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Paper 9
Entered: October 7, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

SURFCAST, INC.,
Patent Owner.

IPR2022-00423
Patent 9,032,317 B2

Before SCOTT B. HOWARD, JASON W. MELVIN, and MICHAEL T. CYGAN, *Administrative Patent Judges.*

HOWARD, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

INTRODUCTION

A. Background and Summary

Microsoft Corp. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–19 of U.S. Patent No. 9,032,317 B2 (Ex. 1001, "the '317 patent"). Surfcast, Inc. ("Patent Owner") filed a Preliminary Response to the Petition (Paper 6, "Prelim. Resp.").

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). *Inter partes* review may not be instituted unless "the information presented in the petition filed under section 311 and any response filed under section 313 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." 35 U.S.C. § 314(a) (2018). "When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim." 37 C.F.R. § 42.108(a) (2021).

For the reasons set forth below, upon considering the briefing and the evidence of record, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner will prevail with respect to at least one of the challenged claims. Accordingly, we institute *inter partes* review on all of the challenged claims based on all of the grounds identified in the Petition.

B. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 2.

Patent Owner identifies itself as the real party in interest. Paper 3, 2 (Patent Owner's Mandatory Notices).

C. Related Matters

The parties identify the following district court proceedings: *SurfCast, Inc. v. Microsoft Corporation*, No. 6:21-cv-01018-ADA (W.D. Tex.) ("Texas Proceeding") and *SurfCast, Inc. v. Microsoft Corporation*, No. 2:12-cv-00333-DBH (D. Me.) ("Maine Proceeding"). Pet. 3; Paper 3, 2. Additionally, Petitioner identifies various *inter partes* review proceedings, including a series of *inter partes* review proceedings that determined that the claims of a related patent were unpatentable.[1] Pet. 1, 3.

D. The '317 Patent

The '317 patent is entitled "System and Method for Simultaneous Display of Multiple Information Sources" and is directed 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, codes (54), (57). As described in the "Background," 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 4:39–47. In response to this need, the '317 patent describes a graphical user interface comprising a grid of tiles that resides on the user's computer desktop. *Id.* at 4:54–55. 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 4:55–58. Figure 1 is reproduced below.

[1] *Microsoft Corporation v. SurfCast, Inc.*, IPR2013-00292 is representative of those proceedings. A copy of the Final Written Decision ("the 403 FWD") is Exhibit 1017.

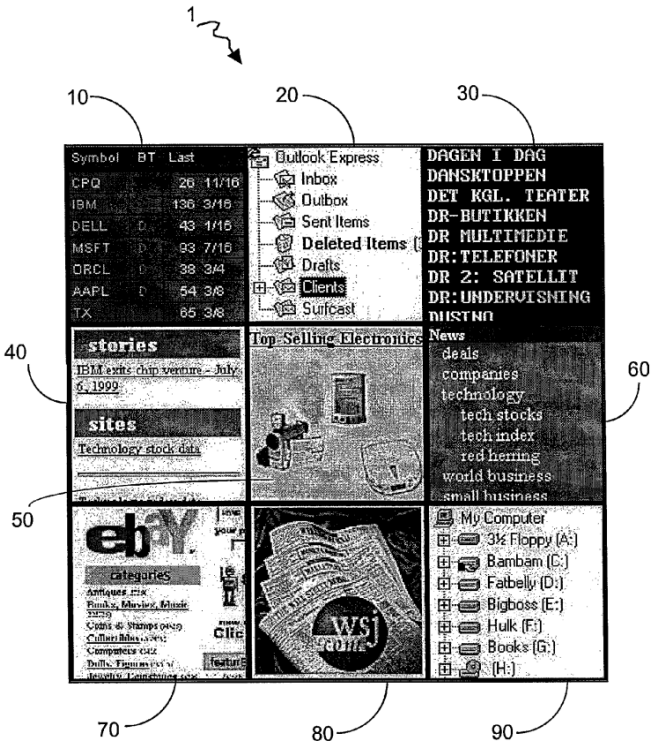

Figure 1 illustrates "a user interface comprising a grid of tiles as might be depicted on a display screen." *Id.* at 6:25–27; *see also id.* at 7:27–39 (describing the various tiles).

E. Illustrative Claims

Claims 1, 5, 12, and 16 are independent. Claims 1 and 5, reproduced below, are illustrative of the claimed invention.

> 1. A system for communicating with multiple data sources, the system comprising:
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> a client device adapted for communication with a server device, wherein the client device includes a display device, a processor configured to execute instructions, and a memory connected to the processor, wherein the processor executes instructions to:
>
> display, using the display device, *a grid of tiles*, wherein a first tile of said grid of tiles is associated with a first data source residing on the server device, and a second tile of said grid of tiles is associated with a second data source, and wherein the first tile displays a current

content from the first data source and the second tile displays a current content from the second data source; and

check whether content in the first data source is updated relative to the current content of the first tile and, if so, display updated information from the first data source on the first tile.

5. A method executed by a client device under control of a program, the client device including a processor, a display device for rendering a visual display, and a memory for storing the program, the method comprising:

partitioning by the client device at least a portion of the visual display into an array of tiles, a first tile in the array of tiles being associated with a first information source, the first information source being located on a first server device;

assigning by the client device a first update rate to the first tile;

at a first update time in accordance with the first update rate, sending a conditional request from the first client device to the first server device for an update of information in the first tile if the information from the first information source currently displayed in the first tile has not changed since a last update;

receiving at the client device a response to the conditional request from the first server device; and

determining whether to update the first tile in accordance with the response from the first server device.

