

Filed on behalf of SurfCast, Inc.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION  
Petitioner

v.

SURFCAST, INC.  
Patent Owner

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Case IPR2013-00292<sup>1</sup>  
Patent 6,724,403

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PATENT OWNER'S  
REQUEST FOR ORAL ARGUMENT  
UNDER 35 U.S.C. § 316(a)(10) AND 37 C.F.R. § 42.70(a)

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

Pursuant to 37 C.F.R. § 42.70(a), Patent Owner, SurfCast, Inc., requests oral argument on the issues set forth below at a place and time set by the Board. Oral argument is presently scheduled for July 10<sup>th</sup>, 2014 (Paper No. 53, “Revised Scheduling Order”).

To allow for a complete review of the issues presented in this proceeding, Patent Owner requests at least one hour of argument time. Patent Owner additionally requests permission to use audio-visual display equipment to present demonstratives, including a projector and screen for computer-generated slides.

Furthermore, Patent Owner requests the use of the Board’s Hearing Room A, due to the number of persons expected to attend in support of Patent Owner.

This filing is timely, being submitted no later than DUE DATE 4, according to the Revised Scheduling Order.

### **Issues to be Presented by Patent Owner at Oral Argument**

Issues 1 – 8 are raised by the Petition and Patent Owner’s Preliminary Response (Paper No. 14), and Patent Owner’s Response (Paper No. 28), and involve the patentability of the claims of U.S. Patent 6,724,403 (“the ’403 Patent”) over the disclosures of several prior art references, upon which trial has been instituted (Paper No. 15).

Issue 9 is raised by the Patent Owner’s Motion For Conditional Amendment, Petitioner’s Opposition thereto and Patent Owner’s Reply.

Issue 10 is raised, per the Board’s authorization (Conference call of May 20, 2014).

1. Items of claim construction. Patent Owner seeks to present its arguments for its proposed claim construction of the following terms recited in the claims of the '403 Patent:
  - a) “tile”; and
  - b) “partitioning a visual display of the device into an array of tiles” / “arrange a display into an array of tiles”;
2. Claims 1 – 13 and 17 – 28, 30 – 33, 35 – 37, and 39 – 43 are patentable over Duhault II (Exhibit 1014);
3. Patent Owner’s submitted evidence (Exhibits 2005 – 2052) are sufficient to establish invention prior to the effective date of Duhault II;
4. Claims 1, 9 – 11, 22, 41 – 43, 46 and 48 – 50 are patentable over Chen (Exhibit 1015);
5. Claims 1 – 3, 5 – 8, 12 – 14, 19, 21, 22, 27, 30, 32, 34, 37 – 40, 46, and 47 are patentable over Duperrouzel (Exhibit 1011);
6. Claims 1 – 3, 5 – 8, 11, 12, 14 – 16, 19, 21, 22, 27, 30, 32, 34, 37 – 40, 43 – 47, and 50 – 52 are patentable over MSIE Kit (Exhibit 1007);
7. Claim 29 is patentable over Chen in view of MSIE Kit;
8. Claims 17, 20, 25, and 28, are patentable over MSIE Kit or Duperrouzel in view of Brown (Exhibit 1030).
9. Patent Owner has demonstrated that it is entitled to the relief requested in

Patent Owner's Motion for Conditional Amendment, including  
demonstrating that Proposed Substitute Claims 53 – 59 are patentably  
distinct over the known prior art.

- a) The Substitute Claims are supported by the specification of the  
'403 Patent
  - b) The Substitute Claims are patentably distinct from the references  
upon which trial was instituted and from the prior art "in general"  
pursuant to 37 C.F.R. § 42.20(c).
10. The Board should construe the claims of the '403 Patent according to the  
*Phillips* standard, as applied by a U.S. District Court.
11. Rebuttal to Petitioner's presentation on all matters, including the issues  
listed above.

Respectfully submitted by:

/Richard G. A. Bone/

Dated: May 23, 2014

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

It is hereby certified that on this 23<sup>rd</sup> day of May, 2014, a copy of the foregoing

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REQUEST FOR ORAL ARGUMENT  
UNDER 35 U.S.C. § 316(a)(10) AND 37 C.F.R. § 42.70(a)

was served via Electronic Mail-upon the following:

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