

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 MOTION FOR OBSERVATIONS ON CROSS-
EXAMINATION OF PETITIONER'S REPLY DECLARANT,
DAVID R. KARGER

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

Pursuant to the Trial Practice Guide (Fed. Reg. 77 (157), 48756, Aug. 14, 2012) at 48767 – 48768, Patent Owner SurfCast, Inc. hereby moves to submit the following observations on the April 24, 2014 deposition of Petitioner’s Reply expert witness in the instant proceeding. The signed transcript of the deposition is in the record of the proceeding as Exhibit 1113.

This Motion is timely filed as it is being submitted no later than DUE DATE 4, according to the Revised Scheduling Order (Paper No. 53).

Patent Owner notes that observations are filed by the “party taking cross-examination”, and that observations are permitted where “the cross-examination takes place after the party has filed its last substantive paper, such that the party has no way to bring relevant testimony to the Board’s attention.” (See, *e.g.*, IPR2013-00358, Paper No. 77 at page 3.) In this instance, Patent Owner deposed Petitioner’s expert, David R. Karger, after Petitioner submitted a single declaration by Dr. Karger (Ex. 1110; “Petitioner’s Reply Declaration”) in support of both its Petitioner Reply (Paper No. 45; “Reply”) and Petitioner’s Opposition to Patent Owner’s Motion to Amend (Paper No. 46; “Opposition”). Patent Owner notes that the Petitioner’s Reply Declaration is clearly divided into two parts, one of which (Exhibit 1110, Section III, at pages 11 – 68, ¶¶ 34 – 165) addresses issues of claim construction and patentability of the claims of the ’403 Patent in support of Petitioner’s Reply, and the other of which (Exhibit 1110, Section IV, at pages 69 –

133, ¶¶ 166 – 346) addresses Patent Owner’s substitute claims in support of Petitioner’s Opposition.

Although Patent Owner has had a chance to address items raised in the portion of the Petitioner’s Reply Declaration that supported the Opposition, it has not been able to do so for the portion that supported the Reply. Patent Owner requested leave to file a sur-Reply, but that request was denied (Paper No. 52). Accordingly the instant Observations are Patent Owner’s last and only chance to offer comment on the statements in Petitioner’s Reply Declaration that support Petitioner’s Reply prior to Oral Argument.

1. Patent Owner’s Observations on the April 24, 2014 Deposition of Petitioner’s Expert, David R. Karger

1. In Exhibit 1113, on page 41, line 8 to page 45, line 15, the witness testified that the ’403 Patent “says nothing about tiles overlapping”, in connection with the portion at column 9, lines 43 – 56 of the ’403 Patent that was cited at paragraph 53 of Petitioner’s Reply Declaration (Exhibit 1110). This testimony is relevant to Patent Owner’s claim constructions because it establishes that a portion of the ’403 Patent cited in support of Petitioner’s proposition that tiles can overlap does not in fact state that.
2. In Exhibit 1113, on page 46, line 16 to page 47, line 10, the witness testified that he could not “find any other examples where the ’403 patent describes tiles

being permitted to overlap.” This testimony is relevant to Petitioner’s Reply Declaration (Exhibit 1110) at paragraph 53 because it establishes that Petitioner’s expert cannot identify any portion of the ’403 patent in which “tiles are permitted to overlap”. The testimony is further relevant because it reinforces Patent Owner’s proposed claim construction, at least for “tile”, and for “partitioning a visual display of the device into an array of tiles” and “arrange a display into an array of tiles”.

3. In Exhibit 1113, on page 50, lines 3 to 9, the witness testified that a tile as described in Exhibit 1088 is not something that is updated. This testimony is relevant to the Petitioner’s Reply Declaration (Exhibit 1110) at paragraph 49. The testimony is relevant because it establishes that Petitioner’s expert cannot identify a tile in at least one of the references he cites to as being an item that is updated.

4. In Exhibit 1113, on page 53, lines 14 to 21, the witness testified that a tile as described in Exhibit 1088 is not something that is updated. This testimony is relevant to the Petitioner’s Reply Declaration (Exhibit 1110) at paragraph 49. The testimony is relevant because it establishes that Petitioner’s expert cannot identify a tile in at least one of the references he cites to as being an item that is updated.

5. In Exhibit 1113, on page 57, lines 6 to 12, the witness testified that a tile as described in Exhibit 1088 is something different from a tile as used in the ’403 Patent. This testimony is relevant to Petitioner’s Reply Declaration (Exhibit 1110)

at paragraph 49. The testimony is relevant because it establishes that Petitioner's expert cannot identify a tile, within the meaning of the '403 Patent, in at least one of the references to which he cites for the proposition that tiles were known in the prior art.

6. In Exhibit 1113, on page 85, lines 15 to 25, the witness testified that for a "visual grid", "[if] you tell me that the tiles are persistent and their positions are persistent, then I would infer that the grid is persistent". This testimony is relevant to the Petitioner's Reply Declaration (Exhibit 1110) at paragraph 49. The testimony is relevant because it establishes that Petitioner's expert understands that persistence of the grid and tiles are dependent upon one another.

7. In Exhibit 1113, on page 190, lines 12 to 16, the witness testified that, under the Board's construction of "tile", "if I have access [to the information] before the tile is selected, ... that doesn't preclude the tile from providing access when the tile is selected". This testimony is relevant to the Petitioner's Reply Declaration (Exhibit 1110) at paragraphs 68, 69, and 71. The testimony is relevant because it establishes that Petitioner's expert understands that Patent Owner's construction of "tile" does not require selection of a tile to be the sole means of providing access to information.

2. Rebuttals, and Reply Thereto

Patent Owner reserves its right to reply to any rebuttals offered by Petitioner to the observations herein.

Respectfully submitted by:

/Richard G. A. Bone/

Dated: May 23rd, 2014

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

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

PATENT OWNER MOTION FOR OBSERVATIONS ON CROSS-
EXAMINATION OF PETITIONER'S REPLY DECLARANT,
DAVID R. KARGER

was served via Electronic Mail upon the following:

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