

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

COREL SOFTWARE, LLC,
Patent Owner.

Case IPR2016-01300
Patent 6,731,309 B1

Before RAMA G. ELLURU, JAMES A. TARTAL, and
DANIEL N. FISHMAN *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Petitioner, Microsoft Corporation, filed a Petition requesting an *inter partes* review of claims 1–3 of U.S. Patent No. 6,731,309 B1 (“the ’309 patent”). Paper 2 (“Pet.”). Patent Owner, Corel Software, LLC, filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition and the Preliminary Response, we conclude the information presented does not show a reasonable likelihood that Petitioner would prevail in showing the unpatentability of any challenged claim of the ’309 patent. Accordingly, we deny the Petition and do not authorize an *inter partes* review of the ’309 patent to be instituted.

I. BACKGROUND

A. *The ’309 Patent (Ex. 1001)*

The ’309 patent, titled “Real Time Preview,” issued May 4, 2004, from U.S. Application No. 09/141,832, filed August 28, 1998. Ex. 1001. The ’309 patent “provides a method and system of . . . previewing the impact of User commands on the entire document by executing User commands as they are identified.” *Id.* at Abstract. According to the ’309 patent, “[g]enerally in the prior art, a command must be selected and then executed by the User, before the menu will be closed and the document will be updated.” *Id.* at 3:19–21. The “primary distinction” between the ’309 patent and the prior art “is that commands need only be identified by the

User, and the identified command will be executed on the active document and the menu left open.” *Id.* at 3:16–19.

Figure 2 of the ’309 patent is reproduced below.

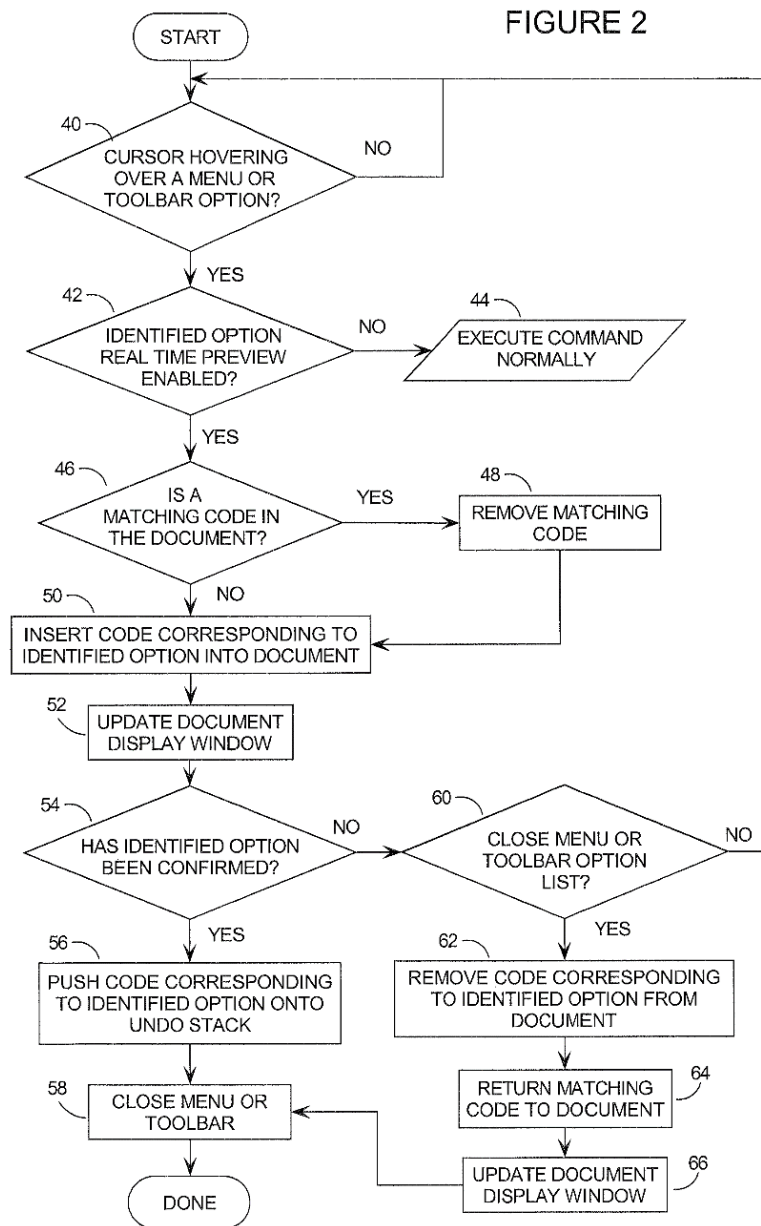


Figure 2 illustrates “a flow chart of a computer software routine for performing real time preview of text document commands.” *Id.* at 2:62–64.

