

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

SURFCAST, INC.,
Patent Owner.

IPR2022-00590
Patent 9,043,712 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 1–4 of U.S. Patent No. 9,043,712 B2 (Ex. 1001, “the ’712 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. 3.

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, 3–4.

D. The ’712 Patent

The ’712 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 4:38–49. In response to this need, the ’712 patent describes a graphical user interface comprising a grid of tiles that resides on the user’s computer desktop. *Id.* at 4:53–54. 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 4:54–57. 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.

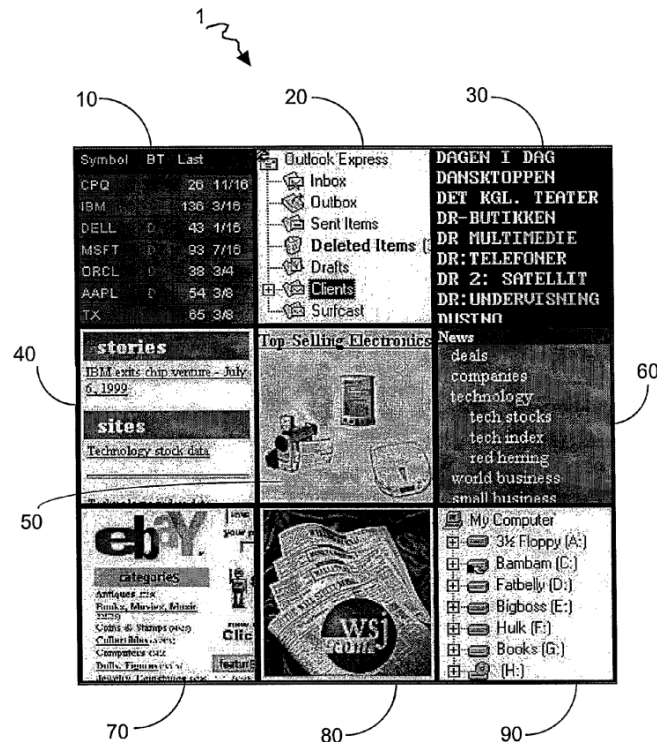


Figure 1 illustrates “a user interface comprising a grid of tiles as might be depicted on a display screen.” *Id.* at 6:25–27; *see also id.* at 7:27–39 (describing the various tiles).

E. Illustrative Claim

Claims 1 and 3 are independent. Claim 1, reproduced below, is illustrative of the claimed invention.

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

partitioning a visual display rendered by the device into *an array of tiles*, wherein each tile in the array of tiles is associated with an information source in a plurality of information sources, wherein content of a second tile of the array of tiles depends upon content of a first tile of the array of tiles;

assigning a first update rate to the first tile;

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

updating content of the second tile based on the information updated to the first tile.

Ex. 1001, 30:23–38 (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
1–4	102(a), (b)	MSIE Kit ³
1–4	103(a)	MSIE Kit, Jones ⁴
1–4	103(a)	MSIE Kit, Miklos ⁵
1–4	103(a)	MSIE Kit, Miklos, Jones
1–4	102(a), (b)	Excel97 ⁶
1–4	103(a)	Excel97
1–4	103(a)	Excel97, Bhansali ⁷ ,
1–4	103(a)	Excel97, Igra ⁸
1–4	103(a)	Excel97, Igra, Bhansali

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 ’712 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 U.S. Patent No. 5,226,117, issued July 6, 1993 (Ex. 1013).

⁶ Person, R. (1997). *Special Edition Using Microsoft Excel 97* (Ex. 1005). All citations are to the native pagination.

⁷ U.S. Patent No. 6,006,239, filed Mar. 15, 1996 (Ex. 1006).

⁸ U.S. Patent No. 6,701,485 B1, issued Mar. 2, 2004 (Ex. 1007).

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 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).⁹

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

⁹ Because neither party addresses objective evidence of non-obviousness, we focus solely on the first three *Graham* factors.

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 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. 12 (quoting Ex. 1003 ¶ 63). 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 ¶ 63).

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.¹⁰

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

¹⁰ 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.

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 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.

The parties argue that we should construe five terms: “tile,” “information source,” “partitioning a visual display rendered by the device into an array of tiles,” “update rate,” and “presented to the first tile.” Pet. 12–21; Prelim. Resp. 12–21.

For the purposes of this Decision, we construe two 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. 12–13 (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.* at 13. Petitioner further argues that the ’712 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.* (citing Ex. 1001, 10:64–65, 11:3–5, 12:3–11).

Petitioner also argues that the Maine Proceeding’s construction¹¹ “adds language not supported by the intrinsic record and which, crucially, may lead to misdirection by the patent owner.” Pet. 14.^{12, 13}

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. 12–13. Patent Owner argues that its construction is supported by the specification of the ’712 patent. *Id.* at 13–14.

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

¹¹ “[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).

