

Filed on behalf of SurfCast, Inc.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

SURFCAST, INC.
Patent Owner

Case IPR2013-00292¹
Patent 6,724,403

SURFCAST, INC.'S
PATENT OWNER REPLY TO
PETITIONER'S OPPOSITION TO MOTION TO CONDITIONALLY AMEND
UNDER 37 C.F.R. §§ 42.121 AND 42.23

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

Table of Contents

1. Patent Owner’s Motion Sufficiently Construed the Substitute Claims	1
2. Patent Owner addressed the most relevant prior art	3
3. All Amendments are Supported by the Written Description	
A. Calling an Application Program by Selecting a Tile	3
B. Persistent Display of a Grid of Tiles	4
4. Proposed Substitute Claims 53 – 59 Are Patentable Over MSIE Kit and Kostas	
A. MSIE Kit	4
B. Kostas	5

Exhibit List

Ex. 1001	U.S. Pat. No. 6,724,403
Ex. 1007	Microsoft Internet Explorer Resource Kit (“MSIE Kit”)
Ex. 1051	WO99/026127 (“Kostes”)
Ex. 1066	Myers, B.A., “The User Interface for Sapphire” (1984)
Ex. 1110	Reply Expert Declaration of David R. Karger
Ex. 1113	Deposition Transcript of David R. Karger, April 24, 2014
Ex. 2081	Reply Expert Declaration of Patent Owner’s Expert, Glenn E. Weadock
Ex. 2088	Deposition Transcript of Joseph Belfiore, July 11, 2013

1. Patent Owner's Motion Sufficiently Construed the Substitute Claims

Petitioner does not identify an ambiguity or any other need to construe any amendment in the Substitute Claims other than “said grid of tiles being persistent from session to session,” and there is none. Any purported need to do so is belied by the fact that Petitioner's expert did not identify any claim construction issue that prevented him from analyzing the patentability of the Substitute Claims against three pieces of prior art. Ex. 1110 at ¶¶ 180 – 346. In any event, Patent Owner's expert, Mr. Weadock, confirms that all of the terms introduced into the Substitute claims would have been well understood by those of ordinary skill in the art and would not need further construction. Ex. 2081 ¶¶ 7 – 49 .

Patent Owner's proposed construction that “persistent,” as used with respect to a tile, 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”; Paper No. 28 at 5) was all that was required for a person of ordinary skill to understand the “said grid of tiles being persistent from session to session” limitation. Ex. 2081 ¶ 7 – 26, and 56. Petitioner's allegation that the use of “tile” rather than “grid” in this construction is ambiguous is without merit: if the tiles in the grid are persistent, then the grid is persistent and vice-versa. Ex. 2081 ¶¶ 7 – 10. Additionally, “session to session” had a well-understood

meaning in the art at the time of the '403 patent which required the tiles to be persistent across sessions whether or not the computer was turned off. Ex. 2081 at ¶¶ 7 – 9. Petitioner's attempt to create ambiguity through its "main memory" argument fails because the '403 Patent is clear that the file system portion of the "main memory" in which tile information is stored is non-volatile. Paper No. 28 at 5; Ex. 2081 at ¶¶ 13, 16 – 26, and 56; Ex. 1001, Fig. 2; *see also* Ex. 1113 at 125:22 – 126:7. Finally, Petitioner itself states without any ambiguity that the persistence language "requires the grid of tiles *on the display* to be persistent." ("Opposition", Paper No. 41 at 4.) That Petitioner itself indicates no ambiguity is evidence that the claim language is clear on its face and does not need construction. Ex. 2081 ¶¶ 7 – 26.

2. Patent Owner Addressed The Most Relevant Prior Art. Petitioner's allegation at page 4 of its Opposition that Patent Owner's Motion only addressed prior art in the Petition is blatantly false. The Motion expressly states that Patent Owner considered the prior art identified in the co-pending district court litigation, the prior art cited in the prosecution of the '403 Patent and in the prosecution of a corresponding European patent application, as well as the art in the petition in its good-faith attempt to identify the most relevant references. (Paper No. 28 at 7.)

