

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,
MATTHEW R. CLEMENTS, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71

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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On December 19, 2013, Microsoft Corporation (“Petitioner”) filed a request for rehearing (Paper 23, “Req.”)² of the Board’s decision (Paper 19, “Dec.”), dated November 19, 2013, which instituted *inter partes* review of claims 1-52 of SurfCast’s (“Patent Owner”) U.S. Patent No. 6,724,403 (“the ’403 patent”). The Board granted Petitioner’s petition filed May 22, 2013, and instituted *inter partes* review of:

1. Claims 1-13, 17-28, 30-33, 35-37, 39-43, and 46-50 under 35 U.S.C. § 102 as anticipated by Duhault II;
2. Claims 1, 9-11, 22, 41-43, 46, and 48-50 under 35 U.S.C. § 102 as anticipated by Chen;
3. Claim 29 under 35 U.S.C. § 103 as obvious over Chen and MSIE Kit;
4. Claims 1-3, 5-8, 11, 12, 14-16, 19, 21, 22, 27, 30, 32, 34, 37-40, 43-47, and 50-52 under 35 U.S.C. § 102 as anticipated by MSIE Kit;
5. Claims 17, 20, 25, and 28 under 35 U.S.C. § 103 as obvious over MSIE Kit and Brown;
6. Claims 1-3, 5-8, 12-14, 19, 21, 22, 27, 30, 32, 34, 37-40, 46, and 47 under 35 U.S.C. § 102 as anticipated by Duperrouzel; and

² Citations are to IPR2013-00292 unless otherwise noted.

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7. Claims 17, 20, 25, and 28 under 35 U.S.C. § 103 as obvious
over Duperrouzel and Brown.

Dec. 40-41. The Board denied all other asserted grounds as being redundant
in light of the grounds for which review was instituted for the same claims.

Dec. 41. Petitioner seeks reconsideration of the decision to deny institution
on the grounds that:

1. Claims 1, 3-5, 7-13, 18, 19, 21-24, 26, 27, 30-33, 35-37, 40-43,
and 46-50 are unpatentable as anticipated under 35 U.S.C.
§ 102(e) by U.S. Patent No. 6,118,493 (“Duhault I”) (Ex.
1013); and
2. Claims 1, 17, 20, 22, 25, and 28 are unpatentable as anticipated
under 35 U.S.C. § 102(b) by U.S. Patent No. 5,819,284
(“Farber”) (Ex. 1016).

The request for rehearing is *denied*.

ANALYSIS

When rehearing a decision on institution, the Board will review the
decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of
discretion may be determined if a decision is based on an erroneous
interpretation of law, if a factual finding is not supported by substantial
evidence, or if the decision represents an unreasonable judgment in weighing
relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir.
2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); and
In re Gartside, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

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Petitioner alleges that, if Patent Owner antedates Duhault II as it intends to (Paper 18, “Prelim. Resp.” at 42), the aforementioned non-instituted grounds will not be redundant to the instituted ground of anticipation by Duhault II (U.S. Patent No. 6,456,334) because, without Duhault II, no other reference will be before the Board on which claims 4, 18, 23, 24, 26, 31, 33, 35, and 36 could be found unpatentable, or on which claims 17, 20, 25, and 28 could be found anticipated. Req. 1-4.

The Board did not overlook or misapprehend Patent Owner’s stated intent to antedate Duhault II. In light of the evidence and arguments, however, we are not persuaded that Duhault I or Farber anticipate the challenged claims of the ’403 patent.

For example, Petitioner alleges that Duhault I discloses “assigning a first refresh rate to a first tile of said array of tiles and a second refresh rate to a second tile of said array of tiles,” as recited in independent claim 1.

Specifically, Petitioner contends:

Duhault I discloses that each video viewing area “will be updated or refreshed at a periodic rate.” [Ex. 1003] at ¶ 607. In the Duhault I system, both a first refresh rate and a second refresh rate are assigned in that a selected tile will be refreshed at a live video rate and the unselected tiles will be refreshed at “the speed of the tuner 12 in switching from channel to channel and the number of channels.” *Id.* at ¶ 618 (quoting Duhault I, Ex. 1013, at 3:47-50); *see also* Ex. 1003 at ¶ 607. The rate at which each television channel is sampled and displayed in a tile (video viewing area) is the refresh rate assigned to the tile. Ex. 1003 at ¶ 607.