Ex. 1001, 30:21–39, 30:49–31:2 (emphases added).

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–19 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §[2]	Reference(s)/Basis
1–19	102(a), (b)	MSIE Kit[3]
1–19	103(a)	MSIE Kit
1–19	103(a)	MSIE Kit, Jones[4]
5–11	103(a)	MSIE Kit, RFC2068[5]
5–11	103(a)	MSIE Kit, RFC2068, Jones
1–19[6]	103(a)	Excel97,[7] Bhansali[8]
12-19	103(a)	Excel97, Bhansali, Perez[9]

Petitioner also relies on a declaration from Henry Houh. Ex. 1003.

ANALYSIS

A. Legal Standards

1. Anticipation

A patent claim is unpatentable under 35 U.S.C. § 102 if "the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill

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[2] The Leahy-Smith America Invents Act ("AIA") included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Because the application that lead to the issuance of the '317 patent was filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability. *See* Ex. 1001, code (22).

[3] Microsoft Press. (1998). *Microsoft Internet Explorer Resource Kit*. (Ex. 1010). All citations are to the native pagination.

[4] U.S. Patent No. 6,819,345 B1, filed Feb. 17, 1998 (Ex. 1011).

[5] Network Working Group, Request for Comment 2068, January 1997 (Ex. 1012).

[6] Petitioner presents two theories/grounds for claims 12–19. *See* Pet. 8. We have consolidated them as a single ground.

[7] Person, R. (1997). *Special Edition Using Microsoft Excel 97* (Ex. 1005). All citations are to the native pagination.

[8] U.S. Patent No. 6,006,239, filed Mar. 15, 1996 (Ex. 1006).

[9] U.S. Patent No. 5,319,777, issued June 7, 1994 (Ex. 1013).

in the art could practice the invention without undue experimentation." *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). "A single prior art reference may anticipate without disclosing a feature of the claimed invention if such feature is necessarily present, or inherent, in that reference." *Allergan, Inc. v. Apotex Inc.*, 754 F.3d 952, 958 (Fed. Cir. 2014). Moreover, the reference must also "disclose[] within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim." *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). However, "the reference need not satisfy an *ipsissimis verbis* test." *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009).

2. Obviousness

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 that requires consideration of four factors: (1) the "level of ordinary skill in the pertinent art," (2) the "scope and content of the prior art," (3) the "differences between the prior art and the claims at issue," and (4) if in evidence, "secondary considerations" of non-obviousness such as "commercial success, long-felt but unsolved needs, failure of others, etc." *Id.* at 17–18. "While the sequence of these questions might be reordered in any particular case," *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for the Federal Circuit has repeatedly emphasized that "it is error to reach a conclusion of obviousness until all

those factors are considered," *WBIP v. Kohler*, 829 F.3d 1317, 1328 (Fed. Cir. 2016).[10]

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The "person having ordinary skill in the art" is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Factors pertinent to a determination of the level of ordinary skill in the art include "(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). "Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case." *Id.*

Petitioner argues that a person having ordinary skill in the art ("PHOSITA") would have had "a Master's degree in software engineering

[10] Because neither party address objective evidence of non-obviousness, we focus solely on the first three *Graham* factors.

or computer science (or equivalent experience working in industry) and several years of experience designing, writing or implementing software products, either at the application or operating system level." Pet. 11 (quoting Ex. 1003 ¶ 66). Petitioner further argues that a PHOISTA "would have been familiar with various technological concepts, including those relating to user interfaces, operating systems and software applications, basic computer functionality, networking and data processing." *Id.* (citing Ex. 1003 ¶ 66).

Patent Owner accepts, for purposes of this Decision, Petitioner's formulation of the level of skill. Prelim. Resp. 4. Patent Owner does not respond to Petitioner's description of what a PHOSITA would have been familiar with.

Accordingly, for purpose of this proceeding, we adopt the Petitioner's proposed level of skill and do not make any preliminary findings regarding the PHOSITA's knowledge.[11]

C. Claim Construction

We apply the same claim construction standard used in the federal courts, in other words, the claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b). Under the *Phillips* standard, the "words of a claim 'are generally given their ordinary and customary meaning,'" which is "the meaning that the term would have to a person of ordinary skill

[11] If Patent Owner disagrees with Petitioner's formulation of the level of skill in the art or the knowledge of a PHOSITA, it must do so in its Response. The parties must also brief how the different level of skill would affect the outcome in this case.

in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips*, 415 F.3d at 1312–13.

Petitioner argues that we should construe four terms: "tile," "data source"/"information source," "partitioning . . . at least a portion of the visual display into an array of tiles," and "update rate." Pet. 12–17. Patent Owner argues that we should construe three terms: "grid," "tile(s)," and "partitioning . . . at least a portion of the visual display into an array of tiles." Prelim. Resp. 10–22.

For the purposes of this Decision, we construe three of those terms below. For all other limitations, we need not expressly construe any claim terms at this time. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that "we need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy'" (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

1. "Tile(s)"

Petitioner argues that we should adopt the same construction determined in the 403 FWD: "a graphical user interface element whose content may be refreshed and that, when selected, provides access to an information source." Pet. 12 (quoting Ex. 1017, 7–10). According to Petitioner, the Board's prior construction "is consistent with every example of a tile disclosed in the specification, such as in Figures 1 and 4, which disclose tiles as graphical user interface elements displayed on a computer screen." *Id.* Petitioner further argues that the '317 patent "further explains that tiles are live and selectable (by mouse or otherwise) and provide the user with access to an associated information source, such as a file or webpage." *Id.* at 13 (citing Ex. 1001, 10:64–65, 11:3–5, 12:3–11).

