

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Microsoft Corporation
Petitioner,

v.

SurfCast, Inc.
Patent Owner

Patent No. 6,724,403

Issued: April 20, 2004

Filed: October 30, 2000

Inventor: Ovid Santoro et al.

Title: SYSTEM AND METHOD FOR SIMULTANEOUS DISPLAY OF
INFORMATION SOURCES

Inter Partes Review Nos. IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO EXCLUDE**

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I. Introduction

Patent Owner's Motion to Exclude should be denied in its entirety. *See* IPR2013-00292, Patent Owner's Motion to Exclude, Paper No. 72, at 1-2 ("Motion"). Several of Patent Owner's motions fail to even explain the basis of the objection; these should be denied on that basis alone. *See* 37 C.F.R. 42.64(c) (movant "must explain the objections"); *see also* Office Patent Trial Practice Guide 77 Fed.Reg. 48756, 48767 (requiring movant to "[e]xplain each objection"). Patent Owner's remaining objections are without merit, as explained below, and should also be denied.

II. Patent Owner's Motion Should Be Denied

1. Petitioner's Cross-Examination of Mr. Weadock Is Admissible

Patent Owner first objects to 15 pages of cross-examination testimony of its expert, Mr. Weadock, arguing that this cross-examination testimony does not relate to the expert's direct testimony in support of Patent Owner's Reply to Petitioner's Opposition to the Motion to Amend (Ex. 2081). *See* Motion at 1-2; May 14, 2014 Dep. of Glenn Weadock (Ex. 2089) at 14:1-30:2. Patent Owner is incorrect; the testimony is directly relevant to its motion to amend. The disputed testimony addresses the element in claim 46 that specifies "arrange a display" as well as certain language Patent Owner seeks to add to this claim element though its motion

to amend.¹ Mr. Weadock’s views on the amended and unamended versions of this element of claim 46 demonstrates that the proposed amendment makes no substantive change to the scope of the claim. *See, e.g.*, Ex. 2089 at 27:9-29:2 (“I think certainly the amended language makes explicit what to me is implicit in the word ‘array.’ So it serves to clarify. And I think that’s part of the function of that addition or amendment, would be to clarify something that to me is already implicit in the concept of an array.”). The testimony therefore shows that the amendment does not render the claims patentable, a conclusion clearly relevant to Patent Owner’s motion to amend. The testimony is therefore within the scope of Mr. Weadock’s direct testimony, is highly relevant and should not be excluded.

2. Petitioner’s Re-Direct Examination of Dr. Karger Is Admissible

Patent Owner objects to certain “further redirect” testimony from Petitioner’s expert, Dr. Karger (*see* April 24, 2014 Dep. of David Karger (Ex. 1113) at 210:9-211:20) as “exceeding the scope” of redirect examination because it followed re-cross examination. Motion at 2. However, the rule cited by Patent Owner is directed only to the *duration* of examination; it does not limit a party to a single sequence of questions on redirect or prohibit re-direct after re-cross in order

¹ Petitioner observes that Patent Owner’s proposed substitute claim 53 is an amended version of claim 46.

to clear up ambiguous testimony elicited on re-cross. *See* 37 C.F.R. § 42.53(c)(2); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48772 App. D (limiting the duration of testimony per 37 C.F.R. § 42.53(c)). Since neither the Rules nor the Trial Practice Guide precludes further redirect testimony within the stated time limitations, and because Patent Owner has never asserted that Petitioner exceeded the proscribed time limits, Patent Owner's request to exclude this testimony should be denied.

3. Petitioner's Exhibits Are Admissible

Patent Owner next challenges in a scattershot manner the admissibility of various exhibits, primarily on the basis of relevance. Motion at 2-7. Evidence is relevant, however, if “it has *any* tendency to make a fact more or less probable than it would be without the evidence; and . . . the fact is of consequence in determining the action.” *See* Fed. R. Evid. 401 (emphasis added). Each of the exhibits Patent Owner objects to satisfies that standard, as shown below.