Pet. 22. However, the system disclosed in Duhault I comprise only one TV

tuner. Ex. 1013, Fig. 1; Fig. 3; col. 2, ll. 34-38; col. 3, ll. 6-29 and ll. 51-62. As a result, Duhault I can provide *either* a multichannel display in which a plurality of viewing areas are each refreshed periodically as the tuner cycles through each channel *or* a single display area refreshed at a “live” rate. *Id.* at col. 3, ll. 14-17; col. 3, ll. 45-50; col. 4, ll. 19-26; col. 5, ll. 15-30. In Figure 4, for example, the step of periodically refreshing each display area in the multichannel display (step 102) is distinct from providing live audio and/or video of a selected channel in the display area (step 106). *Id.* at col. col. 4, ll. 13-38; *see also* Figure 5 (step 138, step 148). Thus, contrary to Petitioner’s contention “that a selected tile will be refreshed at a live video rate and the unselected tiles will be refreshed at ‘the speed of the tuner 12 in switching from channel to channel and the number of channels,’” Duhault I does not disclose refreshing unselected display areas while a selected display area is refreshed at a live video rate.

Dr. Karger’s declaration, unlike the Petition, does not rely on the refreshing of a display area at a “live” video rate. Ex. 1003 ¶ 607. Dr. Karger relies instead only on the updating of a first and second unselected display area at a periodic rate. *Id.* Even assuming that refreshing a first and second unselected display area at the same rate could be considered “assigning a first refresh rate . . . and a “second refresh rate,” it would not disclose “updating information . . . in accordance with said first refresh rate; and simultaneously updating information . . . in accordance with said second refresh rate,” because the second unselected display area is updated serially, not “simultaneously” or even concurrently, with the first unselected display

area. The updating of the first unselected display area is therefore not “at the same time or nearly the same time as updating information from said [first unselected display area],” as we have construed that limitation. Order 15-16. As a result, we are not persuaded that Duhault I anticipates (1) independent claim 1; (2) independent claims 22 and 46, which recite commensurate limitations; and (3) dependent claims 3-5, 7-13, 18, 19, 21, 23, 24, 26, 27, 30-33, 35-37, 40-43, and 47-50.^{3,4}

Petitioner also alleges that Farber discloses, “partitioning a visual display of the device into an array of tiles,” as recited in independent claim 1. Specifically, Petitioner argues that Farber’s screen areas 401-406 are an “array of tiles.” Pet. 40 (citing Ex. 1003 ¶¶ 868-873; Ex. 1016, Fig. 4). However, Petitioner’s argument is based on a claim construction that we did not adopt. Order 11-12. We construed “array of tiles” to mean “an ordered set of two or more tiles.” Farber’s screen areas 401-406 “‘float’ or randomly move throughout the display area, *preferably* without interfering with or

³ Petitioner does not allege in the Petition that the challenged claims are obvious over Duhault I under 35 U.S.C. § 103. As a result, we do not reach that issue.

⁴ In contrast to Duhault I, Duhault II discloses updating one video image using one tuner and *concurrently* updating a plurality of video images using a second tuner. *See, e.g.*, Ex. 1014, col. 2, ll. 1-5 (“One tuner provides full-motion video to a first image, which is generally a larger image residing within the entire window,” while “[a] second tuner provides periodic refreshing to the other generally smaller windows.”). Thus, the disclosure of Duhault II does not share the deficiencies of Duhault I.

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covering each other.” Ex. 1016, col. 6, ll. 48-50 (emphasis added). Because they move randomly and may overlap each other, Farber’s screen areas 401-406 are not “an *ordered* set of two or more tiles.” As a result, we are not persuaded that Farber anticipates (1) independent claim 1; (2) independent claim 22, which recites commensurate limitations; and (3) dependent claims 17, 20, 25, and 28.

For the foregoing reasons, Petitioner has not shown that the Board abused its discretion in denying the grounds of unpatentability based on Duhault I and Farber.

CONCLUSION

Petitioner’s request for rehearing is *denied*.

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