

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 RESPONSE TO  
PETITIONER'S OBSERVATIONS ON CROSS EXAMINATION OF  
GLENN E. WEADOCK

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

## **1. Introduction**

Pursuant to the Trial Practice Guide (Fed. Reg. 77 (157), 48756, Aug. 14, 2012) at 48767 – 48768, Patent Owner SurfCast, Inc. hereby submits the following responses to Petitioner’s Observations (Paper No. 69) on the May 14, 2014 deposition of Patent Owner’s expert witness in the instant proceeding. The signed transcript of the deposition is in the record of the proceeding as Exhibit 2089.

This Response is timely filed as it is being submitted no later than DUE DATE 5, according to the Revised Scheduling Order (Paper No. 53).

## **2. Scope of Observations**

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, Petitioner deposed Patent Owner’s expert, Glenn E. Weadock, after Patent Owner submitted a declaration by Mr. Weadock (Ex. 2081; “Patent Owner’s Reply Declaration”) in support of its Patent Owner Reply (Paper No. 62; “Reply”) to Petitioner’s Opposition to Motion to Amend (Paper No. 46; “Opposition”). On the other hand, Patent Owner deposed Petitioner’s expert, David R. Karger, *before* submitting the Reply (Paper No. 62).

Patent Owner notes that Petitioner provided two sets of observations, the first of which comprised Observation nos. 1 – 5 on the April 24, 2014 deposition of Petitioner's *own* witness (David R. Karger), the second of which comprised Observation nos. 6 – 10 on the deposition of Patent Owner's witness. Only the second set of observations is provided for by the Trial Practice Guide, and the Revised Scheduling Order for this proceeding (Paper No. 53).

By e-mail communication to Petitioner's counsel, Patent Owner's counsel objected to Petitioner's observations 1 – 5, as being outside the scope of observation evidence, and contrary to the plain language of the Scheduling Order. The parties agreed that Petitioner would ask the Board to expunge Paper no. 69 and that Petitioner would replace it with a corrected motion that contained only Observations 6 – 10. Petitioner's counsel sent a memorandum of this agreement by e-mail to the Board ([Trials@uspto.gov](mailto:Trials@uspto.gov)) on May 28, 2014.

Accordingly, Patent owner now responds only to Petitioner's second set of Observations, numbered 6 – 10, as they pertain to the May 14, 2014 deposition of Patent Owner's expert witness, Glenn E. Weadock.<sup>2</sup>

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2 Patent Owner notes that Petitioner's citations to Exhibit 2089 in Petitioner's Motion for Observations (Paper No. 69) refer to the native page numbers of the deposition transcript and not to the page numbers shown in the right-hand side of

### **3. Patent Owner's Response to Petitioner's Observations on the May 14, 2014 Deposition of Patent Owner's Expert, Glenn E. Weadock**

6. Petitioner comments on testimony regarding the term “session”, at 72:10 – 73:20 of Ex. 2089. Petitioner has taken a selected portion of Mr. Weadock’s testimony out of context and has referenced an incomplete portion of his complete testimony to support its incorrect conclusions that Mr. Weadock’s own testimony is internally contradictory and that Patent Owner should have provided a construction of the term “session” in its Motion to Amend. First, in Exhibit 2089, at page 70, lines 6 – 10 (a passage outside of the portion commented on by Petitioner), Mr. Weadock testifies “that ‘session to session’ has a well-understood meaning in the art”. Second, Mr. Weadock testifies on cross, at page 72, lines 10 – 22, that “working on a computer, then leaving it to get a cup of coffee and then coming back” is “more of an English language use of the term ‘session’” and that “normally a computer person would think of a session as something a little bit different than that. I think typically when we talk about sessions, we don’t talk about just walking away for a cup of coffee and then coming back”. Then, on redirect, Exhibit 2089 at page 135:12-139:9 (another passage ignored by Petitioner

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the footer of the Exhibit. Patent Owner adopts the same convention herein, for the sake of consistency.

in their observations), Mr. Weadock testifies that “in the computer context” and as used by the ’403 Patent (Ex. 1001), a “session” would mean “between log-on and log-off operations or between power cycles” and not in the sense of “a human being having a work session”. Mr. Weadock has therefore – quite consistently – stated that the term “session” is both well-understood in the computer arts and that the usage in the ’403 Patent comports with its ordinary meaning in the art.

