

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 No. IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
AMEND**

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Patent Owner bears the burden of proving its proposed substitute claims are patentable. *See, e.g.*, IPR2013-00033, Paper No. 122 at 50-51. The Board has identified at least three criteria important to this analysis. **First**, Patent Owner must “identify how the proposed substitute claims are to be construed, especially when the proposed substitute claims introduce new claim terms.” *Id.* at 51 (emphasis added). A motion that fails to provide “a reasonable construction of the claim features added in the substitute claims ...does not provide adequate information for the Board to determine whether [Patent Owner] has demonstrated the patentability of its proposed substitute claims.” *Id.* at 52. **Second**, “[a] motion to amend claims must identify clearly the written description support for each proposed substitute claim.” *Id.* at 53 (citing § 42.121(b)). Patent Owner must establish “the original disclosure of the application relied upon reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at 53. **Third**, “the patent owner bears the burden of proof in demonstrating patentability of the proposed substitute claims over the prior art in general.” *Id.* at 54-55, 58. A “mere conclusory statement that one or more added claim features are not described in the cited prior art, or would not have been suggested or rendered obvious by the prior art, is facially inadequate.” *Id.* at 55. Moreover, an analysis by Patent Owner that is “limited to the prior art cited in the petition, and [] does not identify the closest

prior art known to [Patent Owner] with respect to the proposed amended claims . . . provides insufficient information to establish that the patentability analysis as to the proposed claims is complete or reliable.” *Id.* at 55.

I. Patent Owner Fails To Provide a Viable Claim Constructions

The principle amendment Patent Owner seeks to add to claim 46 (presented as new claim 53) is the phrase “*wherein selecting a tile calls an assigned application program to provide access to information,*” as well as several additional phrases that modify this “selecting a tile” limitation. *See* Motion at 2-3. Despite this language clearly being the core of the proposed amendments, Patent Owner offers no construction of it. *See* Motion at 5. Moreover, as demonstrated below, because the ‘403 Patent provides **no written description support** for the plain meaning of this proposed amendment, it would be improper to permit it.

Patent Owner also seeks to amend claim 46 by adding the phrase “*said grid of tiles being persistent from session to session*” (Motion at 2), and proposes the following construction for this phrase: “[a]s 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.” Motion at 5. Patent Owner’s proposed construction is illogical, confusing and ambiguous.

First, the amended claim requires the “**grid**” to be persistent, not the “**tiles**.”

Patent Owner's construction, however, points to attributes of individual **tiles**.

Moreover, the specification consistently distinguishes between the grid and the tiles. Ex. 1001 at 10:53-54; 11:15-32. Patent Owner's construction thus confuses the possible meaning of its added language concerning the grid of tiles.

Second, Patent Owner in its construction presents no explanation of what a "session" is. Does "session" mean the period between the launch and close of a computer program? Or does it mean the period between the power on and off of a computer? Or something else? Patent Owner's failure to propose a construction for this claim term conceals its view of the objective meaning the term should be afforded and leaves the Board, the Petitioner and the Public to guess.

Third, Patent Owner presents no explanation for what is required to "maintain" information from "session to session." Would that cover storage in a volatile "main memory," as Patent Owner's provisional application states? *See* Ex. 2066 at 17:11-12 ("The grid itself has an address 404 that specifies its location within the file system of the system's main memory."). Or does it refer only to storage in non-volatile memory, as Patent Owner's expert suggests? Motion at 5. Notably, the term used in the provisional application ("main memory") is universally understood to refer to memory that would be erased when the power is turned off. Ex. 1110 at ¶ 170. Patent Owner makes no effort to reconcile this conflict, rendering its proposed construction ineffective and confusing.

Finally, the proposed new “persistence” language requires the grid of tiles *on the display* to be persistent, since it requires the arrangement of a grid *on a* display and then requires that “**said** grid” be persistent. *See* Motion at 2. Patent Owner, however, includes nothing in its construction that addresses the persistent display of a grid. Patent Owner has therefore not advanced a reasonable construction for its “persistent” limitation.

