

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

SURFCAST, INC.,
Patent Owner.

IPR2022-00591
Patent 9,946,434 B2

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

MELVIN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Microsoft Corporation (“Petitioner” or “Microsoft”) filed a Petition (Paper 1, “Pet.”) requesting institution of *inter partes* review of claims 1–24 (“the challenged claims”) of U.S. Patent No. 9,946,434 B2 (Ex. 1001, “the ’434 patent”). SurfCast, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . 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 that follow, based on the present record, we conclude that Petitioner has shown a reasonable likelihood it will prevail with respect to at least one challenged claim, and we institute *inter partes* review of the ’434 patent.

A. REAL PARTIES IN INTEREST

Petitioner identifies only itself as the real party in interest. Pet. 2. Patent Owner identifies only itself as the real party in interest. Paper 3, 2.

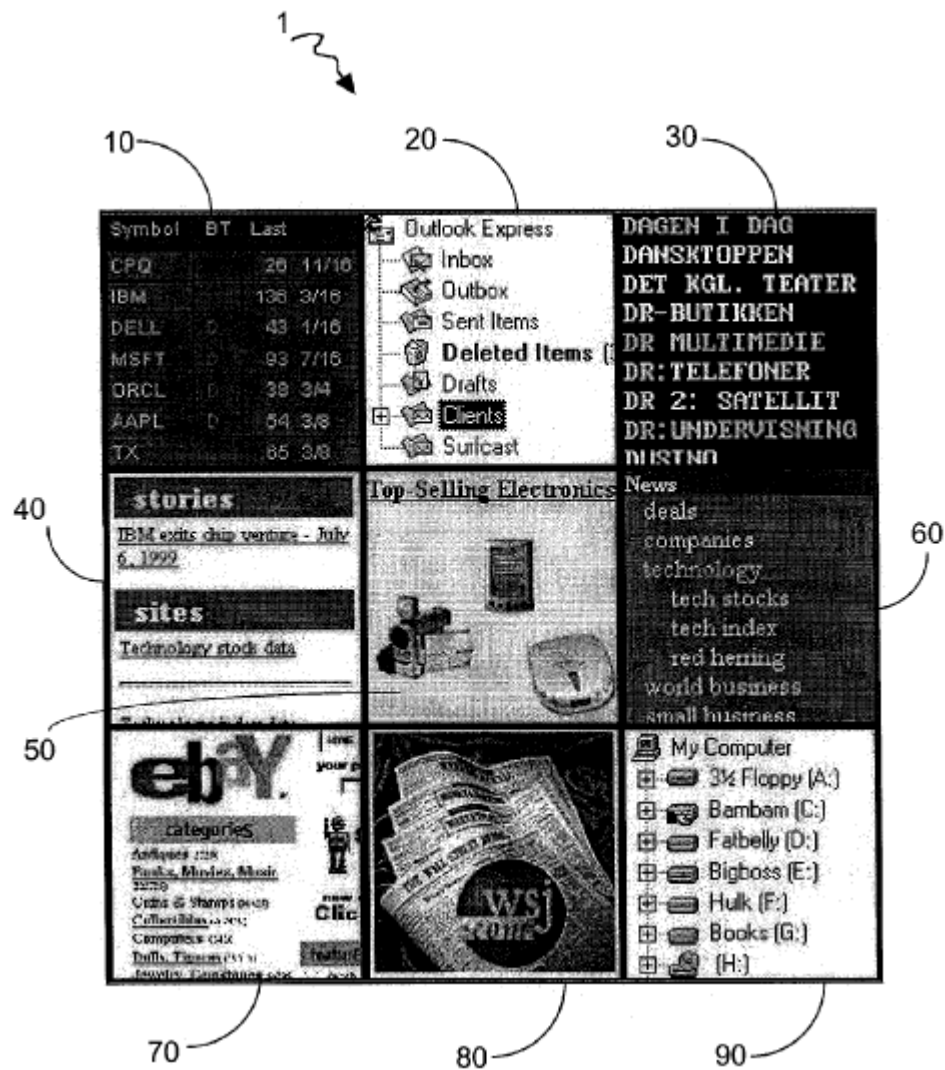
B. RELATED MATTERS

The parties both identify the following matter related to the ’434 patent: *SurfCast, Inc. v. Microsoft Corporation*, No. 6:21-cv-01018-ADA (W.D. Tex.). Pet. 3; Paper 3, 2. Petitioner additionally identifies *SurfCast, Inc. v. Microsoft Corporation*, No. 2:12-cv-00333-DBH (D. Me.),

along with a number of IPR proceedings: IPR2013-00292, IPR2013-00293, IPR2013-00294, IPR2013-00295, IPR2014-00271, IPR2022-00423, IPR2022-00590, IPR2022-00592. Pet. 3–4.