¹² The dispute with the district court construction focuses on the word “persistent.” Pet. 14–15. However, because Patent Owner’s arguments do not rest on whether a tile is persistent (Prelim Resp. 13 n.2), for purposes of this Decision, we do not address whether a tile must be persistent. *See Nidec*, 868 F.3d at 1017.

¹³ Petitioner also makes an argument that is contingent on a possible construction Patent Owner might propose. *See* Pet. 16. Because Patent Owner did not propose such a construction, we do not address it.

construction calls for a “graphical representation,” it is unclear if those phrases have different meanings and, if so, how they impact our analysis of 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 the Response and explicitly address the different language.

2. *“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. 18–19 (citing Ex. 1017, 12; Ex. 1016, 12–13). According to Petitioner, this construction “is consistent with the description of tiles in the specification.” *Id.* at 19 (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. 16 (emphasis added). “More granularly,” Patent Owner argues “‘partitioning’ and ‘arranging’ mean ‘dividing,’ 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. 16–20. According to

Patent Owner, because the claim already recites the plural “tiles,” array must mean something more. *Id.* at 20. Patent Owner argues that the examples of tiles in the specification shows tiles in an orderly fashion. *Id.* at 17–19.

Based on the current record, we agree with Patent Owner. Because the claims recite an “array of tiles” 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 ’712 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 ’712 patent would be orderly.

3. *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 ’712 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. 39–46 (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”).¹⁴ The Interim Procedure provides “several clarifications” to “the PTAB’s current application of *Fintiv* to discretionary denials 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. 6. This type of stipulation is often called a *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. 46–49. 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,

¹⁴ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

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 '712 patent. MSIE Kit is listed on the face of the '712 patent (Ex. 1001, code (56)) 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* Ex. 1002, 509–14). 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. 49. 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 claim 1 and, therefore, that the Examiner overlooked the disclosures in MSIE Kit when examining the claims of the '712 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 “partitioning a visual display rendered by the device into an array of tiles,” “updating information from a first information source in the plurality of information sources presented to the first tile in accordance with the first update rate,” and “updating content of the second tile based on the information updated to the first tile,” as recited in claim 1. *See infra* Sections II.F.2.b, II.F.2.c. *See infra*. We therefore agree with Petitioner that the Office erred in a manner material to the patentability of the challenged claims.

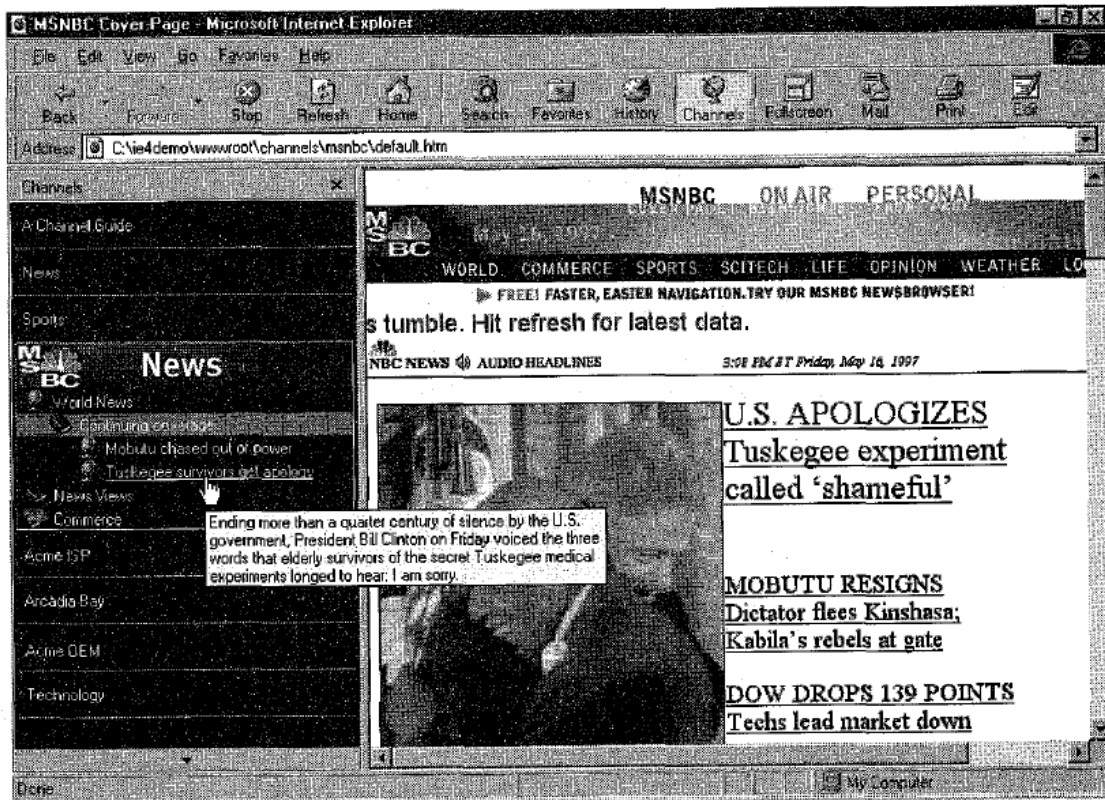
Having considered the respective arguments and evidence of the parties and applied the *Advanced Bionics* framework, we decline to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

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 xxxvi. The figure above shows an Active Channel Bar on the left with a browser window on the right associated with the selected Active Channel element. *Id.* at xxxvi, 212, 694.