Petitioner also argues that the Maine Proceeding's construction[12] "adds language not supported by the intrinsic record and which, crucially, may lead to misdirection by the patent owner." Pet. 13.[13, 14]

Patent Owner argues that the term "tile" means "a graphical representation of an associated information source capable of displaying refreshed content, the graphical representation being persistent and selectable to provide access to underlying information of the associated information source" and tiles means two or more tiles. Prelim. Resp. 14–15. Patent Owner argues that its construction is supported by the specification of the '317 patent. *Id.* at 15–17.

From the papers, it is unclear whether Petitioner's and Patent Owner's proposed constructions are substantially different in a way that will affect the outcome of this proceeding. For example, although Petitioner's construction includes a "graphical user interface" and Patent Owner's construction calls for a "graphical representation," it is unclear if those phrases have different meanings and, if so, how they impact our analysis of

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[12] "A graphical representation of an associated information source capable of displaying refreshed content, the graphical representation being persistent and selectable to provide access to underlying information of the associated information source." Ex. 1018, 27 (Maine Proceeding Claim Construction Order).

[13] The dispute with the district court construction focuses on the word "persistent." Pet. 13–14. However, because Patent Owner's arguments do not rest on whether a tile is persistent (Prelim Resp. 15 n.4), for purposes of this Decision, we do not address whether a tile must be persistent. *See Nidec*, 868 F.3d at 1017.

[14] Petitioner also makes an argument that is contingent on a possible construction Patent Owner might propose. *See* Pet. 15. Because Patent Owner did not propose such a construction, we do not address it.

the prior art. Similarly, the parties use different language relating to "selectable." Again, from the briefing, it is unclear whether the difference is meaningful and will impact our analysis.

Based on the record, and because the parties do not demonstrate that either construction is outcome determinative, for purposes of this Decision, we determine that both constructions are substantially the same (besides the requirement of being persistent, which Patent Owner indicates we do not need to address) and no further construction is needed. However, to the extent that Patent Owner believes its proposed construction is outcome determinative, Patent Owner should make that clear in its briefing and explicitly address the different language.

2. "Grid"

Patent Owner argues that the term "grid" as used in the '317 patent means "a regular arrangement of rows and columns *that contain and control the arrangement and layout of tiles*." Prelim. Resp. 11 (emphasis added). With regard to the emphasized language, Patent Owner argues that "[t]he 'Grid Object' section of the specification addresses '[t]he arrangement, layout and independent functioning of the tiles on the display.'" *Id.* at 12 (quoting Ex. 1001, 14:8–10) (second alteration in original); *see also id.* ("The grid controls the layout and priorities of the tiles." (quoting Ex. 1001, 14:22)). According to Patent Owner, "[t]hese categorical descriptions establish that a grid contains and controls the arrangement and layout of tiles." *Id.* at 12–13. Patent Owner argues this is consistent with the regular arrangement of rows and columns shown in the '317 patent. *Id.* at 13–14.

Based on the current record, we are not sufficiently persuaded that the emphasized language in Patent Owner's proposal is supported. Patent Owner did not propose it in either the earlier *inter partes* review proceedings

or in the Maine proceeding. *See* Ex. 1017, 7–14 (containing no proposed construction of the term "grid"); Ex. 1018, 74 (Patent Owner proposing "a regular layout of rows and columns, wherein a single tile may occupy more than one row and/or column."). Moreover, as discussed below in Section F.2.(b)(2) below, we determine that the asserted prior art teaches a "grid" even under Patent Owner's proposed construction, so adding the Patent Owner argued features to the construction of "grid" would not change the outcome of this Decision. For example, Patent Owner argues that MSIE Kit allows overlap and therefore does not contain and control tiles within rows and columns "or any other grid features" (Prelim. Resp. 24), but allowing overlap would still be consistent with a grid that contains and controls tiles. *See* Ex. 1001, 14:22. Accordingly, at this time, we decline to add it into the construction of the term "grid."

Moreover, based on the current record, we do not include the word "regular" in the claim construction. It is unclear what Patent Owner means by regular. For example, does it mean a consistent number of rows and columns? Or does it have a different meaning? Given that ambiguity, the fact that Patent Owner does not rely on the term regular when discussing the prior art, and Petitioner does not address the limitation, we decline to include it in the claim construction at this time. To the extent that Patent Owner thinks it should be included in the claim construction, Patent Owner shall explain what it means by regular and how it has a material effect on our analysis.

Accordingly, for the purposes of this Decision, we adopt the remainder of Patent Owner's proposed construction—"an arrangement of rows and columns"—which is consistent with the construction in the Maine proceedings. *See* Ex. 1018, 78 ("[A] regular arrangement of rows and

columns, which may, but need not, allow a single tile to occupy more than one row and/or column.").

3. "Partitioning . . . at Least a Portion of the Visual Display into an Array of Tiles"

Petitioner argues that we should use the same construction as in the 403 FWD: "dividing a display or window into two or more tiles." Pet. 16 (citing Ex. 1017, 12–13). According to Petitioner, this construction "is consistent with the description of tiles in the specification." *Id.* (citing Ex. 1001, 7:27–39, Fig. 1).

