception, diligence, and/or

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

reduction to practice of the invention, and his deposition testimony concerns such evidence.

2. Information Incorporated By Reference Into Certain Prior Art Relied Upon By The Board In Its Institution Of Trial

The information listed below are relevant to the claims and grounds for which trial has been instituted. Specifically, the information was incorporated by reference into Ex. 1015 (US 5,432,932 to Chen), Ex. 1007 (MSIE Kit), and Ex. 1030 (US 6,278,448 to Brown), each of which is prior art relied on by the Board to institute trial. Although this information is already of record by the nature of “incorporation by reference,” Petitioner seeks to have the Board issue an order authorizing submission of such information to have a complete record. The specific materials incorporated by reference are as follows:

(1) Materials incorporated by reference in Ex. 1015 (Chen), include: (a) OSF/Motif Style Guide, Revision 1.1 dated 1991, (b) related patent applications (07/713,484, 07/713,471, 07/713,486, 07/965,982, 07/965,956, 07/965,959, 07/965,960, 07/965,981, 07/965,953), (c) RFCs related to the simple network management protocol (RFC 1098, RFC 1067, RFC 1065, RFC 1066, RFC 1227), and (d) Oracle for IBM RISC System/6000 Installation and User’s Guide, ver 6.0, part number 5687-

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

v6.0.31, dated 1991. Each of these documents is relevant to the claims for which trial has been instituted because each provides background information related to the Board's conclusions on what is taught or disclosed in Ex. 1015 (Chen). For example, the OSF/Motif Style Guide provides further support to the Board's positions with respect to "tiles" and "selection." *See, e.g.*, pages 4-4, 4-5, 4-34, 7-58, 7-59, 7-79, and 7-80 of OSF/Motif Style Guide.

(2) The CD distributed with the MSIE Kit (Ex. 1007) is relevant to the claims for which trial has been instituted. For example, the CD includes the Active Desktop "SDK" documentation that provides additional detail on CDF files and Internet Explorer 4, which are discussed and described in Ex. 1007 at 921 and 922.

(3) The publication *Inside Dynamic HTML*, Microsoft Press, Oct. 30, 1997, which is incorporated by reference by Ex. 1030 (Brown), is relevant to the claims for which trial has been instituted because it includes additional documentation of the CDF file format being discussed in Brown.

B. Motion 2 – Order to Produce Entire Deposition Transcripts and Exhibits Thereof

With respect to the deposition transcripts and exhibits for the depositions listed above (Ovid Santoro, Klaus Lagerman, Richard Bone, and Dixon Chan

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

Dick), Petitioner's Motion 2 seeks to have the Board order Patent Owner to produce the entire deposition transcripts and exhibits thereof in the *inter partes* review. Confidential portions of the transcripts and confidential exhibits to the depositions are relevant to the grounds for which trial has been instituted. For example, they are relevant to Patent Owner's contentions of an earlier invention date, as well as to any evidence Patent Owner may advance regarding the alleged conception, diligence, and/or reduction to practice of the claimed invention. Confidential portions of the deposition transcripts and confidential exhibits to the depositions also contain admissions by the inventors of the '403 patent on the teachings in and the relevance to the '403 patent claims of the prior art described in Ex. Nos. 1007 ("MSIE Kit") and 1011 ("Duperrouzel") each of which was relied upon by the Board to institute an *inter partes* review. Petitioner agrees to have these confidential materials be governed by the Board's standard protective order.

C. Motion 3 – Claims that Stand or Fall Together

The Board found sufficient grounds on which to proceed for each of the dependent claims of the '403 patent based on the petition filed by Petitioner. These dependent claims specify nothing more than conventional steps or obvious design choices relative to the independent claims from which they depend. Indeed, in its preliminary response, Patent Owner failed to identify any reason why the

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

additional features recited in these dependent claims could render the claims from which they depend independently patentable. In particular, with the exception of dependent claims 4, 5, 7, 10, 31, 32, 42, and 49, Patent Owner's arguments as to every other dependent claim (*i.e.*, claims 2, 3, 6, 8, 9, 11-21, 23-30, 33-41, 43-45, 47, 48, and 50-52) merely recites the features of the independent claims from which they depend. Consequently, if the parent claim from which these claims depend is held unpatentable, the dependent claims also would be unpatentable.

