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

_____

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

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PATENT OWNER'S NOTICE OF APPEAL

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

In accordance with 37 C.F.R. §§ 90.2(a) and 90.3, notice is hereby given that

Patent Owner SurfCast, Inc. ("SurfCast") hereby appeals to the United States Court

of Appeals for the Federal Circuit from the Patent Trial and Appeal Board's Final

Written Decision in Case No. IPR2013-00292 entered on October 14, 2014 (Paper

No. 93, a copy of which is attached hereto), and from all underlying findings,

determinations, orders, decisions, rulings and opinions, regarding SurfCast's U.S.

Patent. No. 6,724,403 ("the '403 Patent").

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), SurfCast further indicates that

the issues on appeal may include, but are not limited to, the following:

- The Board's determination that:

    (1) Claims 1–13, 17–28, 30–33, 35-37, 39–43 and 46–50 are

        unpatentable under §102(e) based on Duhault II;

    (2) Claims 1, 9–11, 22, 41–43, 46, and 48–50 are unpatentable under

        §102(b) based on Chen;

    (3) Claim 29 is unpatentable under §103(a) based on Chen and MSIE

        kit;

    (4) Claims 1–3, 5–8, 11, 12, 14–16, 19, 21, 22, 27, 30, 32, 34, 37–40,

        43–47, and 50–52 are unpatentable under §102(b) based on MSIE

        Kit;

(5)   Claims 17, 20, 25, and 28 are unpatentable under §103(a) based on

MSIE Kit and Brown;

(6)   Claims 1–3, 5–8, 12–14, 19, 21, 22, 27, 30, 32, 34, 37–40, 46, and

47 are unpatentable under §102(e) based on Duperrouzel;

(7)   Claims 17, 20, 25, and 28 are unpatentable under §103 based on

Duperrouzel and Brown;

and any other finding or determination (legal or factual) supporting or

related to this determination;

- the Board's January 6, 2015 denial of SurfCast's Request for Rehearing

of Final Written Decision under 37 C.F.R. § 42.71(d) (Paper 96) and any

other finding or determination (legal or factual) supporting or related to

this determination;

- the Board's denial of SurfCast's motion to amend the claims of the '403

Patent;

- the Board's claim construction;

- the Board's use of the broadest reasonable interpretation standard; and

- all other issues decided adversely to SurfCast in any orders, decisions,

rulings and opinions.

Simultaneous with this submission, a copy of this Notice of Appeal is being

filed with the Patent Trial and Appeal Board. In addition, three copies of the

Notice of Appeal, along with the required docketing fees, are being filed with the

Clerk's Office for the United States Court of Appeals for the Federal Circuit.

Respectfully submitted by:

Dated: March 5, 2015

/Richard G. A. Bone/

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CERTIFICATE OF FILING

I hereby certify that, in addition to being filed electronically through the

Patent Trial and Appeal Board's Patent Review Processing System (PRPS) on this

5th day of March, 2015, the original version of the foregoing, PATENT OWNER

SURFCAST, INC.'S NOTICE OF APPEAL, was sent via overnight delivery on

this 5th day of March, 2015, with the Director of the United States Patent and

Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF FILING

I hereby certify that three (3) true and correct copies of the foregoing,

PATENT OWNER SURFCAST, INC.'S NOTICE OF APPEAL, were filed via

overnight delivery on this 5th day of March, 2015 to the Clerk's Office of the

United States Court of Appeals for the Federal Circuit, at the following address:

United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W., Suite 401
Washington, DC 20005

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6 and 42.120, the undersigned certifies that a true

and correct copy of the foregoing, PATENT OWNER SURFCAST, INC.'S

NOTICE OF APPEAL, was provided via e-mail to the Petitioner by serving the e-

mail correspondence address of record as follows on this 5th day of March, 2015:

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By:

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FINAL WRITTEN DECISION

UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

MICROSOFT CORPORATION,
Petitioner,

v.

SURFCAST, INC.,
Patent Owner.

Cases IPR2013-00292, IPR2013-00293,
IPR2013-00294, and IPR2013-00295
Patent 6,724,403

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

CLEMENTS, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I.   INTRODUCTION

Petitioner, Microsoft Corporation ("Microsoft"), filed four Petitions

requesting *inter partes* review of claims 1–52 ("the challenged claims") of

U.S. Patent No. 6,724,403 (Ex. 1001, "the '403 patent") pursuant to

35 U.S.C. §§ 311–319. Patent Owner, SurfCast, Inc. ("SurfCast"), filed a

preliminary response in each of the four proceedings:

Case No.	Claims	Petition Paper No.	Preliminary Response Paper No.
IPR2013-00292	1–13 and 15–21	Paper 6 ("292 Pet.")	Paper 18 ("292 Prelim. Resp.")
IPR2013-00293	22–45	Paper 5 ("293 Pet.")	Paper 13 ("293 Prelim. Resp.")
IPR2013-00294	46–52	Paper 4 ("294 Pet.")	Paper 13 ("294 Prelim. Resp.")
IPR2013-00295	1–3, 5–8, 11–17, 19–22, 25, 27, 28, 30, 32, 34, 37–40, 43–47, and 50–52	Paper 3 ("295 Pet.")	Paper 13 ("295 Prelim. Resp.")

On November 19, 2013, the Board granted an *inter partes* review for

all challenged claims on less than all of the grounds of unpatentability

alleged in the Petitions. Paper 19.[1]

After institution of trial, SurfCast filed a Patent Owner's Response.

Paper 27. SurfCast also filed a Motion to Amend Claims that requests

substituting proposed new claims 53–59 for claims 46–52, respectively—

contingent upon a determination of unpatentability. Paper 28. Microsoft

filed a Reply to Patent Owner's Response (Paper 45), and an Opposition to

Patent Owner's Motion to Amend Claims (Paper 46). Microsoft then filed a

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[1] All citations are to IPR2013-00292, unless otherwise noted.

Corrected Reply to Patent Owner's Response. Paper 54. SurfCast then filed

a Reply to Microsoft's Opposition to Patent Owner's Motion to Amend.

Paper 62. Finally, SurfCast filed a Corrected Motion to Amend (Paper 76),

and Microsoft filed a Supplemental Opposition to Patent Owner's Corrected

Motion to Amend (Paper 84).

Additionally, Microsoft filed a Motion to Exclude Evidence (Paper

67), to which SurfCast responded (Paper 81). Microsoft filed a Reply in

Support of Its Motion to Exclude. Paper 83.

SurfCast also filed a Motion to Exclude Evidence (Paper 72) to which

Microsoft responded (Paper 79). SurfCast filed a Reply in Support of Its

Motion to Exclude. Paper 85.

Oral hearing was held on July 10, 2014.[2]

The Board has jurisdiction under 35 U.S.C. § 6(c). This Final Written

Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Microsoft has shown by a preponderance of the evidence that claims

1–52 of the '403 patent are unpatentable. SurfCast's Motion to Amend

Claims is denied.

A. Related Proceeding

Microsoft indicates that the '403 patent is asserted in *SurfCast, Inc. v.
Microsoft Corp.*, No. 2:12-cv-00333 (D. Me.). 292 Pet. 1–2.

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[2] A transcript of the oral hearing is included in the record as Paper 90
("Tr.").

B. The '403 Patent

The subject matter of the '403 patent relates to a graphical user interface that organizes content from a variety of information sources into a grid of tiles, each of which can refresh its content independently of the others. Ex. 1001, Abstract. As described in the "Background of the Invention," at the time of the invention, display technologies lacked a user interface capable of presenting any type of information in a consistent manner and in such a way that all open channels could indicate their activity on a continual basis. *Id*. at 4:24–31. In response to this need, the '403 patent describes a graphical user interface comprising a grid of tiles that resides on the user's computer desktop. *Id.* at 4:37–38. The grid of tiles provides a uniform graphical environment in which a user can access, operate, and/or control multiple data sources on electronic devices. *Id*. at 4:37–41. Figure 1 is reproduced below.
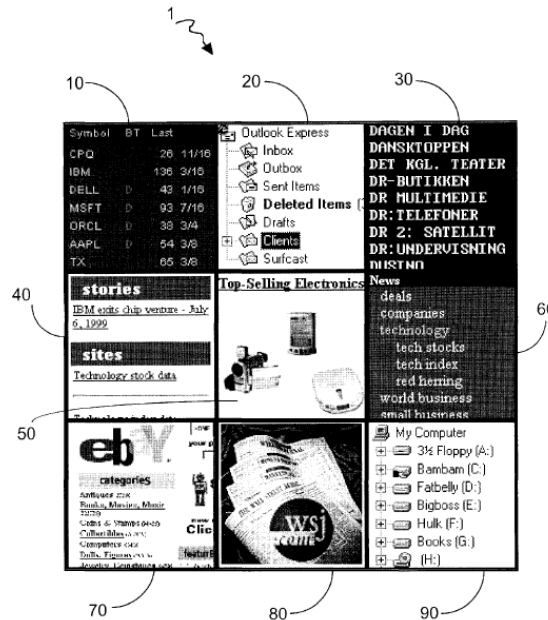

Figure 1 illustrates an embodiment of the graphical user interface. *Id.* at 6:38–39.

C. Illustrative Claims

Of the challenged claims, claims 1, 22, and 46 are independent claims.

Claims 1 and 22 are illustrative and are reproduced below:

1. A method executed by a device under the control of a program, said device including a memory for storing said program, said method comprising:

selecting a plurality of information sources;

partitioning a visual display of the device into an array of tiles, wherein each tile in said array of tiles is associated with an information source in said plurality of information sources;

assigning a first refresh rate to a first tile of said array of tiles and a second refresh rate to a second tile of said array of tiles;

updating information from a first information source in said plurality of information sources presented to said first tile in accordance with said first refresh rate; and

simultaneously updating information from a second information source in said plurality of information sources presented to said second tile in accordance with said second refresh rate.

22. An electronic readable memory to direct an electronic device to function in a specified manner, comprising:

a first set of instructions to control simultaneous communication with a plurality of information sources;

a second set of instructions to arrange a display into an array of tiles;

a third set of instructions to associate a first information source of said plurality of information sources to a first tile of said array of tiles and a second information source of said plurality of information sources to a second tile of said array of tiles;

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a fourth set of instructions to retrieve information from said
first information source in accordance with a first
retrieval rate and retrieve information from said second
information source in accordance with a second retrieval
rate; and

a fifth set of instructions to present information to said first tile
in accordance with said first retrieval rate and present
information to said second tile in accordance with said
second retrieval rate.

D. Prior Art Supporting the Instituted Challenges

Microsoft relies on the following prior art references, as well as the

Declaration of Dr. David R. Karger (Ex. 1003):

Chen	US 5,432,932	July 11, 1995	Ex. 1015
Brown	US 6,278,448 B1	Aug. 21, 2001	Ex. 1030
Duhault ("Duhault II")	US 6,456,334 B1	Sept. 24, 2002	Ex. 1014
Duperrouzel	US 6,832,355 B1	Dec. 14, 2004	Ex. 1011
Microsoft Internet Explorer Resource Kit, Microsoft Press (1998) ("MSIE Kit")			Exs. 1007, 1008, 1009, 1010

E. The Instituted Challenges of Unpatentability

We instituted the instant trial based on the following grounds of

unpatentability:

Reference[s]	Basis	Claims Challenged
Duhault II	§ 102(e)	1–13, 17–28, 30–33, 35–37, 39–43, and 46–50
Chen	§ 102(b)	1, 9–11, 22, 41–43, 46, and 48–50
Chen and MSIE Kit	§ 103(a)	29

Reference[s]	Basis	Claims Challenged
MSIE Kit	§ 102(b)	1–3, 5–8, 11, 12, 14–16, 19, 21, 22, 27, 30, 32, 34, 37–40, 43–47, and 50–52
MSIE Kit and Brown	§ 103(a)	17, 20, 25, and 28
Duperrouzel	§ 102(e)	1–3, 5–8, 12–14, 19, 21, 22, 27, 30, 32, 34, 37–40, 46, and 47
Duperrouzel and Brown	§ 103	17, 20, 25, and 28

II.   ANALYSIS

A. Claim Construction

Consistent with the statute and the legislative history of the AIA, we interpret claims by applying the broadest reasonable construction in the context of the specification in which the claims reside. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Claim terms also are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

An inventor may rebut that presumption by providing a definition of the term in the specification. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Id.*

1. "tile"

All of the challenged claims require a "tile." The '403 patent states that, "[w]hen a tile is selected, whether by mouse click or otherwise, the tile

instantly provides the user with access to the underlying information."
Ex. 1001, 9:25–27. The '403 patent further provides that, "[a] tile is
different from an icon because it provides a real-time or near-real time view
of the underlying information in that it contains continually refreshed
content." *Id.* at 8:36–38; *see id.* at 9:32–33. Accordingly, in the Decision to
Institute, the Board construed "tile" as "a graphical user interface element
whose content may be refreshed and that, when selected, provides access to
an information source." Dec. 9–11.