Patent Owner objects to three exhibits – **Ex. 1085** (Merriam Webster's Collegiate Dictionary, 10th Ed. (1995)); **Ex. 1086** (Excerpts of Microsoft Computer Dictionary, 4th Ed. (1999)); and **Ex. 1087** (Excerpt of Merriam Webster Collegiate Dictionary, 10th Ed. (1995)) – solely on the basis of relevance. Motion at 3. The exhibits are relevant to how one of ordinary skill in the art would understand the terms “access” (Exs. 1085 and 1086) and “periodic” (Ex. 1087),

which Patent Owner addresses in its claim construction arguments, *see, e.g.*, IPR2013-00292, Patent Owner’s Response, Paper No. 27, at 3-4.

Patent Owner next objects to **Ex. 1088** (Excerpts of *Intranet Publishing for Dummies*, Glenn Weadock (1997)) as being irrelevant and incomplete. However, **Exhibit 1088** is relevant to how one of ordinary skill in the art would understand “tile.” It also impeaches Patent Owner’s expert (Glenn Weadock), whose testimony concerning the meaning of the term “tile” is at odds with his own previously published work. *See* Ex. 1110, Reply Decl. of David Karger, at ¶ 49. Further, Patent Owner’s completeness objection is baseless, as the complete version of the document was also placed in the record at the same time as Ex. 1088. *See* Ex. 1092, *Intranet Publishing for Dummies*, Glenn Weadock (1997); March 12, 2014, Dep. of Glenn Weadock (Ex. 2077), at 75:6-13.

Next, Patent Owner asserts without explanation or argument that **Ex. 1089** (*Windows 98 Registry for Dummies*, Glenn Weadock (1998)) is irrelevant. Motion at 3. However, Rule 42.64(c) expressly requires that a motion to exclude “must explain the objections.” 37 C.F.R. 42.64(c); *see also* Trial Practice Guide 77 Fed.Reg. 48756, 48767 (requiring movant to “[e]xplain each objection.”). Because Patent Owner entirely fails to explain its objection, its objection to **Ex. 1089** must be denied. In any event, **Ex. 1089** is also relevant because it confirms that MSIE Kit discloses that administrators could prevent users from rearranging Desktop

Items, including by locking down the “default” Active Desktop layout of a “3 by 2 grid” of Desktop Items. That functionality, along with other disclosures of Active Desktop, demonstrates that Patent Owner’s proposed substitute claims are not patentable. *See* Ex. 1110 at ¶ 191. **Ex. 1089** is therefore relevant.

Patent Owner next lodges a series of conclusory objections to **Ex. 1090** (GDDM, Base Application Programming Guide, Version 3, Release 2 (1996)); **Ex. 1091** (U.S. Patent No. 5,974,567); **Ex. 1092** (*Intranet Publishing for Dummies*, Glenn Weadock (1997)); **Ex. 1093** (U.S. Patent No. 5,577,935) and **Ex. 1094** (U.S. Patent No. 7,949,687). First, Patent Owner objects to Exhibits **1090** and **1091** as “irrelevant and misleading” and to Exhibits **1092-94** as being irrelevant. Motion at 3-5. However, that Patent Owner believes evidence may be “misleading” is no basis for exclusion. At most it would go to the weight of the evidence. Had Patent Owner believed that Exhibits **1090** and **1091** were misleading, it should have cross-examined Dr. Karger on them and argued the point to the Board.

Moreover, each of Exhibits 1090-91 and 1093-04 is relevant to how one of ordinary skill in the art would have understood the word “partitioning” to include creating overlapping partitions, which undercuts Patent Owner’s arguments to the contrary. *See, e.g.*, Ex. 1110 at ¶ 54. Exhibit **1092** is also relevant to how one of ordinary skill in the art would understand “tile,” in part because it impeaches Patent Owner’s expert (Glenn Weadock), whose testimony concerning the

meaning of that term is at odds with his own previously published works. *See* Ex. 1110 at ¶ 49.

