

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

Inventors: 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 MICROSOFT CORPORATION'S RESPONSE TO
PATENT OWNER'S MOTION FOR OBSERVATIONS**

As authorized by the Board in its Order of April 21, 2014, IPR2013-00292 Paper No. 53, Petitioner submits the following response to Patent Owner's observations on Exhibit 1113 (Transcript for deposition of David Karger on April 24, 2014).

(1) In Observation No. 1, Patent Owner asserts that "the '403 Patent cited in support of Petitioner's proposition that tiles can overlap does not in fact state that." However, in Exhibit 1113, from page 384 (p. 197), line 20 to page 386 (p. 199), line 21, Dr. Karger testified that the '403 patent indeed discloses embodiments of overlapping tiles, pointing to column 9, lines 45-47 of the '403 patent ("In this embodiment, double clicking tile 402 or 412 causes the image to be expanded to fit the whole display area.") as an example.

(2) In Observation No. 2, Patent Owner asserts that "Petitioner's expert cannot identify any portion of the '403 patent in which 'tiles are permitted to overlap'" and that "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.'" As noted above, in Exhibit 1113, from page 384 (p. 197), line 20 to page 386 (p. 199), line 21, Dr. Karger testified that the '403 patent indeed discloses embodiments of overlapping tiles, pointing to column 9, lines 45-47 of the '403 patent ("In this embodiment, double clicking tile 402 or 412 causes the image to be expanded to fit the whole display

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area.”) as an example.

(3) In Observation Nos. 3 and 4, Patent Owner asserts that Dr. Karger “testified that a tile as described in Exhibit 1088 is not something that is updated” and that this “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.” However, Exhibit 1088 is a book written by Patent Owner’s own expert (Mr. Weadock), which expressly defines a “tile,” and Dr. Karger explained in Exhibit 1113, on page 243 (p. 56), lines 15-23 that the definition of “tile” given by Exhibit 1088 is relevant in the sense of being comprehensive, and also relevant because there is no requirement of persistence in the definition of “tile” in Exhibit 1088, just like there are no requirements of persistence in the definition of “tile” in the other examples Dr. Karger mentions in his declaration (*e.g.*, Exs. 1020, US 5,321,750, and 1040, US 5,812,123), which are closer (than Ex. 1088) to the tiles in the ‘403 patent.

(4) In Observation No. 5, Patent Owner asserts that Dr. Karger further “testified that a tile as described in Exhibit 1088 is something different from a tile as used in the ’403 Patent” and that this “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.” As noted above, Exhibit 1088 is a book

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written by Patent Owner's own expert (Mr. Weadock), which expressly defines a "tile," and Dr. Karger explained in Exhibit 1113, on page 243 (p. 56), lines 15-23 that the definition of "tile" given by Exhibit 1088 is relevant in the sense of being comprehensive, and also relevant because there is no requirement of persistence in the definition of "tile" in Exhibit 1088, just like there are no requirements of persistence in the definition of "tile" in the other examples Dr. Karger mentions in his declaration (*e.g.*, Exs. 1020, US 5,321,750, and 1040, US 5,812,123), which are closer (than Ex. 1088) to the tiles in the '403 patent."

(5) In Observation No. 6, Patent Owner asserts that "Petitioner's expert understands that persistence of the grid and tiles are dependent upon one another" because he 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." However, in Exhibit 1113, page 273 (p. 86), lines 2-23, Dr. Karger explains that the grid formed by the persistent tiles would not necessarily be persistent even if "the data structure includes the position and that the entire data structure for each tile is persistent" and that Patent Owner's misunderstanding "is a consequence of there being not a lot of detail about exactly what this patent wants to mean by persistence and so forth. I could persistently maintain information about the tiles, the grid, the layout and so on and so forth, without having the visual presentation itself be persistent."

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(6) In Observation No. 7, Patent Owner asserts 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.” While Patent Owner *now* appears to agree with Petitioner in saying that “Patent Owner’s construction of ‘tile’ does not require selection of a tile to be the sole means of providing access to information,” Patent Owner took inconsistent positions throughout the proceeding. *See, e.g.*, IPR2013-00292, Patent Owner Response, Paper No. 27 at 37 (“However, that change upon selection does not provide access to the underlying information source because the information from the underlying information source was already being displayed before the image was even selected.”)

Dated: June 6, 2014

Respectfully Submitted,

/Jeffrey P. Kushan/
Jeffrey P. Kushan
Registration No. 43,401
Sidley Austin LLP
1501 K Street NW
Washington, DC 20005
jkushan@sidley.com

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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 RESPONSE TO PATENT
OWNER'S MOTION FOR OBSERVATIONS has been served in its entirety by e-
mail on the following counsel of record for Patent Owner, per 37 C.F.R. §
42.6(e)(4)(ii):

Richard G. A. Bone (Lead Counsel)

RBone@VLPLawGroup.com;

Patents@VLPLawGroup.com

James M. Heintz (Backup Counsel)

292_IPR_DLAteam@dlapiper.com

Dated: June 6, 2014

Respectfully submitted,

/Jeffrey P. Kushan/

Jeffrey P. Kushan

Reg. No. 43,401

Sidley Austin LLP

1501 K Street NW

Washington, DC 20005

jkushan@sidley.com

Attorney for Petitioner