

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 JONI Y. CHANG and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *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
Patent 6,724,403

On April 16, 2014, a conference call was held between respective counsel for Petitioner and Patent Owner, and Judges Chang and Clements. The stated purpose of the call was to discuss Petitioner's request to move the hearing date and Patent Owner's requests for (1) leave to file a sur-reply; (2) leave to file a second motion to amend; and (3) adjustments to due dates 3-5. The following issues were discussed.

Sur-Reply

Patent Owner requested leave to file a sur-reply to Petitioner's Reply (Paper 45, "Reply") filed March 31, 2014, or, in the alternative, a motion to strike. According to Patent Owner, (1) the Reply includes a large volume of material, some of which it believes may be improper, but which may be more efficient to deal with in a sur-reply; (2) the Reply contains material that could have been put in the original petition because it is material from the concurrent litigation that Petitioner had in hand; (3) the Reply mischaracterizes deposition testimony; and (4) the declaration accompanying the Reply cites additional pages of the MSIE Kit reference that were not cited in the original declaration. Accordingly, Patent Owner believes a sur-reply or, in the alternative a motion to strike, is appropriate.

According to Petitioner, (1) the Reply addresses the exact same functionality relied upon in the Petition, and relied upon by the Board in deciding to institute; (2) Petitioner's expert responded to Patent Owner's arguments about certain functionality involving selectability; (3) the dispute over the Reply is moot because the opinions of Patent Owner's expert that the disputed portions of the Reply rebut are not based on the Board's claim construction; (4) the additional pages in MSIE Kit are pertinent to the Motion to Amend, so could have come in anyway; and (5)

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

the issues raised by Patent Owner are more appropriately addressed in the cross-examination of Dr. Carter than in a sur-reply.

Upon consideration of the parties' arguments, we agreed with Petitioner that Patent Owner has not shown good cause for authorizing a sur-reply at this stage of the proceeding. The Board is in the best position to decide whether something in a Reply is a new issue and, if so, we will not consider it.

Second Motion to Amend

Patent Owner requested leave to file a second motion to amend. According to Patent Owner, the second motion to amend would address points raised in Petitioner's Opposition to its Motion to Amend, but would not raise new issues of claim construction or introduce new claim terms. Patent Owner argued that there was good cause under 37 C.F.R. § 42.121(c) because the second motion to amend would narrow issues to be considered at oral argument and in the final written decision, and that it would be fair to allow it to address a small and limited number of items that Petitioner raised in its Opposition.

Petitioner argued that (1) the showing of "good cause" required by 37 C.F.R. § 42.121(c) is a high bar, which Patent Owner cannot meet; (2) the onus is on Patent Owner to address all of the requirements in its first Motion to Amend; (3) a second motion to amend would disrupt this proceeding, where briefing is already completed, because it would necessitate another round of briefing, which would prejudice Petitioner.

Patent Owner proposed that it confer with Petitioner about the proposed amendments. We agreed with Patent Owner's proposal to confer with Petitioner, and explained that, if the parties reach agreement, Patent Owner may request

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

another conference with the Board to present a joint request for leave for Patent Owner to file a second motion to amend.

Adjustments to Due Dates

Petitioner requested an adjustment to Due Date 7 on the grounds that Petitioner's counsel is traveling internationally on July 9. We instructed the parties to meet and confer regarding mutually convenient hearing dates, and to propose several alternatives to the Board. Later on April 16, 2014, Petitioner's counsel emailed the Board reporting that the Parties had conferred and proposing any date between July 10 and July 18, 2014, inclusive. We reset Due Date 7 for July 10, 2014. We concurrently are issuing a Revised Scheduling Order to set forth this change and other changes that are discussed below.

Patent Owner requested an adjustment to Due Dates 3-5. Patent Owner argued that, because the Board recently moved the hearing date by nearly two weeks (Paper 51), Due Dates 3, 4, and 5 could also be pushed back by two weeks. Patent Owner indicated that the adjustments were necessary because (1) Petitioner's expert was made available for deposition on only two days, and the day on which the deposition is currently scheduled is problematic for Patent Owner's counsel; and (2) if Patent Owner's requests for a sur-reply or a second motion to amend are granted, those would merit additional time.

Petitioner explained that it initiated the conversation about scheduling, that it offered its expert for deposition on two days in response to Patent Owner's request, and that its expert had made alternative teaching arrangements to accommodate potential deposition on the dates requested by Patent Owner's counsel. Petitioner argued that the deposition is scheduled for April 24, Patent Owner's Reply is due

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

on May 2, and it therefore sees no need for additional time. Nevertheless, Petitioner's counsel indicated that it does not object to an extension of a few days.

We proposed moving Due Date 3 to May 9. Each party indicated that it had no problem with moving Due Date 3 to May 9. We also proposed delaying Due Dates 4, 5, and 6 by one week in light of the changes to Due Date 3.

Accordingly, we reset Due Date 3 to May 9, Due Date 4 to May 23, Due Date 5 to June 6, and Due Date 6 to June 13. We also note that, for Due Date 4, both Petitioner and Patent Owner may file a Motion for Observation, and, for Due Date 5, both parties may file a Response to Observation. Accompanying this Order is a Revised Scheduling Order reflecting the reset Due Dates.

Corrected Reply Brief

Petitioner requested leave to file a corrected Reply Brief to address three typos that it identified to Patent Owner in an email prior to the conference call. Patent Owner requested time to review the email before it responded. Petitioner is authorized to file a corrected Reply Brief that addresses the typos identified to Patent Owner if Patent Owner does not oppose. If it files a corrected Reply Brief, Petitioner must also file, as an exhibit, a redline against the original Reply Brief indicating the changes made in the corrected Reply Brief.

ORDER

It is

ORDERED that Patent Owner's request for authorization to file a sur-reply is DENIED;

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

FURTHER ORDERED that Patent Owner's request for authorization to file a second motion to amend is DENIED;

FURTHER ORDERED that Due Date 3 is reset to May 9, Due Date 4 is reset to May 23, Due Date 5 is reset to June 6, Due Date 6 is reset to June 13, Due Date 7 is reset to July 10, as reflected in the revised Scheduling Order issued concurrently with this Order;

FURTHER ORDERED both parties may file a Motion for Observation before or on Due Date 4, and both parties may file a Response to Observation before or on Due Date 5, and

FURTHER ORDERED that Petitioner is authorized to file, within 5 business days, a corrected Reply Brief accompanied by a redline filed as an exhibit that shows the changes made to the corrected Reply Brief if Patent Owner does not oppose.

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

For PETITIONER:

Jeffrey P. Kushan, Esq.
Joseph Micallef, Esq.
JKushan@sidley.com
JMicallef@sidley.com

For PATENT OWNER

Richard G. A. Bone, Esq.
James M. Heintz, Esq.
RBone@VLPLawGroup.com
Patents@VLPLawGroup.com
292_IPR_DLAteam@dlapiper.com