

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

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

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1. Introduction

Pursuant to 37 C.F.R. § 42.64, Patent Owner opposes Petitioner's motion to exclude (Paper No. 67; "Motion"). This Opposition is timely, as it is submitted on DUE DATE 5 of the Revised Scheduling Order (Paper No. 53).

2. Patent Owner Evidence Petitioner Requests to be Excluded

A. Patent Owner's Expert used the Correct Claim Construction

Petitioner has moved to exclude "certain paragraphs of Exhibits [*sic*] 2004 (Declaration of Glenn Weadock) because they rely on a claim construction that is differ [*sic*] from and inconsistent with the Board's claim construction". Mot. at 1. The grounds of exclusion are: relevance; lacking foundation; relying on facts not in evidence; containing improper legal conclusions; and mischaracterizing evidence. Mot. at 1 Taken literally, there are *five* separate grounds of exclusion for each of *ten* separate (¶¶ 29, 44, 54, 92, 103-104, 119-120, 136, and 137) of Ex. 2004, but none of these 50 grounds is specifically articulated. Petitioner only provides a single rationale for exclusion (that the Board's claim construction was not discussed), and applies it to only ¶¶ 29 and 44 of Ex. 2004 (Mot. at 1 – 2).

Petitioner states that it "objected to this evidence" by letter to Patent Owner's lead counsel, on January 29, 2014 (Mot. at 2, and Attachment A to Mot.), but the objections to Ex. 2004 set forth in that letter (Attachment A to letter) did not even reference the paragraphs that were articulated later in the Motion, and therefore were even less specific than those to which Patent Owner now responds. Patent Owner timely responded to Petitioner by (Ex. 2092) pointing out that the objections lacked the specificity required by 37 C.F.R. § 42.64(b)(1). Petitioner's

objections to the specific paragraphs of Ex. 2004 have therefore been waived.

Nevertheless, in the event that the Board entertains Petitioner's now untimely objections, Patent Owner addresses those objections in full as follows.

Petitioner's motion to exclude portions of Ex. 2004 should be denied at least because the grounds for objection are pertinent to the weight to be accorded the testimony and not its admissibility. Furthermore, because Ex. 2004 properly addresses Patent Owner's proposed construction, those objections are unfounded.

The Board's claim construction is not final, and is reviewable in light of both parties' subsequent briefings and oral argument. Patent Owner has offered an expert declaration (Ex. 2004) in support of its proposed claim construction, an issue that remains alive in the proceeding, and this testimony is therefore admissible and relevant despite Petitioner's objections.

The identified paragraphs of Ex. 2004 do not "lack foundation", or "rely on facts not in evidence" because they rely on portions of the '403 Patent (*e.g.*, Ex. 2004 at ¶ 29), the Board's interim claim construction (Paper No. 19), the knowledge of a person of ordinary skill (Ex. 2004 at ¶¶ 37, 38), and the declaration of Petitioner's expert (Ex. 1003). Petitioner's other grounds address the weight to be afforded the evidence, not its admissibility.

Petitioner's sole rationale of exclusion (that the Board's claim construction was not addressed) is incorrect as applied to at least ¶ 44 of Ex. 2004 ("I therefore respectfully disagree with the Board's view of a tile ..."). For the remaining paragraphs, Patent Owner's expert is supporting Patent Owner's claim

construction, but also referencing the Board's interim claim construction as applicable: see, *e.g.*, Ex. 2004 at ¶¶ 30, 31, 45, 51, 58, 66, 67, and 68. Mr. Weadock also references the Board's analysis when discussing the particular references over which trial was instituted. See, *e.g.*, Ex. 2004 at ¶¶ 84, 121, and 124. Although Petitioner identifies portions of Ex. 2004 in which the Board's analysis was not explicitly referenced, those paragraphs cannot and should not be read out of context. When reviewed in its entirety, it is clear that the Board's construction was analyzed and that nothing in Ex. 2004 should be excluded.