Patent Owner next argues that **Exhibits 1095** thru **1098**, are irrelevant and untimely; in fact they are neither. These exhibits describe prior art “hot spot” functionality, and are therefore relevant to Petitioner’s original arguments regarding the “hot spot” functionality disclosed in MSIE Kit (Ex. 1007). *See, e.g.*, Ex. 1007, MSIE Kit at 177 (“Therefore, information in desktop items often includes hyperlinks or hot spots, so users can click a designated area to open a browser window and obtain the details they want.”). Petitioner’s expert, Dr. Karger, relied on the “hot spot” functionality disclosed in MSIE Kit to demonstrate in his original declaration (Ex. 1003) that Active Desktop Items are selectable to provide access to an underlying information source, and Petitioner cited that testimony in its petition. *See* Ex. 1003, Decl. of David Karger, at ¶ 270; *see also* IPR2013-00295, Petition, Paper No. 4, at 22. Patent Owner contested that disclosure in its response. *See* IPR2013-00292, Patent Owner’s Response, Paper No. 27, at 48-51. Exhibits **1095** thru **1098** were therefore offered to rebut Patent Owner’s assertions and show that a person of ordinary skill in the art would have understood the “hot spot” functionality of MSIE Kit to permit, for example, the entire Active Desktop Item to be made clickable in order to activate a link such as a hyperlink or Active X control. *See, e.g.*, Ex. 1110 at ¶¶ 115-116, 153. These

exhibits are therefore relevant to one of the several ways in which the disclosure of MSIE Kit satisfies the claims.

Patent Owner argues **Ex. 1099** (*swm: An X Window Manager Shell*, Thomas LaStrange (1990)) is irrelevant but provides no explanation why. Motion at 7. Therefore, any argument on relevance is waived for failure to explain the objection, and this exhibit should remain in the record. *See* 37 C.F.R. 42.64(c); *see also* Trial Practice Guide 77 Fed.Reg. 48756, 48767 (requiring movant to “[e]xplain each objection.”). In any event, the exhibit is relevant because it rebuts Patent Owner’s assertion that prior art windows were not persistent. *See* Ex. 1110 at ¶ 52.

Patent Owner argues **Ex. 1100** (U.S. Patent No. 5,982,445) is irrelevant. This exhibit demonstrates that a person of ordinary skill would understand that selecting a “mailto” link, as disclosed in MSIE Kit (Ex. 1007), would call an e-mail application, and is therefore relevant to how MSIE Kit renders the proposed amended claims unpatentable. *See* Ex. 1110 at ¶¶ 229-232.

Patent Owner argues that **Ex. 1101** (Excerpts of The American Heritage Dictionary, 2nd College Ed. (1985)); **Ex. 1107** (EP 1,161,716); **Ex. 1108** (U.S. Patent No. 3,760,364); and **Ex. 1109** (June 27, 2013 Dep. Tr. of Klaus Lagermann (D. Me.)) are irrelevant, but again provides no explanation why. Motion at 7. Therefore, any argument on relevance for these exhibits is waived for failure to

explain the objection, and they should not be excluded. *See* 37 C.F.R. 42.64(c); *see also* Trial Practice Guide 77 Fed.Reg. 48756, 48767. In any event, Exhibit **1101** is relevant to how one of ordinary skill in the art would understand the ordinary English word “when,” as used in the Board’s construction of “tile.” *See* Ex. 1110 at ¶ 69. Exhibits 1107 (EP 1,161,716) and 1108 (U.S. Patent No. 3,760,364) likewise are relevant because they show how one of ordinary skill in the art would understand the term “main memory,” which appears in Patent Owner’s putative priority document and which Patent Owner has erroneously relied on to show written description support. *See* Ex. 1110 at ¶ 170; *see also* IPR2013-00292, Patent Owner’s Conditional Motion to Amend, Paper No. 28, at 5.

Exhibit **1109** (Dep. Tr. of Klaus Lagermann, June 27, 2013 (D. Me.)) is relevant as it discloses Mr. Lagermann’s (an inventor of the ‘403 Patent) understanding of how the claims of the ‘403 patent relate to Active Desktop functionality, such as that disclosed in MSIE Kit (Ex.1007). *See* Ex. 1110 at ¶ 237. It is also relevant to these proceedings because in that transcript Mr. Lagermann agrees that the only aspect of the system disclosed in the ‘403 patent that the inventors characterize as “novel” was in fact not novel precisely because Active Desktop included that functionality first. *See* Ex. 1109 at 52:23-54:4. That admission is relevant to the level of ordinary skill in the art and to the patentability

of the claims at issue here.

4. Petitioner’s Reply Declaration Is Admissible

Patent Owner also moves to exclude portions of the Dr. Karger’s Reply Declaration (Ex. 1110) on various grounds. Motion at 7-9. Patent Owner’s request should be denied.

