

Filed on behalf of SurfCast, Inc.

By: Richard G. A. Bone (RBone@VLPLawGroup.com)

VLP Law Group LLP

555 Bryant Street, Suite 820

Palo Alto, CA 94301

Tel. (650) 419 2010

FAX (650) 353 5715

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

SURFCAST, INC.
Patent Owner

Case IPR2013-00292
Patent 6,724,403

PATENT OWNER'S MOTION FOR
CONDITIONAL AMENDMENT UNDER 37 C.F.R. § 42.121

I. INTRODUCTION

In the event that the Board were to find original claim 46 of U.S. Patent No. 6,724,403 (the “’403 patent”) unpatentable, Patent Owner SurfCast Inc. requests that challenged original claims 46-52 be canceled and replaced with substitute claims 53-59 set forth herein pursuant to 37 C.F.R. § 42.121. Claims 53-59 are claim-for-claim substitutions for claims 46-52, respectively, and thus are presumptively reasonable under 37 C.F.R. § 42.121(a)(3). This motion was approved by the Board during a conference call on December 9, 2013. *See also* Scheduling Order, Paper No. 25.

This amendment is responsive to grounds 1, 2, 4 and 6 listed in the Board’s Decision (Paper 19) at 40-41. This amendment does not enlarge the scope of original claims 46-52 because each of the limitations found in those original claims are also present in the respective substitute claims, except that the term “array” in original claims 46-52 has been replaced with the narrower term “grid.”

II. CLAIMS LISTING

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.

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 grid of 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, 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.

54 (substitute for claim 47). The system of claim 53 [[46]] wherein said grid array comprises more than one row and more than one column.

55 (substitute for claim 48). The system of claim 53 [[46]] wherein said processor additionally executes instructions for uniformly assigning at least one attribute of each tile in said grid array of tiles.

56 (substitute for claim 49). The system of claim 55 [[48]] wherein said attribute is a retrieval rate.

57 ((substitute for claim 50). The system of claim 53 [[46]] wherein said first retrieval rate is assigned automatically.

58 (substitute for claim 51). The system of claim 53 [[46]] wherein said processor additionally executes instructions for storing said grid array of tiles on a second device.

59 (substitute for claim 52). The system of claim 53 [[46]] wherein said processor additionally executes instructions for retrieving said grid array of tiles from a second device.

III. IDENTIFICATION OF SUPPORT IN APPLICATION

The original disclosure of the '403 patent is the originally-filed application assigned to serial no. 09/702,325 filed on October 30, 2000 ("the '325 application," Exhibit 1002). The '403 patent claims priority to provisional application no. 60/162,522, filed on October 29, 1999 ("the '522 application," Exhibit 2066). Priority to the '522 application is being sought for substitute claim 53. Accordingly, set forth below is an identification of support from both the '325 application and the '522 application for each of the limitations added to claims 53-59 (other than amendments to revise claim dependency) in conformance with 37 C.F.R. § 42.121(b)(1)-(2). In the discussion below, the format x:y-z is used to refer to page x from line y to line z, inclusive. Line numbers refer to actual line numbers, not to the numbered scale indicated on the left hand side of Exhibits 1002 and 2066.

Support for the substitute limitation "a grid" can be found in Exhibit 2066 at 9:6-7 and 11:11-12; and in Exhibit 1002 at 13:20-22 and 14:26-28.

Support for the additional limitation "that are not permitted to overlap" can be found in Exhibit 2066 at 16:22-23; and in Exhibit 1002 at 13:33-35 and 23:12-14.

Support for the additional limitation "said array being persistent from session to session" can be found in Exhibit 2066 at 17:8-22 and Fig. 7; and in

Exhibit 1002 at 24:24-32, Fig. 12, and 28:5-13. Note that in the passage in Exhibit 2066 at 17:8-22, the word “persistently” is not used explicitly. But this passage states that the “grid itself has an address 404 that specifies its location within the file system of the system’s main memory.” This indicates that the grid address is stored in a non-volatile memory such as a hard drive in the case of a personal computer. Exhibit 2063 ¶ 33d. This passage also states that the “grid also stores a tile list 416 containing attributes of each respective tile.” This indicates that the attributes of the tile are stored by the non-volatile grid in nonvolatile memory, thereby making the grid persistent. Exhibit 2063 ¶ 33e. This passage further states that the tile’s position and refresh rates are stored, and also states that a password is stored. Storing the password also signifies that the source of the information used to update the tile is one of the attributes that is stored, because otherwise a 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.

Support for the additional limitation “wherein the tiles are selectable, and wherein selecting a tile calls an assigned application program to provide access to information” can be found in Exhibit 2066 at 8:24-27; 10:22-23; 16:16-17, 17:23-25 and 18:14-15; and in Exhibit 1002 at 21:26-27; 22:1-2 and 22:15-16.