SurfCast asserts that "tile" should be construed as "a graphical user
interface element whose content may be refreshed, that is persistent, and
that, when selected, provides access to an information source <u>assigned to the
tile</u>." PO Resp. 3–5 (emphasis original) (citing Ex. 1001, Figs. 5, 6, 9:25–
32, 11:1–3, 11:23–25; Ex. 2004 ¶¶ 43, 44). Microsoft argues that the
proposed modification is (1) superfluous; (2) in conflict with other terms in
the claim, which recites "associating" an information source with the tile;
and (3) inserts the word "tile" into the definition of "tile." Pet. Reply 2–3.
We agree with Microsoft that SurfCast's proposed claim construction is
inconsistent with the language of the independent claims. Independent claim
1 explicitly requires that "each tile in said array of tiles is *associated* with an
information source." Independent claims 22 and 46 recite commensurate
limitations. To the extent that there is no conflict between the proposed
construction and the language of the claim because "assigned" and
"associated" have the same scope in light of the '403 patent, the proposed
modification is superfluous.

SurfCast also asserts that the Board's construction is overly broad because it does not require a tile to be "persistent." PO Resp. 6–11. Specifically, SurfCast argues that the Board mischaracterized a "description of implementation details" at column 15, lines 54 to 64 of the '403 patent as a "preferred embodiment." *Id.* at 6–7. As SurfCast concedes, however, column 15 describes an "exemplary implementation." *Id.* at 6–7. Microsoft argues that the Board is not permitted to read "implementation details" into the claims without a clear an unambiguous disclaimer, and that SurfCast identifies no such disclaimer. Pet. Reply 2 (citing *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1367 (Fed. Cir. 2012)). We agree with Microsoft. None of the passages of the '403 patent relied upon by SurfCast "define" a "tile" as requiring persistence. We, therefore, decline to import that limitation from an exemplary implementation.

SurfCast also argues that (1) a person of ordinary skill in the art would recognize that tiles are persistent (PO Resp. 7); (2) persistence is a necessary and fundamental property of tiles (*id.* at 7–8); and (3) the '403 patent does not describe any embodiment that requires or even permits a tile to be not persistent (*id.* at 8). Microsoft counters that (1) there is no evidence that "persistence" is definitional; (2) SurfCast's conception and diligence evidence do not use the word "persistent;" (3) Mr. Ovid Santoro, a named inventor of the '403 patent, is aware of no document during the periods of alleged conception and diligence that show "persistence" was considered part of the invention; and (4) "persistence" does not distinguish a tile from a window. Pet. Reply 1. We agree with Microsoft that the '403 patent does not set forth with reasonable clarity, deliberateness, and precision a

definition of "tile" as requiring persistence. The '403 patent uses "persistent," to mean "not saved explicitly but [] preserved from session to session." Ex. 1001, 15:63–64 ("Items in the metabase are 'persistent,' that is they are not saved explicitly but are preserved from session to session."). That term is applied, however, only to the "preferred embodiment" depicted in Figure 17. *Id.* at 6:7–9. None of the passages relied upon by SurfCast preclude an embodiment in which a "tile" is saved explicitly. Several passages cited by SurfCast describe persistence as a feature of a "grid" of tiles, but the claims recite an "array," not a "grid." Even assuming that persistence is necessary to the functioning of an "array of tiles," a claim need not recite every structure or function necessary to carry out the invention. *Rodime PLC v. Seagate Techs., Inc.*, 174 F.3d 1294, 1303 (Fed. Cir. 1999). As a result, we decline to construe "tile" to require persistence.

Finally, SurfCast argues that a window is not within the Board's construction of "tile." PO Resp. 5–6, 11–12. SurfCast does not, however, propose a modification to the Board's construction, and we are not persuaded any modification is necessary.

Accordingly, the Board maintains its construction of "tile" as "a graphical user interface element whose content may be refreshed and that, when selected, provides access to an information source."

2. *"partitioning a visual display of the device into an array of tiles"*

The phrase "partitioning a visual display of the device into an array of tiles" appears in claim 1. In the Decision to Institute, the Board construed "partitioning a visual display of the device into an array of tiles" as "dividing a display or window into two or more tiles." Dec. 12–13.

SurfCast asserts that "partitioning a visual display of the device into an array of tiles" should be construed to require that the tiles be non-overlapping because the '403 patent describes "the present invention" as "comprising the steps of: partitioning a visual display of a computer into an array of tiles <u>in a non-overlapping configuration</u>." PO Resp. 13–14 (emphasis original) (citing Ex. 1001, 4:55–59). Microsoft counters that the testimony of Mr. Glenn Weadock, SurfCast's declarant in support of SurfCast's proffered construction, is irrelevant extrinsic evidence, and that the use of the phrase "the present invention" does not support SurfCast's position. Pet. Reply 3–4.

We are unpersuaded by SurfCast's arguments. As Microsoft points out, if the '403 patent used the term "partitioning" to mean "*in a non-overlapping configuration*," the clause "*in a non-overlapping configuration*" would be superfluous. Pet. Reply 4. Its presence implies that "partitioning" alone does not connote "in a non-overlapping configuration."

SurfCast also argues that non-overlap is "essential to all embodiments of the invention" (PO Resp. 16), but as we discussed above, a claim need not recite every structure or function necessary to carry out the invention. *Rodime*, 174 F.3d at 1303. Microsoft points out that dependent claim 3 limits the array of tiles to a "non-overlapping configuration," but independent claim 1 is not so limited. Pet. 7, 9. SurfCast counters that claim differentiation is not implicated because claim 3 recites limitations in addition to "non-overlapping." PO Resp. 16–18. SurfCast concedes, however, that its proposed construction would render superfluous the words "non-overlapping" in claim 3. Tr. 55–56. Claims should not be construed

so as to render terms redundant or superfluous. *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) ("[C]laims are interpreted with an eye toward giving effect to all terms in the claim."). We, therefore, are not persuaded that "partitioning" should be construed to include "non-overlapping."

Accordingly, the Board maintains its construction of "partitioning a visual display of the device into an array of tiles" as "dividing a display or window into two or more tiles."

3. *"refresh rate" / "retrieval rate"*

The phrase "refresh rate" appears in claims 1, 4, 6, 7, 10, and 11. The phrase "retrieval rate" appears in claims 22, 31, 33, 39, 42, 43, 46, 49, and 50. In the Decision to Institute, the Board construed "refresh rate / retrieval rate" as "a recurring time interval at which information displayed in a tile is refreshed or retrieved." Dec. 14–15.

SurfCast asserts that the Board's construction is overly narrow because it is limited to "a recurring time interval," and, therefore, erroneously excludes aperiodic rates. PO Resp. 18–26. Microsoft counters that (1) SurfCast's reliance on extrinsic evidence is improper; (2) SurfCast's proposed construction is broader than the Board's construction, and therefore does not impact patentability; and (3) SurfCast's argument was previously considered and rejected. Pet. Reply 4–5.

Upon consideration of SurfCast's proposed claim constructions, arguments, and supporting evidence, we agree with SurfCast that the broadest reasonable construction of "refresh rate" / "retrieval rate" encompasses aperiodic rates. Specifically, we are persuaded that the claim

language is not sufficiently "clearly limited to one or more embodiments."
TIP Systems, LLC v. Phillips & Brooks/Gladwin, Inc., 529 F.3d 1364, 1375
(Fed. Cir. 2008). The '403 patent describes an example of the grid
managing the "refresh rate" of a tile associated with "locally stored word
processing or spread sheet files," in which the tile is configured "to refresh
only when the underlying data is written to the local hard drive." Ex. 1001,
12:50–56. Even if such a "refresh rate" is limited only to embodiments
involving a locally stored word processing or spreadsheet file, nothing in the
language of the independent claims precludes the recited "information
source" from being a locally stored word processing or spreadsheet file.

Accordingly, we construe "refresh rate" / "retrieval rate" as "a criteria
upon which information displayed in a tile is refreshed or retrieved."

4. "user-defined array size"

The phrase "user-defined array size" appears in claim 2. The '403
patent states that "a user may specify a presentation of the grid, consisting of
its dimensions, (i.e., the number of tiles to display and their arrangement)."
Ex. 1001, 11:9–11. Accordingly, in the Decision to Institute, the Board
construed "user-defined array size" as "the number and arrangement of tiles
to display, as specified by the user." Dec. 16.

SurfCast asserts that "user-defined array size" should be construed as
"the number and arrangement of tile ***positions*** in the array as specified by
the user." PO Resp. 26–27 (citing Ex. 1001, 11:9–11; Ex. 2004 ¶ 66).
Microsoft counters that the phrase "tile positions" does not appear in the
'403 patent. Microsoft is correct. SurfCast's citation to the '403 patent
provides no support for SurfCast's proposed user-specified array tile

"positions;" it refers only to the number and arrangement of tiles, as does the Board's construction. Mr. Weadock testifies that the plain and ordinary meaning of "arrangement" includes positioning, but provides no evidence to support that assertion. Ex. 2004 ¶ 66.

Accordingly, the Board maintains its construction of "user-defined array size" as "the number and arrangement of tiles to display, as specified by the user."

B. Antedating Duhault II

SurfCast seeks to disqualify Duhault II as prior art by establishing a date of invention prior to the filing date of Duhault II. PO Resp. 28–36.

The '403 patent claims the benefit of an earlier filing date, October 29, 1999, through a provisional application. Microsoft asserts that Duhault II qualifies as prior art under 35 U.S.C. § 102(e). *See, e.g.,* 292 Pet. 2, 25. Duhault II has an actual filing date of June 29, 1999. Although Duhault II was filed before the earliest effective filing date of the '403 patent, 35 U.S.C. § 102(e)(2) requires the prior art patent to have been filed "before the invention by the applicant for patent." *See, e.g.*, *Loral Fairchild Corp. v. Matsushita Elec.*, 266 F.3d 1358, 1362 (Fed. Cir. 2001). An inventor "may date his patentable invention back to the time of its conception, if he connects the conception with its reduction to practice by reasonable diligence on his part, so that they are substantially one continuous act." *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996) (internal citation and quotations omitted).

Conception

"Conception must be proved by corroborating evidence which shows
that the inventor disclosed to others his completed thought expressed in such
clear terms as to enable those skilled in the art to make the invention."
Coleman v. Dines, 754 F.2d 353, 359 (Fed. Cir. 1985). The requirement for
corroboration of inventor's testimony arose out of a concern that inventors
testifying at trial would be tempted to remember facts favorable to their case
by the lure of protecting their patent or defeating another's patent.
Mahurkar, 79 F.3d at 1577 (citing *Price v. Symsek*, 988 F.2d 1187, 1195
(Fed. Cir. 1993)); *see also Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed.
Cir. 1997) ("The tribunal must also bear in mind the purpose of
corroboration, which is to prevent fraud, by providing independent
confirmation of the inventor's testimony."). However, "[t]here is no
particular formula that an inventor must follow in providing corroboration of
his testimony of conception." *Singh v. Brake*, 222 F.3d 1362, 1367 (Fed.
Cir. 2000) (citing *Kridl*, 105 F.3d at 1450). Rather, a rule of reason applies
to determine whether the inventor's testimony has been corroborated. *Price*,
988 F.2d at 1194. "The rule of reason, however, does not dispense with the
requirement for some evidence of independent corroboration." *Coleman*,
754 F.2d at 360.

In their declarations, inventors Ovid Santoro and Klaus Lagermann
testify that they conceived the subject matter of each of the challenged
claims prior to June 29, 1999, the filing date of Duhault II ("the critical
date"). Ex. 2005, 2–11; Ex. 2006, 2–7. To corroborate Mr. Santoro's and
Mr. Lagermann's testimony, SurfCast submits emails exchanged between

Mr. Santoro and Mr. Lagermann (Exs. 2024–2029, 2036), entries from Mr.
Santoro's notebook (Ex. 2023), white papers (Exs. 2037, 2067, 2068),
photographs of a flip chart (Ex. 2041), and a letter from SurfCast's attorneys
(Ex. 2009). PO Resp. 30–32. SurfCast also summarizes its conception
evidence. Ex. 2065.