Patent Owner argues that the phrase means "dividing some or all of a display into multiple tiles displayed in an *orderly* fashion." Prelim. Resp. 18 (emphasis added). "More granularly," Patent Owner argues "'partitioning' means 'dividing,' 'at least a portion of the visual display' means 'some or all of a display,' and 'array of tiles' means 'multiple tiles displayed in an orderly fashion.'" *Id.*

Patent Owner further argues that Petitioner is effectively removing the term "array" from its construction. Prelim. Resp. 17–22. According to Patent Owner, because the claim already recites the plural "tiles," array must mean something more. *Id.* at 18. Patent Owner argues that the examples of tiles in the specification shows tiles in an orderly fashion. *Id.* at 18–21.

Based on the current record, we agree with Patent Owner. Because claims 5–19 recite an "array of tile*s*" using the plural tiles, an array of tiles must mean something more than two or more tiles. Otherwise, we would not be giving any meaning to the word "array." We further agree with Patent Owner that, based on the ordinary meaning and the examples of arrays shown in the '317 patent (*see*, *e.g.*, Ex. 1001, Fig. 1), the limitation requires "dividing some or all of a display into multiple tiles displayed in an

orderly fashion." In doing so, any array that is similar to that shown in a figure of the '317 patent would be orderly.

4. Other Claim Limitations

For purposes of this Decision, we need not construe expressly any other claim terms. *See Nidec*, 868 F.3d at 1017.

D. Discretionary Denial – Parallel Proceedings

Patent Owner argues that we should exercise discretion under 35 U.S.C. § 314 and deny institution because the '317 patent is the subject of a pending district court proceeding—the Texas proceeding—that is at an advanced stage and involves the same parties, overlapping claims, and the same prior art. Prelim. Resp. 3–13 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential)).

In determining whether to exercise discretion on behalf of the Director, we are guided by the Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation ("Interim Procedure").[15] The Interim Procedure provides "several clarifications" to "the PTAB's current application of *Fintiv* to discretionary denial where there is parallel litigation" in response to comments received from stakeholders in response to a Request for Comments (RFC). Interim Procedure 2.

"Petitioner stipulates that, if this review is instituted, it will not pursue in the district court any ground that is raised or reasonably could have been raised during this IPR." Pet. 5. This type of stipulation is often called a

[15] Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

Sotera-type stipulation. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (Institution Decision) (precedential). In light of that *Sotera*-type stipulation, we "will not discretionarily deny institution in view of parallel district court litigation." Interim Procedure 3; *see also id.* at 7–8.

E. Discretionary Denial – 325(d)

1. Legal Standard

Patent Owner urges us to exercise our discretion to deny institution of trial under 35 U.S.C. § 325(d). Prelim. Resp. 41–45. Under § 325(d), we have discretion to deny a petition that presents the same or substantially the same prior art or arguments as previously presented to the Office. In evaluating whether the factual predicate under § 325(d) is met, we consider a number of non-exclusive factors, as set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (Institution Decision) (precedential as to Section III.C.5, first paragraph) ("the *Becton Dickinson* factors"):

> (a) the similarities and material differences between the asserted art and the prior art involved during examination;
>
> (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
>
> (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
>
> (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
>
> (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and

> (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, IPR2017-01586, Paper 8 at 17–18.

In performing an analysis under § 325(d), "the Board uses the following two-part framework":

> (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. . . . If, after review of [*Becton, Dickinson*] factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8, 10 (PTAB Feb. 13, 2020) (Institution Decision) (precedential) (footnote omitted).

2. Analysis

There is no dispute that MSIE Kit was previously presented to the Office during prosecution of the '317 Patent. MSIE Kit is listed on the face of the '317 Patent (Ex. 1001, 2) and appears to have been considered by the Examiner during prosecution, as the reference was cited in an Information Disclosure Statement (IDS), which the Examiner signed without indicating that MSIE Kit was not considered (*see* Pet. 6–7). Thus, part one of the *Advanced Bionics* framework has been satisfied with regard to MSIE Kit, and we move on to part two to determine whether Petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.

Patent Owner argues that Petitioner has failed to show any material error by the Examiner during prosecution. Prelim. Resp. 44–45. We disagree. Although the Examiner considered MSIE Kit in an IDS, as Petitioner notes, MSIE Kit was not discussed in any Office Action or Response. *See* Pet. 7. Thus, according to *Becton, Dickinson* factor (c), we find that MSIE Kit was not extensively evaluated during examination and was not the basis for a rejection. Moreover, with respect to *Becton, Dickinson* factor (e), as explained below when we discuss the merits, we are persuaded that Petitioner has presented compelling evidence that MSIE Kit anticipates at least claims 1 and 5 and therefore, that the Examiner overlooked the disclosures in MSIE Kit when examining the claims of the '317 patent. *See Advanced Bionics*, Paper 6 at 8 n.9 ("An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims."). For example, Petitioner points to specific disclosures in MSIE Kit to persuasively show based on the current record that the reference discloses "wherein the processor executes instructions to: display, using the display device, a grid of tiles" as recited in claim 1. *See infra* Sections II.F.2.b. We therefore agree with Petitioner that the Office erred in a manner material to the patentability of the challenged claims.