B. Patent Owner Properly Redacted Certain Privileged Material, and Properly Objected to Other Testimony as Privileged

Petitioner argues that "Patent Owner's prosecution counsel was instructed not to answer numerous questions regarding his diligence, supposedly evidenced by [redacted] documents [Exs. 2035, 2049, and 2050] based on an assertion that the redacted portions of the documents were protected by the attorney-client privilege" and "therefore moves to exclude all of [Dr. Bone's deposition] testimony and the related direct testimony relied on by Patent Owner". Mot. at 2-3.

Patent Owner responds that the redactions in Exhibits 2035, 2049, and 2050 are unrelated to the portions documents upon which Patent Owner relies. Specifically, in Ex. 2035 (Dr. Bone's time entry log book), the entries redacted are those that pertain to clients of Pennie & Edmonds LLP *other than* Patent Owner. The time entries for those clients are irrelevant to the work performed for Patent Owner. Moreover, the privilege that protects them is not Patent Owner's to waive. In Exhibits 2035 and 2049, the redacted entries pertain to time entry narratives that

describe work carried out by other attorneys at the Pennie firm who were advising Patent Owner in matters other than the preparation of the patent application.

Because the redacted portions of these exhibits are not relied upon by Patent Owner, Petitioner's motion to exclude the exhibits on this basis is not availing.

Second, during Dr. Bone's deposition, there were only six questions to which an instruction not to answer based on the attorney client privilege was given. Petitioner has now identified them in its Motion, but asserted during the deposition that privilege had been waived with respect to all testimony. Petitioner's counsel declined to identify portions for which privilege was waived during deposition, even when specifically invited to do so by deponent's counsel. Ex. 2073 at 179.

Petitioner's questioning is directed to attorney diligence, for which a critical showing is that there was reasonable continuity of work on the application, including the dates of that work. ("We emphasized that the attorney's records should 'show the exact days when activity specific to [the patentee's] application occurred'." *In re Enhanced Sec. Research*, 739 F.3d 1347, 1358 (Fed. Cir. 2014)). None of the dates, and the time spent on each date, as well as a narrative for the work related to Patent Owner's patent application, were redacted. By contrast, the testimony solicited by Petitioner during deposition for which an assertion of privilege was made, was not related to patent application preparation. Instead, Petitioner wanted the substance of attorney-client conversations and the legal advice Dr. Bone was providing as part of his work. Thus privilege was properly asserted. Petitioner cites *Seagate* for the proposition that an assertion of attorney-

client privilege cannot be used as both a sword and a shield. But Patent Owner is not relying on information over which it claimed privilege; rather is using the non-privileged information to establish diligence, and *Seagate* does not apply.

Furthermore, Petitioner cites no authority entitling it to inquire into attorney-client conversations to refute diligence. Patent Owner is required to advance evidence that its attorney was working diligently on the patent, but is not required to divulge how those activities relate to diligence. See e.g., *Monsanto Co. v. Mycogen Plant Science, Inc.*, 261 F.3d 1356, 1366 - 1368 (Fed. Cir. 2001). Dr. Bone's declaration (Ex. 2008) explained which entries were related to drafting the patent application – such information is all that is needed to prove diligence.

Petitioner also seeks to exclude Patent Owner Exhibit Nos. 2009 – 2012, 2015, 2016, 2018 – 2022, 2035, 2049, and 2050 that were redacted in part. Patent Owner placed no reliance on the redacted portions of any exhibit. The redactions protect confidentialities or privileged information that are irrelevant to this proceeding, and are therefore proper; the Exhibits should not be excluded.

Petitioner moves to exclude certain of Patent Owner's exhibits having dates redacted but which are "relied upon to establish the date of conception". Patent Owner disagrees to the extent that, for conception, the specific dates are irrelevant, other than that they are established to be before the date of the reference (in this case, Duhault II). Inventor Santoro asserts, in his declaration, that the dates of the documents used to establish conception are before the filing date of Duhault II. This is therefore entirely consistent with Patent Office practice when establishing

conception. MPEP § 715.07(II) (“When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date.”)