Microsoft counters that SurfCast's reliance on *Mahurkar* for the
principle that corroboration is not required for physical exhibits is inapposite
because it is the technical content of a document—not the date—that does
not require corroboration. Pet. Reply 6. According to Microsoft, SurfCast
was required to corroborate the dates of its conception documents with non-
inventor evidence, and it failed to do so, with the exception of an email
(Ex. 2024) to Dixon Dick, who has not testified in this proceeding. Hence,
Microsoft contends that SurfCast's evidence consists only of documents
drafted by and communicated between the inventors. Pet. Reply 6–7.

The exhibits offered by SurfCast to establish conception have been
challenged as to authenticity. Paper 67, 4–5 (challenging Exs. 2023–2029,
2034, 2036–2038, 2067, and 2068). SurfCast did not cure this defect. To
authenticate these documents, SurfCast provides only inventor testimony.
Paper 81, 5 (relying on testimony of Mr. Santoro); Ex. 2005 ¶¶ 10 (regarding
Exs. 2024–2029 and 2036), 13 (regarding Ex. 2023), 17 (regarding Exs.
2037, 2038, 2067, and 2068), 33 (regarding Ex. 2034). Inventor testimony
is not sufficient to authenticate a document offered to corroborate the
inventor's testimony. The purpose of corroboration is to prevent fraud by
providing *independent* confirmation of the inventor's testimony. *See, e.g.,*

Kridl, 105 F.3d at 1449. A document authenticated by only an inventor does not achieve that purpose because it is not sufficiently independent.

SurfCast asserts that Mr. Santoro's notebook (Ex. 2023) can serve to establish conception because corroboration is not required when a party seeks to prove conception through the use of physical exhibits. PO Resp. 31, n.4 (citing *Mahurkar,* 79 F.3d at 1577 ("This court does not require corroboration where a party seeks to prove conception through the use of physical exhibits.")). SurfCast's reliance on *Mahurkar* is misplaced. The principle that corroboration is not required when a party seeks to prove conception through the use of physical exhibits is directed to the technical content of a document, not to the date or origin of the document. The law requires sufficient proof for the date and identity of a physical exhibit offered to show conception. *Price*, 988 F.2d at 1194–95. Here, the date of the physical exhibits is not corroborated sufficiently for the reasons discussed above.

On this record, and under a rule-of-reason analysis, the earliest date of conception we accord SurfCast is October 29, 1999, the filing date of the provisional application to which the '403 patent claims benefit. Because Duhault II was filed June 29, 1999, SurfCast has not antedated Duhault II successfully.

Reasonable Diligence

Although SurfCast has failed to prove an earlier conception and antedate the effective date of the Duhalt II reference, we exercise our discretion and analyze SurfCast's alleged diligence to a reduction to practice. During the period in which reasonable diligence must be shown,

there must be continuous exercise of reasonable diligence. *In re McIntosh*, 230 F.2d 615, 619 (CCPA 1956); *see also Burns v. Curtis*, 172 F.2d 588, 591 (CCPA 1949) (referring to "reasonably continuous activity"). A party alleging diligence must account for the entire critical period. *Griffith v. Kanamuru*, 816 F.2d 624, 626 (Fed. Cir. 1987); *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966).

Even a short period of unexplained inactivity is sufficient to defeat a claim of diligence. *Morway v. Bondi*, 203 F.2d 742, 749 (CCPA 1953); *Ireland v. Smith*, 97 F.2d 95, 99–100 (CCPA 1938). In *In re Mulder*, 716 F.2d 1542, 1542–46 (Fed. Cir. 1983), the Federal Circuit affirmed a determination of lack of reasonable diligence, where the evidence of record was lacking for a two-day critical period. Likewise, in *Rieser v. Williams*, 255 F.2d 419, 424 (CCPA 1958), there was no diligence where no activity was shown during the first 13 days of the critical period.

A party alleging diligence must provide corroboration with evidence that is specific both as to facts and dates. *Gould*, 363 F.2d at 920; *Kendall v. Searles*, 173 F.2d 986, 993 (CCPA 1949). The rule of reason does not dispense with the need for corroboration of diligence that is specific as to dates and facts. *Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993; *see Coleman v. Dines*, 754 F.2d 353, 360 (Fed. Cir. 1985).

In their declarations, Mssrs. Santoro and Lagermann testify that the subject matter of each of the challenged claims was diligently reduced to practice from at least June 29, 1999 until October 29, 1999, the filing date of the provisional application to which the '403 patent claims benefit. To corroborate Mr. Santoro's and Mr. Lagermann's testimony, SurfCast

submitts invoices from SurfCast's law firm (Exs. 2049, 2050), time entries
of Dr. Richard Bone (Ex. 2035), a Declaration of Dr. Bone (Ex. 2008), and a
Declaration of Tom Dechaene, co-founder of SurfCast (Ex. 2007). SurfCast
also summarizes Dr. Bone's time entries (Ex. 2051) and activity (Ex. 2052).

Microsoft counters that (1) Dr. Bone is an interested party and his
testimony must therefore be corroborated to counter bias; (2) Dr. Bone's log
book (Ex. 2035) lacks corroboration because there is no evidence of when
the entries were made and their accuracy other than Dr. Bone's testimony;
(3) the log book entries cannot be linked reliably to any element of the
claimed invention; and (4) Dr. Bone did not work on the application that
issued as the '403 patent for significant portions of the critical period. Pet.
Reply 7–9.

Dr. Bone has a financial interest in the outcome of the co-pending
district court case involving the '403 patent and, as a result, has a financial
interest in the outcome of this proceeding. Ex. 2073, 19:6–9; 64:19–65:22.
As an interested party, his testimony must be corroborated by documentary
evidence. *Lacks Indus., Inc. v. McKechnie Vehicle Components USA, Inc.*,
322 F.3d 1335, 1350 (Fed. Cir. 2003). To corroborate that testimony,
SurfCast relies upon Dr. Bone's log book (Ex. 2035) and two invoices from
a law firm to SurfCast (Exs. 2049 and 2050). However, the exhibits offered
by SurfCast to establish reasonable diligence have been challenged as to
authenticity. Paper 67, 2–5 (challenging Exs. 2035, 2049, and 2050).
SurfCast did not cure this defect. To authenticate Dr. Bone's log book,
SurfCast provides only Dr. Bone's testimony. Ex. 2008 ¶ 10. To
authenticate the invoices, SurfCast provides only the testimony of Mr.

Santoro. Paper 81, 5 (relying on testimony of Mr. Santoro); Ex. 2005 ¶¶ 27
(regarding Exhibit 2049), 45 (regarding Exhibit 2050). As discussed above,
the testimony of an interested party, such as Mr. Santoro and Dr. Bone, is
not sufficient to authenticate a document offered for purposes of
corroboration. The purpose of corroboration is to prevent fraud by
providing *independent* confirmation of the interested party's testimony. *See,
e.g., Kridl*, 105 F.3d at 1449. A document authenticated by only an
interested party does not achieve that purpose because it is not sufficiently
independent.

Even if corroborated, Dr. Bone's log book does not show sufficiently
the continuous exercise of reasonable diligence during the entire critical
period. Even excluding weekends, Dr. Bone did not perform any activity for
SurfCast on June 29–30, July 1, July 6–8, August 5–6, August 9–10, August
20, August 23, August 25–27, September 6–10, September 15, September
20–21, September 24, September 28, October 1, October 11, October 14–15,
October 20, and October 27. Ex. 2035, 14–134. Moreover, seventeen days
on which Dr. Bone logged activity for SurfCast involved activity of 45
minutes or less. *Id.* In addition, Microsoft argues that Dr. Bone's activity
was "contrary to reasonable diligence" because he worked on later-assigned
matters out of chronological order. Reply 9. Dr. Bone explains that he was
hired as a law clerk days before being assigned the application that led to the
'403 patent, and that "when starting the process of populating my docket
with a full load of work, it was not necessarily possible to take on work
strictly chronologically in the sense of managing an initial influx of work
according to the most immediate due-dates." Ex. 2008 ¶ 15. "[I]t is not

necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved; and if the attorney has a reasonable backlog of work which he takes up in chronological order and carries out expeditiously, that is sufficient." *Rines v. Morgan*, 116 U.S.P.Q. 145 (C.C.P.A. 1957). However, that has not been shown in this case. Here, the evidence reflects an entire week of inactivity in addition to numerous gaps, and Dr. Bone acknowledges that he worked on later-assigned matters, and worked on them out-of-order. Reply 9 (citing Ex. 1102).

On this record, and under a rule-of-reason analysis, we cannot conclude that there was reasonably continuous activity toward reducing the invention to practice sufficient to support a determination of reasonable diligence.

C. Anticipation by Duhault II

Microsoft alleges that claims 1–13, 17–28, 30–33, 35–37, 39–43, and 46–50 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Duhault II. 292 Pet. 25–27; 293 Pet. 27–29; 294 Pet. 20–21.

SurfCast counters that Duhault II does not disclose all of the claim limitations recited in dependent claims 1, 22, and 46, or in independent claims 4, 10, 31, 42, and 49. PO Resp. 28–39.

Upon consideration of the parties' contentions and supporting evidence, we determine that Microsoft has demonstrated by a preponderance of evidence that claims 1–13, 17–28, 30–33, 35–37, 39–43, and 46–50 are anticipated by Duhault II. In our discussion below, we address SurfCast's arguments presented in the Patent Owner Response, focusing on the disputed claim limitations.

Duhault II

Duhault II describes a method and system for displaying video wherein multiple tuners are used to display multiple video images within a scaleable window. Ex. 1014, 1:65–67. The term "video image" refers to a unique channel of video received in the form of an analog or digital signal from a satellite, a cable network, the internet, or other on-demand video device. *Id.* at 3:1–9. One tuner provides a full-motion video to a first image, which is generally a larger image residing within the entire window. *Id.* at 2:1–3. A second tuner provides periodic refreshing to the other generally smaller windows. *Id.* at 2:3–5. Selection of the smaller windows allows for periodic full-motion video, individual full-motion video, switching of location, audio feed, and other desirable manipulation of video images. *Id.*at 2:5–8.

Figure 1 of Duhault II is reproduced below to depict Duhault II's display device having a plurality of video images:
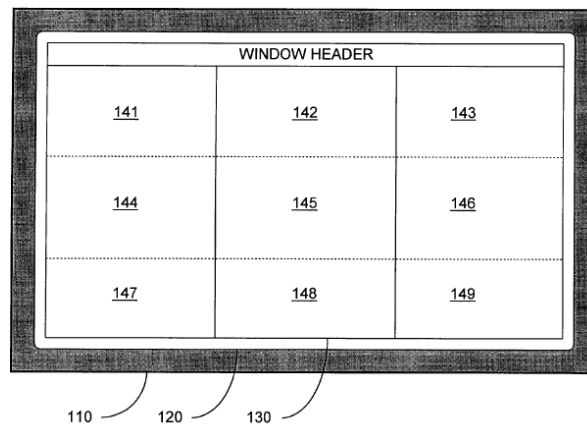

FIGURE 1

As shown in Figure 1 of Duhault II, display device 110 has screen area 120, substantially all of which is taken up by window 130. *Id.* at 2:16–20. In the embodiment depicted, window 130 has a window header and displays nine

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video images 141 to 149. *Id.* at 2:27–29. In other embodiments, window 130 may not have a window header or may have more or fewer video images displayed. *Id.* at 2:29–31.

Tile

Independent claims 1, 22, and 46 recite "tiles." In its Petitions, Microsoft asserts that Duhault II's video images disclose the "tile" claim feature. 292 Pet. 26 (citing Ex. 1003 ¶¶ 680–686); 293 Pet. 28 (citing Ex. 1003 ¶¶ 709–717); 294 Pet. 21 (citing Ex. 1003 ¶¶ 736–745). SurfCast contends that Duhault II's video images are not the recited "tiles" because "they are not assigned individual refresh rates." PO Resp. 36–37. As an initial matter, neither the claim language nor our construction of "tile" requires an "individual" refresh rate. Mr. Weadock testifies that Duhault II does not disclose assigning refresh rates because it is "conceivable" that the video images could be refreshed at "random intervals." Ex. 2004 ¶ 94. We are not persuaded by Mr. Weadock's testimony because we construe "refresh rate" / "retrieval rate" to encompass aperiodic rates for the reasons discussed above. The '403 patent explicitly describes an embodiment in which a tile may be refreshed at random intervals (i.e., only when the associated information source is written to the local hard drive). Ex. 1001, 12:50–56. Mr. Weadock also testifies that Duhault II's video images may be refreshed at a periodic, but not predetermined, rate. Ex. 2004 ¶ 94. However, neither the claim language nor our construction of "refresh rate" / "retrieval rate" requires that the "refresh rate" / "retrieval rate" be "predetermined."