Support for the additional limitation “the assigned application program being different from a program that arranges the display into the grid of tiles that are not permitted to overlap” can be found in Exhibit 2066 at 10:22-23; and in Exhibit 1002 at 22:15-16. These passages both state that the “Application resides over existing applications without replacing any of them; rather, it enables them to be called from the grid itself.” What is being called in this sentence is the existing application. Since the existing applications are not being replaced by the Application and the Application resides over existing applications, it follows that the existing applications are different from the Application. Exhibit 2063 ¶ 35-37. The Application is the software program that provides the tiles. Exhibit 2063 ¶ 36.

Support for the additional limitation “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” can be found in Exhibit 2066 at Fig. 1 and 12:10-16 (electronic mail application 20 and web browsers 40-80); 9:29-31 (word processing application); Fig. 9, reference numerals 310, 312 and 17:5-7 (streaming video player and web browser); and 6:13-18 (chat application); and in Exhibit 1002 at Fig. 1 and 16:10-16 (electronic mail application 20 and web browsers 40-80); 24:9-10 (word processing application); Fig. 7, reference numerals

712,714 and 13:28-29 (streaming video player and web browser); and 19:12-17 and Fig. 16 (chat application).

IV. PATENTABILITY OF SUBSTITUTE CLAIMS

Set forth below is a detailed explanation as to why substitute claim 53 is patentably distinct from the references relied on in the grounds that are the subject of this *inter partes* review and from the prior art “in general” pursuant to 37 C.F.R. § 42.20(c) as that regulation has been interpreted by the Board. *See, e.g.*, IPR2012-00027, paper 66, at 33.

A. Identification of References Analyzed Herein

Patent Owner respectfully submits that it has made a good faith attempt to identify the references (“references” is used herein because the status as prior art of at least one reference asserted by Petitioner in this trial is contested) most relevant to substitute claim 53 for analysis herein. Patent Owner has considered the 69 documents and online materials identified by Petitioner in the Petition and the co-pending district court litigation, the alleged prior art cited in the original prosecution of the ’403 patent, and a corresponding European patent application (WO 96/20470) to identify references most relevant to the proposed amendment.

Patent Owner believes that the most relevant of the known references discussed above include MSIE Kit (Ex. 1007), Duperrouzel (Ex. 1011), Duhault II (Ex. 1014), Chen (Ex. 1015), Duhault I (Ex. 1013), Farber (Ex. 1016), Brown (Ex.

10), Nadan (Ex. 1020), Nawaz (Ex. 1018), Hasset (Ex. 1017), Kostas (Ex. 1051), the Ultrix Window Manager for X windows (Ex. 1067), the Motorola Envoy (Ex. 1061), and Nokia (Ex. 1060) (collectively, the “Analyzed References”). Substitute claim 53 is patentable over all of the Analyzed references, alone or in combination, for the reasons discussed below.

B. Claim 53 is Not Anticipated By Any Analyzed Reference

Patent Owner respectfully submits that none of the Analyzed References anticipates substitute claim 53 for the reasons set forth below. Detailed support for the following reasons are provided by Patent Owner’s expert as set forth in Exhibit 2063.

MSIE Kit does not disclose “a grid of tiles that are not permitted to overlap”; “wherein the tiles are selectable, and wherein selecting a tile calls an assigned application program to provide access to information” or “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. 2063 ¶¶ 89-97.

Duperrouzel does not disclose “said grid of tiles being persistent from session to session”; “wherein the tiles are selectable, 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” or “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.” Exhibit 2063 ¶¶ 109-118.

Duhault I and II do not disclose “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” or “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.” Exhibit 2063 ¶¶ 130-135; 66-75.

Duhault II also does not disclose “said grid of tiles being persistent from session to session.” Exhibit 2063 ¶ 65.

Chen does not disclose “wherein the tiles are selectable, 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” or “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.”

Exhibit 2063 ¶¶ 76 -81.

Farber does not disclose “wherein the tiles are selectable, and wherein selecting a tile calls an assigned application program to provide access to information ...” or “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.” Exhibit 2063 ¶¶ 136-144.

Brown does not disclose “a grid of tiles that are not permitted to overlap, said grid of tiles being persistent from session to session”; “wherein the tiles are selectable, and wherein selecting a tile calls an assigned application program to provide access to information ...” or “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.” Exhibit 2063 ¶¶ 98 – 107.

Nadan does not disclose “wherein the tiles are selectable, 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” or that “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.” Exhibit 2063 ¶¶ 149 - 155.

Nawaz does not disclose “a grid array of tiles that are not permitted to overlap, said grid of tiles being persistent from session to session”; “wherein the tiles are selectable, 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” or “wherein an 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.” Exhibit 2063 ¶¶ 156-164.

Hassett does not disclose “said grid of tiles being persistent from session to session”; “wherein the tiles are selectable, 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” or “wherein an 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. 2063 ¶¶ 174-182.

Ultrix Window Manager for X windows does not disclose “wherein the tiles are selectable, and wherein selecting a tile calls an assigned application program to provide access to information” or “arrange a display into a grid of tiles that are not permitted to overlap.” Exhibit 2063 ¶¶ 145 - 148.