2. Analysis of Claim 1

a) Undisputed Limitations

The preamble of claim 1 recites “[a] method executed by a device under the control of a program, the device including a memory for storing the program, the method comprising.” Ex. 1001, 30:24–26. Petitioner argues that MSIE Kit discloses the preamble. Pet. 24. More specifically, Petitioner argues MSIE Kit discloses “the Active Desktop and Active

Channel interfaces available on computers running the Windows and Internet Explorer 4 programs” and that “computers necessarily include a processor to perform operations implemented by stored software in a memory.” *Id.* (citing Ex. 1006, 4, 174, 176, 179, 180; Ex. 1028, 515; Ex. 1003 ¶¶ 103–104, 170).

Claim 1 further recites “wherein each tile in the array of tiles is associated with an information source in a plurality of information sources.” Ex. 1001, 30:28–30. Petitioner argues MSIE Kit discloses that limitation. Pet. 29–30. Specifically, Petitioner argues that “[t]he disclosed system stores a link, such as a URL, which associates an Active Channel element with an information source, such as a website.” *Id.* at 29 (citing Ex. 1010, 111, 212). Petitioner also argues that “the browser pane of the Internet Explorer window can be associated with an ‘information source,’ *e.g.*, the web page it is displaying at any point in time, by the system using the URL of that web page to obtain the information to be displayed in the browser pane.” *Id.* (emphasis omitted) (citing Ex. 1010, xxxv, 111, 188, 212, 220, 690; Ex. 1003 ¶ 132). Petitioner also argues that “Active Channel elements and the browser pane may be associated with any of the plurality of websites and web pages available on the Web because they can include any web content supported by Internet Explorer.” *Id.* at 30 (citing Ex. 1010, 212, 221; Ex. 1003 ¶ 133).

Claim 1 further recites “wherein content of a second tile of the array of tiles depends upon content of a first tile of the array of tiles.” Ex. 1001, 30:30–32. Petitioner argues MSIE Kit discloses this limitation. Pet. 30–31. Specifically, Petitioner argues that “when a user selects an Active Channel element, (“*first tile*”), it expands and displays a summary notification page, which notification page is also displayed in the browser pane (“*second*

tile”).” *Id.* at 30 (citing Ex. 1010, xxxvi, 212, 694, 696; Ex. 1003 ¶ 136); *see also id.* at 31 (discussing example).

Claim 1 further recites “assigning a first update rate to the first tile.” Ex. 1001, 30:33. Petitioner argues MSIE Kit discloses that limitation. Pet. 31–32. Specifically, Petitioner argues that MSIE Kit discloses that

each Active Channel element may be updated based on a programmed subscription schedule, EX1010, 185, 200, 211, 213, 215, 223, when the user indicates the Channel should be updated, EX1010, 133, 140, 220, 558, 694, or when the user clicks on the Channel and thereby expands the element to display a detailed map of the Channel, EX1010, 220, 212, xxxvi; EX1003, ¶151.

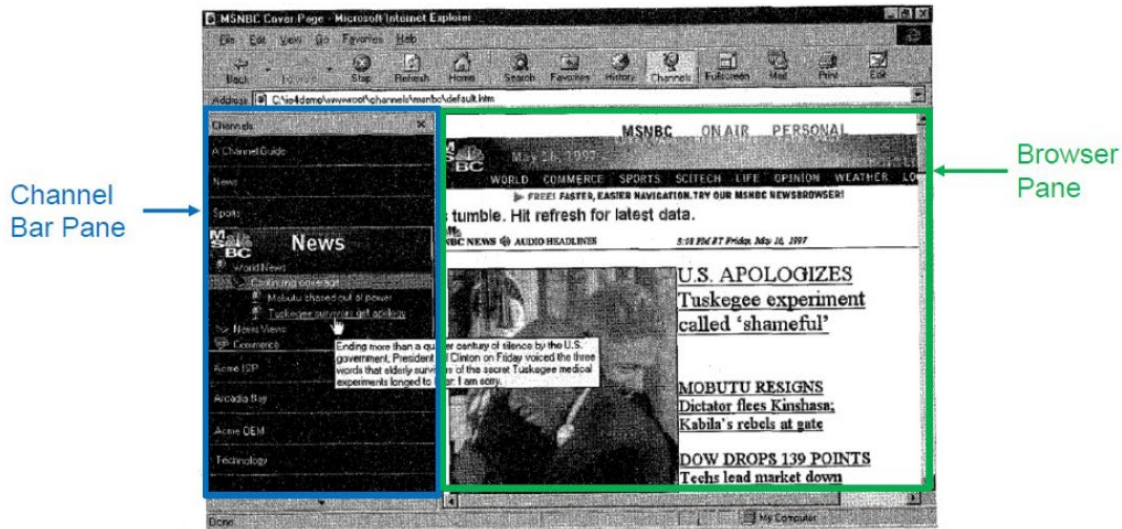
Pet. 31–32.