In any case, Petitioner has had the information all along because the same exhibits are in evidence in the parallel litigation (D.Ct. Maine, 2:12-cv-00333). Ex. 2023, for example, even has the Bates numbers on it from the Maine case.

Finally, Patent Owner had filed unredacted copies of the exhibits on February 10, 2014 in the instant proceeding. Those versions were expunged from the record by the Board on May 28, 2014, long after Petitioner needed to rely upon them for the purpose of its Petitioner Reply. Patent Owner will file a motion to have the redacted versions replaced with the unredacted versions in due course.

C. Patent Owner’s Diligence Testimony Should Not be Excluded

Petitioner moves to exclude deposition testimony of Dr. Bone for being “uncorroborated and speculative”. Petitioner statement that “Patent Owner relies on that testimony” (Mot. at 6) is incorrect because the February 19, 2014 deposition of Dr. Bone took place *after* the Patent Owner Response was filed.

There is a circularity to Petitioner’s objections: Dr. Bone’s diligence evidence comprises pages from a time entry log book (Ex. 2035), and a Declaration (Ex. 2008). The best evidence is the time entry log book because it is a contemporaneous record of Dr. Bone’s activity in 1999 and was made in the

routine course of business.

Petitioner by its own admission elicited very little from Dr. Bone at deposition in the way of testimony that it seeks to rely on; in fact, Petitioner now seeks to exclude large portions of that testimony as “speculation” by an “interested” witness. However speculative the testimony may be, it does not controvert what was written in the time entry log book in 1999. The fact that Dr. Bone cannot now remember more details than what is written in the logbook does not negate that work was done on the days in question as narrated in the logbook. Furthermore, Patent Owner does not rely on Dr. Bone’s deposition testimony.

Petitioner further asserts that Dr. Bone’s deposition testimony needs to be corroborated because it is the “oral testimony by [an] interested part[y]”. Petitioner identifies no fact solicited at deposition, and upon which either party seeks to rely, that requires corroboration. Furthermore, Dr. Bone’s financial interest in Patent Owner did not exist at the time that the time entries were made. The entries are therefore not required to be corroborated, but in any case, a number of entries *are* corroborated by invoices from the Pennie firm to Patent Owner.

D. Patent Owner’s Reply is Within the Scope of a Proper Reply

Petitioner’s objections to portions of Patent Owner’s Reply (Paper No. 62) as beyond the scope have no place in a motion to exclude, at least because they do not rely on an objection in the record (IPR2013-00063, Paper No. 71 at 13 – 14).

Further, a “reply may only respond to arguments raised in the corresponding opposition”. (§ 42.23; Trial Practice Guide at p. 48767). In each of Petitioner’s

objections, Patent Owner was simply responding to arguments raised by Petitioner in Opposition to the motion to amend (Paper No. 46).

Petitioner states that it “objected to the expert’s new testimony” and to Patent Owner’s “new testimony” by letter to Patent Owner’s lead counsel (Mot. at 8, 9, and 10, and Attachment B). However, the objections set forth in Petitioner’s letter did not reference Patent Owner’s alleged new testimony but instead only objected to Patent Owner’s exhibits that accompanied Patent Owner’s Reply.

Petitioner objects to Ex. 2081 (apparently in its entirety) “as irrelevant, lacking foundation, assuming facts not in evidence, calling for legal conclusion, inconsistent with evidence of record, misleading, mischaracterizing evidence, untimely, and outside the scope of a proper reply.” (Attachment B to Mot. at page 1). Even though the letter lists certain paragraphs of Ex. 2081 for each ground of rejection, there is no specific explanation of the basis for any of the objections.

