

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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SURFCAST, INC.'S  
PATENT OWNER MOTION TO EXCLUDE PETITIONER EVIDENCE  
UNDER 37 C.F.R. § 42.64

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

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Pursuant to 37 C.F.R. § 42.64, Patent Owner, SurfCast, Inc. hereby moves to exclude certain Petitioner submissions and Petitioner testimony in the instant proceeding.

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).

**1. Cross-examination testimony of Patent Owner's expert Glenn Weadock that exceeded the scope of the May 14, 2014 deposition**

Patent Owner objects to the questions located at page 14, line 1 to page 30, line 2 of Exhibit 2089 as exceeding the scope of the May 14, 2014 deposition. The May 14, 2014 deposition is permitted to cross-examine the witness on the contents of his declaration in support of Patent Owner's Reply to Petitioner's Opposition to Motion to Amend (Ex. 2081). The questions at the identified portion of the deposition transcript pertain to Mr. Weadock's first declaration in support of Patent Owner's response (Ex. 2004), and address claim 46, an original claim of the '403 Patent and not a substitute claim. The questions in this portion, and the answers thereto, should be struck from the record as untimely, and as exceeding the scope of cross-examination. Patent Owner objected on the record to this testimony at Ex. 2089, page 15, lines 9 – 13.

Petitioner had an opportunity to cross examine Patent Owner's expert on the

subject matter of his prior declaration, at deposition on March 12, 2014.

**2. Re-redirect-examination testimony of Petitioner's expert David Karger that exceeded what is permitted by the rules at the April 24, 2014 deposition**

Patent Owner objects to the questions located at page 210, line 9 to page 211, line 20 of Exhibit 1113 as exceeding the scope of the April 24, 2014 deposition of Petitioner's expert. The Trial Practice Guide at 48762 sets forth the times for Witness Cross-Examination under the rules see 42.53(c)(2), and specifically provides for periods of cross-examination, redirect examination, and recross-examination for uncompelled direct testimony. (See also, Appendix D of the Trial Practice Guide at 48772.) There is no provision for a further redirect period after recross. The questions in this portion, and the answers thereto, should be struck from the record as exceeding the scope of redirect-examination under the rules. Patent Owner objected to this testimony at Ex. 1113, page 210, lines 11 – 12 and 17 – 18, and at page 211, lines 14 – 17 and 21 – 24.

**3. Petitioner exhibits**

Patent Owner objects to various exhibits that Petitioner submitted in conjunction with its Patent Owner Reply (Paper No. 45) and its Opposition to Motion to Amend (Paper No. 46).

Those exhibits for which objections are now restated include: Nos. 1085 – 1101 and 1107 – 1109.

Patent Owner's counsel timely served Petitioner's counsel with written objections to these exhibits, by e-mail on April 7, 2014, as evinced by Ex. 2090. Those objections are copied here or restated in the following. Patent Owner received no response from Petitioner's counsel to those objections.

Exhibit 1085 (Merriam Webster's Collegiate Dictionary, 10th Ed. (1995) for the term "access"): SurfCast objects to this document as irrelevant, at least because it provides no context for the use of the term in the computer arts.

Exhibit 1086 (Excerpts of Microsoft Computer Dictionary, 4th Ed. (1999) for the term "access"): SurfCast objects to this document as irrelevant, at least because its pertinence to graphical user interfaces has not been established.

Exhibit 1087 (Excerpts of Merriam Webster's Collegiate Dictionary, 10th Ed. (1995) for the term "periodic"): SurfCast objects to this document as irrelevant.

Exhibit 1088 (Excerpts of Glenn E. Weadock, Intranet Publishing for Dummies (1997)): SurfCast objects to this document as irrelevant, and incomplete.

Exhibit 1089 (Glenn E. Weadock, Windows 98 Registry for Dummies (1998)): SurfCast objects to this document as irrelevant.

Exhibit 1090 (GDDM, BaseProgramming Guide, Version 3, Release 2

(September 1996)): SurfCast objects to this document as irrelevant and misleading. Petitioner has cited to page 465 of Exhibit 1090 for the premise that “overlapping partitions” were known in the “prior art”. However, the referenced portion of Exhibit 1090 is misleading because it does not describe “partitioning” a display, and the reference as a whole does not speak to that concept. Instead, the reference describes ways of using partitions to save computing resources (e.g., for screen redraws; Exhibit 1090 at page 453). Additionally, the term partition is used in Exhibit 1090 to describe display elements that enable different functions to be carried out within them. (Ex. 1090 at p.453). Furthermore, at p. 463 of Ex. 1090, the reference describes two panels, each of which may contain multiple partitions.