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) Partitioning a Visual Display Rendered by the Device into an Array of Tiles

(1) Petitioner’s Arguments

Claim 1 further recites “partitioning a visual display rendered by the device into an array of tiles.” Ex. 1001, 30:27–28. Petitioner argues MSIE Kit discloses this limitation. Pet 25–29. Specifically, Petitioner argues that MSIE Kit “discloses dividing/arranging a display, or a portion of it such as a browser window, into a Channel Bar pane, having a number of Active Channel elements, and a browser pane” as shown in the annotated figure reproduced below. *Id.* at 25.



Id. The figure above shows an Channel Bar Pane on the left with a Browser Pane on the right associated with the selected Active Channel element.

Ex. 1010, xxxvi. It has been annotated by Petitioner to show the Channel Bar Pane (blue) and the Browser Pane (green). Pet. 25. According to Petitioner, “[e]ach Active Channel element is a ‘tile’ as claimed, as is the browser pane” and “the displayed Active Channel elements and the browser pane collectively are ‘an array of tiles’ because they are an orderly grid-like arrangement of those structures.” Pet. 25.

With regard to the Active Channel elements, Petitioner argues that they “are each ‘graphical user interface elements’ because they are separate areas of the graphical display that can be manipulated by a user in order to interface with the software and computer system.” *Id.* at 26 (citing Ex. 1010, xxxvi, 690, xxxv; 212; Ex. 1003 ¶ 115). Petitioner further argues that “the content of Active Channel elements may be refreshed according to an update rate assigned, for example, by the provider of the linked Webpage using a CDF file.” *Id.* (citing Ex. 1010, 185, 213, 215, 223; Ex. 1003 ¶ 116). Petitioner further argues that

Active Channel elements can be selected by a user by pointing to and clicking on the element and, when selected, access is provided to an associated website or page (“*information source*”), such as by expanding the element to display sub-channels and hyperlinks from the information source, and a summary of the linked page.

Pet. 26–27 (citing Ex. 1010, 696; Ex. 1003 ¶ 117).

With regard to the Browser Pane, Petitioner argues that because “[i]t is a separate area of the graphical display that can be manipulated by the user,” the Browser Pane is a graphical user interface element. Pet. 27 (citing Ex. 1003 ¶ 119). Petitioner also argues that “[t]he contents of the browser pane may be refreshed whenever the user clicks on one of the Active Channels to the left, clicks the Refresh button on the browser toolbar, or presses the F5 button on the keyboard.” *Id.* (citing Ex. 1010, 133, 140, 212, 558, 694, 696; Ex. 1003 ¶ 120). Petitioner also argues that “the browser pane may be selected by a user clicking within the pane and, for example, activating one of the hyperlinks displayed on the page.” *Id.* (citing Ex. 1010, 136, 137, 776).

Petitioner also argues that, “as shown in the figure above, the Active Channel elements and browser pane may be displayed in a grid within an Internet Explorer window, and are therefore displayed in an array, since a grid is a type of array as it is an orderly arrangement of information.” Pet. 28 (citing Ex. 1054,¹⁵ 3; Ex. 1003 ¶ 122; Ex. 1001, 16:10–12).¹⁶

¹⁵ It is unclear what exhibit Petitioner is citing as Exhibit 1054 is not in the record.

¹⁶ Petitioner also provides arguments under the Maine Proceeding claim construction. Pet. 27–29.

(2) Patent Owner's Arguments

Patent Owner argues that Active Channel elements are not tiles. Prelim. Resp. 22–26. Specifically, Petitioner argues that although the Active Channel elements are graphical elements that can be refreshed, “Active Channel elements lack the other attributes of tiles.” *Id.* at 23. More specifically, Patent Owner argues that “[c]licking on a link of an Active Channel element to display content in a separate window or pane does not constitute a tile.” *Id.* According to Patent Owner, “the fact that clicking the link will display content in a separate window or pane distinguishes Active Channel elements from tiles.” *Id.* at 23–24.

Patent Owner further argues that “[e]xpanding an Active Channel element to display sub-channels and hyperlinks also fails to constitute a tile.” Prelim. Resp. 24. According to Patent Owner, the fact that the hierarchy is expandable does not mean that it “provide[s] access to information of an underlying information source.” *Id.* Instead, Patent Owner argues, expanding the hierarchy “merely displays more or less of a table of contents that is defined by a Channel Definition Format (CDF) text file.” *Id.* (citing Exc. 1010, 215, 220).