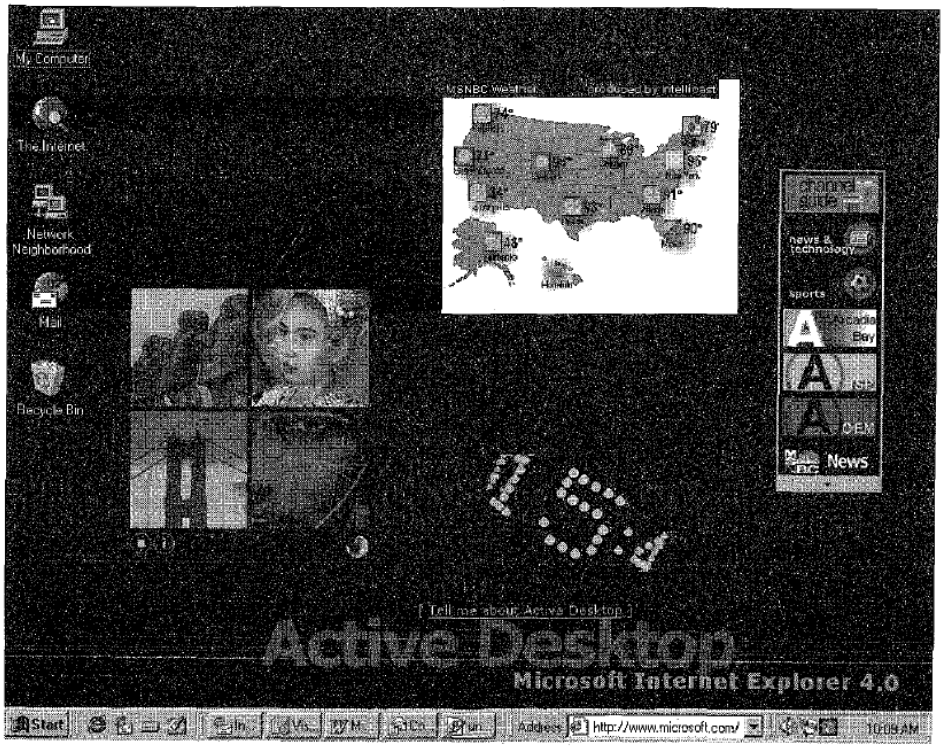
Having considered the respective arguments and evidence of the parties and applied the *Advanced Bionics* framework, we decline to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

F. Asserted Anticipation by MSIE Kit

1. 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. 1010, 174, 180, 183, 211. MSIE Kit describes Active Desktop Items ("Item(s)") 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. MSIE Kit shows a sample desktop, which is reproduced below.



Id. at xxx. The figure shows an Active Desktop which includes a 2x2 grouping of Items. *Id.*

2. Analysis of Claim 1

a) Undisputed Limitations

The preamble of claim 1 recites "[a] system for communicating with multiple data sources, the system comprising." Ex. 1001, 30:21–22. Petitioner argues that MSIE Kit discloses the preamble. Pet. 20–21. According to Petitioner, MSIE Kit "discloses a system, such as a personal computer running Internet Explorer 4, that can communicate with multiple web sites." *Id.* at 20 (citing Ex. 1010, xxiv, xxxx, 4, 174–78, 180, 184–85; Ex. 1003 ¶ 110). Petitioner further argues that "[e]ach web site may be associated with and displayed in an Active Desktop Item located on the user's desktop, and is therefore a 'data source' for its associated Item because it is a source of data for that Item." *Id.* at 20–21 (emphasis omitted) (citing Ex. 1010, 246; Ex. 1003 ¶ 111).

Claim 1 further recites "a client device adapted for communication with a server device." Ex. 1001, 30:23–24. Petitioner argues that MSIE Kit discloses this limitation. Pet. 21. According to Petitioner, the computer running Internet Explorer 4 (the client device) communicates with web sites—which Petitioner maps to shared resources provided by a server device—for display in Items. *Id.* (citing Ex. 1010, xvi, xxx, 88, 174–78, 180, 184–86, 192, 219–23, 246, 384, 391–94; Ex. 1003 ¶¶ 114–116).

Claim 1 further recites "wherein the client device includes a display device, a processor configured to execute instructions, and a memory connected to the processor." Ex. 1001, 30:24–26. Petitioner argues that MSIE Kit discloses this limitation. Pet. 21–22. Specifically, Petitioner argues that MSIE Kit discloses "operation of the Active Desktop software on 'a display device' of a user's computer." *Id.* (emphasis omitted) (citing Ex. 1010, 131–132).

Claim 1 further recites "wherein a first tile of said grid of tiles is associated with a first data source residing on the server device, and a second tile of said grid of tiles is associated with a second data source." Ex. 1001, 30:28–32. Petitioner argues that MSIE Kit discloses this limitation. Pet. 25. Specifically, Petitioner argues MSIE Kit "discloses a 3x2 grid of Active Desktop Items" "and that each Item in the grid may be associated with a different data source, such as a website or page." *Id.* (citing Ex. 1010, xvi, xxx, xxxi, 174–78, 180, 183).

Claim 1 further recites "and wherein the first tile displays a current content from the first data source and the second tile displays a current content from the second data source." Ex. 1001, 30:32–35. Petitioner argues MSIE Kit discloses this limitation. Pet. 25. Specifically, Petitioner argues that "Active Desktop Items are refreshed at a specified rate assigned to that item" and "display[s] current content of their associated data source." *Id.* (citing Ex. 1010, xxx, 177, 180, 223; Ex. 1003 ¶ 172).