As to **Ex. 1110, ¶¶ 54-55**: Patent Owner argues these paragraphs are irrelevant and exceed the scope of the reply brief. Incorrect. These paragraphs are relevant to how one of ordinary skill in the art would have understood the word “partitioning” to include creating overlapping partitions. Moreover, these paragraphs directly rebut Patent Owner’s arguments in opposition to the petition, which is the very purpose of a reply. *See, e.g.*, IPR2013-00292, Patent Owner’s Response, Paper No. 27, at 12; *see also* Ex. 2063, Declaration of Glenn Weadock In Support Of Motion to Amend, at ¶ 96.

As to **Ex. 1110, ¶ 57**: Patent Owner asserts this paragraph should be excluded “because it does not specifically address Patent Owner’s arguments made in the Patent Owner Response” and because, according to Patent Owner, it mischaracterizes the prior art on which these proceedings are based as including the claimed “tiles.” Motion at 8. Both points are clearly wrong. Ex. 1110, ¶ 57 explicitly states Dr. Karger’s opinion that Patent Owner’s proposed amendment would not result in a patentable claim, thus directly addressing Patent Owner’s

arguments. As for mischaracterization, as Dr. Karger has demonstrated (*see, e.g.*, Ex. 1003 at ¶¶ 268, 475-76, 540, 576, 605, 628, 661, 682), and the Board has found (*see* IPR2013-00292, Institution Decision, Paper No. 19, at 25-41), the cited prior art does disclose “tiles.” In any event, that Patent Owner does not agree with that conclusion does not mean that Dr. Karger is mischaracterizing anything and certainly is no basis for exclusion.

As to **Ex. 1110, ¶¶ 116, 122**: Patent Owner provides no viable basis for excluding these paragraphs, arguing only that Dr. Karger cites additional pages of MSIE Kit (Ex. 1007) in response to Patent Owner’s expert’s testimony. Motion at 8-9. But the entirety of MSIE Kit (Ex. 1007) has been properly placed into evidence without objection from Patent Owner. Moreover, Dr. Karger’s citations to MSIE Kit in Ex. 1110, ¶ 116 are directly in response to Patent Owner’s expert’s assertions that MSIE Kit (Ex. 1007) fails to disclose the ability to disclose a word processor or spreadsheet application *anywhere in the document*. *See* Ex. 2004 at ¶¶ 115-18. Further, Dr. Karger’s citations to MSIE Kit in Ex. 1110, ¶ 122 are directly in response to Patent Owner’s expert’s assertions that MSIE Kit (Ex. 1007) fails to disclose the ability to select an Active Desktop Item *anywhere in the document*, *see* Ex. 2004 at ¶ 119. Petitioner relied on that selection functionality in its original petition. *See* Ex. 1003 at ¶ 270; *see also* IPR2013-00295, Petition, Paper No. 4, at 22. In any event, Dr. Karger’s testimony and the passages he cites in Ex. 1110, ¶¶

116 and 122 are also relevant to Petitioner’s opposition to Patent Owner’s motion to amend, as Dr. Karger’s Reply Declaration demonstrates. *See, e.g.*, Ex. 1110 at ¶¶ 213-15. Accordingly, even if that testimony had been new evidence, it would be proper and admissible because Petitioner was entitled to advance new evidence in its opposition to the motion to amend.

As to **Ex. 1110, ¶ 131-132**: Patent Owner asserts that these paragraphs, which relate to the “hot spot” functionality in MSIE Kit (Ex. 1007) raise “a new issue by Petitioner, not previously relied upon in their Petition.” Motion at 9. It also states that this testimony “relies on new evidence” in the form of citations to additional pages of MSIE Kit (Ex. 1007) and to exhibits 1095-1098. Reliance on the “hot spot” functionality in MSIE Kit, however, is certainly **not** “a new issue by Petitioner, not previously relied upon in their Petition.” As demonstrated above, Petitioner’s expert relied on the “hot spot” functionality of MSIE Kit in his original declaration filed with the Petition, specifically citing Ex. 1007, MSIE Kit at 177. *See* Ex. 1003 at ¶ 270. Indeed, that page of MSIE Kit discusses the “hot spot” functionality: “Therefore, information in desktop items often includes hyperlinks **or hot spots**, so users can **click a designated area** to open a browser window and obtain the details they want.” *See* Ex. 1007 at 177. And Petitioner relied on the cited testimony by Dr. Karger in its Petition. *See* IPR2013-00295, Petition, Paper No. 4, at 22. Moreover, Patent Owner specifically responded to that testimony in

its response, even quoting the very sentence relied on by Dr. Karger. *See* IPR2013-00292, Patent Owner’s Response, Paper No. 27, at 48 (quoting MSIE Kit at 177).