Motorola Envoy does not disclose “a grid of tiles . . . 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.” Exhibit 2063 ¶¶ 120 - 129.

Kostes does not disclose either “wherein” clause of substitute claim 53.

Exhibit 2063 ¶¶ 165 - 173.

Nokia does not disclose either “wherein” clause of substitute claim 53.

Exhibit 2063 ¶¶ 183 - 190.

B. None of the Additional References, Alone Or In Combination,

Renders Claim 53 Obvious

Substitute claim 53 is directed toward a system that includes a general purpose GUI that provides tiles that can call a variety of application programs. This claimed feature, together with the claimed persistence of the tiles from session to session, and the claimed difference between the application program called when a tile is selected and the program that displays the tiles, allows the system of claim 53 to act as a desktop alternative that replaces the functionality of a desktop

Exhibit 2063 ¶¶ 191, 194.

In contrast to the system of claim 53, the four primary references alleged to anticipate original claim 46 (MSIE Kit, Duperouzzel, Chen and Duhault II) all relate to special purpose application programs, systems or devices that do not include any means to call other, different application programs, and certainly not through user selection of their respective graphical elements (MSIE Kit’s Active Desktop items, Duperouzzel’s panes, Chen’s instruments, and Duhault II’s video images). Ex. 2063 ¶ 191. One of ordinary skill in the art would not modify any of

these special purpose application programs, systems and devices to call different application programs when their respective elements are selected as required by claim 53 because doing so is contrary to their design and would be contrary to a user's expectation. Such modifications would not occur to a person of ordinary skill, for the simple reason that it was well known in the art that applications do specific things – they are, to oversimplify somewhat, “where the work gets done” – and GUIs provide a platform from which to call, or invoke, applications. Adding a grid of tiles capable of being selected to call assigned applications that are different would not have added useful functionality or utility to inventions such as Duperrouzel, Duhault II and Chen. Ex. 2063 ¶ 194. There is no suggestion in *any* of the primary references put forth by Petitioner that an operating-system-like capability to call additional, different application programs would be useful in the context of the inventions described by those references. Ex. 2063 ¶ 194.

Modifying the other relevant prior art to arrive at the system of claim 53 would likewise not be obvious. For example, the fact that X Windows does not distinguish between an icon and a window is contrary to the need for a grid of tiles as set forth in claim 53. Exhibit 2063 ¶ 196. Thus, there would be no motivation for combining the teachings of X Windows with any of the prior art relevant to claim 53. Moreover, the Envoy's specific use of a pictorial representation of a desk and in and out boxes are contrary to the other relevant art's use of windows,

scrolling and/or floating headlines to display information to the user. Thus, one of ordinary skill in the art would not be motivated to incorporate this or any feature of the Envoy into the special purpose application programs, systems or devices in the relevant prior art, or vice versa. Exhibit 2063 ¶ 196. The screen saver (Hassett, Farber) and stock trading station (Nawaz) art, as well as Nadan, Kostas and Nokia are so specific and different from the other relevant prior art that one of ordinary skill in the art would not be motivated to incorporate any feature from these references into other special purpose applications/systems. Thus, it would not be obvious to combine the additional prior art with each other or with the primary art to achieve claim 53. Exhibit 2063 ¶ 194.

Lastly, even assuming it were possible to cherry-pick specific features of the various references considered above to arrive at the particular features found in substitute claim 53, there were powerful market forces that would have discouraged one of ordinary skill in the art from doing so. Ex. 2063, ¶ 196. In particular, the movement in the art toward standardization and the powerful market forces driving that movement would have led one of ordinary skill in the art in a direction away from the invention of substitute claim 53. Exhibit 2063 ¶ 196.

V. CONCLUSION

If the Board finds claim 46 unpatentable, Patent Owner requests that original claims 46-52 be replaced with substitute claim 53-59 set forth herein.

Respectfully submitted by:

/Richard G. A. Bone/

Dated: January 24, 2014

RICHARD G. A. BONE, Reg. No. 56,637

VLP Law Group LLP

555 Bryant St., Suite 820

Palo Alto, CA 94303

Telephone: (650) 419-2010

Facsimile: (650) 353-5715

RBone@VLPLawGroup.com;

Patents@VLPLawGroup.com

Attorney for SurfCast, Inc.

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

It is hereby certified that on this 24th day of January, 2014, a copy of the foregoing

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was served via Electronic Mail, as “.pdf” attachment(s), upon the following:

Jeffrey Kushan
jkushan@sidley.com

Joseph Micallef
jmicallef@sidley.com

Sidley Austin LLP
1501 K Street NW
Washington, DC 20005
Tel.: (202) 736-8000
Fax: (202) 736-8711
Attorneys for Petitioner, Microsoft Corporation Ltd.

By:

/Richard G. A. Bone/
Richard G. A. Bone
Reg. No. 56,637