Claim 1 further recites "check whether content in the first data source is updated relative to the current content of the first tile and, if so, display updated information from the first data source on the first tile." Ex. 1001, 30:36–39. Petitioner argues MSIE Kit discloses this limitation. Pet. 25–27. Specifically, Petitioner argues "Internet Explorer 4 performs 'automated visiting and crawling of sites on a scheduled basis ***to check for updated content***' relative to the last update, which would be currently displayed in the Item." *Id.* at 25–26.

After reviewing Petitioner's arguments and information regarding the limitations identified above, including the Houh Declaration, which are not addressed by Patent Owner at this stage (*see* Prelim. Resp.), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this

Decision, that MSIE Kit discloses each of the limitations recited in this section.

b) Wherein the Processor Executes Instructions to: Display, Using the Display Device, a Grid of Tiles

(1) The Parties' Arguments

Claim 1 further recites "wherein the processor executes instructions to: display, using the display device, a grid of tiles." Ex. 1001, 30:26–28. Petitioner argues that MSIE Kit discloses this limitation. Pet. 22–25. Specifically, Petitioner argues that "[t]he Internet Explorer functionality described in MSIE Kit was necessarily implemented by a processor executing computer instructions." *Id.* at 23 (citing Ex. 1028, 115, 243–44, 359, 415; Ex. 1003 ¶ 142). Petitioner further argues that the "[b]y default, Internet Explorer lays out new Active Desktop Items on a 3 by 2 grid" with each Item being a tile. *Id.* (emphasis omitted) (quoting Ex. 1010, 183) (citing Ex. 1003 ¶ 144).

Petitioner further argues that each Item is a tile under both its proposed construction and the Maine proceeding construction. Pet. 23–25. Specifically, Petitioner argues that "Active Desktop Items are 'graphical user interface elements' because they are rectangular, borderless frames on the display that a user may interact with, and thereby interface with the computer and its software." *Id.* at 23 (citing Ex. 1010, xxx, 174–77, 180–83; Ex. 1016, 32; Ex. 1003 ¶ 147). Petitioner further argues that the "Items can be refreshed at a specified rate assigned to that Item" and can provide access to an information source when selected, such as by clicking a link within the Item or clicking a hot spot in the Item to open a browser window with the displayed information. *Id.* at 23–24 (citing Ex. 1010, 137, 176, 177, 180,

183, 184, 196–202, 213, 223, 400, 420, 740; Ex. 1003 ¶¶ 148, 150–155).[16] Petitioner further argues that each of the Items is persistent. *Id.* at 24–25.

Patent Owner argues that MSIE Kit discloses neither a "grid" nor "tiles." Prelim. Resp. 23–28.

With regard to the "grid," Patent Owner argues that "[a]lthough MSIE Kit refers to a default layout on a grid," it does not "disclose any rows or columns that contain and control the arrangement and layout of tiles." Prelim. Resp. 23–24. Instead, Patent Owner argues, the Active Desktop will overlap items as more of them are added. *Id.* According to Patent Owner, this means that "MSIE Kit has no rows, columns, or any other grid features that *contain and control the arrangement and layout of tiles*." *Id.* at 24 (emphasis added).

With regard to tiles, Patent Owner argues that the Active Desktop Items are not selectable. Prelim. Resp. 25–26. For example, Patent Owner argues that when selected, they open a separate window as opposed to the Active Desktop item *per se*. *Id.*

(2) Our Analysis

Based on the current record, we are sufficiently persuaded that Petitioner has shown that MSIE Kit discloses this disputed claim limitation. Specifically, MSIE Kit shows an example of a desktop 2x2 grid of Items in an exemplary figure and further describes how the default is a "3 by 2 grid." Ex. 1010, xxx, 183; Ex. 1003 ¶ 144. Each of the Items is a graphical element that can be selected by clicking on a link or hot spot. Ex. 1003

[16] Because Petitioner has made a sufficient showing on this record with respect to clicking a link or a hotspot within an Item, we do not address Petitioner's alternative argument regarding dragging Items or using keyboard navigation, or Patent Owner's responses thereto, at this time.

¶¶ 149–155; Ex. 1010, 177, 183, 740. In addition, the Items can be refreshed. Ex. 1010, xxx, 174–77, 180–83, 196–202, 223; Ex. 1003 ¶¶ 147–148.

Based on the current record, we do not agree with Patent Owner's arguments. First, for purposes of this Decision, we do not require the grid "contain and control" the arrangement of the tiles. Accordingly, Patent Owner's arguments (Prelim. Resp. 23–24) are not commensurate with the scope of the claims. But even if we did require that the grid "contain and control" the arrangement of the tiles, we would still not agree with Patent Owner's argument. MSIE Kit's desktop does contain and control the arrangement of tiles, even if it permits overlap in certain instances. Specifically, the depicted arrangement conforms to a row-and-column grid without overlap (Ex. 1010, xxx), meeting even Patent Owner's construction.

Second, Patent Owner has not sufficiently explained why selecting an Item to open a new window is outside the scope of the claim. *See* Prelim. Reps. 24–27. Rather, based on the current record, MSIE Kit shows that when an Item is clicked/selected, it provides access to the underlying information of the associated information source in a new window. On the current record, we do not see how causing a new window to open is outside the scope of the claim under the claim construction proposed by Patent Owner.

c) Conclusion Regarding Claim 1

Based on the current record, there is a reasonable likelihood that Petitioner will prove that claim 1 is unpatentable as anticipated by MSIE Kit.

3. Analysis of Claim 5

Because Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the '317 patent is unpatentable,

we institute on all grounds and all claims raised in the Petition. *See* 37 C.F.R. § 42.108(a). Therefore, at this stage of the proceeding, it is not necessary for us to provide an assessment of every challenge raised by Petitioner. However, because Patent Owner has raised additional arguments regarding claim 5, we discuss them at this time to provide guidance to the parties.