Further, citing additional pages of MSIE Kit is not relying on “new evidence,” since the entirety of MSIE Kit had already been put into evidence with the Petition and the additional pages rebutted Patent Owner’s specific arguments in opposition that nowhere did MSIE Kit disclose the selectability of Active Desktop Items. *See id.* Nor was it improper to advance additional exhibits to rebut Patent Owner’s arguments by showing how a person of ordinary skill in the art would understand the “hot spot” functionality disclosed in MSIE Kit. Patent Owner’s arguments on this point should also be rejected.

5. Petitioner’s Cross-Examination Testimony Is Admissible

Patent Owner also moves to exclude certain cross-examination testimony *simply because* an objection was made on the record and without any explanation of how the cited testimony was objectionable. *See* Motion at 9-11. Patent Owner’s failure to explain its objections require these arguments to be rejected. *See* 37 C.F.R. 42.64(c) (stating movant “must explain the objections”); *see also* Trial Practice Guide 77 Fed.Reg. 48756, 48767 (requiring movant to “[e]xplain each objection.”).

The testimony is in any event admissible. The cited questioning of Mr.

Lagermann, Motion at 9-10 (citing Ex. 2075 at 57:8-58:17)², were unambiguous, not compound and in all other ways in proper form, as demonstrated both by Patent Owner’s failure to provide any explanation otherwise and by the witness’ ability to readily answer those questions. Indeed, Petitioner notes that Patent Owner never objected to the question at Ex. 2075 at 58:15-17 (“Q. And it is your opinion that clicking on a portion of tile can be selecting the tile itself. A. Yes.”).

The cited questions to Mr. Weadock, Motion at 10, were also in proper form, as confirmed by Patent Owner’s inability to explain otherwise and by the ready ability of Patent Owner’s experienced expert witness to answer them all.

The cited questioning of Dr. Bone at **Ex. 2073/1102, 64:19-65:22**, which is objected to on the basis of relevance is directly relevant to the credibility of Dr. Bone (Patent Owner’s lead counsel and prosecuting attorney) due to his financial interest in the outcome of this matter and the related district court proceedings.

As to **Ex. 2073/1102, 54:16-56:5**: Patent Owner asserts that the testimony at pages 54:16-56:5 of this transcript should be excluded because a “timely objection as to privilege was made.” However, the cited transcript passage **is** the assertion of the privilege and Petitioner relies on the cited passage, and the passage is relevant, precisely *because* a privilege objection was made. More precisely, Patent Owner

² Petitioner notes that this transcript has also been placed in the record as Ex. 1104 and the cited passage is found at Ex. 1104 at 58:8-59:17.

chose to assert the attorney-client privilege over the testimony of its diligence witness (Dr. Bone) rather than permit discovery into its putative evidence of diligence. As Petitioner argued in its Reply, by preventing discovery into its evidence, Patent Owner cannot carry its burden to show reasonable diligence, and therefore cannot prove an invention date that would remove Duhault II (Ex. 1013) as prior art. *See* IPR2013-00292, Petitioner’s Reply to Patent Owner Response, Paper No. 45, at 8.

Moreover, the assertion of privilege during a deposition, without more, is not a valid reason to exclude the portion of the deposition transcript that includes the assertion, since the objection alone does not indicate a lack of relevance.

III. Conclusion

Based on the reasons provided above, the Board should dismiss SurfCast’s Motion to Exclude.

Dated: June 6, 2014

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of June, 2014, a copy of this Petitioner Microsoft Corporation's Opposition to Patent Owner's Motion to Exclude has been served in its entirety by e-mail on the following counsel of record for patent owner:

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