The sole piece of prior art that Petitioner singled out as not having been

analyzed by Patent Owner, Myers (Ex. 1066), is clearly less relevant than the references analyzed by Patent Owner in the Motion. As Petitioner's expert admitted on cross examination (Ex. 1113 at 170:7-171:3), Myers' icons cannot be used to call assigned application programs as is required by what *Petitioner* has identified as the "*principle [sic] amendment*" (Opp. at 2; emphasis added). Petitioner's expert also admitted that Myers' icons are not persistent. (Ex. 1113 at 197:14-19.) Petitioner's expert further admitted that Myers does not anticipate claim 53, whereas he contends that two other references analyzed in Patent Owner's Motion, MSIE Kit (Ex. 1007) and Kostas (Ex. 1051), are anticipatory. (*Id.* at 182:20-24; Motion at 8 and 13.) Myers is far less relevant than either of these references and fails to cure their deficiencies. (Ex. 2081, at ¶¶ 96 – 105.)

3. All Amendments Are Supported By the Written Description. Petitioner has argued that the limitations "wherein selecting a tile calls an assigned application program" and "arrange a display into a grid of tiles . . . said grid of tiles being persistent from session to session" are not supported by the specification of the '403 Patent. As explained by Mr. Weadock, the first limitation is clearly supported by the portions of the written description cited in the Motion at 5; Petitioner ignores these portions in asserting otherwise. (Ex. 2081 ¶¶ 55 – 56.) With respect to the second limitation, the '403 Patent discloses that the grid of tiles

is stored in a file system (Ex. 1001 at 12:66-13:1). Petitioner's and Patent Owner's experts agree that one of skill in the art would understand that the file system is typically stored in a non-volatile hard disk. (Ex. 1113 at 125:22-126:7; Ex. 2081 ¶¶ 13, 16–19, 56.) Support for all of the amendments has been established.

4. The Substitute Claims Are Patentable Over MSIE Kit and Kostas.

Petitioner alleges only two reasons why the substitute claims are unpatentable. (Paper No. 41 at 9 – 15.) First, the Opposition alleges that MSIE Kit (Ex. 1007) anticipates substitute claims 53 – 59. (Opp. at 9-12.) However, MSIE Kit does not disclose “wherein selecting a tile calls an assigned application program.” An application program is not called when an Active Desktop item is selected, and neither Petitioner nor its expert identify anything in MSIE Kit to the contrary. Instead, Petitioner and its expert point to selecting a link or other object *within* an Active Desktop item to satisfy this limitation. (Opp. at 10; Ex. 1110 ¶¶ 120-139 and 213-216.) Selecting a link or some other object in an item is different from selecting the Active Desktop item itself. Ex. 2081 ¶¶ 58 – 64. Also, Microsoft's § 30(b)(6) witness, Joseph Belfiore, admitted that, if an Active Desktop item displays a website without making any links visible within it, then such an item could not be used to call any application—there would be nothing for a user to select. (Ex. 2088 at 172:7 – 173:4; Ex. 2081 ¶ 59). In contrast, a tile according to

Substitute Claim 53 is a significant improvement because it will call an application program regardless of whether the information in the tile includes any links or has any hotspots or other objects. (Ex. 2081 at ¶ 63.) Furthermore, MSIE Kit does not disclose other limitations of the Substitute Claims. (Ex. 2081 ¶¶ 57 – 79.)

Second, Petitioner contends that Kostas (Ex. 1051) anticipates the Substitute Claims. (Opp. at p. 14 – 15.) However, like MSIE Kit, Kostas does not disclose “wherein selecting a tile calls an assigned application program.” (Ex. 2081 at ¶¶ 40 – 43; 80 – 95.) Petitioner’s expert admitted in cross-examination that his opinion was based on the alleged tiles in Kostas being the items in the “montage view,” not the “netchannels.” (Ex. 1113 at 137:10-18.) However, Kostas does not disclose that the items in the montage view call an application program when selected. (Ex. 2081 ¶¶ 87 – 88.) Additionally, the netchannels themselves cannot be selected to call an application program. (Ex. 2081 ¶¶ 90 – 93.) Rather, a link in the netchannels can be selected to call an application program. But this is different from selecting one of the netchannels itself (which are not arranged in a grid) to call an application program for the same reasons discussed above in connection with MSIE Kit (Ex. 1007). Kostas also does not disclose the second “wherein clause” and other limitations of the Substitute Claims, as shown by Paten Owner’s expert, Mr. Weadock. (Ex. 2081 ¶¶ 80 – 95.)

Respectfully submitted by:

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

It is hereby certified that on this 9 day of May, 2014, copies of the foregoing

PATENT OWNER REPLY TO
PETITIONER'S OPPOSITION TO MOTION TO CONDITIONALLY AMEND

And accompanying newly-cited EXHIBITS

were served via Electronic Mail and Federal Express upon the following:

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