Patent Owner further argues that “[c]licking on hyperlinks also fails to account for the attributes of tiles.” Prelim. Resp. 24. Patent Owner argues that this shows that “[a]ccess is provided only by a separate display feature, not the selected item.” Prelim. Resp. 24–25. Similarly, Patent Owner argues that “[p]ointing to hyperlinks to display page summaries also fails to provide the attributes of tiles” for the same reason. *Id.* at 25.

(3) 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 Active Channel elements and the Browser Pane displayed in an orderly fashion. *See* Ex. 1010, xxxvi. The Browser Pane is a tile because it is a graphical element which can be manipulated by the user, refreshed, and data from an information source can be selected by selecting a hyperlink in the browser. *See* Ex. 1003 ¶¶ 119–121. We further note that at the present time, Patent Owner has not disputed that the Active Channel elements and the Browser Pane form an array nor that the Browser Pane is a tile. *See* Prelim. Resp.

Based on the current record, we are also sufficiently persuaded that Active Channel elements are tiles. As Patent Owner has conceded (at the present time), they are graphical elements that can be refreshed. Prelim. Resp. 23; *see also* Ex. 1003 ¶¶ 115–116. There also is no dispute that a user clicking a link displayed in the Active Channel element causes the selected page to be opened in a separate window or in the Browser Pane. Ex. 1003 ¶ 117; Prelim. Resp. 24–25. Based on the current record, that shows that the Active Channel element and that the selection provides access to an associated information source. *See* Ex. 1003 ¶ 117.

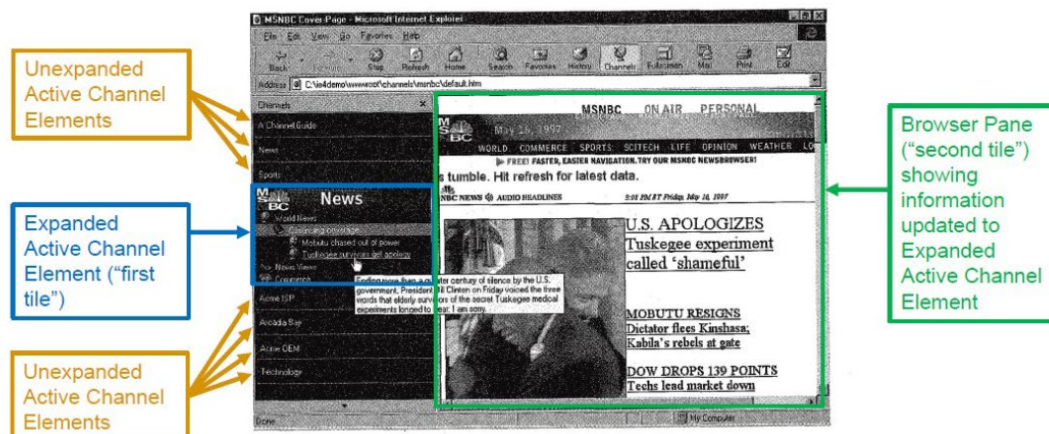
Based on the current record, we do not agree with Patent Owner’s argument. Patent Owner has not sufficiently explained why selecting an item to open a new window is outside the scope of the claim. *See* Prelim. Reps. 24–25. Rather, based on the current record, MSIE Kit shows that when an item is clicked/selected, 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 construction proposed by Patent Owner.

c) Updating Elements

(1) The Parties' Arguments

Claim 1 further recites “updating information from a first information source in the plurality of information sources presented to the first tile in accordance with the first update rate” and “updating content of the second tile based on the information updated to the first tile.” Ex. 1001, 30:34–38. Petitioner argues that MSIE Kit discloses those limitations. Pet. 32–33. Specifically, Petitioner argues that an Active Channel element will update its displayed information “according to its programmed update schedule, when the user indicates the Channel should be updated, or when the user clicks on the Channel element and thereby expands the element to display a detailed map of the Channel.” *Id.* at 32 (citing Ex. 1010, 211, 213, 215, 223, 220, 212, 694, xxxvi; Ex. 1003 ¶¶ 148–156).

Petitioner also argues that selecting and expanding an Active Channel element to show the hierarchy “causes the content of browser pane (“second tile”) to be updated and display the notification page associated with the expanded Active Channel element, as shown [in the figure reproduced] below.” Pet. 33 (citing Ex. 1010, xxxvi, 212, 694, 696; Ex. 1003 ¶ 160).



Id. (citing Ex. 1010, xxxvi). The figure above depicts both unexpanded and expanded Active Channel elements and a browser pane showing information that Petitioner says is updated to the expanded Active Channel element. *Id.* Petitioner annotated the figure to denote the features mentioned above. *Id.*

Patent Owner argues “MSIE Kit fails to disclose the claimed interrelated updating of the first tile and the second tile.” Prelim. Resp. 26; *see also id.* at 27–29 (providing argument). Specifically, Patent Owner argues that expanding an Active Channel element does not update the element with information from the website. *Id.* at 27–28. According to Patent Owner, “expanding an Active Channel element merely displays more elements of a ‘channel hierarchy or table of contents’ which is written in a Channel Definition Format (CDF) text file that ‘contains no Web content itself.’” *Id.* at 27.

