

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*.

**REQUEST FOR REHEARING REGARDING CERTAIN GROUNDS
DENIED AS REDUNDANT**

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
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As invited by the Board during the initial conference call on December 12, 2013, and pursuant to 37 CFR § 42.71(d)(2), Petitioner requests a rehearing as to the Board's decision not to institute *inter partes* review with respect to certain references the Board found 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 two patents that were filed earlier than Duhault II – specifically, Farber (Ex. 1016) and 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. On December 10, 2013, Microsoft filed its List of Proposed Motions; Motion 5 on that list sought an order enlarging the scope of the present trial to include grounds based on anticipation for both Duhault I and Farber. *See* Petitioner's List of Proposed Motions (IPR2013-00292, IPR2013-00293, IPR2013-00294, and IPR2013-00295, Paper 21) at 9-10. On the initial conference call, the Board denied that Motion, but invited Petitioner to submit a Request for Rehearing.

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Presently, 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. However, 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 attempt to antedate Duhault II (Ex.1014) as prior art, Petitioner’s respectfully submits that Grounds asserting anticipation based on Duhault I and Farber are not redundant, since Patent Owner has made no indication that it will attempt to prove (and apparently cannot prove in any event) a date of invention early enough to remove Duhault I or Farber as prior art. Put another way, should Patent Owner successfully demonstrate a date of invention early enough to remove Duhault II as prior art, then Duhault I and Farber could not be redundant, since in that event no other reference would be before the Board on which claims 4, 18, 23, 24, 26, 31, 33, 35, and 36 could be found unpatentable and no other reference would be before the Board on which claims 17, 20, 25, and 28 could be found unpatentable as anticipated.

Importantly, Patent Owner has acknowledged that the teachings of Duhault I are effectively the same relative to the claims as the teachings in Duhault II. *See,*

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e.g., IPR2013-00292, Paper No. 18, Patent Owner Preliminary Response at 38 (“the disclosure of Duhault I is redundant in the face of the disclosure of Duhault II...”). Because Patent Owner has not suggested it can antedate Duhault I, an unjust outcome is possible if Patent Owner successfully demonstrates a date of invention early enough to remove Duhault II as prior art, because the Board may ultimately not resolve the patentability issues that it has found to exist for a number of claims based on the admittedly common teachings of the Duhault I and II references.

Accordingly, Petitioner hereby respectfully moves for rehearing and institution of trial on (i) those Ground in Petitioner’s original petitions asserting claims of the ‘403 Patent are unpatentable under 35 U.S.C. §102 as anticipated by Duhault I and (ii) also those Ground in Petitioner’s original petitions asserting claims of the ‘403 Patent are unpatentable under 35 U.S.C. §102 as anticipated by Farber.

Petitioner therefore seeks an order from the Board enlarging the scope of the present trial to include the following grounds for this trial:

- (i) Claims 1, 3-5, 7-13, 18, 19, 21-24, 26, 27, 30-33, 35-37, 40-43, and 46-50 are anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,118,493 to Duhault (“Duhault I”) (Ex. 1013);

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- (ii) Claims 1, 17, 20, 22, 25 and 28 are anticipated under § 102(a), 102(b), and § 102(e) by U.S. Patent No. 5,819,284 to Farber et al. (“Farber”) (Ex. 1016);¹

¹ Petitioner notes that it has included in its request herein all of the claims of the '403 Patent against which Duhault I and Farber were originally asserted as anticipating in Petitioners petitions because that would seem to be the most efficient use of the Board's time. For example, if the Board were to grant rehearing and institute on the ground that claim 17 of the '403 Patent is anticipated by Farber, it would necessarily have to apply Farber against all of the elements of claim 1, the independent claim from which claim 17 depends. Similarly, if the Board were to grant rehearing and institute on the basis of Duhault I, it would be efficient to apply Duhault I against all of the claims that reference was asserted against as anticipating in Petitioner's original petitions.

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IPR2013-00294, and IPR2013-00295
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For the reasons provided above, Petitioner respectfully requests that its request for rehearing be granted and an order enlarging the scope of the trial in these consolidated proceedings be entered.

Dated: December 19, 2013

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 19th day of December 2013, a copy of this
REQUEST FOR REHEARING REGARDING CERTAIN GROUNDS DENIED
AS REDUNDANT has been served in its entirety by e-mail on the following
counsel of record for Patent Owner:

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