Patent Owner presents no claim interpretations for the other phrases it seeks to add to its claims, including, for example, what makes two computer programs “different”. *See* Motion at 4-7. Patent Owner’s failure to provide reasonable claim constructions with its motion, prejudices the Board, Petitioner and the public, and prevents a fair evaluation of the merits of its claim amendment. Certainly, Patent Owner should not be heard in reply to belatedly offer some new explanation of its claim language that contests the issues raised herein but which was never included in its motion. The motion should therefore be denied for at least this reason.

II. Patent Owner Failed to Address Relevant Prior Art

Patent Owner does not address highly relevant prior art known to Patent Owner, as is required to support a motion. *See* IPR2012-00027, Paper 26 at 7. At most, Patent Owner discusses the prior art identified in the Petition and states “Patent Owner believes that the most relevant of the known references **discussed above** include” certain of the references included in the Petition. Motion at 7

(emphasis added). But that is not enough to carry Patent Owner's burden, since it limits the universe of prior art to those references identified in the petition instead of the "prior art known to Patent Owner." *See* IPR2012-00027, Paper 26 at 7.

That failure is material in this proceeding. For example, Patent Owner was aware of Ex. 1066 ("Myers"), which was discussed in the initial expert report of Dr. Karger (Ex. 1003) at ¶¶ 73-74. As Dr. Karger establishes, Myers discloses or would have made obvious all elements of the claims. Ex. 1110 at ¶¶ 335-346. Despite this, Patent Owner makes no mention of Myers in its Motion. Patent Owner's failure to address this substantial prior art known to it also compels denial of Patent Owner's motion to amend. *See* IPR2012-00027, Paper 26 at 7-8.

III. The Substitute Claims Are Not Supported by the Written Description

A. Calling an Application Program By Selecting a Tile

Patent Owner seeks to add: "wherein selecting a tile calls an assigned application program to provide access to information." Motion at 2. As support, Patent Owner cites three sentences from the utility application which led to the issuance of the '403 Patent. *See* Motion at 5, citing Ex. 1002 at 21:26-27; 22:1-2; and 22:15-16. The first is "*Each tile is associated with a data stream or application program and allows a choice of displayed images.*" Ex, 1002 at 21:26-27 (found in the '403 Patent at 10:54-56). Next is "*Each tile is separately associated with a source of information, for example, an application program,*

datastream or file, any one of which may be another grid object.” Ex. 1002 at 22:1-2 (found in the ‘403 Patent at 11:1-3). Finally, it cites: “*Therefore the application resides over existing applications without replacing any of them; rather it enables them to be called from the grid itself.*” Ex. 1002 at 22:15-16 (found in the ‘403 Patent at 11:23-24). As is apparent, and was confirmed by both parties’ experts, none of these passages describes calling an application program **by** selecting a tile. Ex. 1110 at ¶¶ 174-176; Ex. 1106, Weadock Tr. at 60:15-63:7. They therefore do not provide written description support for “wherein selecting a tile calls an assigned application program to provide access to information.”

Patent Owner also cites two additional passages from the provisional application to which the ‘403 Patent claims priority. *See* Motion at 5, citing Ex. 2066. The provisional application, however, is not incorporated by reference into the ‘403 Patent specification, *see* Ex. 1001 at 1:5-8, so it cannot supply written description support for the claims of that patent, *see Harari v. Lee*, 656 F.3d 1331 (Fed. Cir. 2011). In any event, neither of the additional cited passages describe “wherein selecting a tile calls an assigned application program to provide access to information” either. The first, at Ex. 2066, 8:24-27 (found in similar form in the ‘403 Patent at 4:34-37) reads: “*The present invention provides a simple, easy to use graphical interface that facilitates the organization and management of multiple data sources corresponding to a user's needs and interests.*” The second,

at Ex. 2066, 17:23-25 (found in the ‘403 Patent at 11:9-12) reads: “*By using the native attributes of a tile, a user may specify a presentation of the grid, consisting of its dimensions, (i.e., the number of tiles to display and their arrangement), and the programs or files to be associated with each tile.*” Again, neither describes calling an application program **by** selecting a tile. Ex. 1110 at ¶¶ 177-178. Thus, there is no written description support for Patent Owner’s proposed amendment.