Claim 5 recites, *inter alia*, "*partitioning* by the client device at least a portion of the visual display into an *array of tiles*." Ex. 1001, 30:53–54 (emphases added). Patent Owner's arguments focus on the phrases "partitioning" and "array of tiles." Prelim. Resp. 32. We likewise focus our analysis on the same phrases.

Petitioner relies on its argument regarding a grid of tiles, discussed above for claim 1. Pet. 28. For the same reasons discussed above for claim 1, based on the current record, Petitioner sufficiently shows that MSIE Kit discloses the disputed limitation.

Patent Owner argues MSIE Kit does not teach dividing in an "orderly fashion." Prelim. Resp. 32. Specifically, Patent Owner argues MSIE Kit recites using arbitrary positions for the Active Desktop Items. Patent Owner further argues that "there is no division or separation of a display or other element into multiple tiles." *Id.* According to Patent Owner, "[t]he default grid layout referenced by MSIE Kit does not change the fact that the display in which Active Desktop Items are arbitrarily position is not divided." *Id.*

Patent Owner's argument appears to be premised on an understanding that a prior art reference must anticipate in all instances. But that is not the law. Instead, "[j]ust as 'an accused product that sometimes, but not always, embodies a claimed method nonetheless infringes,' *Bell Communications Research, Inc. v. Vitalink Communications* Corp., 55 F.3d 615, 622–623

(Fed. Cir. 1995), a prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention." *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003). For example, in *Power Integrations, Inc. v. Fairchild Semiconductor International, Inc.*, 843 F.3d 1315, 1336 (Fed. Cir. 2016), the Federal Circuit determined that it was sufficient to show that a reference anticipated in "the process of startup," even if the reference did not show anticipation during "normal operation," reasoning that "[n]othing in the claims requires that the current threshold increase during the power supply's normal operation." *See also ParkerVision, Inc. v. Qualcomm Inc.*, 903 F.3d 1354, 1361 (Fed. Cir. 2018) ("Similarly, a prior art reference may anticipate or render obvious an apparatus claim—depending on the claim language—if the reference discloses an apparatus that is reasonably capable of operating so as to meet the claim limitations, even if it does not meet the claim limitations in all modes of operation."). Because, as discussed above, Petitioner points to an example that meets the claim limitation, it is inapposite that some of the arrangements of Items in MSIE Kit might not.

Accordingly, there is a reasonable likelihood that Petitioner will prove the claim 5 is unpatentable as anticipated by MSIE Kit.

G. Asserted Obviousness in View of Excel97 and Bhanali

As discussed above, it is not necessary for us to provide an assessment of every challenge raised by Petitioner. However, to provide the parties guidance for the trial, we discuss the parties' arguments regarding disputed limitations.

1. Excel97

Excel97 describes the Microsoft Excel 97 spreadsheet program. Ex. 1005. Excel97 states that its "most important enhancement . . . is how it

can help you work with others in your workplace and communicate over corporate intranets and the Internet." *Id.* at 1.

2. Bhansali

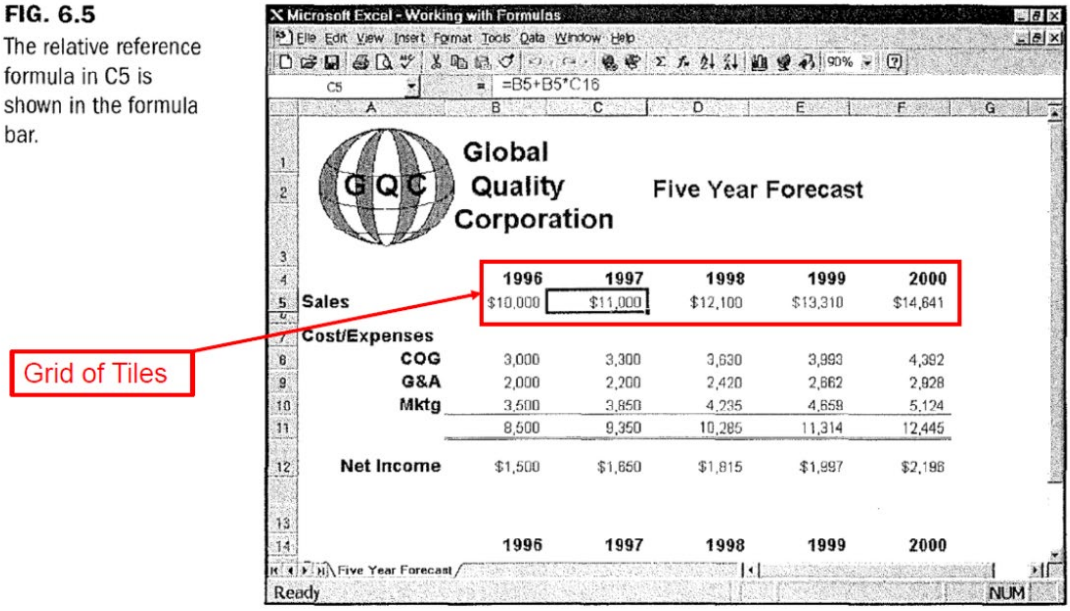
Bhansali is entitled "Method and System for Allowing Multiple Users to Simultaneously Edit a Spreadsheet." Ex. 1006, code (54); *see also id.* at 1:6–9, code (57). The system keeps a log of changes by each user, determines when conflicting changes have occurred, and either "allow[s] the user to select the wining action or automatically selecting the most recent action as the winning action." *Id.* at code (57).

