

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 SUPPLEMENTAL OPPOSITION TO PATENT OWNER'S
CORRECTED MOTION TO AMEND**

Pursuant to Paper No. 77, Patent Owner filed a second, “corrected,” motion to amend that makes two additional changes to its proposed substitute claim 53. *See* Paper No. 77 at 2. The first revises proposed substitute claim 53 by changing the phrase “*grid of tiles*” to “*tiles*”; thereby making claim 53 read: “said ~~grid of~~ tiles being persistent from session to session.” *See* Ex. 2091 at 2. The second adds into the “wherein” clause of claim 53 the words “by a user” to specify “the tiles are selectable *by a user*.” *See id.* The two additional changes do not render the claims patentable – Petitioner’s previously presented arguments regarding the original proposed amended claim 53 apply equally to its revised proposed amended claim 53. In addition, changing “grid of tiles” to “tiles” introduces new patentability defects into claim 53. The Board should deny the second motion to amend.

ARGUMENT

I. Revised Proposed Claim 53 Remains Unpatentable.

“**Grid of Tiles**” to “**Tiles.**” Patent Owner’s change to specify the “tiles” (rather than “grid of tiles”) on the display are “persistent” does not resolve the patentability issues previously identified, and introduces new patentability defects.

Initially, proposed substitute claim 53 continues to require the tiles *on the display* to be persistent, as it still requires instructions to “arrange *a display* into *a grid of tiles*” and then specifies “*said tiles* being persistent.” Paper No. 76 at 2. As Petitioner previously has explained, the persistent *display* of graphical user

interface elements is not the same thing as the persistent *storage* of information describing those elements. *See* Ex. 1110 at ¶¶ 168-172. Thus, Patent Owner’s latest “tweaks” to the claim language do not cure the problems Petitioner previously identified. The corrected substitute claim 53 based on Patent Owner’s proposed interpretation of “persistent” remains inconsistent with the disclosure.

Newly “corrected” proposed substitute claim 53 also introduces new patentability deficiencies. In particular, the “corrected” substitute claim 53, based on Patent Owner’s express construction of the claim term “persistent,” is not supported by the written description of the ’403 patent, albeit for slightly different reasons than those identified for original proposed substitute claim 53.

Petitioner previously explained the only instance of “persistence” in the specification appears at column 15, lines 63-64, which states: “[i]tems in the metabase are ‘persistent’, that is they are not saved explicitly but are preserved from session to session.” (Emphasis added.) *See* Ex. 1001, 15:63-64; *see also* Ex. 1110 at ¶ 168. By placing the word “persistent” in quotes and following it by the transitional phrase “that is,” the inventors clearly were explaining to the public they were expressly defining the term “persistent.” This definition in “persistent” in the ’403 patent, however, is flatly inconsistent with the construction of “persistent” which Patent Owner has proposed for its new claim 53. Under Patent Owner’s proposed definition, “persistent” would mean “*that at least the tile’s*

*position in a grid or array, the tile's refresh rate, and a source of information associated with the tile are maintained from session to session,” see Paper No. 76 at 5. Under that definition, in corrected substitute claim 53, the phrase “said [grid of] tiles being persistent from session to session,” would mean that three specific attributes of tiles – its position in a grid, its refresh rate and a source of information associated with the tile – are maintained from session to session. But the '403 patent nowhere, either expressly or impliedly, suggests a “tile” is “persistent” because these three attributes of “tiles” are maintained from session to session. Instead, the definition of “persistence” in the '403 patent indicates generally that “*items in the metabase* are persistent” – not tiles alone or randomly selected attributes of tiles.*

Petitioners corrected motion to amend therefore should be denied because corrected proposed amended claim 53 is unpatentable for lack of written description support under 35 U.S.C. § 112. As is well settled, the specification “must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc); *see also* 37 C.F.R. § 42.121(b). It is also legally irrelevant that it might be possible for a skilled person to extrapolate from the actual disclosure of the '403 patent and to thereby create a process or system which stores these three data elements of “tiles.” Instead, the correct

inquiry is what the written description conveys to a person of ordinary skill the inventors had possession of. *See Purdue Pharma v. Faulding Inc.*, 230 F.3d 1320, 1326-27 (Fed. Cir. 2000); *see also* 37 C.F.R. § 42.121(b). For similar reasons, the proposed amendment would add new matter to the patent in violation of 35 U.S.C. § 132, which expressly commands that “[n]o amendment shall introduce new matter into the disclosure of the invention.” *See also* 37 C.F.R. § 42.121(a)(2)(ii).

The record in these proceedings also now renders the proposed substitute claims invalid for indefiniteness under *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. ____ (2014) (Slip Op. June 2, 2014) (adopting the “reasonable certainty” standard for indefiniteness). The inventors in their specification and the Patent Owner on the record in these proceedings have asserted two significantly different meanings for “persistence.” Both definitions can’t be correct. *See id.* By asserting a meaning for a claim term that is so different from an express definition in the specification, the Patent Owner has assured that the claim, when read in light of the specification and these proceedings, fails to provide reasonable certainty about the scope of the invention. The proposed amended claims are therefore indefinite.

Selectable By A User. Patent Owner’s second modification – changing “wherein the tiles are selectable” to “wherein the tiles are selectable by a user” – makes no material change to claim 53, as any party that selects a tile would, by definition, be “a user.” For reasons previously explained, each prior art reference

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at issue in this proceeding shows tiles being selectable by a user. Because Patent Owner's second modification "does not respond to a ground of unpatentability involved in the trial," it is improper. *See* 37 C.F.R. § 42.121(a)(2)(i); *see also Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 at 5.

II. Claim 53 Remains Unpatentable over the Prior Art

These minor changes to claim 53 do not resolve the patentability defects over the prior art, which Petitioner has previously identified. For example, each of the references Petitioner has cited against the prior version of the proposed substitute claims clearly shows that the "said tiles being persistent" language is satisfied. *See, e.g.*, Ex. 1110 at ¶¶ 193-197, 289-292, 340-341; Ex. 1113 at p. 164 (351:2-11), 177 (365:4-25). Moreover, each of the references previously cited against the proposed substitute claims shows that the "wherein the tiles are selectable by a user" is satisfied. *See, e.g.*, Ex. 1110 at ¶¶ 116-139, 153, 208, 213-232, 286, 303-306, 312, 313, 340, 344; Ex. 1113 at pp. 148-151 (335:9-338:10), 155-163 (342:11-350:5), 170 (357:7-23), 193-194 (380:19-381:13). Thus, the two changes to proposed claim 53 do nothing to distinguish the claims from the prior art upon which the grounds in this proceeding are based.

CONCLUSION

For the reasons set forth above, Patent Owner's motion should be denied.

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Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of June, 2014, a copy of this **PETITIONER'S SUPPLEMENTAL OPPOSITION TO PATENT OWNER'S CORRECTED MOTION TO AMEND** 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):

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