Finally, what one of ordinary skill in the art might find *obvious* from the written description – the exclusive focus of Mr. Weadock’s opinions – is irrelevant. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571-72 (Fed.Cir.1997)(written description requirement cannot be satisfied by that which would be obvious from the disclosure).

B. Persistent Display of a Grid of Tiles

Patent Owner also seeks to amend claim 46 to recite: “arrange a display into a grid ~~an array~~ of tiles ..., said grid of tiles being persistent from session to session.” Motion at 2. The amended claim thus requires the grid *that is arranged on the display* to be persistent from session to session. The ‘403 Patent includes no disclosure of this concept. At most, the ‘403 Patent discloses that certain grid and tile information can be persistently stored in a database. Ex. 1110 at ¶ 168. But persistently storing data about tiles in a database is not what is claimed, and is different from persistently displaying a grid of tiles on a display. Ex. 1110 at ¶¶

169.

The portions of the written description identified by Patent Owner also do not establish possession of a “persistent” grid. Figure 12 shows the “data structure of the grid object,” but says nothing about persistency. In fact, this is what Patent Owner’s provisional application expressly states: “the grid itself has an address 404 that specifies its location within the file system **of the system’s main memory.**” Ex. 2066 at 17:11-12 (emphasis added). While this sentence changed in the non-provisional application, its context remained the same. Ex. 1001 at 12:66-13:1. Thus, the grid data structure is an active data structure used by the computer during its operation, consistent with the observation that it is stored in **volatile** memory. Ex. 2066 at 17:11-12; *see also* Ex. 1110 at ¶ 170. The only support Patent Owner advances (other than attorney argument) is a single sentence from its expert that the reference to the grid having an address 1024 specifying its location means it is stored persistently. Ex. 2063 at ¶ 33(d). But this could equally refer to *transient* storage (*e.g.*, caching), not persistent storage. Ex. 1110 at ¶ 172. The written description, thus, does not unequivocally establish the **grid data structure** is persistently stored.

Accordingly, Patent Owner has failed to show that, as of the filing date of the ‘403 Patent, it was in possession of the inventions defined by its proposed substitute claims. Ex. 1110 at ¶¶ 167-179.

IV. The Proposed Substitute Claims Are Anticipated By and Obvious In View of The Prior Art

A. MSIE Kit

As the Board concluded, MSIE Kit (Ex. 1007) anticipates claims 46-47 and 50-52 of the ‘403 Patent. *See, e.g.*, Institution Decision, Paper 19 at 31 and 32; *see also* Ex. 1003 at ¶¶ 399-413; Ex. 1110 at ¶ 114. Similarly, the Board concluded Chen (Ex. 1015) anticipates claims 48-49 of the ‘403 Patent. *See, e.g.*, Institution Decision, Paper 19 at 26-29; *see also* Ex. 1003 at ¶¶ 847-861; Ex. 1110 at ¶ 91. The proposed substitute claims 53-59 are similarly unpatentable, as MSIE Kit satisfies the proposed new language of those claims and any possible distinction between MSIE Kit and the substitute claims would have been obvious. For example, Patent Owner seeks to change the claim word “array” to “*grid*.” Motion at 2-3. However, MSIE Kit explains that “[b]y default, Internet Explorer lays out new Active Desktop Items on a 3 by 2 grid.” Ex. 1007, MSIE Kit at 183 (emphasis added). Ex. 1110 at ¶¶ 188-89.