We also understand SurfCast to be arguing that Duhault II does not disclose the claimed step of "assigning a first refresh rate to a first tile of said array of tiles and a second refresh rate to a second tile of said array of tiles" because "the refresh rate is not assigned to the video image itself, but rather is a property of the tuner." PO Resp. 36. Duhault II describes embodiments in which a first portion of video images is refreshed by a first tuner while a second portion of video images is periodically refreshed by a second tuner. *Id.* (citing Ex. 1014, 3:9–24). If the first portion consists of only a single video image, that video image is refreshed at full-motion video rate by a first tuner while the second portion, consisting of multiple video images are refreshed by a second tuner at less than full-motion video rate. Ex. 1014, 3:24–30. In other words, the refresh rate of a video image is determined by the number of other video images assigned to the same tuner. Thus, Duhault II's disclosure of assigning one or more video images to a "first portion" and a "second portion" discloses the assignment of a "refresh rate" to each of those video images.

SurfCast also contends that Duhault II's video images are not the recited "tiles" because they are not "selectable to provide access to an information source," as we have construed "tile" to require. PO Resp. 36–37. The '403 patent describes an embodiment in which a tile, when selected, provides access to a television channel. Ex. 1001, 9:25–32 ("[w]hen a tile is selected, whether by mouse click or otherwise, the tile instantly provides the user with access to the underlying information, whether that data be . . . or a television signal."). Duhault II similarly discloses that "if a user desired to watch the video image 146 of FIG. 1 in full-motion-video the user would

select the video image 146 by pointing a cursor at the image and clicking," and that "the second tuner is used to implement the full-motion-video of the selected video image." Ex. 1014, 4:1–14 (emphasis removed); *see id.* at Figs. 5, 6, 3:56–67. SurfCast argues that "the information from the underlying information source was already being displayed before the image was even selected," and that "only the rate at which the video image receives information from the tuner is updated." PO Resp. 37. However, Duhault II discloses that, prior to selection, the video image is available at only less than full-motion video rate; only when the video image is selected does Duhault II provide access to the video image at full-motion-video rate. Ex. 1014, Figs. 5, 6, 3:9–4:24.

Finally, SurfCast contends that Duhault II's video images are not "tiles" as construed by SurfCast. We decline to adopt SurfCast's proposed construction of "tile" for the reasons discussed above. We, therefore, need not reach these arguments.

In view of the foregoing, we conclude that Microsoft has demonstrated sufficiently that Duhault II describes the "tile" claim feature.

A [first/second] priority value (claims 4, 31)

Claim 4 recites "assigning said first refresh rate and said second refresh rate in accordance with a first priority value of a first information source associated with said first tile and a second priority value of a second information source associated with said second tile." Claim 31 similarly recites "assign[ing] said first retrieval rate and said second retrieval rate in accordance with a predetermined priority scheme."

Microsoft asserts that Duhault II's video images are assigned a higher or lower refresh rate depending on whether a user has prioritized that image by

selecting it. 292 Pet. 26 (citing Ex. 1003 ¶ 690); 293 Pet. 28 (citing Ex. 1003 ¶ 725). SurfCast contends that Duhault II does not disclose priority values being assigned to video images because "[a] priority value and a refresh rate are different from one another." PO Resp. 39. Microsoft counters that SurfCast cites no evidence and that its expert does not contest Dr. Karger's analysis of those claims. Pet. Reply 11. Even assuming that "a priority value may be used to distinguish between two tiles that, because of their contents, might be automatically assigned the same refresh rates," as SurfCast contends (PO Resp. 39), we are persuaded sufficiently that Duhault II discloses a priority value. Microsoft identifies the selection of a video image by a user as an assignment of a first (higher) priority value and the grouping of non-selected video images as an assignment of a second (lower) priority value. *See, e.g.*, 292 Pet. 26 (citing Ex. 1003 ¶ 690). Thus, the selection of the video image "[is] used to distinguish between two [video images] that, because of their contents, might otherwise be automatically assigned the same refresh rates."

Upon consideration of the parties' contentions and evidence, we determine that Microsoft has demonstrated by a preponderance of evidence that Duhault II describes priority values, as recited in claims 4 and 31.

Assigning refresh rates uniformly (claims 10, 42, 49)

Claim 10 recites "wherein said attribute [that is assigned uniformly] is a refresh rate." Claims 42 and 49 recite commensurate limitations.

Microsoft asserts that Duhaut II discloses that multiple unselected video viewing areas are assigned the same refresh rate using the same methodology. 292 Pet. 26 (citing Ex. 1003 ¶ 696); 293 Pet. 28 (citing Ex. 1003 ¶ 734); 294 Pet. 21 (citing Ex. 1003 ¶ 748). SurfCast contends that

Duhault II does not disclose assigning refresh rates uniformly to all of the video images because "the refresh rate is defined by the tuner associated with the images." PO Resp. 39. Microsoft counters that SurfCast cites no credible evidence and that its expert does not contest Dr. Karger's analysis of those claims. Pet. Reply 11. Microsoft relies upon Duhault II's disclosure that each of eight video images may be updated by a single tuner. *See, e.g.*, 292 Pet. 26 (citing Ex. 1003 ¶ 696). Dr. Karger's testimony that "[a] person of ordinary skill in the art would understand that the refresh rate of eight tiles can be uniform because they are updated by the same tuner," is unrebutted. Ex. 1003 ¶ 696.

Upon consideration of the parties' contentions and evidence, we determine that Microsoft has demonstrated by a preponderance of evidence that Duhault II describes assigning refresh rates uniformly, as recited in claims 10, 42, and 49.

Conclusion

For the foregoing reasons, we determine that Microsoft has demonstrated by a preponderance of the evidence that claims 1–13, 17–28, 30–33, 35–37, 39–43, and 46–50 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Duhault II.

D. Anticipation by Chen

Microsoft alleges that claims 1, 9–11, 22, 41–43, 46, and 48–50 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Chen. 292 Pet. 27–33; 293 Pet. 29–34; 294 Pet. 21–26.

SurfCast counters that Chen does not disclose (1) the elements arranged as in the claim; and (2) "tiles." PO Resp. 40–46.

Upon consideration of the parties' contentions and supporting evidence, we determine that Microsoft has demonstrated by a preponderance of evidence that claims 1, 9–11, 22, 41–43, 46, and 48–50 are anticipated by Chen. In our discussion below, we address SurfCast's arguments presented in the Patent Owner Response, focusing on the disputed claim limitations.

Chen

Chen describes a performance monitoring tool for a data processing system. Ex. 1015, 2:61. The performance monitoring tool may be used for monitoring, capturing, saving, retrieving, and analyzing data processing system operations. *Id.* at 2:63–65. The performance monitoring tool is built on a client/server model in which a server program, known as a "Data Supplier," runs as a daemon on a server system and one or more client programs, known as "Data Consumers," provides the monitoring facilities. *Id.* at 4:3–10. The basic monitoring device is called a monitor. *Id.* at 5:11. Within a monitor, "one or more sets of data processing system statistics may be observed in subwindows called instruments." *Id.* at 5:14–17. An instrument can monitor a set of statistics supplied from any host on the network that runs the Data Supplier daemon. *Id.* at 5:17–19.

Figure 12d is reproduced below depicting Chen's monitor having a plurality of instruments:

FIG. 12d
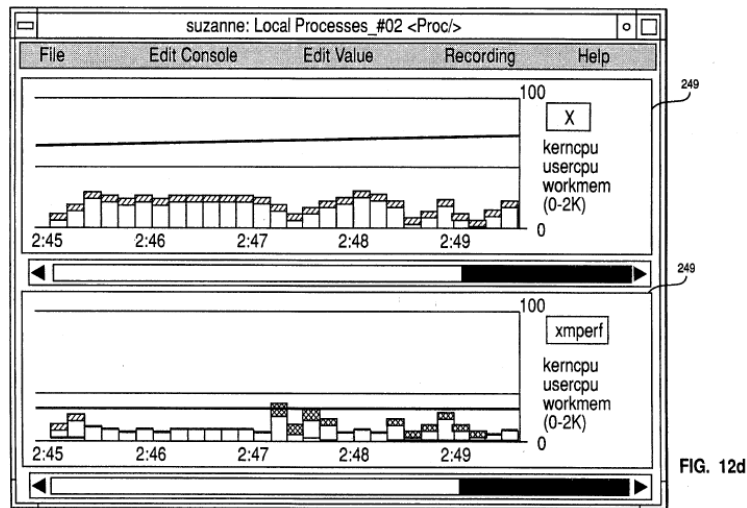
As shown in Figure 12d of Chen, an instrument shows statistics for a system resource over a period of time, as shown at 249. *Id.* at 23:35–37. GUI (graphical user interface) 80 allows the user to start and stop recording from any active monitoring instrument. *Id.* at 6:63–65, 13:15–21. The user can add new instrument subwindows to the console and has control over the sampling frequency of the instrument. *Id.* at 8:29–31, 8:38–40. Each instrument has an "interval" property that determines the number of milliseconds between observations. *Id.* at 23:45–48, 24:3–5.

Reliance on Chen's preferred embodiment

SurfCast asserts that Chen does not disclose the elements arranged as in the claim because the disclosures we relied upon must be pieced together from disparate parts of the reference, but does not elaborate. PO Resp. 40 (citing *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008)). Microsoft counters that SurfCast offers no evidence to support its assertion and that the portions of Chen addressed by Dr. Karger are all from Chen's preferred embodiment. Pet. Reply 11 (citing Ex. 1110 at ¶¶ 91–93). We agree with Microsoft. The parts of Chen relied upon by the Microsoft

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are not "disparate parts of the reference," but rather subsystems of a single
embodiment.

Tiles

Independent claims 1, 22, and 46 recite "tiles." In its Petitions,
Microsoft asserts that Chen's instruments disclose the "tile" claim feature.
292 Pet. 29–30 (citing Ex. 1003 ¶¶ 757–759); 293 Pet. 31 (citing Ex. 1003
¶¶ 808–811); 294 Pet. 23 (citing Ex. 1003 ¶¶ 850–851). SurfCast contends
that Chen's instruments are not the recited "tiles" because they are not
graphical user interface elements "that, when selected, provide[] access to an
information source," as required by the Board's construction. PO Resp. 42–
46. Specifically, SurfCast argues that "[s]electing any one of the[] submenu
items [in an Instrument Menu] . . . will not *provide access* to an information
source or the underlying information of the instrument's information
source." PO Resp. 45. Microsoft counters that the Board's findings in the
Decision to Institute were based on selecting instruments, not submenu
controls, and that selecting an instrument "provides access to an information
source" because selecting that instrument makes available a submenu control
to initiate recording and makes available Chen's marking functionality. Pet.
Reply 12 (citing Ex. 1110 ¶ 98). Microsoft is correct. When we addressed
this argument by SurfCast in our Decision to Institute, we determined that
"Chen discloses that individual instruments may be selected or unselected"
and that "the options available in an instrument's Instrument Menu depend,
in part, upon whether that instrument is selected." Dec. 28. An example of
the "access" provided by selecting an instrument is the ability to control the
information source by, e.g., selecting "Begin Recording" from that

instrument's Instrument Menu. Ex. 1015, Fig. 11, 14:67–15:2. The user has no such ability when the instrument is not selected. *Id.* at Fig. 11 ("N/A"). SurfCast contends that the claim limitation "provides access to an information source" requires access to the information in the recording file, but we do not interpret "provides access" so narrowly. SurfCast has not adequately explained why the ability to control an information source is not "provid[ing] access" to that information source.

SurfCast also contends that Chen's instruments are not "tiles" as construed by SurfCast. PO Resp. 42. We decline to adopt SurfCast's proposed construction of "tile" for the reasons discussed above. We, therefore, need not reach these arguments.

In view of the foregoing, we conclude that Microsoft has demonstrated sufficiently that Chen describes the "tile" claim feature.

Conclusion

For the foregoing reasons, we determine that Microsoft has demonstrated by a preponderance of the evidence that claims 1, 9–11, 22, 41–43, 46, and 48–50 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Chen.

E. Obviousness over Chen and MSIE Kit

Microsoft alleges that claim 29 is unpatentable under 35 U.S.C. § 103(a) as obvious over Chen and MSIE Kit. 293 Pet. 35–36.