Exhibit 1091 (U.S. Patent No. 5,974,567): SurfCast objects to this document as irrelevant and misleading. Exhibit 1091 is irrelevant to the claims of the ’403 Patent because it describes a “ghost partition”, pertaining to a data storage device, and does not describe a graphical user interface element. Furthermore, Petitioner has not identified with any specificity any portion or teaching of Exhibit 1091 that pertains to Patent Owner’s claim construction, or the proffered statement that the “prior art” includes examples of “overlapping partitions”.

Exhibit 1092 (Glenn E. Weadock, Intranet Publishing for Dummies (1997) – Full version of Ex. 1088): SurfCast objects to this document as irrelevant.

Exhibit 1093 (U.S. Patent 5,577,935): SurfCast objects to this document as

irrelevant. Exhibit 1093 is irrelevant to the claims of the '403 Patent because it describes a "coaxial, angular connector for installation on a printed circuit board" and does not describe a graphical user interface element. Furthermore, Petitioner has not identified with any specificity any portion or teaching of Exhibit 1093 that pertains to Patent Owner's claim construction, or the proffered statement that the "prior art" includes examples of "overlapping partitions".

Exhibit 1094 (U.S. Patent 7,949,687): SurfCast objects to this document as irrelevant. Exhibit 1094 is not prior art to the '403 Patent because it has a U.S. patent that has an earliest effective priority date of December 31, 2007. It is irrelevant to the claims of the '403 Patent because it describes a "relational database having overlapping partitions", which are not themselves graphical user interface elements. Furthermore, Petitioner has not identified with any specificity any portion or teaching of Exhibit 1094 that pertains to Patent Owner's claim construction, or the proffered statement that the "prior art" includes examples of "overlapping partitions".

Exhibit 1095 (U.S. Patent 6,616,701): SurfCast objects to this document as irrelevant and untimely. Exhibit 1095 is a U.S. patent describing "method and apparatus for identifying features of multidimensional image data in hypermedia systems" (Ex. 1095, Abstract). The disclosure of Exhibit 1095 is irrelevant to the claims of the '403 Patent, and it should not be admitted because it is cited in

support of an argument that could have been raised – but was not raised – in the Petition.

Exhibit 1096 (U.S. Patent 7,139,970): SurfCast objects to this document as irrelevant and untimely. Exhibit 1096 is a U.S. patent describing “apparatus and methods implementing a technique for creating an electronic artwork with a hot area” (Ex. 1096, Abstract). The disclosure of Exhibit 1096 is irrelevant to the claims of the ’403 Patent, and it should not be admitted because it is cited in support of an argument that could have been raised – but was not raised – in the Petition.

Exhibit 1097 (HTML 4.0 Specification (April 24, 1998)): SurfCast objects to this document as irrelevant and untimely. Exhibit 1097 is a publication describing hyper-text mark-up language, cited to for its description of “image maps”. The disclosure of Exhibit 1097 is irrelevant to the claims of the ’403 Patent, and it should not be admitted because it is cited in support of an argument that could have been raised – but was not raised – in the Petition.

Exhibit 1098 (Scott Isaacs, Inside Dynamic HTML (1997)): SurfCast objects to this document as irrelevant and untimely. Exhibit 1098 is a publication describing hyper-text mark-up language, cited to for its description of “image maps”. The disclosure of Exhibit 1098 is irrelevant to the claims of the ’403 Patent, and it should not be admitted because it is cited in support of an argument



that could have been raised – but was not raised – in the Petition.

Exhibit 1099 (Thomas E. LaStrange, “swm: An X Window Manager Shell” (1990)): SurfCast objects to this document as irrelevant.

Exhibit 1100: (U.S. Patent 5,982,445) SurfCast objects to this document as irrelevant. Exhibit 1100 is a U.S. Patent describing “hypertext markup language protocol for television display and control”. The disclosure of Exhibit 1099 is irrelevant to the claims of the ’403 Patent and is only cited for to establish the normal operation of an internet mail protocol at the time of the ’403 Patent.

Exhibit 1101 (Excerpts of The American Heritage Dictionary, Second College Edition (1985) for the term “when”): SurfCast objects to this document as irrelevant.

Exhibit 1107 (EP 1,161,716B): SurfCast objects to this document as irrelevant.

Exhibit 1108 (U.S. Patent 3,760,364): SurfCast objects to this document as irrelevant.

Exhibit 1109 (Redacted Deposition Transcript of Klaus Lagermann, dated June 27, 2013 (from pending civil action in District Court in Maine)): SurfCast objects to this document as irrelevant.

#### **4. Petitioner Reply Declaration**

Patent Owner moves to exclude portions of Petitioner’s Reply evidence,

specifically Exhibit 1110 (Reply Expert Declaration of David Karger).

