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Paper 96
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

SURFCAST, INC.
Patent Owner

Case IPR2013-00292[1]
Patent 6,724,403

Before MICHAEL P. TIERNEY, JONI Y. CHANG, MATTHEW R. CLEMENTS, *Administrative Patent Judge*.

DECISISON
Request for Rehearing
37 C.F.R. § 42.71

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

On November 14, 2014, SurfCast, Inc. ("Patent Owner") filed a request for rehearing of the final written decision (Paper 93, "Dec.")[2] holding claims 1–52 of U.S. Patent No. 6,724,403 ("the '403 patent") unpatentable. Paper 94 ("Req."). The final written decision held, *inter alia*, claim 34 unpatentable under (1) 35 U.S.C. § 102(b) as anticipated by MSIE Kit; and (2) 35 U.S.C. § 102(e) as anticipated by Duperrouzel. Dec. 34–41, 63. Patent Owner seeks reconsideration of the decision to hold claim 34 unpatentable on the grounds that:

1. Neither MSIE Kit nor Duperrouzel disclose a graphical user interface element that "when selected, provides access an information source" as required by the Board's construction of "tile;"
2. The Board improperly construed "tile" by omitting the requirements that it be (1) "persistent," which Duperrouzel's display panes are not; and (2) have an information source "assigned to the tile," which MSIE Kit's active desktop items do not; and
3. The Board improperly applied the broadest reasonable interpretation standard for claim construction.

The request for rehearing is *denied*.

I. ANALYSIS

In pertinent part, 37 C.F.R. § 42.71(d) states:

> The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each

[2] Citations are to IPR2013-00292 unless otherwise noted.

> matter was previously addressed in a motion, an opposition, or a reply.

We have reviewed Patent Owner's request for rehearing and carefully considered Patent Owner's arguments. We are not persuaded, however, that the Board misapprehended or overlooked Patent Owner's arguments presented in its response or evidence with respect to the patentability of claim 34. We now address Patent Owner's arguments presented in its request for rehearing in turn.

"when selected, provides access to an information source"

Patent Owner alleges that the Board misapprehended and/or overlooked evidence that MSIE Kit's Active Desktop items and Duperrouzel's display panes do not "when selected, provide[] access to an information source," as we construed "tile" to require. Req. 2–3. With respect to MSIE Kit, Patent Owner argues that the "only way to access information using an Active Desktop item is to select a link or hot spot *within* the information displayed in the items, not by selecting the item itself." Req. 3. We addressed this argument in the final written decision and found it unpersuasive. Dec. 36. That an Active Desktop item is capable of being configured in a way that does not provide access to an information source does not negate the fact that it is capable of being configured in a way that *does* provide access to an information source.

Patent Owner also argues that MSIE Kit does not support the Board's assertion that a "hot spot" can be an entire Active Desktop item. Req. 3–4. Petitioner cited page 420 of MSIE Kit, which defines a "hot spot" as "[e]stablish[ing] regions of the screen that can process mouse clicks." Ex. 1110 ¶ 131 (citing Ex. 1007, 420). Petitioner's expert, Dr. Klarger,

testified that "one of ordinary skill in the art would have known how to create a hot spot and that it could be defined anywhere on an Active Desktop Item, including across the entire Item." Ex. 1110 ¶ 132. In its request for rehearing, Patent Owner identifies no evidence in MSIE Kit that suggests a "hot spot" cannot be an entire Active Desktop item. Accordingly, we are not persuaded that we overlooked or misapprehended the evidence with respect to MSIE Kit's "hot spot."

Patent Owner also argues that we misapplied our construction of tile to mean "when selected, provides *an ability to* access ~~to~~ an information source" instead of "when selected, provides access to an information source." Req. 4. To the extent that Patent Owner is arguing that selecting an Active Desktop item provides only "an ability" to access a web page because that selection merely enables a user to select a hyperlink within the Active Desktop item, that argument ignores the "hot spot" functionality of MSIE Kit. For the same reasons, we are not persuaded by Patent Owner's argument "[a]ny alleged access to the information source that does not result from the selection of the tile itself, reads the 'when selected' requirement out of the Board's construction." Req. 5. If selecting the link is not possible unless the Active Desktop item has previously been selected, then selection of the Active Desktop item provides access to (i.e., the ability to select hyperlinks within) the information source (i.e., the information shown in the Active Desktop item).