Patent Owner further argues that clicking a hyperlink does not update a first tile; instead, it causes the website to be accessed and displayed in a separate window. Prelim. Resp. 28. According to Patent Owner, “[t]he Active Channel element (allegedly the first tile) is not updated by clicking a hyperlink.” *Id.*

Patent Owner further argues that scheduled updates do not update the first tile. Prelim Resp. 28–29. According to Patent Owner, the only update is a “red gleam appears in the left corner of the icon for the top-level channel.” *Id.* at 28 (citing Ex. 1010, 213, 693).

For the same reasons as above, Patent Owner also argues that Petitioner does not show that MSIE Kit discloses the limitation that “[u]pdates to the second tile must be ‘based on the information updated to the first tile.’” Prelim. Resp. 29.

(2) Our Analysis

Based on the current record, Petitioner has sufficiently shown that MSIE Kit discloses these disputed limitations. Specifically, Petitioner sufficiently shows that MSIE Kit recites that the user can schedule updates. Ex. 1003 ¶¶ 155–156. For example, MSIE Kit describes how “[Active] Channel updates use scheduled Web crawls.” Ex. 1010, 213. Initially, “[w]hen updated content is available for a channel, the red gleam appears in the left corner of the icon for the top-level channel.” *Id.* Petitioner further sufficiently shows that when the user clicks the top-level channel after the red gleam appears, the updated lower-level information appears. *Id.* at 212; *see also* Ex. 1003 ¶ 156. Accordingly, Petitioner sufficiently shows that MSIE Kit discloses “updating information from a first information source in the plurality of information sources presented to the first tile in accordance with the first update rate” as recited in claim 1.

Petitioner also sufficiently shows that MSIE Kit discloses “updating content of the second tile based on the information updated to the first tile” as recited in claim 1. Specifically, Petitioner sufficiently shows that clicking the updated Active Channel element causes the Browser pane to be updated and show the pages associated with the selected Active Channel element. *See* Ex. 1010, 212, 694, 696; Ex. 1003 ¶¶ 160–61.

We do not agree with Patent Owner’s arguments. Although Patent Owner is correct that updated information is reflected by a red gleam in the corner (Prelim. Resp. 28–29), Patent Owner ignores what happens when the updated Active Channel element is selected after the update. That is, Patent Owner ignores that when the user clicks the top-level channel after the red gleam appears, the updated lower-level information appears. *See* Ex. 1003 ¶ 156; Ex. 1010, 212. Stated differently, based on the current record, the

initial update alone may not show the updated information in the Active Channel element, but selecting the Active Channel element after the update will display updated information. *See* Ex. 1003 ¶ 156; Ex. 1010, 212.¹⁷

Moreover, although the claim requires updating information to the first tile, the claim does not recite displaying the updated information. *See* Ex. 1001, 30:34–36. Accordingly, Patent Owner’s argument is not commensurate with the scope of the claim.

d) 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.

G. Asserted Obviousness in View of MSIE Kit and Miklos

Because Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the ’712 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, we discuss them at this time to provide guidance to the parties.

Petitioner argues that if we determine that that MSIE Kit does not disclose the limitation “relating to the content of one tile depending on and updating based on the content of another,” it would have obvious to a person having ordinary skill in the art to include such functionality in the system of

¹⁷ Because Petitioner has made a sufficient showing on this record with respect to selecting the Active Channel element after the update, we need not address Petitioner’s alternative arguments as to how MSIE Kit allegedly discloses the updating limitations, or Patent Owner’s responses thereto, at this time.

MSIE Kit in view Miklos. Pet. 40; *see also id.* at 40–42 (detailing argument). Specifically, Petitioner argues that Miklos teaches “a technique for automatically updating hierarchically related windows in which a computer system tracks updates made to related open windows. When updates to one window occur, ‘the simultaneous update of the data within all related windows is performed.’” *Id.* at 40 (quoting Ex. 1013, code (57) and citing Ex. 1013, 3:34–43, 5:58–6:14).

Patent Owner argues that Miklos does not cure that potential deficiency. Prelim Resp. 29–32. Specifically, Patent Owner argues that “the only updating of Miklos’ parent window (allegedly the first tile) is by a user typing input directly into that window.” Prelim Resp. 3. According to Patent Owner, “Miklos has no other information source to update its parent window and fails to plug this hole in MSIE Kit. Nor would it be logical to try to graft such features onto the already flawed combination of MSIE Kit in view of Miklos.” *Id.*

Based on the current record, we are sufficiently persuaded that Miklos broadly teaches updating data in all of the related windows at the same time. *See, e.g.*, Ex. 1013, code (57) (“Once all occurrences of the data within the related windows have been identified, the simultaneous update of the data within all related windows is performed.”); 3:41–43 (“The code 18 then enables the user to automatically change all occurrences of the item in related windows.”); 5:58–6:14 (describing updating procedure). Based on the current record, Patent Owner focuses too narrowly on the specific implementation of Miklos while not addressing its broader teaching.

