

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

SURFCAST, INC.
Patent Owner.

Case IPR2013-00292¹
Patent 6,724,403

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

TIERNEY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

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

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
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An initial conference call in the above proceeding was held on December 12, 2013, between respective counsel for Petitioner and Patent Owner, and Judges Tierney, Chang and Clements. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 20) and any motions that the parties intend to file. Prior to the call, both Patent Owner and Petitioner filed lists of proposed motions. Papers 21 and 22. The following issues were discussed.

Microsoft's Proposed Motions

1. Motion to Submit Supplemental Information

Microsoft requested authorization to file a motion to submit supplemental information concerning portions of transcripts and exhibits from the deposition of certain witnesses taken in connection with a related district court proceeding. The motion would also seek to file materials that are “incorporated by reference” into three specific exhibits already of record.

Microsoft agreed during the conference call that the evidence sought to be filed might instead be filed as evidence in connection with a Reply to a Patent Owner Response. Accordingly, Microsoft's request to file a motion to submit supplemental information was not authorized.

2. Motion for Additional Discovery

Microsoft sought additional discovery with respect to deposition transcripts and exhibits relevant to Surfcast's potential earlier conception, diligence, and/or reduction to practice of the claimed invention. Microsoft's request is premature at

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this time. Specifically, Surfcaster has not yet filed its Patent Owner Response and has not yet sought to antedate the prior art relied upon in the Decision to Institute. Should Surfcaster seek to antedate the prior art, Surfcaster is required to provide the evidentiary basis supporting its allegations. Accordingly, Microsoft's request for additional discovery is dismissed without prejudice as the request is premature.

3. Motion Seeking to Have Surfcaster's Claims Stand or Fall Together

Microsoft seeks to file a motion that would hold certain Surfcaster claims as unpatentable over the claims from which they depend. Surfcaster disagreed with Microsoft's proposal contending that it is premature to determine whether claims stand or fall together as Surfcaster has not yet filed a Patent Owner Response. Further, Surfcaster indicated that each of its claims was patentable on its own merits.

The Board denied authorization to file a motion to have Surfcaster's claims stand or fall together at this time. The Board, however, did request that the parties confer as to how best to streamline the proceeding and contact the Board should the parties agree on suggested approaches.

4. Motion to Enlarge the Scope of the Proceeding

Microsoft requests authorization to file a motion that would enlarge the scope of the proceeding. Specifically, the Decision to Institute denied institution of certain grounds on the basis that they were redundant. Microsoft contends that the Board should reconsider its decision holding the grounds redundant.

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The Board denied authorization to file a motion to enlarge the proceeding as Microsoft can, and did, file a request for rehearing pursuant to 37 C.F.R. § 42.71(d)(2). Paper 23.

Surfcaster's Proposed Motions

Surfcaster stated that they are contemplating filing a motion to amend. The Board and Surfcaster 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 Surfcaster 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).

Schedule

The parties agreed to discuss extending Due Date 1 amongst themselves.

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