SurfCast counters that (1) claim 29 depends from claim 22, which is not anticipated by Chen; and (2) there is no clear rationale for combining Chen and MSIE Kit. PO Resp. 46–47.

Upon consideration of the parties' contentions and supporting evidence, we determine that Microsoft has demonstrated by a preponderance of evidence that claim 29 is obvious over Chen and MSIE Kit. In our analysis below, we address SurfCast's argument presented in the Patent Owner Response.

MSIE Kit

MSIE Kit describes features of Microsoft Windows Internet Explorer 4, including Microsoft Active Desktop functionality in conjunction with Windows 98 or Windows NT. Ex. 1007, 174, 180, 183, 211. MSIE Kit describes Active Desktop "items" presented on a user's desktop. *Id.* Each item is associated with an information source on the Web. *Id.* at 174, 176, 177, 180, 183. Each item is presented typically on the desktop in a borderless frame without a title bar or scrollbars. *Id.* at 176, 183. By default, the items are laid out in a 3x2 grid. *Id.* at 176–177, 180, 183. Each item displays information from a URL and is updated periodically. *Id.* at 176–177, 180, 188, 201. The user may choose how frequently to update, or a content provider may specify the frequency in a "CDF" file. *Id.* at 177, 183, 188, 223. Users may select an item in order to move it on the desktop or may select a link within the item to open that link in a new browser window. *Id.* at 177, 183.

Claim 22

As discussed above, Microsoft has established by a preponderance of the evidence that Chen anticipates the subject matter of claim 22. Thus, we are not persuaded that claim 29 is patentable merely by virtue of its dependence from claim 22.

Rationale for combining

Microsoft contends that it would have been obvious to combine Chen and MSIE Kit because they are analogous art in related fields. 293 Pet. 35–36 (citing Ex. 1003 ¶¶ 824). SurfCast contends that "there is no clear rationale for combining Chen and MSIE Kit" because, *inter alia*, "[t]he systems are very different art and are used for very different purposes," and "[o]ne of skill in the art would not be motivated to use Active Desktop items in a high-performance monitoring system disclosed by Chen." PO Resp. 46–47 (citing Ex. 2004 ¶¶ 108, 109, 111). Microsoft counters that the combination upon which the Board instituted review relies upon the combination of MSIE Kit's password scheme, not its Active Desktop Items, with the instruments of Chen, and SurfCast presents no credible evidence challenging that combination. Pet. Reply 12–13.

In its Petition, Microsoft relied upon Dr. Karger's testimony that "a person of ordinary skill would have considered [the limitation of claim 29] to be an obvious design choice or a routine modification to an existing system" and that "one skilled in the art would have found it obvious to combine Chen with MSIE Kit because they are analogous art in related fields." 293 Pet. 35–36 (citing Ex. 1003 ¶¶ 822–825). Mr. Weadock disagrees with Dr. Karger's testimony on the basis that "Dr. Karger does not explain . . . what functionality Active Desktop would bring to Chen," that "[t]he core abilities of Web browsers . . . would have had no usefulness in the invention of Chen," and that both the "target user communities" and the "technical requirements" for Chen and MSIE Kit are very different. Ex. 2004 ¶¶ 108, 109, 111. Dr. Karger, in turn, testifies that (1) Mr.

Weadock's arguments are irrelevant to the proposed combination of MSIE

Kit's *password scheme* with Chen; (2) both references address a need for

data security in presenting regularly updated information from a variety of

information sources; (3) a person of ordinary skill in the art could easily take

the password functionality of Active Desktop and add it to the instruments

of Chen; and (4) doing so was well within the average level of skill in the art

in 1999 because passwords had been used with computer interfaces for

decades, and one of ordinary skill in the art would have understood that their

use with Chen would have improved the security of Chen. Ex. 1110 ¶¶ 107–

113.

On this record, there is sufficient evidence to support a finding that

the claims merely combine known elements for their known purpose to

achieve a predictable result. *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 416

(2007).

Conclusion

For the foregoing reasons, we determine that Microsoft has

established by a preponderance of the evidence that claim 29 is unpatentable

under 35 U.S.C. § 103(a) as obvious over Chen and MSIE Kit.

F. Anticipation by MSIE Kit

Microsoft alleges that claims 1–3, 5–8, 11, 12, 14–16, 19, 21, 22, 27,

30, 32, 34, 37–40, 43–47, and 50–52 are unpatentable under 35 U.S.C.

§ 102(b) and § 102(a) as anticipated by MSIE Kit. 295 Pet. 20–34.

SurfCast counters that MSIE Kit does not disclose all of the claim

limitations recited in independent claims 1, 22, and 46, or in dependent

claims 3 and 30. PO Resp. 47–54.

Upon consideration of the parties' contentions and supporting
evidence, we determine that Microsoft has demonstrated by a preponderance
of evidence that claims 1–3, 5–8, 11, 12, 14–16, 19, 21, 22, 27, 30, 32, 34,
37–40, 43–47, and 50–52 are anticipated by MSIE Kit. In our discussion
below, we address SurfCast's arguments presented in the Patent Owner
Response, focusing on the disputed claim limitations.

Tiles

Independent claims 1, 22, and 46 recite "tiles." In its Petition,
Microsoft asserts that MSIE Kit's Active Desktop items disclose the "tile"
claim feature. 295 Pet. 22, 24, 27 (citing Ex. 1003 ¶¶ 268, 356–363, 401–
404). SurfCast contends that MSIE Kit's Active Desktop items are not
"tiles" because they do not, "when selected, provide[] access to an
information source," as required by the Board's construction. PO Resp. 47–
51. Specifically, SurfCast contends that a user cannot select an Active
Desktop item itself, but can select only a link or hot spot inside the Active
Desktop item. *Id.* at 48. Microsoft counters that (1) clicking on a link
within an Active Desktop items selects both the item and the link; and (2)
SurfCast ignores the hot spot functionality of Active Desktop items, which
permits a user to select an item by clicking any portion of the item and be
provided access to an assigned information source; (3) moving an item to an
un-obscured location or resizing an item "provides access" to the
information source depicted in that item; and (4) once an Active Desktop
item is selected, "access" is provided to the information source because the
user may move through hyperlinks in that information source and select one
by pressing the "enter" key. Pet. Reply 14–15.

We are not persuaded by SurfCast's argument that an Active Desktop
item cannot be selected. SurfCast concedes that the links and hot spots are
included in the Active Desktop item. *See, e.g.*, PO Resp. 48. If a user
selects a link *included* in an Active Desktop item, the user necessarily selects
the Active Desktop item. SurfCast argues that an Active Desktop item
displaying a web page with no links or a link-free portion of a web page
provides no mechanism to access any information. PO Resp. 49–50. Even
assuming that were true, it would still not account for the "hot spot"
functionality disclosed by MSIE Kit. As Microsoft points out, a "hot spot"
can be defined to encompass the entire Active Desktop item such that
clicking any portion of the item (regardless of what is displayed in that item)
provides access to an assigned information source. Pet. Reply 15 (citing Ex.
1007, 213–14; Ex. 1110 ¶¶ 131–33).

SurfCast also contends that MSIE Kit's Active Desktop items are not
"tiles" as construed by SurfCast. PO Resp. 47. We decline to adopt
SurfCast's proposed construction of "tile" for the reasons discussed above.
We, therefore, need not reach these arguments.

In view of the foregoing, we conclude that Microsoft has
demonstrated sufficiently that MSIE Kit describes the "tile" claim feature.

Partitioning

SurfCast also contends that MSIE Kit does not disclose "partitioning a
visual display of the device into an array of tiles" as construed by SurfCast.
PO Resp. 51–52. We decline to adopt SurfCast's proposed construction of
"partitioning a visual display of the device into an array of tiles" for the
reasons discussed above. We, therefore, need not reach these arguments.

In view of the foregoing, we conclude that Microsoft has
demonstrated sufficiently that MSIE Kit describes the "partitioning" claim
feature.

Uniform size and shape (claims 3 and 30)

Claim 3 recites "partitioning said array of tiles in a non-overlapping
configuration wherein each tile of said array of tiles is a uniform size and
shape." Claim 30 recites a limitation with commensurate scope.

Microsoft contends that MSIE Kit discloses how Active Desktop
partitions a desktop into a 3 x 2 grid, which yields cells of an identical size
arranged in a non-overlapping layout. 295 Pet. 29–30 (citing Ex. 1003 ¶¶ 289–
294, 380). SurfCast contends that MSIE Kit does not disclose "partitioning
said array of tiles . . . wherein each tile of said array of tiles is a uniform size
and shape" because (1) "200 X 200 pixels" is a suggested maximum, not a
default; (2) MSIE Kit elsewhere discloses items with a size of 200 X 80
pixels; and (3) Dr. Karger could not tell whether the two-by-two grid on
page xxx of MSIE Kit depicts a single Active Desktop item or multiple
items. PO Resp. 52–54. Microsoft counters that (1) "Active Desktop Items
will be displayed by default in a non-overlapping 3 X 2 grid;" and (2) a
default size is implied by MSIE Kit's disclosure that a new Active Desktop
item can be created without specifying its size. Pet. Reply 16 (citing
Ex. 1110 ¶¶ 143–45).

As discussed above, we construe "partitioning a visual display of the
device into array of tiles" as "dividing a display or window into two or more
tiles." We, therefore, interpret the additional limitation recited in claims 3
and 30 as requiring that the outcome of the "partitioning" is tiles with a
uniform size and shape. MSIE Kit discloses that, "[b]y default, Internet

Explorer lays out new Active Desktop items on a 3 by 2 grid," and that
"[f]or a desktop at a resolution of 640 x 480, . . . this would translate into a
maximum size of no more than 200×200 pixels." Ex. 1007, 183. Thus, at
least at the time that Internet Explorer lays out new Active Desktop Items,
those items have "a uniform size and shape." Subsequent to that layout, a
user may re-size one or more items such that each item no longer has a
uniform size and shape, as SurfCast contends. The language of claims 3 and
31, however, does not require that each of the tiles in the array *remain* a
uniform size and shape *after* partitioning. In that regard, we note that the
'403 patent discloses that tiles may change in size and shape in response to
user input. *See, e.g.*, Ex. 1001, 9:43–56.

Upon consideration of the parties' contentions and evidence, we
determine that Microsoft has demonstrated by a preponderance of evidence
that MSIE Kit describes the disputed claim feature.

Conclusion

For the foregoing reasons, we determine that Microsoft has
established by a preponderance of the evidence that claims 1–3, 5–8, 11, 12,
14–16, 19, 21, 22, 27, 30, 32, 34, 37–40, 43–47, and 50–52 are unpatentable
under 35 U.S.C. § 102(b) as anticipated by MSIE Kit.

G. Anticipation by Duperrouzel

Microsoft alleges that claims 1–3, 5–8, 12–14, 19, 21, 22, 27, 30, 32,
34, 37–40, 46, and 47 are unpatentable under 35 U.S.C. § 102(e) as
anticipated by Duperrouzel. 295 Pet. 41–54.

SurfCast counters that Duperrouzel does not disclose all of the claim
limitations recited in independent claims 1, 22, and 46. PO Resp. 54–60.

Upon consideration of the parties' contentions and supporting
evidence, we determine that Microsoft has demonstrated by a preponderance
of evidence that claims 1–3, 5–8, 12–14, 19, 21, 22, 27, 30, 32, 34, 37–40,
46, and 47 are anticipated by Duperrouzel. In our discussion below, we
address SurfCast's arguments presented in the Patent Owner Response,
focusing on the disputed claim limitation.

Duperrouzel

Duperrouzel describes a display system that simultaneously displays
multiple web pages in a plurality of non-overlapping "display panes."
Ex. 1011, Abstract, 2:4–11, 5:1–2, Fig. 2. In one embodiment, the display
system is a web browser. *Id.* at Abstract. A user may designate the number
of non-overlapping display areas to be displayed. *Id.* Each display pane can
be controlled individually to refresh the web page currently displayed at a
rate specified by the user. *Id.* at 13:36–42, Fig. 19. Duperrouzel discloses
that, in one embodiment, "the web page display is executed in a windows
environment such as Microsoft Active Desktop in conjunction with the
Internet Explorer engine." *Id.* at 11:38–65.