H. Asserted Anticipation by Excel97

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. *Analysis of Claim 1*

a) *Array of Tiles*

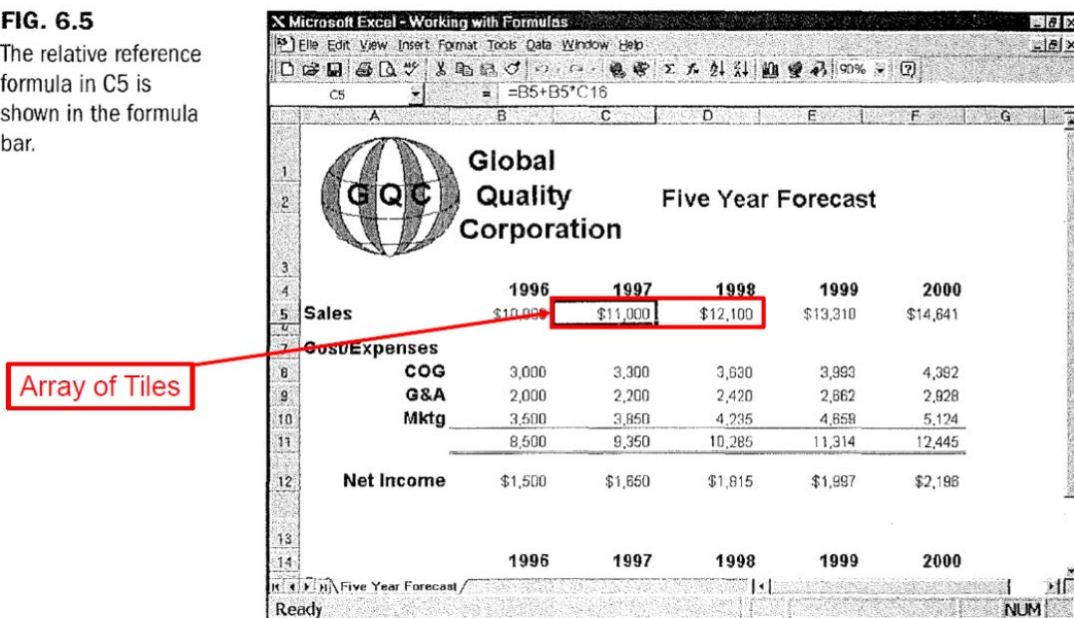
(1) *The Parties' Arguments*

Claim 1 recites, *inter alia*, “an array of tiles.” Ex. 1001, 30:28.

Petitioner and Dr. Houh direct our attention to an annotated version of Excel 97 Figure 6.5, reproduced below.

FIG. 6.5

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



Ex. 1003 ¶ 218 (citing Ex. 1005, 203). Figure 6.5 is a spreadsheet containing a five-year forecast. Ex. 1005, 203. The figure has been

annotated to identify cells containing sales for 1997 and 1998 as an “Array of Tiles.” Ex. 1003 ¶ 218, cited by Pet. 44–45.

According to Petitioner, each cell is a tile because it “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” and users can manipulate the cells by selecting the cell and entering information. Pet. 46 (citing Ex. 1005, 16, 75–88, 90–105, 405–414, 1147; Ex. 1003 ¶ 223). Petitioner also argues that the cells can be refreshed and “selected by way of mouse clicks or keyboard commands and, when selected, provide access to a linked information source, such as an Excel file (also called a ‘workbook,’ EX1005, 312), an Office document, a program, or a Web page.” *Id.* at 47 (citing Ex. 1005, 2, 29, 39–45, 70, 470, 729, 759, 899, 963, 1030, 1084, 1143; Ex. 1003, ¶¶ 224–226). Petitioner also argues that “selecting a cell permits the user to manipulate information displayed in the cell.” Ex. 1005, 2, 42, 70, 75–76, 275–295; Ex. 1003 ¶¶ 227–229).

Petitioner alternatively argues under the Maine Proceeding’s claim construction, that “[c]ells . . . are graphical elements because they are visual structures displayed on a computer screen” and “a cell is associated with an information source such as a particular Excel file/workbook, a value or formula stored in the file is depicted graphically in the cell.” Pet. 47 (citing Ex. 1005, 14, 17 36–39, Fig. 1.1; Ex 1003 ¶ 232). According to Petitioner, this is analogous to the text in tile 404, which is a part of Figure 4 of the ’712 patent. *Id.* at 47–48 (citing Ex. 1001, Fig. 4, 11:45–49; Ex. 1003 ¶¶ 233–236).

Patent Owner argues that Petitioner is mistaken that cells of a spreadsheet containing hyperlinks that launch other application windows are tiles. Prelim Resp. 30–36. Specifically, Patent Owner argues that a

hyperlink is not “graphical representations that are selectable to provide access to underlying information of the associated information source” and are not capable of displaying refreshed content. *Id.* However, because Petitioner does not rely on hyperlinks, Patent Owner’s argument is inapposite.