With respect to Duperrouzel, Patent Owner argues that we misapprehended or overlooked "evidence that selecting one of Duperrouzel's display panes does not provide access to underlying web page information." Req. 5–7. We addressed this argument in the final written

decision and found it unpersuasive. Dec. 40–41. As an initial matter, Patent Owner's arguments about maximizing are misplaced insofar as our final written decision is not based on the maximizing functionality in Duperrouzel. *Id.* In the final written decision, we determined that "a display pane, when selected, provides access to (i.e., the ability to scroll to see more of) the information source (i.e., web page)." Dec. 41. Patent Owner does not dispute that, but argues that the ability to scroll is not "access to an information source," because it is merely "an ability to access" an information source. Req. 6. We disagree. The '403 patent does not define "access to an information source" in a way that excludes the ability to scroll within the information source. In fact, the '403 patent discloses an embodiment in which a "tile" is "a web browser tile called a surftile 1602." Ex. 1001, 15:14–18. Duperrouzel's accessing of web page via a browser, including scrolling the web page, is therefore consistent with the Specification of the '403 patent. Thus, we are not persuaded that we misapprehended or overlooked evidence in finding that Duperrouzel's display pane "when selected, provides access to an information source" because it, when selected, lets a user scroll within the web page.

Claim construction of "tile"

Patent Owner argues that we misapprehended or overlooked the evidence cited in support of its proposed construction of "tile" to require "persistence" because (1) when a claim term has no plain and ordinary meaning, the term must be accorded the meaning suggested by the Specification; and (2) *Rodime PLC v. Seagate Techs., Inc.*, 174 F.3d 1294 (Fed. Cir. 1999) is inapplicable because the claims at issue are not means-plus-functions claims. Req. 7–9. We addressed Patent Owner's argument

and evidence in our final written decision and found it unpersuasive. Dec. 9–10. As we explained, "[n]one of the passages of the '403 patent relied upon by SurfCast 'define' a 'tile' as requiring persistence. We, therefore, decline to import limitations from an exemplary implementation." Dec. 9. Nothing in Patent Owner's request for rehearing persuades us that we overlooked or misapprehended the disclosure in the '403 patent. Nowhere does the '403 patent set forth with reasonable clarity, deliberateness, and precision that a "tile" must be persistent. Because we are not persuaded that our construction of "tile" should be modified, we need not address Patent Owner's arguments about whether Duperrouzel's display panes are persistent.

Patent Owner also argues that we misapprehended or overlooked the evidence cited in support of its proposed construction of "tile" to require that an information source be "assigned to the tile" because the Board's construction recites only "that access is provided to *an* information source, which can read on *any* information source" and, therefore, "assigned to the tile" is not superfluous because it specifies that the information source must be one that is "assigned to the tile." Req. 10–14. We addressed Patent Owner's argument and evidence in our final written decision and found it unpersuasive. Dec. 8. Nothing in Patent Owner's request for rehearing persuades us that we overlooked or misapprehended the disclosure in the '403 patent. None of the claims require the recited "information source" to be assigned to a tile, nor do they require the recited "tile" to be assigned to an information source. They require only that a "tile" be "associated" with an information source. That limitation in the claims is independent of our construction of "tile." Moreover, the '403 patent nowhere sets forth with

reasonable clarity, deliberateness, and precision that a "tile" must have an information source "assigned" to it. Because we are not persuaded that our construction of "tile" should be modified, we need not address Patent Owner's arguments about whether an information source is "assigned to" MSIE Kit's Active Desktop item.

Broadest reasonable interpretation

Patent Owner argues that the Board should have applied the *Phillips* standard instead of the broadest reasonable interpretation when construing the terms of the '403 patent because, as a practical matter, Patent Owner's ability to amend claims is precluded. Req. 14–15. We disagree. "A claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. § 42.100(b). Both the United States Courts of Customs and Patent Appeals and the United States Court of Appeals for the Federal Circuit have recognized that the broadest reasonable interpretation serves an important public interest and that a key factor in its use is that patent owners before the Office are provided an opportunity to amend their claims and obtain appropriate coverage for their inventions with express claim language. *See, e.g.*, *In re Reuter*, 670 F.2d 1015 (CCPA 1981) (holding that broadest reasonable interpretation is applicable in reissue proceedings); *In re Yamamoto*, 740 F.2d 1569 (Fed. Cir. 1984) (holding that broadest reasonable interpretation is applicable in reexamination proceeding). Indeed, Patent Owner availed itself of the opportunity to amend by filing a Motion to Amend (Paper 28) and a Corrected Motion to Amend (Paper 76). Patent Owner argues in its request for rehearing that "the ability to amend the claims in an *Inter Partes* Review (IPR) has been so abrogated that it can no

longer serve as justification for the applicability of [the broadest reasonable interpretation standard]" because, *inter alia*, "the Board limits motions to amend to 15 double spaced, 14 point font pages." Req. 14–15. Patent Owner conceded during oral argument, however, that it did not ask for additional pages. Paper 90, 83. We are not persuaded that we misapprehended or overlooked the proper claim construction standard for this *inter partes* review.

Conclusion

For the foregoing reasons, Patent Owner has not shown that the final written decision should be modified.

ORDER

Accordingly, it is:

ORDERED that Patent Owner's request for rehearing is *denied*.

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