Petitioner's Motion 3 thus seeks an order from the Board finding the following claims unpatentable over claims from which they depend, either directly or indirectly; namely:

- claims 2, 3, 6, 8, 9, and 11-21 relative to claim 1,
- claims 23-30, 33-41, and 43-45 relative to claim 22, and
- claims 47, 48, and 50-52 relative to claim 46.

The order sought by Petitioner would employ the well-established practice of the Board in contested cases and in *ex parte* appeals of using representative claims to determine the patentability of related dependent claims, and will lessen the burden on the Board in conducting these proceedings. Consequently, Petitioner submits this proposed motion is proper and should be authorized.

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

**D. Motion 4 – Order Regarding Discovery of Alleged Conception
and Reduction to Practice of the Invention**

In its Preliminary Responses, Patent Owner states:

*Patent Owner intends to establish, by Declaration under 37
C.F.R § 1.131, inventive acts prior to the effective date of
Duhault II showing that it is not prior art to the '403 Patent.*

See, e.g., Patent Owner Preliminary Response (IPR2013-00292, Paper No. 18) at 42. Patent Owner has thus stated it intends to present certain evidence supporting its contention that it had conceived and reduced to practice the claimed invention prior to the effective filing date of at least one of the prior art references relied on by the Board to institute this trial.

Petitioner is entitled, under the “routine discovery” provisions of 37 C.F.R. § 42.51(b)(1), to take the deposition of the inventors and any custodian of evidence and/or corroborating witness for the alleged conception, diligence, and reduction to practice of the invention, as well as the production of all documents relating to conception, diligence, and reduction to practice. Out of an abundance of caution and to avoid a future dispute that might prejudice Petitioner’s ability to obtain this discovery during its discovery period, Petitioner’s Motion 4 seeks to have the Board authorize this routine discovery now, or to confirm that Petitioner is entitled to this scope of discovery under the “routine discovery” provisions of 37

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

C.F.R. § 42.51(b)(1).

E. Motion 5 – Certain Grounds Denied As Redundant

The Board instituted *inter partes* review of claims 1-13, 17-28, 30-33, 35-37, 39-43, and 46-50 as being anticipated by Ex. 1014 (Duhault II) under 35 U.S.C. §102. *See, e.g.*, Decision to Institute (IPR2013-00292, Paper No. 19) at 40. Petitioner identified other grounds for anticipation for these claims, including grounds based on an earlier filed patent to Duhault II, *i.e.*, Duhault I (Ex. 1013). Those asserted grounds, however, were denied “as redundant in light of the determination that there is a reasonable likelihood that the challenged claims are unpatentable based on the grounds of unpatentability on which we institute an *inter partes* review.” *See id.* at 38-40. Consequently, Ex. 1014 (Duhault II) is the only reference relied upon by the Board to find claims 4, 17, 18, 20, 23-26, 28, 31, 33, 35, and 36 anticipated in this trial.

In its preliminary response, the Patent Owner stated that it “intends to establish, by Declaration under 37 C.F.R § 1.131, inventive acts prior to the effective date of Duhault II showing that it is not prior art to the ’403 Patent.” *See, e.g.*, Patent Owner Preliminary Response (IPR2013-00292, Paper No. 18) at 42. Given Patent Owner’s assertion that it intends to antedate Duhault II (Ex.1014) as prior art, Petitioner’s Motion 5 seeks an order from the Board enlarging the scope

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

of the present trial to include the following grounds for this trial that are based on anticipation:

- claims 4, 18, 23, 24, 26, 31, 33, 35, and 36 are unpatentable under 35 U.S.C. §102 as anticipated by Duhault I (Ex. 1013),
- claims 17, 20, 25, and 28 are unpatentable under 35 U.S.C. §102 as anticipated by Farber (Ex. 1016).

* * * * *

Petitioner respectfully requests the Board to authorize motions 1 to 5 specified above. If the grounds for trial are modified, or if Patent Owner seeks to amend the claims during this proceeding, Petitioner reserves the right to request additional motions as appropriate. Petitioner also reserves the right to file opposition(s) to Patent Owner's motion(s) as permitted under the appropriate rules.

Dated: December 10, 2013

Respectfully Submitted,

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Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

CERTIFICATE OF SERVICE

I hereby certify that on this 10th day of December 2013, a copy of this
PETITIONER'S LIST OF PROPOSED MOTIONS has been served in its entirety
by e-mail on the following counsel of record for Patent Owner:

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