“At step 40 a command is identified by a cursor hovering over a menu or toolbar option.” *Id.* at 6:40–41. “The cursor being positioned above a command is generally described as hovering, and is used to identify commands.” *Id.* at 6:48–50. “Once a command has been identified, the software routine corresponding to the identified command is executed, and it checks whether the identified command is enabled for the real time preview at step 42.” *Id.* at 6:66–7:2. “If the identified command is enabled for real time preview, the execution continues with step 46, which investigates whether there is a matching code already in the User document.” *Id.* at 7:20–23. “A matching code is typically one which effects the same text block and in the same manner as the identified command, but yields a different appearance.” *Id.* at 7:23–25.

If a matching code exists, the routine will remove the matching code at step 48 and insert the identified command code at step 50. *Id.* at 7:26–31. “If no matching code exists, the program continues directly to insert the code corresponding to the identified command at step 50.” *Id.* at 7:32–34. “If the document display window requires updating to present a clear image to the User, it is done at step 52.” *Id.* at 7:61–63. The User may confirm or accept the identified command at step 54 wherein “a query to the User may be provided as a dialogue box in a command window, or by similar means.” *Id.* at 8:2–5. “If the User confirms the identified command, then the program need only push the identified command unto the Undo Stack at step 56, which contains a listing of the executed commands in sequential order, and close the menu or toolbar at step 58.” *Id.* at 8:6–10. “If the User does not confirm the identified command at step 54, either the menu or toolbar may

be closed, or a new command identified which returns the program to step 40.” *Id.* at 8:23–25. “When the menu or toolbar is closed without confirming the identified command at step 60, the application returns the document to the state it was prior to the command being identified.” *Id.* at 8:27–29. “Code corresponding to the identified command is removed from the active document at step 62, the matching code that was removed at step 48 is returned at step 64, and the document display window is updated at step 66.” *Id.* at 8:29–32.

B. Illustrative Claim

Of the challenged claims of the ’309 patent, claim 1 is independent. Claims 2 and 3 depend from claim 1. Claim 1 of the ’309 patent is illustrative of the claims at issue:

1. A method of providing a real time preview of changes to guidelines or margins in a computer system operating a document editing program, comprising the steps of:
 - storing an active document in a memory medium;
 - displaying at least part of an active document in a document display window including document guidelines or margins;
 - responding to one of said guidelines or margins being grabbed and relocated f[r]om a first location to a second location by:
 - inserting code corresponding to said guideline or margin at said second location into said memory medium
 - storing said active document; and
 - removing code corresponding to said guideline or margin at said first location from said memory medium
 - storing said active document.

Ex. 1001, 14:12–27.

C. Related Proceedings

Petitioner states that the '309 patent is a subject of the following civil action: *Corel Software LLC v. Microsoft Corporation*, 2:15-cv-00528 (D. Utah). Pet. 3.

Related patents owned by Patent Owner directed to similar technology have been challenged by Petitioner in Cases IPR2016-01083, IPR2016-01084, PR2016-01085, and IPR2016-01086.

D. Asserted Ground of Unpatentability

Petitioner contends that claims 1–3 of the '309 patent are unpatentable based on the following grounds:

Reference[s]	Basis	Challenged Claims
QuarkXPress ¹ and WordPerfect ²	§ 103	1 and 2
QuarkXPress, WordPerfect, and Baker ³	§ 103(a)	3
WordPerfect and IRIS ⁴	§ 103(a)	1 and 2
WordPerfect, IRIS, and Baker	§ 103(a)	3

The Petition also relies on the Declaration of Dr. Daniel A. Menascé (Ex. 1003).