Patent Owner also proposes to require that the displayed tiles be “*not permitted to overlap*” and that the grid be “*persistent from session to session*.” Motion at 2. MSIE Kit discloses that system administrators have the ability to prevent users from rearranging Active Desktop Items, including Items that were created via the “default” Active Desktop layout of a “3 by 2 grid.” Ex. 1110 at ¶¶ 190-191. Patent Owner’s expert ignores this disclosure of MSIE Kit. *See* Ex.

2063 at ¶¶ 90-91. A default grid layout of Active Desktop Items in an arrangement where the administrator has employed the control that prevented users from rearranging the Items satisfies the “*not permitted to overlap*” limitation.

Dr. Karger also confirms that MSIE Kit discloses that Active Desktop Items are “*persistent from session to session*,” since they remain on the screen from session to session and information about their position, refresh/retrieval rate and associated information source is stored in non-volatile memory. Ex. 1110 at ¶¶ 193-196. Patent Owner does not contest these conclusions. See Ex. 2063 at ¶¶ 89-97.

Patent Owner also seeks to add language requiring “*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*” (hereinafter “the first wherein clause”). Motion at 2-3.

MSIE Kit discloses that Active Desktop Items are selectable by, for example, clicking a hot spot, link or control within the Item, and also by using the TAB or SHIFT+TAB keys. Ex. 1110 at ¶¶ 119-136. MSIE Kit also describes how selecting an Active Desktop Item could call a web browser, such as Internet Explorer 4 or Netscape Navigator. Ex. 1110 at ¶¶ 216-218. Moreover, MSIE Kit discloses that Active Desktop Items could be used with web pages employing

Active X controls that can be used to launch application programs inside a browser window, including an electronic mail application (Outlook Express), chat applications (Netmeeting or Microsoft Chat 2.0) and a streaming video application (Netshow), among others. Ex. 1110 at ¶¶ 219-232. Internet Explorer, Netscape Navigator, Outlook Express, Netmeeting, Microsoft Chat 2.0 and Netshow are application programs different from the Active Desktop programming that displays Active Desktop Items in a grid. Ex. 1110 at ¶¶ 233-241. Each of these applications is assigned to an Active Desktop Item when a link or control for calling them appears in the Item. Ex. 1110 at ¶¶ 217, 218, 221, 225, 228, 231. Patent Owner's expert ignores this disclosure of MSIE Kit. See Ex. 2063 at ¶¶ 92-97. MSIE Kit thus discloses and suggests the first "wherein" clause of Patent Owner's proposed substitute claims. Ex. 1110 at ¶ 213-241.

Patent Owner also seeks to add to its claims "*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*" (hereinafter "the second wherein clause"). Motion at 3. As noted above, MSIE Kit discloses and suggests use of Internet Explorer (web browser), Netscape Navigator (web browser), Outlook Express (electronic mail application), Netmeeting (chat

application), Microsoft Chat 2.0 (chat application) or Netshow (streaming video player), and that different Active Desktop Items could be assigned any one of these applications. Ex. 1110 at ¶¶ 213-241 and 242. MSIE Kit thus discloses the second “wherein” clause of Patent Owner’s proposed substitute claims, and therefore all of the elements of substitute claim 53. Ex. 1110 at ¶¶ 242-244.

The elements of proposed substitute claims 54-59 are satisfied by MSIE Kit at least in the same manner the Board found corresponding claims 47-52 were satisfied by MSIE Kit. Institution Decision, Paper 19 at 31-32; Ex. 1110 at ¶¶ 114, 245-267.

Substitute claim 55 requires executing instructions for uniformly assigning an attribute to the tiles of the grid and substitute claim 56 specifies that such attribute be a retrieval rate. Motion at 3. MSIE Kit discloses that a user can create new Active Desktop Items by simply assigning the URL of the information source to the Active Desktop Item, *i.e.*, without specifying the retrieval rate for the Item and instead relying on the default retrieval rate. Ex. 1110 at ¶¶ 248-249. MSIE Kit also discloses that an administrator can set up Active Desktop Items on his or her own computer, including a grid of Items each having uniform attributes such as a retrieval rate, and also have that grid of Items, including their settings, distributed to the users in a network. Ex. 1110 at ¶¶ 188-191, 194-195, 200, 248, 249. MSIE Kit therefore discloses executing instructions for uniformly assigning a retrieval

rate to the tiles of a grid. *Id.* Patent Owner's expert ignores this disclosure of MSIE Kit. *See* Ex. 2063 at ¶¶ 87-97. MSIE Kit thus discloses the requirements of substitute claims 55 and 56.