Patent Owner notes that the time period for a response to Petitioner’s letter, under 37 C.F.R. 42.64(b)(2), fell outside of the due-date for the parties to file motions to exclude evidence, but before the period for oppositions to those motions. Patent Owner therefore presents its bases for opposition herein.

Patent Owner did not offer new arguments for its construction of “said grid of tiles being persistent from session to session”. Petitioner argues that Patent Owner “advances new interpretations and alleged support for the” language of the proposed substitute claims. Mot. at 7, citing to Paper No. 62 at 1 – 2, and Ex. 2081 at ¶¶ 7 – 49. However, the arguments and support are not new. Patent Owner’s

expert explained how the term should be construed in a prior Declaration (Ex. 2063 at ¶¶ 30 – 33). In all other respects, Patent Owner responds directly to arguments made in Petitioner’s opposition and are therefore proper.

Petitioner argues that “Patent Owner had an obligation to sufficiently construe its proposed amended claims in its motion”. (Mot. at 7, citing to IPR2013-0033: Paper No. 122 at 50 – 51, where a newly proposed limitation was not supported by a means plus function construction.) However, in the instant proceeding, in contrast to IPR2013-00033, the language of Patent Owner’s substitute claims is borrowed from the claim construction for the unamended claims, which was fully briefed for the Board’s and Petitioner’s consideration. See, *e.g.*, Patent Owner Response (Paper No. 27 at 6 – 11).

Patent Owner did not offer new support for its construction. Petitioner objects to ¶¶ 55 and 56 of Ex. 2081 as “improperly offer[ing] new testimony” on claim support. To the contrary, Patent Owner, through its expert, is just replying to an issue that Patent Owner had raised in Opposition.

Patent Owner is entitled to rebut invalidity arguments raised by Petitioner over Myers and Kostas. Petitioner has argued that Patent Owner’s arguments over, and expert testimony in respect of Myers (Ex. 1066), should be excluded because “Patent Owner’s burden was to ‘demonstrat[e] patentability of the proposed substitute claims over the prior art in general.’”. This argument ignores Patent Owner’s clear statement that it considered the “references most relevant to the proposed amendment”. Paper No.28 at page 7, which included the references

attached to the Petition, and therefore included Myers.² Patent Owner considered Myers to be less relevant than other references meriting attention. Reply at 3.

Furthermore, Patent Owner's Reply analysis of Myers is proper because it "respond[s] to arguments raised in the corresponding opposition." (cf. Trial Practice Guide at 48767). Petitioner's Opposition claimed that Myers was a relevant reference that was not considered. Patent Owner – in reply – simply and properly rebutted those arguments.

Petitioner has argued that Patent Owner's arguments over, and expert testimony in respect of, Kostas (Ex. 1051), should be excluded because it is "outside the proper scope of reply". Mot. at 9 – 10. Patent Owner's analysis of Kostas, in Reply, is proper because it "respond[s] to arguments raised in the corresponding opposition." (cf. Trial Practice Guide at 48767). Patent Owner had assessed patentability of its substitute claims over Kostas and advanced two reasons it believed to be sufficient to support that premise. Paper No. 28 at 13. Petitioner had disagreed and responded with new arguments as to why Kostas might render Patent Owner's substitute claims unpatentable. Paper No. 46 at 14 – 15, supported by Petitioner's Reply Declaration (Ex. 1110). Patent Owner – in reply – simply rebutted those arguments.

Patent Owner made best use of space in its motion to amend. Petitioner argues that

² Petitioner has dropped its allegation that Patent Owner had limited its analysis to just those references identified in the Petition (Paper No. 46 at p.4).

Patent Owner had an opportunity to request additional pages in its motion to amend, but did not do so. Mot. at 10. Patent Owner reminds Petitioner that, at a Conference Call with the Board on December 12, 2013, Patent Owner sought clarification of the rules for page limits on motions to amend and how best to present the amended claims. Patent Owner was told not to request additional pages for the motion but to, instead, show the substitute claims in mark-up form within the body of the motion.³ Patent Owner remains of the view that it provided sufficient argument to support its motion to amend.