7. Petitioner comments on testimony regarding the term “call”, at 86:15 – 89:13 of Ex. 2089. Petitioner has taken a selected portion of Mr. Weadock’s testimony out of context and has referenced an incomplete portion of his testimony to support its incorrect conclusions that Mr. Weadock’s own testimony is internally contradictory and that Patent Owner should have provided a construction of the term “call”. Mr. Weadock states consistently throughout the quoted portion that “making a window a listener” is not a typical use of the word “call”. Furthermore, in Exhibit 2089, on page 92, lines 13 – 20, in a portion of Mr. Weadock’s cross-examination testimony that follows directly from the portion quoted by Petitioner, Mr. Weadock confirms that the meaning of “call” offered by Dr. Karger relates to “the Sapphire system” in which an icon *cannot* call an application in the normal meaning of the word.

8. Petitioner comments on testimony regarding the term “selected”, at 97:1 – 99:2 of Ex. 2089. Petitioner has mis-characterized the testimony of Mr. Weadock

as it pertains to resizing an Active Desktop item. In particular, Patent Owner's claim language is selecting, not resizing, "a tile calls an assigned application program to provide access to information". Petitioner has conflated the actions of "clicking" and "resizing" an Active Desktop item, as discussed in cross-examination testimony, with Patent Owner's actual claim language as referenced in Mr. Weadock's Reply Declaration. There is no inconsistency in Mr. Weadock's testimony: the quoted portion at paragraph 134 of the Reply Declaration is true because MSIE Kit does not disclose "selecting a tile to call an assigned application program". Whether clicking or resizing an Active Desktop item selects that item is distinct from whether there is an associated call to an assigned application program disclosed in that reference. Furthermore, Mr. Weadock's testimony is perfectly consistent with that of Mr. Belfiore (Ex. 2088) because the latter testified that an Active Desktop item in which there was no displayed link could not be selected to provide access to an assigned application (even if it had been recently resized) because it would not do anything when a user clicked on it.

9. Patent Owner objects to Petitioner's faulty logic in its observation on Mr. Weadock's testimony at 101:8 – 13 regarding "information on [a] hard drive", and for citing the testimony out of context. First, just because Mr. Weadock admits that it is possible to have "[some] information on [a] hard drive" that is not "displayed from session to session" does not *require* that the "grid" in question is

not itself displayed from session to session. As Mr. Weadock states just before the portion quoted by Petitioner, in Ex. 2089 at 101: 2 – 6, “if [the grid is] functioning as a desktop replacement, then one would expect a grid to be displayed in each session.” This interpretation is wholly consistent with the portion of Mr.

Weadock’s Reply Declaration at Paragraph 15 that is cited by Petitioner: Mr. Weadock is basing his assessment on the entire disclosure of the specification of the ’403 Patent.

10. Petitioner’s Observation #10 mischaracterizes Mr. Weadock’s testimony: Mr. Weadock never agreed that the definition of “program” in the Dictionary (Ex. 1114) proffered by Petitioner is a plain and ordinary meaning of that term. (See Ex. 2089 at p. 109:17 – 110:1 and p. 110 at lines 13 – 14.) Petitioner has offered no testimony that the definition in Ex. 1114 is a proper definition of ‘program’. Mr. Weadock’s testimony that Ex. 1114 does not reflect the plain and ordinary meaning stands unrebutted, as no contrary evidence for the meaning of the term was provided by Petitioner’s expert, either in his Declaration (Ex. 1110) or during deposition (Ex. 1113).

#### **4. Conclusion**

For at least the foregoing reasons, the Board should disregard Petitioner’s Observations numbered 6 – 10.

Respectfully submitted by:

/Richard G. A. Bone/

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

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

PATENT OWNER RESPONSE TO  
PETITIONER'S OBSERVATIONS ON CROSS EXAMINATION OF  
GLENN E. WEADOCK

was served via Electronic Mail upon the following:

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