¹ Using QuarkXPress (1993) (Ex. 1007, “QuarkXPress”).

² WordPerfect Version 6.0 for Windows User’s Guide (1994) (Ex. 1004, “WordPerfect”).

³ U.S Patent No. 6,185,591 B1, issued Feb. 6, 2001 (Ex. 1006, “Baker”).

⁴ Meyers, Debbie *IRIS Showcase User’s Guide* (1996) (Ex. 1005, “IRIS”).

II. ANALYSIS

A. *Printed Publications*

The scope of an *inter partes* review is limited. In particular, 35 U.S.C. § 311(b) provides:

SCOPE.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

Petitioner contends both QuarkXPress and IRIS qualify as prior art under 35 U.S.C. § 102(b), as a publication published more than a year before the purported priority date of the '309 patent. Pet. 5.

The determination of whether a given reference qualifies as a prior art “printed publication” involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). The key inquiry is whether the reference was “sufficiently accessible to the public interested in the art” before the critical date. *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989); *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981). “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014) (quoting *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008)). The status of a reference as a printed publication is a legal question “based on underlying factual determinations.” *Id.*

[W]hether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as a “printed publication” . . . should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.

Wyer, 655 F.2d at 227 (citing *Philips Electronic & Pharmaceutical Industries Corp. v. Thermal & Electronics Industries, Inc.*, 450 F.2d 1164, 1171 (3d Cir. 1971)).

1. *Petitioner Has Not Made a Threshold Showing that QuarkXPress is a Prior Art Printed Publication*

Petitioner offers no general description of QuarkXPress, which spans over 400 pages. *See* Ex. 1007. According to Dr. Menascé, “QuarkXPress is a reference manual for a widely used document editing software application that was available in the mid-1990s.” Ex. 1003 ¶ 66. In support of its contention that QuarkXPress is a prior art printed publication, Petitioner contends QuarkXPress includes a copyright notice indicating it was first published in 1993. *Pet.* at 5–6. Petitioner also asserts that “the OCLC WorldCat also lists the three volumes of QuarkXPress books (including “Using QuarkXPress) [and] also indicates a publication date of 1993—more than a year before the purported priority date of the [sic] []’309] patent.” *Id.* at 6 (citing Ex. 1013 (identified in the Petition Exhibit List as a “[s]creen capture of WorldCat listing for *Using QuarkXPress* available at [a web link]⁵ (accessed May 3, 2016)”). Petitioner argues, without citing any

⁵ http://www.worldcat.org/title/quarkxpress/oclc/223221359&referer=brief_results.

precedential opinion, that “the Board has long considered a copyright notice in the reference it-self alone as sufficient to establish a prima facie publication date.” Pet. 6 (citing , inter alia, *FLIR Systems, Inc., v. Leak Surveys, Inc.*, Case IPR2014-00411, slip op. at 18–19 (PTAB Sept. 5, 2014) (Paper 9) (stating that “that the Copyright notice prima facie establishes a prior art date of 2002”).

Patent Owner argues that a copyright notice, alone, is insufficient to establish public accessibility as of a particular date. Prelim. Resp. 9 (citing, inter alia, *ServiceNow, Inc. v. Hewlett-Packard Co.*, Case IPR2015-00716, slip op. at 17 (PTAB Aug. 26, 2015) (Paper 13) (finding a copyright notice insufficient)). Patent Owner further contends that the WorldCat listing identified by Petitioner as corresponding to QuarkXPress is insufficient additional support of public accessibility for multiple reasons, including that: (1) the WorldCat listing indicates a copyright notice for itself of 2001-2016, providing no evidence of accessibility prior to the effective filing date of the ’309 patent, (2) the WorldCat listing refers to a three volume set, while QuarkXPress indicates it is part of a four volume set, and (3) there is insufficient evidence to establish the WorldCat listing refers to the same document with the same number of pages identified by Petitioner as QuarkXPress. *Id.* at 10–12. Patent Owner additionally notes that Petitioner

provides no declaration testimony in support of its contention that QuarkXPress was publicly accessible.⁶ *Id.* at 14.