E. Patent Owner’s “Additional Evidence” is Relevant

Petitioner objected to various portions of Patent Owner’s Exhibits in support of its Patent Owner Response, motion to amend (Paper No. 28), and Reply to Opposition to amend (Paper No. 62), as irrelevant. (Mot. at 11 – 14). Where Petitioner relies on objections in its January 29, 2014 letter (Attachment A to Mot.), Patent Owner regards those objections as waived for lack of specificity. Objections in its May 16, 2014 letter (Attachment B to Mot.) are addressed herein. The portions of Exhibits 2004 and 2081 pertaining to Active Desktop are relevant. Petitioner objects to a single paragraph in each of Exhibits 2004 and 2081 because “it is irrelevant that the actual Active Desktop software does not arrange tiles into a

³ Reference was made to that conference call at a subsequent conference call with the Board, on May 20, 2014, when Patent Owner sought to request leave to file a corrected motion to amend, and Petitioner did not controvert the reference to the prior call. (A transcript of the May 20, 2014 call is in Exhibit 1115.)

3x2 grid by default.” Patent Owner disagrees, at least because the paragraphs in question speak to what one of ordinary skill in the art would understand when confronted with software that failed to function as described in accompanying documentation, and also because it calls into question whether MSIE Kit (Ex. 1007) is an enabling reference for purposes of anticipation.

The portions of Exhibits 2004, 2063 and 2081 pertaining to a desktop replacement are relevant. Petitioner objects to various paragraphs in Exhibits 2004, 2063 and 2081 because “what is required by a desktop replacement is not relevant to any issue in these proceedings.” Patent Owner disagrees, at least because the paragraphs in question concern aspects of Patent Owner’s claim construction, and draw upon statements made within the specification of the ’403 Patent. See, for example, Ex. 2004 at ¶¶ 46 and 47; Ex. 2063 at ¶¶ 31 and 32; and Ex. 2081 at 12, 36, and 39. Patent Owner further disagrees with Petitioner that the various paragraphs were relied upon in Petitioner’s Reply (Paper No. 62).

The portions of Ex. 2081 pertaining to “runs” are relevant. Patent Owner rebuts Petitioner’s objections to ¶¶ 98 – 102 of Ex. 2081: as is established at least in ¶ 39 of Ex. 2081, Patent Owner’s expert shows that the terms “call” and “run” can both be used to describe the execution of an application program. In ¶¶ 98 – 102 of Ex. 2081, Patent Owner’s expert is using the term run as was used by Petitioner’s expert during testimony in the context of Myers (Ex. 1066). Accordingly the usage is also relevant because it is rebutting statements made by Petitioner’s expert.

The portions of Ex. 2081 pertaining to certain functionality of MSIE Kit are

relevant. Petitioner objected to ¶ 68 of Ex. 2081 as irrelevant for stating that certain functionality of MSIE Kit “would sacrifice many of the benefits of the invention”. Mot. at 12. Patent Owner disagrees: whether a reference informs one of ordinary skill in the art to practice in a way distinct from what is required by Patent Owner’s claims is germane to the non-obviousness of those claims.

The portions of Ex. 2088 relied on by Patent Owner are relevant. Petitioner objected to Ex. 2088 in its entirety as irrelevant and lacking foundation. Mot. at 12. The cited testimony of Mr. Belfiore (one of Petitioner’s 30(b)(6) witnesses from the parallel litigation) is relevant because it corroborates a portion of MSIE Kit that is pertinent to Patent Owner’s claim construction: that clicking on an Active Desktop item that does not display an active link has no effect on the item.

In any case, to the extent that Patent Owner only needs to rely upon certain quote passages from Ex. 2088, Patent Owner is willing to resubmit a form of Exhibit 2088 redacted in its entirety save for the quoted passages.