It also would have been obvious to employ uniform retrieval rates with Active Desktop Items. Such uniform retrieval rates were well-known in the prior art, as they are disclosed in Chen and Duhault I, Ex. 1015 at 24:3-12 and Ex. 1013 at 3:44-46, 3:14-18, and 4:17-23, and their implementation was well within the level of skill in the art as of 1999. Ex. 1110 at ¶¶ 250-256; Ex. 1003 at ¶¶ 616, 617. Moreover, one of ordinary skill in the art would have had reason to use such uniform rates, for example, when using Active Desktop Items to access multiple sources of information of similar types (e.g., CNN and ABC News). Ex. 1110 at ¶ 252. Patent Owner may read some portions of MSIE Kit as teaching away from such a use because of bandwidth considerations, but MSIE Kit permitted Active Desktop Items to have uniform retrieval rates while still retrieving information *at different times or days*. Ex. 1110 at ¶ 252. Thus, for example, two Active Desktop Items assigned to CNN and ABC News, respectively, could both retrieve information at a rate of once a day, but could be configured to retrieve information from CNN and ABC News at different times of the day. Ex. 1110 at ¶ 252. Such functionality would create no adverse bandwidth considerations, and thus there is no teaching away of the claimed functionality. Ex. 1110 at ¶ 252. MSIE Kit thus

discloses all elements of Patent Owner’s proposed substitute claims, or renders them obvious, and Patent Owner has failed to carry its burden to show patentability over the prior art. Ex. 1110 at ¶¶ 180-267.

B. Kostes

The proposed substitute claims are also unpatentable over the PCT Application WO9926127 by Kostes et al (Ex. 1051)(“Kostes”), which is prior art to those claims at least under Section 102(a). Ex. 1110 at ¶ 268. Kostes describes a user interface for displaying information from multiple information sources at the same time, all of which may be regularly updated at an assigned retrieval rate. The information is displayed in a “montage view,” which is a grid of non-overlapping persistent tiles. Ex. 1110 at ¶¶ 281-293. The tiles of Kostes can also be used to call a number of different application programs, including a web browser and an email application. Ex. 1110 at ¶¶ 303-306. Dr. Karger explains in detail how Kostes anticipates or renders obvious each of Patent Owner’s proposed substitute claims. Ex. 1110 at ¶¶ 268-334.

Patent Owner has advanced the testimony of its expert as to why Kostes does not render the substitute claims unpatentable. Ex. 2063 at ¶¶ 165-173. The expert cites only two reasons why he contends Kostes does not anticipate the proposed substitute claims. First, he states that the panes of Kostes are not tiles because they are not selectable. *Id.* at ¶¶ 170-71. However, Kostes explains that

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its panes permit a user to click on a link within a pane or interact with an application program within a pane, so the panes are selectable and when selected provide access to an information source. Ex. 1110 at ¶¶ 303-306. Patent Owner's expert also states, without explanation, that Kostas does not disclose calling two different application programs from the Markush group of the proposed substitute claims. Ex. 2063 at ¶¶ 172. But Kostas expressly discloses that selecting a pane can call a web browser or an email program. Ex. 1110 at ¶¶ 309-316. Kostas therefore also renders Patent Owner's proposed substitute claims unpatentable.

Accordingly, Patent Owner has not shown the patentability of its proposed substitute claims, so its motion should be denied for this reason as well.

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Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 31st day of March 2014, a copy of this
**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO
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