Patent Owner moves to exclude Paragraphs 54 and 55 of Exhibit 1110 and the references cited in those paragraphs (Exhibits 1090, 1091, 1093, and 1094) as irrelevant and exceeding the scope of a reply brief. Paragraphs 54 and 55 of Exhibit 1110 are in the portion of the Exhibit that address Patent Owner's Response (Paper No. 28). Paragraph 54 states that "the prior art included examples of overlapping partitions" but does not establish that any of the cited documents is "prior art" and does not establish that the disclosure of the references relied upon is relevant to the claims of the '403 Patent. Neither of paragraphs 54 or 55 of Exhibit 1110 identifies with any specificity a portion of Exhibits 1091, 1093, or 1094 that pertain to Patent Owner's claim constructions. For Exhibit 1090, the cited portion does not support Petitioner's premise because the referenced "partitions" do not use the term in a customary manner, as described hereinabove.

Patent Owner moves to exclude Paragraph 57 of Ex. 1110 because it does not specifically address Patent Owner's arguments made in the Patent Owner Response. Patent Owner further objects to Paragraph 57 for mischaracterizing the cited references. Contrary to the statements in Paragraph 57, the cited references (Duperrouzel, MSIE Kit, Duhault II, and Chen) do not describe "tiles" within the meaning of either the Board's or Patent Owner's proposed constructions.

Patent Owner moves to exclude Paragraphs 116 and 122 of Exhibit 1110

because they references material in the cited references that was not relied upon in the Petition and Patent Owner's Response. Specifically, at least the following Pages of MSIE Kit cited to have not previously been relied on by Petitioner: 288, 301, 323, 342, 369, 561, 591, 740, 751, 795, and 797.

Patent Owner moves to exclude Paragraphs 131 – 132 of Exhibit 1110 for their description of “hot spots”. This is a new issue by Petitioner, not previously relied upon in their Petition. It also relies on new evidence, in the form of citations to MSIE Kit (Exhibit 1007) not previously cited (*e.g.*, pages 400, and 420), and in citations to new exhibits, 1095 – 1098.

#### **5. Cross-examination testimony for which objections were timely made**

Patent Owner moves to exclude all cross-examination and recross-examination testimony offered by Patent Owner's witnesses during depositions, and relied upon by Petitioner in papers of record, for which objections were properly and timely made. Pertinent portions of the depositions of Patent Owner's witnesses, include at least the follows:

- a) Klaus Lagermann, inventor (deposed March 6, 2014; transcript at Ex. 2075 and Ex. 1104).

Patent Owner moves to exclude Petitioner's reliance on the portion at 57:8 – 58:17 cited by Petitioner in Reply (Paper No. 45, at page 15),

because timely objections as to form were made (Ex. 1104 at 57:14 and 58:2,11);

- b) Glenn Weadock, expert (deposed March 12, 2014; transcript at Ex. 2077 and Ex. 1106).

Patent Owner moves to exclude Petitioner's reliance on the portion at 27:9 – 16 cited by Petitioner in Reply (Paper No. 45, at page 10), because a timely objection as to form was made (Ex. 1106 at 27:12); Patent Owner moves to exclude Petitioner's reliance on the portion at 121:13 – 122:6 cited by Petitioner in Reply (Paper No. 45, at page 13), because a timely objection as to form was made (Ex. 1106 at 121:20).

Patent Owner moves to exclude Petitioner's reliance on the portion at 132:20 – 133:3 cited by Petitioner in Reply (Paper No. 45, at page 16), because a timely objection as to form was made (Ex. 1106 at 133:1).

Patent Owner moves to exclude Petitioner's reliance on the portion at 60:15 – 63:7 cited in Petitioner's Opposition (Paper No. 46, at page 6), because timely objections as to form were made (Ex. 1106 at 60:24; 61:6,22; 62:3,25; and 63:6)

- c) Richard Bone, prosecuting agent/attorney of the '403 Patent (deposed

February 19, 2014; transcript at Ex. 2073 and Ex. 1102).

Patent Owner moves to exclude Petitioner's reliance on the portion at 64:19 – 65:22 cited by Petitioner in Reply (Paper No. 45, at page 7), because a timely objection as to relevance was made (Ex. 1102 at 64:23).

Patent Owner moves to exclude Petitioner's reliance on the portion at 54:16 – 56:5 cited by Petitioner in Reply (Paper No. 45, at page 8), because a timely objection as to privilege was made throughout the cited portion (Ex. 1102 at 64:23).

## **6. Conclusion**

For at least the foregoing reasons, the Board should exclude the testimony and other evidence referenced herein.

Respectfully submitted by:

/Richard G. A. Bone/

Dated: May 23<sup>rd</sup>, 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

PATENT OWNER MOTION TO EXCLUDE PETITIONER EVIDENCE  
UNDER 37 C.F.R. § 42.64

was served via Electronic Mail upon the following:

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