Petitioner's focus on whether a copyright notice is evidence of the date of a reference disregards Petitioner's burden to show that the reference was publicly accessible by a particular date. Indeed, a copyright notice may be evidence of the date of a reference. *See, e.g., FLIR Systems, Inc.*, slip op. at 18–19 (stating that “[o]n the record before us, we are persuaded that the Copyright notice prima facie establishes a prior art date of 2002”). The copyright notice, alone, however, sheds virtually no light on whether the document was publicly accessible as of that date, therefore additional

⁶ We note that Petitioner sought authorization to file a reply brief to Patent Owner's Preliminary Response to further address whether either QuarkXPress or IRIS is prior art. *See* 37 C.F.R. § 42.108(c) (providing that a petitioner may be authorized to file a reply to the preliminary response upon a showing of good cause). During a teleconference between counsel for the parties and the Board on October 27, 2016, Petitioner explained that it not only sought to file an additional brief, but also to submit additional evidence in the form of declarations. Petitioner's request was denied for lack of “good cause.” That Petitioner may have determined from Patent Owner's Preliminary Response that the information Petitioner provided with the Petition failed to provide a threshold showing that either QuarkXPress or IRIS is a prior art printed publication did not support a finding of “good cause” in this case, much less justify submitting additional evidence not included with the Petition, which Patent Owner was deprived of addressing in its Preliminary Response. As noted above, an *inter partes* review may not be instituted unless “the information presented in the petition” shows a reasonable likelihood that the petitioner would prevail. 35 U.S.C. § 314(a). Petitioner did not identify any persuasive basis to provide additional declaration evidence outside of the Petition prior to institution of *inter partes* review to show a fundamental element of Petitioner's contentions -- that the references asserted by Petitioner are prior art as printed publications.

evidence is typically necessary to support a showing of public accessibility. *See, e.g., Ford Motor Co. v. Cruise Control Techs. LLC*, Case IPR2014-00291, slip op. at 9–10 (PTAB June 29, 2015) (Paper 44) (discussing evidence of public accessibility that supported a finding that a reference was a prior art printed publication). Rather than evidence public accessibility, the copyright notice appears in QuarkXPress along with an express limitation on the use and dissemination of QuarkXPress, stating “[t]his manual may not, in whole or in part, be copied, photocopied, reproduced, translated, or converted to any electronic or machine readable form without prior written consent of Quark, Inc.” Ex. 1007, 4. Thus, the evidence suggests that if it was distributed at all, it was only in a restricted and limited fashion to persons who acquired the underlying QuarkXPress software product. Accordingly, we look to whether Petitioner has provided other evidence or argument to support its contention that QuarkXPress was publicly accessible.

In this case, Petitioner has provided insufficient persuasive evidence that QuarkXPress was disseminated to the public as of any particular date, and does not otherwise explain why this particular manual was “sufficiently accessible to the public interested in the art” before the critical date. *See In re Cronyn*, 890 F.2d at 1160; *see also ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 865–66 (Fed. Cir. 2010) (finding no error in district court’s determination that user manuals were not printed publications in the absence of evidence of the source, publication, or public accessibility of either manual). Petitioner does not provide a satisfactory explanation of the relevance of the WorldCat listing for QuarkXPress software, contending

only that it “indicates a publication date of 1993.” Pet. 6. Thus, the WorldCat listing provided in support of the public accessibility of QuarkXPress appears to do no more than identify the copyright date shown on QuarkXPress. The WorldCat listing copyright notice for itself of 2001-2016 is after the application date of the ’309 patent. Ex. 1013 2. The WorldCat listing contains no other creation or entry date for the WorldCat listing itself and, therefore, provides no additional evidence of when QuarkXPress was publicly accessible. Indeed, Petitioner provides no explanation for how the WorldCat listing shows QuarkXPress was available such that interested and ordinarily skilled persons could locate it exercising reasonable diligence. *See Suffolk Techs.*, 752 F.3d at 1364; *see also International Business Machines Corporation v. Intellectual Ventures II LLC*, Case IPR2015-01323, slip op. at 13–14 (PTAB Sept. 27, 2016) (Paper 38) (finding listing in WorldCat database fails to support public accessibility of asserted reference).