Tiles

Independent claims 1, 22, and 46 recite "tiles." In its Petition,
Microsoft asserts that Duperrouzel's display panes disclose the "tile" claim
feature. 295 Pet. 42–43, 45, 47 (citing Ex. 1003 ¶¶ 438, 540, 575–576).
SurfCast contends that Duperrouzel's display areas are not the recited "tiles"
because they do not, "when selected, provide[] access to an information
source," as required by the Board's construction. PO Resp. 55–57.
Specifically, SurfCast contends that "each pane is a window that contains an

application and is always active and accessible to the user," and that a user has no additional access to a display pane when it is selected because "they are fully functional web-browser applications displaying active web-pages that can be accessed directly by the user." *Id.* SurfCast further contends that "maximizing a display pane does not perform the function of providing access to any information because that access was already present and is unaltered by increasing the size of the pane." *Id.* at 57. Microsoft counters that (1) SurfCast's argument is unsupported by expert testimony; (2) Duperrouzel discloses, in addition to maximizing, the ability to save, print, or refresh the web page displayed in a pane when that pane is selected; and (3) both maximizing and refreshing are described by the '403 patent as examples of providing access. Pet. Reply 17 (citing Ex. 1011, Figs. 8, 9, 9:27–53).

We are not persuaded that Duperrouzel's display panes do not "when selected, provide[] access to an information source." Each of the display panes (i.e., "tiles") in Duperrouzel displays at least a portion of a web page (i.e., "information source"). Each pane has a scroll control 242 that controls the position of the web page being displayed within the display pane. Ex. 1011, 6:41–43 ("A scroll control 242 of the display pane 212*a* controls the position of the web page being displayed in the display pane 212*a*."). Duperrouzel also discloses that "the controls for each display pane 212 affect only that display pane." *Id.* at 6:47–49 (emphasis removed). SurfCast acknowledges that the scroll bars provide access to the web page. Tr. 66 ("That's not more access because you already have that access by using the slide bars."). Because the scroll bars of a display pane affect only that

display pane, however, a user cannot scroll that display pane unless it is
selected. Thus, 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).

SurfCast also contends that Duperrouzel's display panes are not
"tiles" as construed by SurfCast. PO Resp. 57–60. We decline to adopt
SurfCast's proposed construction of "tile" for the reasons discussed above.
We, therefore, need not reach these arguments.

In view of the foregoing, we conclude that Microsoft has
demonstrated sufficiently that MSIE Kit describes the "tile" claim feature.

Conclusion

For the foregoing reasons, we determine that Microsoft has
established by a preponderance of the evidence that claims 1–3, 5–8, 12–14,
19, 21, 22, 27, 30, 32, 34, 37–40, 46, and 47 are unpatentable as anticipated
by Duperrouzel.

H. Obviousness over either MSIE Kit and Brown or Duperrouzel and Brown

Microsoft alleges that claims 17, 20, 25, and 28 are unpatentable
under 35 U.S.C. § 103(a) as obvious over either (1) MSIE Kit and Brown, or
(2) Duperrouzel and Brown. 295 Pet. 37–38, 57–58, 60.

SurfCast counters that Brown does not teach "tiles" and therefore does
not cure the alleged deficiency in MSIE Kit and Duperrouzel. PO Resp. 60.
For the reasons discussed above, however, we are not persuaded that MSIE
Kit and Duperrouzel are deficient.

Upon consideration of the parties' contentions and supporting
evidence, we determine that Microsoft has demonstrated by a preponderance

of evidence that claims 17, 20, 25, and 28 are obvious over MSIE Kit and

Brown, and over Duperrouzel and Brown.

I. *SurfCast's Corrected Motion to Amend Claims*

SurfCast moves to substitute claims 53–59 for challenged claims 46–

52, respectively, if we find original claim 46 unpatentable. Mot. Amend 1.

As stated above, we determine that Microsoft has demonstrated by a

preponderance of the evidence that all of the challenged claims are

unpatentable, including claim 46. Therefore, SurfCast's Motion to Amend is

before us for consideration. For the reasons set forth below, SurfCast's

Motion to Amend is *denied*.

Proposed substitute claim 53 is an independent claim and proposed

substitute claims 54–59 depend from proposed substitute claim 53.

Proposed substitute claim 53 is reproduced as follows:

> 53 (substitute for claim 46): A system for facilitating the organization and management of multiple data sources, comprising:
>
> a device that includes a processor configured to execute instructions, a memory connected to said processor to store at least one program that includes a graphical user interface, and an input device, wherein said processor executes instructions to:
>
> control simultaneous communication with a plurality of information sources;
>
> arrange a display into a grid an array of tiles that are not permitted to overlap, said grid of tiles being persistent from session to session;
>
> associate a first information source of said plurality of information sources to a first tile of said grid array of tiles and a second information source of said plurality of

> > information sources to a second tile of said grid ~~array~~ of
> > tiles;
>
> > retrieve information from said first information source in
> > accordance with a first retrieval rate and retrieve
> > information from said second information source in
> > accordance with a second retrieval rate; and
>
> > present information to said first tile in accordance with said first
> > retrieval rate and present information to said second tile
> > in accordance with said second retrieval rate<u>;</u>
>
> > <u>wherein the tiles are selectable, and wherein selecting a tile
> > calls an assigned application program to provide access
> > to information, the assigned application program being
> > different from a program that arranges the display into
> > the grid of tiles that are not permitted to overlap;</u>
>
> > <u>wherein the assigned application program for the first tile and
> > the assigned application program for the second tile are
> > different application programs selected from among the
> > group consisting of a web browser, a word processing
> > application, an electronic mail application, a chat
> > application, and a streaming video player.</u>

Mot. Amend. 2–3 (emphasis added by SurfCast to show the changes).

A motion to amend claims in an *inter partes* review is not, itself, an amendment. As the moving party, SurfCast bears the burden of proof to establish that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). Therefore, SurfCast's proposed substitute claims are not entered automatically, but only upon SurfCast's having demonstrated by a preponderance of the evidence the patentability of those substitute claims. *See, e.g.*, 37 C.F.R. § 42.1(d) (noting that the "default evidentiary standard [in proceedings before the Board] is a preponderance of the evidence.").

1. *Claim Construction*

Claim construction is an important step in a patentability
determination. *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1339 (Fed.
Cir. 2003); *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir.
2003) ("Both anticipation under § 102 and obviousness under § 103 are two-
step inquiries. The first step in both analyses is a proper construction of the
claims . . . . The second step in the analyses requires a comparison of the
properly construed claim to the prior art." (Internal citations omitted)). A
motion to amend claims must identify how the proposed substitute claims
are to be construed, especially when the proposed substitute claims introduce
new claim terms. *See Idle Free Sys., Inc. v. Bergstrom, Inc.*, IPR2012-
00027, slip op. at 7 (PTAB June 11, 2013) (Paper 26) ("*Idle Free*").

In its Motion to Amend, SurfCast asserts that the claim term
"persistent" means "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." Mot. Amend 5 (citing Ex. 2063 ¶ 33e).
SurfCast's proposed construction improperly imports limitations—"the tile's
position in a grid or array, the tile's refresh rate, and a source of information
associated with the tile"—from the Specification into the claims. The
proposed substitute claim requires only that "said tiles be[] persistent from
session to session." This is consistent with the '403 patent's use of
"persistent" to mean "not saved explicitly but [] preserved from session to
session." Ex. 1001, 15:63–64. In contrast, the disclosure relied upon by Mr.
Weadock (Ex. 2063 ¶ 33e (citing Ex. 1001, 13:8–11)) does not use the word
"persistent" and describes merely "one embodiment of grid object 700."

Ex. 1001, 12:31 (emphasis removed). Moreover, SurfCast's proposed construction of "persistent" includes the phrase "session to session," which would render the same language in proposed substitute claim 53 superfluous. *See Bicon*, 441 F.3d at 950 ("[C]laims are interpreted with an eye toward giving effect to all terms in the claim."); *see also Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (disapproving of claim constructions that render phrases in claims superfluous). As such, we decline to adopt SurfCast's proposed construction of "persistent."

SurfCast introduces several other new claim terms—e.g., "session," "calls," "application program,"—in its proposed substitute claims. SurfCast argues that those claim features distinguish the proposed substitute claims from the prior art. *See, e.g.*, Mot. Amend 8–13. Yet, SurfCast does not provide any persuasive claim constructions or explanations for how the new claim terms should be construed.

Without a reasonable construction of the new claim features added by the proposed substitute claims, SurfCast's motion does not provide adequate information for us to determine whether SurfCast has demonstrated the patentability of its proposed substitute claims over the prior art generally. Therefore, we are not persuaded that SurfCast has met its burden to demonstrate patentability of the proposed substitute claims under 37 C.F.R. § 42.20(c).

  2. *Written Description Support*

A motion to amend claims must identify clearly the written description support for each proposed substitute claim. 37 C.F.R. § 42.121(b). The requirement that the motion to amend must set forth the

support in the original disclosure of the patent is with respect to *each claim*,
not for a particular feature of a proposed substitute claim. In other words, it
is inadequate to show written description support for just the claim feature
added by the proposed substitute claim. The motion must account for the
claimed subject matter as a whole, i.e., the *entire* proposed substitute claim,
when showing where there is sufficient written description support for each
claim feature. *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, slip op. at 4
(PTAB June 3, 2013) (Paper 27).

In its Motion to Amend, SurfCast does not set forth adequate written
description support for all of the claim features. Rather, SurfCast merely
addresses the new claim features added by the proposed substitute claims.
Mot. Amend 4–7. As a result, SurfCast's Motion to Amend fails to set forth
the written description support for each proposed substitute claim as
required by 37 C.F.R. § 42.121(b)(1) and § 42.121(b)(2).

3. *Patentability over Prior Art*

The patent owner bears the burden of proof in demonstrating
patentability of the proposed substitute claims over the prior art in general,
and, thus, entitlement to add these claims to its patent. *Idle Free*, slip op. at
7. In a motion to amend, the patent owner must show that the conditions for
novelty and non-obviousness are met for the prior art available to one of
ordinary skill in the art at the time of the invention. With regard to
obviousness as the basis of potential unpatentability of the proposed
substitute claims, the patent owner should present and discuss facts which
are pertinent to the first three underlying factual inquiries of *Graham*: (1)
the scope and content of the prior art, (2) differences between the claimed

subject matter and the prior art, and (3) the level of ordinary skill in the art,

with special focus on the new claim features added by the proposed

substitute claims. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

The patent owner should identify each new claim feature, and come forward

with technical facts and reasoning about that particular feature. Some

discussion and analysis should be made about the specific technical

disclosure of the closest prior art as to each particular feature, and the level

of ordinary skill in the art, in terms of ordinary creativity and the basic skill

set of a person of ordinary skill in the art, regarding the feature.

Here, we are unpersuaded that SurfCast has demonstrated by a

preponderance of the evidence that the proposed substitute claims are

patentable. In its Motion to Amend, SurfCast does not address, in any

meaningful way, what was previously known in the art, much less the level

of ordinary skill in the art, regarding each new claim feature added by its

proposed substitute claims. Notably, proposed substitute claim 53 adds the

following features:

(1)   tiles are *not permitted to overlap*,

(2)   tiles are *persistent* from session to session,

(3)   wherein the tiles are selectable by a user, and wherein
       selecting a tile calls an assigned application program to
       provide access to information, the assigned application
       program being different from a program that arranges the
       display into the grid of tiles that are not permitted to
       overlap;

(4)   wherein the assigned application program for the first tile
       and the assigned application program for the second tile
       are *different application programs* selected from among
       the group consisting of a web browser, a word processing

application, an electronic mail application, a chat application, and a streaming video player.

Not permitted to overlap

In its Motion to Amend, SurfCast argues that MSIE Kit, Brown, Nawaz, and Utility Window Manager for X Windows do not disclose the "not permitted to overlap" feature. However, there is no persuasive explanation in the Motion to Amend as to why Duhault II, Duperrouzel, and Chen do not disclose the "not permitted to overlap" feature. Mot. Amend 8–13. One of ordinary skill in the art would have recognized that at least Duhault II, Duperrouzel, and Chen describe or suggest that new claim feature. *See, e.g.,* Ex. 1014, Fig. 1, 2:27–31; Ex. 1011, Abstract, 2:4–11, 5:1–2, Fig. 2; Ex. 1015, Fig. 12d, 32:1–3, 32:12–15.

Persistent

In its Motion to Amend, SurfCast argues that Duperrouzel, Duhault II, Brown, Nawaz, and Hassett do not disclose the "persistent from session to session" feature. However, there is no persuasive explanation in the Motion to Amend as to why MSIE Kit does not disclose the "persistent from session to session" feature. Mot. Amend 8–13. SurfCast also does not address its own admitted prior art—icons (Ex. 1001, 3:25–51)—regarding the claims "persistent from session to session" feature. One of ordinary skill in the art would have recognized that at least icons and MSIE Kit describe or suggest that new claim feature. *See, e.g.,* Ex. 1007, 50–60, 175.