3. Analysis of Claim 1 – "Grid of Tile"

Claim 1 recites, *inter alia*, "a grid of tile." Ex. 1001, 30:28.

Petitioner argues that "Excel97 discloses that a display, or a portion of it such as a window, can be divided into a grid of cells in an orderly row and column format." Pet. 50 (citing Ex. 1005, 69, 102, 181, Fig, 4.5 (p. 102); Ex. 1003 ¶¶ 389–390). Petitioner identifies Figure 6.5 as an exemplary grid of tiles consisting of cells "displayed in an orderly 5x2 grid arrangement." *Id.* at 50–51 (citing Ex. 1005, 203, Fig. 6.5; Ex. 1003 ¶¶ 392–396). A version of Figure 6.5 annotated by Petitioner is reproduced below.

FIG. 6.5
The relative reference formula in C5 is shown in the formula bar.



Ex. 1003 ¶ 392 (citing Ex. 1005, 203, Fig. 6.5). Figure 6.5 is a spreadsheet containing a five-year forecast. Ex. 1005, 203. The figure has been annotated to identify cells containing years and sales as "Grid of Tiles."

Petitioner also argues that "[e]ach cell is a graphical user interface element because each is a graphical/visual structure displayed on a computer screen that the user can manipulate and thereby interface with the software and computer running the software." Pet. 51 (citing Ex. 1005, 16, 75–88; Ex. 1003 ¶¶ 398). Petitioner further argues that each cell can be selected by mouse clicks or keyboard commands and that "[s]electing a cell permits the user to manipulate information displayed in the cell and save that information back to the workbook file." *Id.* (citing Ex. 1005, 2, 29, 35, 39, 40–45, 65, 70, 75–76, 275–95, 1084; Ex. 1003 ¶¶ 401–404). Petitioner further argues that "[c]ell contents may be refreshed/updated." *Id.* (citing Ex. 1005, 29, 443; Ex. 1003 ¶¶ 399–400).

Petitioner alternately argues under the Maine proceeding's claims construction, that "[c]ells are graphical elements because they are visual

structures displayed on a computer screen depicting information from the associated file, particularly where surrounded by a border." Pet. 51–52 (citing Ex. 1005, 14, 17, 36–39, 179, Fig. 1.4; Ex 1003 ¶ 407). According to Petitioner, this is analogous to the text in tile 404, which is a part of Figure 4 of the '317 patent. *Id.* at 52 (citing Ex. 1001, Fig. 4, 11:45–49; Ex. 1003 ¶¶ 408–409). Based on the current record, we question the sufficiency of Petitioner's arguments.

Patent Owner argues that Petitioner is mistaken that cells of a spreadsheet containing hyperlinks that launch other application windows are tiles. Prelim Resp. 28–30. Specifically, Patent Owner argues that a hyperlink is not "graphical representation of an associated information source" and are not capable of displaying refreshed content. *Id.* Based on the current record, we agree with Patent Owner that Petitioner has not sufficiently explained how a hyperlink can be refreshed. Moreover, we question whether a hyperlink is a "graphical representation of an associated information source." Instead, a hyperlink is simply a static electronic link providing direct assess to an information source.

However, in addition to hyperlinks, Petitioner also focuses on Excel97's Figure 6.5, which has cells that have formulas linked to the contents of other cells. For example, cell C5 displays the content of the formula B5 + B5 *C16. That is, $11,000 is a graphical representation of the formula applied to the data from another source (the cells). After reviewing Petitioner's arguments and information regarding this theory, including the Houh Declaration, which are not addressed by Patent Owner at this stage (*see* Prelim. Resp. 28–31), we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that Excel97 teaches a "grid of tiles."

4. Analysis of Claim 5

Claim 5 recites, *inter alia*, "partitioning by the client device at least a portion of the visual display into an array of tiles." Ex. 1001, 30:53–54.

In addition to the arguments discussed above for the "grid of tiles," Petitioner also argues that "Excel97 causes a display to be divided into a grid of cells ('*tiles*'), which is a particular form of an array because it is an orderly arrangement, and therefore '*an array of tiles*.'" Pet. 59. Patent Owner relies on the same arguments discussed above for claim 1. Prelim. Resp. 33–34. For the same reasons discussed above for claim 1, we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that Excel97 teaches this disputed limitation.

H. Petitioner's Other Challenges

Petitioner also asserts various other challenges against claims 1 and 5, as well as claims 2–4 and 6–19, based on anticipation and/or obviousness. *See* Pet. 27–28, 30–46, 57–59, 62–72. Patent Owner does not separately address the merits of Petitioner's other prior art challenges. *See* Prelim. Resp. 28, 32–34. Because, as discussed above, Petitioner meets the threshold for institution by demonstrating a reasonable likelihood that at least claim 1 and 5 are unpatentable as anticipated by MSIE Kit, we need not decide whether Petitioner's other challenges demonstrate the same. Those challenges, in our view, are best left for trial after full development of the record.

CONCLUSION

Because Petitioner demonstrates that at least one claim of the '317 patent meets the threshold for institution, we institute an *inter partes* review of all claims as challenged in the Petition. *See* 37 C.F.R. § 42.108(c).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–19 of the '317 patent is instituted; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of trial, which will commence on the entry date of this Decision.

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