The portions of Ex. 2081 pertaining to “persistence” are relevant. Petitioner moved to exclude ¶¶ 11 and 12 of Ex. 2081 that – in Petitioner’s view – “suggest[] that the written description requirement [of 35 U.S.C. § 112] can be satisfied by what the specification of the ’403 patent *indicates* or suggests”. Mot. at 13 (emphasis herein). Petitioner argues that the word “indicate ... goes solely to whether the claim element would have been obvious from the specification”.

Petitioner’s argument is contrary to well established case law. To comply with the written description requirement of 35 U.S.C. § 112, “each claim limitation

must be expressly, *implicitly*, or inherently supported in the originally filed disclosure.” MPEP § 2163 (emphasis added). When an explicit limitation in a claim “is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have *understood*, at the time the patent application was filed, that the description requires that limitation.” *Hyatt v. Boone*, 146 F.3d 1348, 1353, (Fed. Cir. 1998) (emphasis added). The testimony objected to by Petitioner is precisely the showing of what a person of ordinary skill in the art would have understood from the ’403 Patent (*i.e.*, what the ’403 Patent specification would have indicated to a person of ordinary skill in the art) that is discussed in *Hyatt*. As such, Mr. Weadock’s testimony is entirely proper.

Finally, Petitioner equates the verb “indicate” to “suggest” (Mot. at. 13) in an attempt to infer that a portion of the ’403 Patent quoted as “indicating” something does not actually show it. This is contrary to the plain meaning of the word “indicate”, whose meanings include: to be a sign of; evidence; show; to state or express, especially briefly or in a general way; and to point out or point to; direct attention to. (See, <http://dictionary.reference.com/browse/indicate?s=t>) Thus “indicate” does not mean suggest or make obvious.

Exhibits 2051, 2052, 2065 are relevant. Inventor Santoro cites to Ex.2065 (¶19 of Ex. 2005), and Dr. Bone cites to Ex.2052 (¶¶ 16, 22). The exhibits are therefore not hearsay or “lawyer argument”, and do not lack foundation, but have been authenticated by the respective declarants who testify to their content. There is therefore no cognizable basis for excluding either of them.

F. Patent Owner's Expert is qualified to testify

Petitioner's *Daubert* challenge to Mr. Weadock's testimony (Mot. at 15) is without merit. The only challenge on this basis is to Mr. Weadock's testimony in Ex. 2089 at 92:21 – 93:11. However, Petitioner cites to this testimony out of context, and presents an improper hypothetical. The quoted passage is part of a line of questioning (starting at 85:15 of Ex. 2089) on Mr. Weadock's statement in his declaration (Ex. 2081 ¶ 51) that Dr. Karger had admitted that Myers' icons could not call application programs. Prior to the testimony cited by Petitioner, Mr. Weadock had twice testified that "making the program a listener was not calling a program because doing so does not ask the program to perform a task." Ex. 2089 at 91:3-18. Petitioner's counsel later asked a *different* hypothetical question, which was not the subject of Mr. Weadock's declaration: "And you believe that receiving input from an input device could be asking the application to perform a function?" Ex. 2089 at 91:22-92:2. This question conflates the concepts of making a program a listener, which is not an action by a program (it is a designation by an operating system of a destination for future user input in response to selection of an icon), with an action that is performed by the program, *i.e.*, actually receiving user input, which only occurs *after* the icon has been selected. Mr. Weadock's report did not address that issue, so any failure to analyze this hypothetical is entirely irrelevant and does not undermine Mr. Weadock's competence as an expert.

3. Conclusion

For at least the foregoing reasons, the Board should deny Petitioner's Motion to Exclude the identified evidence.

Respectfully submitted by:

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Dated: June 6th, 2014

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

It is hereby certified that on this 6th day of June, 2014, a copy of the foregoing

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

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