Selecting a tile calls an assigned application program

In its Motion to Amend, SurfCast argues that none of the prior art it analyzed discloses the "selecting a tile calls an assigned application program" feature. Mot. Amend 8–13. With respect to MSIE Kit, for

example, Mr. Weadock testifies that MSIE Kit does not disclose this feature because an Active Desktop Item cannot be selected; only a link within an Active Desktop Item can be selected. Ex. 2063 ¶¶ 92–93. We rejected that argument, however, for the reasons discussed above in our analysis of the patentability of the original claims. One of ordinary skill in the art would have recognized that at least MSIE Kit describes or suggests that new claim feature. *See, e.g.,* Ex. 1007, 213–214.

Different Application Programs

In its Motion to Amend, SurfCast argues that none of the prior art it analyzed discloses the "selecting a tile calls an assigned application program" feature. Mot. Amend 8–13. With respect to MSIE Kit, for example, Mr. Weadock that selecting a link within an Active Desktop Item "does not call a different program from MSIE, but merely opens another instance of MSIE." Ex. 2063 ¶ 94. We are not persuaded by SurfCast's argument. MSIE Kit discloses subkeys in the Windows registry that associate programs other than Internet Explorer with certain types of URLs. Ex. 1007, 127–28. For example, Outlook Express can be associated with "mailto:" URLs. *Id.* Other programs can be associated with "news:" and "snews:" URLs. *Id.* Accordingly, one of ordinary skill in the art would have recognized that at least MSIE Kit describes or suggests that new claim feature.

4. *Conclusion*

For the foregoing reasons, SurfCast has not, in its Motion to Amend, set forth a prima facie case for the relief requested or satisfied its burden of proof. Consequently, the current situation does not require us to consider

Microsoft's Opposition and SurfCast's Reply. SurfCast's Motion to Amend

is *denied*.

J. Microsoft's Motion to Exclude

Microsoft's Motion to Exclude seeks to exclude the following

categories of evidence:

(1) Paragraphs of Mr. Weadock's Declaration that address
    SurfCast's proposed claim construction (Ex. 2004 ¶¶ 29, 44, 54,
    92, 103, 104, 119, 120, 136, 137);

(2) Redacted exhibits cited to support SurfCast's conception and
    reduction to practice arguments (Exhibits 2009, 2010, 2011,
    2012, 2015, 2016, 2018, 2019, 2020, 2021, 2022, 2023, 2024,
    2025, 2026, 2027, 2028, 2029, 2034, 2035, 2036, 2037, 2038,
    2049, 2050, 2067, 2068), and Mr. Bone's testimony about the
    same (Ex. 2073);

(3) The testimony of Dr. Bone (Exhibit 2073);

(4) Portions of Patent Owner's Reply (Paper 62) and a declaration of
    Mr. Weadock (Ex. 2081) alleged to be outside the proper scope
    of a reply; and

(5) Evidence alleged to be irrelevant (Ex. 2004 ¶ 85, 93, 101, 114;
    Ex. 2051; Ex. 2052; Ex. 2063 ¶ 57; Ex. 2065; Ex. 2081 ¶ 11, 12,
    15, 65, 68, 98–102; Ex. 2088).

Paper 67. SurfCast filed an Opposition to Microsoft's Motion to Exclude.

Paper 81. Microsoft filed a Reply to SurfCast's Opposition to its Motion to

Exclude. Paper 83. As movant, Microsoft has the burden of proof to

establish that it is entitled to the requested relief. *See* 37 C.F.R. § 42.20(c).

For the reasons stated below, Microsoft's Motion to Exclude is *granted-in-*

part and *denied-in-part*.

1. Weadock testimony regarding SurfCast claim construction

Microsoft moves to exclude paragraphs 29, 44, 54, 92, 103, 104, 119, 120, 136, and 137 of Mr. Weadock's declaration (Ex. 2004) as irrelevant under FRE 401, lacking foundation (FRE 703), relying on facts not in evidence (FRE 702), containing improper legal conclusions, and mischaracterizing evidence (FRE 403). Paper 67, 1–3; Paper 83, 1. Specifically, Microsoft argues that these paragraphs rely on a claim construction that differs from and is inconsistent with the Board's claim construction. Paper 67, 1. However, as SurfCast points out, the Board's construction of a claim term in a Decision to Institute is not final, and is reviewable in light of both parties' subsequent briefings and oral argument. Paper 81, 1–3. Mr. Weadock's testimony properly relies on the Specification of the '403 patent and the knowledge of a person of ordinary skill in the art to support SurfCast's claim construction. Accordingly, the motion is *denied* as to paragraphs 29, 44, 54, 92, 103, 104, 119, 120, 136, and 137 of Mr. Weadock's declaration (Ex. 2004).

2. Conception and reduction-to-practice exhibits

Microsoft moves to exclude Exhibits 2009, 2010, 2011, 2012, 2015, 2016, 2018, 2019, 2020, 2021, 2022, 2023, 2024, 2025, 2026, 2027, 2028, 2029, 2034, 2035, 2036, 2037, 2038, 2049, 2050, 2067, and 2068, and Mr. Bone's testimony about the same (Ex. 2073) as irrelevant (FRE 401), lacking foundation (FRE 703), lacking authenticity (FRE 901), and violating the doctrine of completeness (FRE 106). Paper 67, 2–5; Paper 83, 1–2. Specifically, Microsoft argues that SurfCast precluded it from testing SurfCast's evidence by redacting portions of these exhibits and by asserting

privilege during the deposition of Dr. Bone. *Id.* SurfCast later provided
unredacted versions of exhibits. Paper 81, 3–6; Papers 88, 91. SurfCast did
not, however, cure Microsoft's objection to the exhibits' authenticity. As
discussed above, the exhibits offered to corroborate the conception and
diligence testimony of Mr. Santoro, Mr. Lagermann, and Dr. Bone are
authenticated only by the testimony of Mr. Santoro (for conception exhibits)
or Dr. Bone (for diligence exhibits). The testimony of an interested party,
such as Mr. Santoro and Dr. Bone, is not sufficient to authenticate a
document offered for purposes of corroboration. The purpose of
corroboration is to prevent fraud by providing *independent* confirmation of
the interested party's testimony. *See, e.g., Kridl*, 105 F.3d at 1449. A
document authenticated by only an interested party does not achieve that
purpose because it is not sufficiently independent. Accordingly, the motion
is *granted* as to Exhibits 2009, 2010, 2011, 2012, 2015, 2016, 2018, 2019,
2020, 2021, 2022, 2023, 2024, 2025, 2026, 2027, 2028, 2029, 2034, 2035,
2036, 2037, 2038, 2049, 2050, 2067, and 2068.

3. Dr. Bone's testimony

Microsoft moves to exclude the testimony of Dr. Bone (Ex. 2073)
because it is the uncorroborated testimony of an interested party, and
because it is speculative. Paper 67, 5–6; Paper 83, 2–3. Microsoft does not,
however, identify a Federal Rule of Evidence under which the evidence is
inadmissible. It is within the Board's discretion to assign the appropriate
weight to be accorded to evidence. In its motion, Microsoft has not
explained adequately why the Board should exclude witness testimony on
diligence, instead of giving it little or no weight. *See, e.g., Donnelly*

Garment Co. v. NLRB, 123 F.2d 215, 224 (8th Cir. 1942) ("One who is capable of ruling accurately upon the admissibility of evidence is equally capable of sifting it accurately after it has been received . . . ."). Moreover, Microsoft may not challenge, in a motion to exclude, the sufficiency of the evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767. The Board is capable of taking into account the baselessness of a witness's testimony, if any, when weighing all of the testimony of the witness. Accordingly, the motion is *denied* as to Exhibit 2073.

4. *SurfCast's Reply to Opposition to its Contingent Motion to Amend*

Microsoft moves to exclude pages 2 to 5 of SurfCast's Reply to Opposition to Motion for Conditional Amendment (Paper 62), paragraphs 7–49, 55, 56, and 80–105 of Dr. Weadock's Reply Declaration (Ex. 2081), and page 144, line 20 to page 145, line 3 of Dr. Weadock's deposition (Ex. 2089) as outside the scope of a proper reply. Specifically, Microsoft argues that SurfCast provided new arguments and testimony about the proper construction of terms in the proposed amendments, written description support for the proposed amendments, and patentability of the proposed substitute claims over the prior art. *Id.* SurfCast counters that its arguments and evidence were responsive to the arguments made by Microsoft in its Opposition. Paper 83, 7–11.

Having considered the parties' contentions and evidence, we are not persuaded that SurfCast's Reply to Opposition to Motion for Conditional Amendment, and the accompanying testimony of Mr. Weadock, should be excluded. A motion to exclude is not a mechanism to argue that a reply contains new arguments or relies on evidence necessary to make out a prima

facie case. A motion to exclude, for instance, must state why the evidence is inadmissible (e.g., based on relevance or hearsay), identify the corresponding objection in the record, and explain the objection. *See* 37 C.F.R. § 42.64(c); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767. Whether a reply contains arguments or evidence that are outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to our determination. Therefore, Microsoft's argument that SurfCast's Reply contains new arguments and relies on new evidence is improper.

In any event, the mere fact that the Reply, and Mr. Weadock's accompanying testimony, includes evidence that was not discussed specifically in the Contingent Motion to Amend is insufficient to establish the impropriety of such evidence, much less inadmissibility under the Federal Rules of Evidence. The very nature of a reply is to respond to the opposition, which in this case is the Patent Owner Response. *See* 37 C.F.R. § 42.23(b). The need for relying on evidence not previously discussed in the Motion to Amend may not exist until a certain point has been raised in the opposition. Much depends on the specific arguments made in the opposition. As the movant, Microsoft has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Here, Microsoft's motion does not contain any meaningful discussion of the arguments that Microsoft made in its Opposition, which reasonably might or might not have triggered SurfCast's reliance on the arguments and evidence that Microsoft now seeks to exclude. Without such discussion, Microsoft has not shown that SurfCast's Reply and Mr. Weadock's testimony in support of that Reply exceeds the proper scope of reply evidence.

For the foregoing reasons, the motion is *denied* as to SurfCast's Reply
to Opposition to Motion for Conditional Amendment (Paper 62), paragraphs
7–49, 55, 56, and 80–105 of Dr. Weadock's Reply Declaration (Ex. 2081),
and page 144, line 20 to page 145, line 3 of Dr. Weadock's deposition (Ex.
2089).

5. *Evidence alleged to be irrelevant*

Microsoft moves to exclude paragraphs 85, 93, 101, and 114 of Mr.
Weadock's Declaration in support of SurfCast's Patent Owner Response
(Ex. 2004), paragraph 57 of Mr. Weadock's Declaration in support of
SurfCast's Contingent Motion to Amend (Ex. 2063), paragraphs 12, 15, 65,
68, and 98–102 of Mr. Weadock's Declaration in support of SurfCast's
Reply to Opposition to its Motion to Amend (Ex. 2081), and Exhibit 2088 as
irrelevant. Paper 67, 11–14. SurfCast counters that the evidence is relevant.
Paper 83, 11–14. Again, Microsoft's motion does not contain any
meaningful discussion of the arguments that Microsoft made in its
Opposition, which reasonably might or might not have triggered SurfCast's
reliance on the arguments and evidence that Microsoft now seeks to exclude.
Without such discussion, Microsoft has not shown that SurfCast's Reply and
Mr. Weadock's testimony in support of that Reply is irrelevant.
Accordingly, Microsoft's motion is *denied* as to paragraphs 85, 93, 101, and
114 of Mr. Weadock's Declaration in support of SurfCast's Patent Owner
Response (Ex. 2004), paragraph 57 of Mr. Weadock's Declaration in support
of SurfCast's Contingent Motion to Amend (Ex. 2063), paragraphs 12, 15,
65, 68, and 98–102 of Mr. Weadock's Declaration in support of SurfCast's
Reply to Opposition to its Motion to Amend (Ex. 2081), and Exhibit 2088.

Microsoft also moves to exclude Exhibits 2051, 2052, and 2065 because they were created by SurfCast counsel and are hearsay, are irrelevant, lack foundation, and should be excluded for the same reasons as the underlying exhibits that they summarize. Paper 67, 14. SurfCast counters that the exhibits are not hearsay and do not lack foundation because they have been authenticated by Mr. Santoro and Dr. Bone. Paper 81, 14. Exhibits 2051, 2052, and 2065 summarize exhibits offered to support SurfCast's conception and diligence arguments. We granted Microsoft's motion to exclude the exhibits underlying these summaries for the reasons discussed above. For the same reasons, Microsoft's motion also is *granted* as to Exhibits 2051, 2052, and 2065.