Moreover, the evidence offered by Petitioner does not show sufficiently that the WorldCat listing of a “Reference Manual” purportedly included with the “QuarkXPress version 3.2 software” necessarily corresponds to the document Petitioner identifies as QuarkXPress. Collectively, all of the information provided by Petitioner shows only a copyright notice date and that, alone, is insufficient to support a threshold showing of public accessibility for QuarkXPress. Accordingly, we are not persuaded, based on the facts of this case, that the copyright notice on the QuarkXPress reference coupled with the WorldCat listing provided in this case are sufficient evidence to support a threshold showing of public

accessibility as of a particular date to support institution of *inter partes* review. *See, e.g., ServiceNow, Inc.*, slip op. at 17.

2. *Petitioner Has Not Made a Threshold Showing that IRIS is a Prior Art Printed Publication*

Petitioner offers no general description of IRIS, which spans over 280 pages. *See* Ex. 1005. According to Dr. Menascé, “IRIS is a reference manual for the IRIS Showcase document editing software application, which was also available in the mid-1990s.” Ex. 1003 ¶ 103. In support of its contention that IRIS is a prior art printed publication, Petitioner contends IRIS includes a copyright notice indicating it was first published in 1996. Pet. at 5. Petitioner also asserts that “the Wake Forest University listing for IRIS confirms the publication date of 1996.” *Id.* at 5 (citing Ex. 1012 (identified in the Petition Exhibit List as Screen Capture of Wake Forest University listing for IRIS Showcase User’s Guide available at [web link]⁷ (accessed June 2, 2016))). Petitioner offers no additional explanation of the “Wake Forest University listing” in the Petition and it is not addressed in Dr. Menascé’s declaration.

Patent Owner notes that IRIS “appears to be a PDF of an online user guide.” Prelim. Resp. 12. Patent Owner further states that in addition to a 1996 copyright date, IRIS also provides a copyright notice of 2009-2015. *Id.* Indeed, IRIS states “© 2009 – 2015 Silicon Graphics International Corp.” Ex. 1005 2. Patent Owner argues that “[d]espite IRIS containing conflicting copyright dates, Petitioner picks the earlier copyright date

⁷ http://menehune.opt.wfu.edu/Kokua/Irix_6.5.21_doc_cd/usr/share/Insight/library/SGI_bookshelves/SGI_EndUser/books/ShowcaseUG/sgi_html/front.html

without providing any reasoning for doing so and without even acknowledging the other conflicting copyright dates that suggest IRIS is not prior art.” *Id.* at 13. With regard to the Wake Forest Listing for IRIS, Patent Owner contends, and we agree, that it shows “nothing more than a 2016 copy of the same page of IRIS bearing a 1996 copyright date.” *Id.* (citing Ex. 1012 1 and Ex. 1005 1).

In this case Petitioner has provided insufficient persuasive evidence that IRIS was disseminated to the public as of any particular date, and does not otherwise explain why this particular manual was “sufficiently accessible to the public interested in the art” before the critical date. *See In re Cronyn*, 890 F.2d at 1160; *see also ResQNet.com*, 594 F.3d at 865–66. Petitioner has not shown that IRIS has a copyright date of 1996 in light of the conflicting copyright dates of 2009 – 2015 also appearing in IRIS. Moreover, Petitioner provides no explanation of the significance of the Wake Forest Listing for IRIS and the Wake Forest Listing does not explain the conflicting copyright dates shown in IRIS. As explained above with respect to QuarkXPress, a copyright notice, alone, sheds virtually no light on whether the document was publicly accessible as of that date, therefore additional evidence is typically necessary to support a showing of public accessibility. The Wake Forest Listing appears to do no more than identify one of several copyright dates shown on IRIS.

Accordingly, we are not persuaded, based on the facts of this case, that the copyright notice on the IRIS reference coupled with the Wake Forest Listing provided in this case are sufficient evidence to support a threshold

showing of public accessibility as of a particular date to support institution of *inter partes* review.

III. CONCLUSION

The only grounds of unpatentability asserted by Petitioner against the '309 patent in the Petition rely upon QuarkXPress or IRIS, and, as discussed above, Petitioner has not presented sufficient persuasive information in the Petition and accompanying evidence to make a threshold showing that either QuarkXPress or IRIS is a prior art printed publication. Accordingly, for the foregoing reasons, the information presented in the Petition and accompanying evidence does not establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of any challenged claim of the '309 patent.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

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