Patent Owner further argues that “[a] cell containing a formula is also not ‘a graphical representation of an associated information source capable of displaying refreshed content.’” Prelim. Resp. 36. Patent Owner further argues that “performing a refresh by pressing the F9 key or changing the contents of another cell referenced by the formula will not update the graphical representation of the formula.” *Id.*

Based on the current record, we disagree with Patent Owner’s arguments regarding Excel97. Instead, we are sufficiently persuaded by Petitioner’s argument. We see no difference between the display of the output of a formula in cell C5 of Excel97’s Figure 6.5 and the example of a tile in Figure 4 of the ’712 patent. Like the display of numbers in Excel97 Figure 6.5, item 404 in Figure 404 shows text in a tile. Ex. 1001, Fig. 4.

We are also sufficiently persuaded by Petitioner’s argument that the information displayed¹⁸ in a cell can be refreshed. As explained by Excel97, a user can “[r]ecalculate the tables by pressing F9 or clicking the Calc Now button on the Calculation tab to calculate all worksheets.” Ex. 1005, 729. That is, based on the current record, the content of the cells can be refreshed or updated to reflect changes in other cells. *See* Ex. 1003 ¶¶ 224–225.

¹⁸ Although we agree with Petitioner that the information in the cell is refreshed and displayed, claim 1 only recites that the information is refreshed; there is no requirement that the refreshed information is displayed. *See* Ex. 1001, 30:34–36.

Accordingly, we are persuaded that Petitioner sufficiently demonstrates, for purposes of this Decision, that Excel97 teaches a “array of tiles.”

b) “Updating Information from a First Information Source . . . in Accordance with the First Update Rate

Claim 1 further recites “updating information from a first information source in the plurality of information sources presented to the first tile in accordance with the first update rate.” Ex. 1001, 30:34–36.

Petitioner argues that the information displayed in a cell will be updated when the underlying data is changed, when the cell formula recalculates, or when the user press F9. Pet. 55–56 (citing Ex. 1003 ¶¶ 266–282). According to Petitioner, each update is made in accordance with an update rate or “criteria upon which information displayed in a tile is updated.”¹⁹ *Id.* at 56 (citing Ex. 1003 ¶¶ 266–281, 285).

Patent Owner argues that “these actions have and establish no criteria for updating a tile. They simply occur whenever a user edits a cell.” Prelim. Resp. 36–37. Stated differently, Patent Owner argues that “[t]here is simply an action by a user at some arbitrary moment entirely at the user's discretion.” *Id.* at 37.

Based on the current record, we are sufficiently persuaded by Petitioner's argument that Excel97 teaches this disputed limitation. For example, in Figure 6.5, C5 is based on data in cells B5 and C16. *See* Ex. 1005, 203. If the data in cells B5 or C16 are changed, the user can press F9 and update what is displayed in cell C5. *See* Ex. 1003 ¶¶ 271, 285.

¹⁹ For purposes of this Decision, Patent Owner adopted Petitioner's proposed claim construction. Prelim. Resp. 21.

Petitioner additionally notes that each cell in the spreadsheet that contains a formula will automatically update when the values of the cells referenced by the formula change. Pet. 55 (citing Ex. 1005, 197). Furthermore, Petitioner also points to cells in a first workbook that have values based on linked data in a separate workbook (Pet. 62–63 (citing Ex. 1005, 823–855)); the linked data is updated when the first workbook is opened (Ex. 1005, 831). Each of these examples satisfy the agreed-upon claim construction of the “update rate” as “the criteria for updating information displayed in a tile.” See Prelim. Resp. 21.²⁰

We do not agree with Patent Owner’s argument. There is nothing in the agreed upon claim construction that requires a programmed or preset update rate. To the contrary, the ’712 patent describes an example where data is updated/refreshed when the underlying data is written to a hard drive. Ex. 1001, 17:5–10 (“In a preferred embodiment, according to priorities that may be applied to individual tiles on a tile by tile basis if desired, the grid manages the refresh rate of each tile in the grid. For example, for locally stored word processing or spread-sheet files, the user might configure the tiles to refresh only when the underlying data is written to the local hard drive.”). We see no material difference between Excel97 and the example in the ’712 patent.

I. Petitioner’s Other Challenges

Petitioner also asserts various other challenges against claim 1, as well as claims 2–4, based on anticipation and/or obviousness. See Pet. 34–40,

²⁰ We note that the agreed-upon claim construction is that applied to “the Maine court’s construction” of claims in U.S. Patent 6,724,403, which, unlike the claims here, contain a “displaying” limitation.

58–72. Patent Owner does not separately address the merits of Petitioner’s other prior art challenges. *See* Prelim. Resp. 29–32, 38–39. Because, as discussed above, Petitioner meets the threshold for institution by demonstrating a reasonable likelihood that at least claim 1 is 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 ’712 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 1–4 of the ’712 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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Patent 9,043,712 B2

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