6. *Whether Mr. Weadock is qualified as an expert*

Microsoft moves to exclude Mr. Weadock's testimony because it does not meet the standard for expert testimony (FRE 702). Paper 67, 15; Paper 83, 5. Specifically, Microsoft argues that Mr. Weadock's testimony is unreliable and inadmissible because he has not considered "the kinds of things an expert would consider when trying to determine whether asking a program to receive information from an input device is calling it." *Id.* SurfCast counters that Mr. Weadock's testimony is quoted out of context and relates to an irrelevant hypothetical. Paper 81, 15.

Having considered the parties' contentions and evidence, we are not persuaded that Mr. Weadock's testimony is not the result of "the same level of intellectual rigor that characterizes the practice of an expert in the relevant field." *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 152 (1999). The proposed substitute claim language recites "wherein selecting a tile *calls* an

assigned application program to provide access to information" (emphasis
added). Mr. Weadock testified that he "ha[d]n't done that analysis" of "the
kinds of things an expert would consider when trying to determine whether
asking a program to receive information from an input device is calling it,"
not that he had not considered such things. Ex. 2089, 92:22–93:6. Earlier in
the deposition, Mr. Weadock testified that "when you call a program,
typically a normal person of skill in the art would understand that to mean
launching an application or possibly asking an application to do a task, to
perform some function," (*Id.* at 91:16–20) and that receiving input from an
input device "could be" asking the application to perform a function.
Therefore we are not persuaded that Mr. Weadock failed to consider how a
person of ordinary skill in the art would consider "call" as recited in the
proposed substitute claim language.

For the foregoing reasons, we decline to exclude Mr. Weadock's
testimony.

K. SurfCast's Motion to Exclude

SurfCast's Motion to Exclude seeks to exclude the following items of
evidence:

(1) Mr. Weadock's cross-examination testimony pertaining to his
first declaration (Ex. 2089, 14:1–30:2);

(2) Dr. Karger's redirect testimony (Ex. 1113, 210:9–211:20);

(3) Exhibits 1085–1101 and 1107–1109;

(4) Dr. Karger's Declaration (Exhibit 1110 ¶¶ 54, 55, 57, 116, 122,
131, 132) filed in support of Microsoft's Reply to SurfCast's
Patent Owner Response, and the exhibits cited therein (Exhibits
1090, 1091, 1093–1098);

> (5) Testimony of Klaus Lagermann (Exhibits 2075 and 1104, 57:8-58:17);
>
> (6) Testimony of Glenn Weadock (Exhibits 2077 and 1106, 27:9-16, 60:15-63:7, 121:13-122:6, 132:30-133:3);
>
> (7) Testimony of Richard Bone (Exhibits 2073 and 1102, 54:16-56:5, 64:19-65:22).

Paper 72. Microsoft filed an Opposition to SurfCast's Motion to Exclude.

Paper 79. SurfCast filed a Reply to SurfCast's Opposition to its Motion to

Exclude. Paper 85. As movant, SurfCast has the burden of proof to

establish that it is entitled to the requested relief. *See* 37 C.F.R. § 42.20(c).

For the reasons stated below, SurfCast's Motion to Exclude is *denied-in-part*

and *dismissed-in-part*.

1. *Mr. Weadock's cross-examination testimony (Ex. 2089)*

SurfCast moves to exclude page 14, line 1 to page 30, line 2 of the

deposition (Ex. 2089) of its expert, Mr. Weadock. Paper 72, 1. A motion to

exclude must explain the objection. 37 C.F.R. § 42.64(c). Specifically, "[a]

motion to exclude must: . . . (b) Identify where in the record the evidence

sought to be excluded was relied upon by an opponent." Office Patent Trial

Practice Guide, 77 Fed. Reg. at 48,767. Here, SurfCast's Motion to exclude

does not indicate that Microsoft relied upon the testimony sought to be

excluded. In any event, since we have not relied upon page 14, line 1 to

page 30, line 2 of Exhibit 2089, the motion is *dismissed* as moot as to these

paragraphs.

2. *Dr. Karger's redirect testimony (Ex. 1113)*

SurfCast moves to exclude page 210, line 9 to page 211, line 20 of the

deposition (Ex. 1113) of Microsoft's expert, Dr. Karger. Paper 72, 2. Again,

SurfCast's Motion to Exclude does not indicate that Microsoft relied upon the testimony sought to be excluded. In any event, since we have not relied upon page 210, line 9 to page 211, line 20 of Exhibit 1113, the motion is *dismissed* as moot as to these paragraphs.

3. *Exhibits 1085–1101 and 1107–1109*

SurfCast moves to exclude Exhibits 1085–1101 and 1107–1109 as irrelevant under FRE 401. Paper 72, 2–7. SurfCast moves to exclude Exhibits 1090 and 1091 on the additional basis that they are misleading. *Id.* SurfCast moves to exclude Exhibits 1095–1098 on the additional basis that they are untimely. *Id.* Since we have not relied upon Exhibits 1085–1101 and 1107–1109, the motion is *dismissed* as moot as to these exhibits.

4. *Dr. Karger's Declaration (Ex. 1110) and exhibits cited therein*

SurfCast moves to exclude paragraphs 54 and 55 of a Declaration of Dr. Karger (Ex. 1110) and the references cited in those paragraphs (Exhibits 1090, 1091, 1093, 1094) as exceeding the proper scope of a reply. Paper 72, 7–8. SurfCast argued in its Patent Owner Response that those terms should be construed to exclude overlapping. PO Resp. 12–18. The testimony in paragraphs 54 and 55 relates to whether "partitioning a visual display into an array of tiles" / "arrange a display into an array of tiles" should be construed to exclude overlapping partitions. Ex. 1110 ¶¶ 54, 55. Accordingly, we determine that paragraphs 54 and 55 are directly responsive to SurfCast's claim construction arguments.

SurfCast also moves to exclude paragraph 57, which relates to whether MSIE Kit discloses non-overlapping tiles. Paper 72, 8. SurfCast argued in its Patent Owner Response that MSIE Kit does not teach non-

overlapping tiles. PO Resp. 51–52. The testimony in paragraph 57 relates to whether MSIE Kit discloses arranging Active Desktop items in a non-overlapping configuration. Accordingly, we determine that paragraph 57 is directly responsive to SurfCast's arguments.

SurfCast also moves to exclude paragraph 116 and 122, which relate to whether Active Desktop items in MSIE Kit can be selected to provide access to information or to an application program. Paper 72, 8–9. SurfCast argued in its Patent Owner Response that the Active Desktop items of MSIE Kit are not "tiles" because they do not "when selected, provide[] access to an information source," and they cannot be used to invoke an application such as a word processing or spreadsheet program. PO Resp. 47–51. The testimony in paragraphs 122 and 116 responds to whether active desktop items can be selected and provide access to information or applications. Accordingly, we determine that paragraphs 116 and 122 are directly responsive to SurfCast's arguments.

Finally, SurfCast moves to exclude paragraphs 131 and 132 on the grounds that the discussion of "hot spots" in MSIE Kit is new evidence not previously cited. Paper 72, 9. SurfCast raised the issue of "hot spots" in its Patent Owner Response by arguing, *inter alia*, that "a user cannot select an Active Desktop item itself, but rather can only select a link or a hot spot inside the Active Desktop item." PO Resp. 48. The testimony in paragraphs 131 and 132 responds to whether hot spots can be selected. Accordingly, we determine that paragraph 131 and 132 are directly responsive to SurfCast's arguments.

For the foregoing reasons, the motion is *denied* as to paragraphs 54, 55, 57, 116, 122, 131, and 132 of Exhibit 1110 and Exhibits 1090, 1091, 1093, and 1094.

5. *Lagermann Testimony (Exs. 1104, 2075)*

SurfCast moves to exclude page 57, line 8 to page 58, line 17 of a deposition (Exs. 1104, 2075) of an inventor, Mr. Lagermann. Paper 72, 9–10. The transcript reflects three objections to form. In its Motion to Exclude, SurfCast does not explain the nature of the objection to form, but we understand SurfCast to object to the leading form of the question. Leading questions are permitted on cross-examination. Fed. R. Evid. 611. SurfCast's witness was under cross-examination by Microsoft's counsel. Microsoft's counsel was, therefore, permitted to use leading questions. Accordingly, the motion is *denied* as to page 57, line 8 to page 58, line 17 of each of Exhibits 1104 and 2075.

6. *Weadock Testimony (Exs. 1106, 2077)*

SurfCast moves to exclude (1) page 27, lines 9–16; (2) page 121, line 13 to page 122, line 6; (3) page 132, line 20 to page 133, line 3; and (4) page 60, line 15 to page 63, line 7 of a deposition (Exs. 1106, 2077) of SurfCast's expert, Mr. Weadock. Paper 72, 10. The transcript reflects objections to form. In its Motion to Exclude, SurfCast does not explain the nature of the objection to form. We understand SurfCast to object to the leading form of the question. As we explained above, Microsoft's counsel was permitted to use leading questions because SurfCast's witness was under cross-examination. Fed. R. Evid. 611. Accordingly, the motion is *denied* as to (1) page 27, lines 9–16; (2) page 121, line 13 to page 122, line 6; (3) page 132,

line 20 to page 133, line 3; and (4) page 60, line 15 to page 63, line 7 of each
of Exhibits 1106 and 2077.

7. *Bone Testimony (Exs. 1102, 2073)*

SurfCast moves to exclude (1) page 64, line 19 to page 65, line 22;
and (2) page 54, line 16 to page 56, line 5 of a deposition (Exs. 1102, 2073)
of Dr. Bone. Paper 72, 10–11. The first portion of transcript reflects only a
relevance objection. We are persuaded by Microsoft's argument that this
testimony is relevant to the credibility of Dr. Bone. Paper 79, 13. The
second portion of transcript reflects an objection and an assertion of
privilege. As Microsoft notes, however, the cited passage *is* the assertion of
privilege. Dr. Bone did not answer to the question, so there is no privileged
testimony to exclude. Microsoft relies on only the fact that privilege was
asserted; not on any privileged information. Accordingly, the motion is
denied as to (1) page 64, line 19 to page 65, line 22; and (2) page 54, line 16
to page 56, line 5 of each of Exhibits 1102 and 2073.

III. CONCLUSION

Microsoft has met its burden of proof by a preponderance of the
evidence in showing that claims 1–52 of the '403 patent are unpatentable
based on the following grounds of unpatentability:

Reference[s]	Basis	Claims Challenged
Duhault II	§ 102(e)	1–13, 17–28, 30–33, 35–37, 39–43, and 46–50
Chen	§ 102(b)	1, 9–11, 22, 41–43, 46, and 48–50
Chen and MSIE Kit	§ 103(a)	29

Reference[s]	Basis	Claims Challenged
MSIE Kit	§ 102(b)	1–3, 5–8, 11, 12, 14–16, 19, 21, 22, 27, 30, 32, 34, 37–40, 43–47, and 50–52
MSIE Kit and Brown	§ 103(a)	17, 20, 25, and 28
Duperrouzel	§ 102(e)	1–3, 5–8, 12–14, 19, 21, 22, 27, 30, 32, 34, 37–40, 46, and 47
Duperrouzel and Brown	§ 103	17, 20, 25, and 28

IV. ORDER

In consideration of the foregoing, it is

ORDERED that claims 1–52 of the '403 patent are held unpatentable;

FURTHER ORDERED that SurfCast's Motion to Amend Claims is *denied*;

FURTHER ORDERED that Microsoft's Motion to Exclude is *granted-in-part* with respect to Exhibits 2009, 2010, 2011, 2012, 2015, 2016, 2018, 2019, 2020, 2021, 2022, 2023, 2024, 2025, 2026, 2027, 2028, 2029, 2034, 2035, 2036, 2037, 2038, 2049, 2050–2052, 2065, 2067, and 2068, and otherwise is *denied-in-part*;

FURTHER ORDERED that SurfCast's Motion to Exclude is *denied-in-part* and *dismissed-in-part*;

FURTHER ORDERED that a copy of this Decision be entered into the files of Cases IPR2013-00292, IPR2013-00293, IPR2013-00294, and IPR2013-00295; and

FURTHER ORDERED that, because this is a Final Written Decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2013-00292, IPR2013-00293,
IPR2013-00294, IPR2013-00295
Patent 6,724,403

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