C. THE '434 PATENT

The '434 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). The '434 patent describes a graphical user interface comprising a grid of tiles that resides on the user's computer desktop. *Id.* at 4:66–5:3. 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 5:4–6. Figure 1 is reproduced below.



Ex. 1001, Fig. 1. Figure 1 illustrates “a user interface comprising a grid of tiles as might be depicted on a display screen.” *Id.* at 6:44–46; *see also id.* at 7:45–58 (describing the various tiles).

D. CHALLENGED CLAIMS

Claims 1, 9, and 17 are independent, with claim 1 reciting a system and claims 9 and 17 reciting methods. Claim 1 is reproduced below:

1. A system for simultaneous display of multiple application programs, the system comprising:
a computing device having a memory;

a display; and

a processor configured to execute instructions stored in the memory, to:

- arrange a portion of a display into one or more grids of non-overlapping tiles, each grid of tiles being persistent;
- associate a first application program of the plurality of application programs with a first tile of a first grid of the one or more grids of tiles and a second application program of the plurality of application programs with a second tile of the first grid of tiles;
- assign a first refresh rate to the first tile and a second refresh rate to the second tile; and
- simultaneously update content displayed in the first tile in accordance with the first refresh rate, and update content displayed in the second tile in accordance with the second refresh rate;

wherein each tile has:

- a first selection operation that calls the application program associated with the tile, the associated application program being different from a program that arranges the display into the one or more grids of tiles, and
- a second selection operation that provides a menu of options for a user to ascertain or adjust properties of the tile; and

wherein the associated application program for the first tile and the associated application program for the second tile are different application programs selected from among the group consisting of a web browser, a word processing application, an electronic mail application, a chat application, a weather application, a news application, a spreadsheet application, a music application, and a streaming video player.

Ex. 1001, 31:10–47. The remaining claims depend directly from claim 1, 9, or 17. *Id.* at 31:48–34:22.

E. ASSERTED GROUNDS

Petitioner asserts the following unpatentability grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1, 2, 4–10, 12–18, 20–24	102	MSIE Kit ¹
1–24	103	MSIE Kit
1–24	103	MSIE Kit, Jones ²
1–24	103	Excel97 ³
1–24	103	Excel97, Bhansali ⁴

Pet. 8. Petitioner relies also on the Declaration of Dr. Henry Houh. Ex. 1003.

F. LEGAL STANDARDS

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

¹ Microsoft Press. (1998). *Microsoft Internet Explorer Resource Kit*. (Ex. 1010). All citations are to the native pagination.

² U.S. Patent No. 6,819,345 B1, filed Feb. 17, 1998 (Ex. 1011).

³ Person, R. (1997). *Special Edition Using Microsoft Excel 97* (Ex. 1005). All citations are to the native pagination.

⁴ U.S. Patent No. 6,006,239, filed Mar. 15, 1996 (Ex. 1006).

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).

A patent claim is unpatentable as obvious if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103. Obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of non-obviousness.⁵ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

⁵ Patent Owner has not submitted such objective evidence here.

II. ANALYSIS

A. DISCRETIONARY DENIAL

Patent Owner argues that we should exercise our discretion to deny institution because a jury trial is scheduled for June 19, 2023. Prelim. Resp. 41–48 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential)).

“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. In light of that stipulation, we decline to discretionarily deny institution under *Fintiv*. See Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, at 3, 7–8, Memorandum, June 21, 2022.⁶

Patent Owner argues also that we should deny institution under 35 U.S.C. § 325(d) because MSIE Kit was before the Examiner during the ’434 patent’s prosecution and because Excel97, like MSIE Kit, discloses “hyperlinks . . . as the mechanism used to open an associated application.” Prelim. Resp. 49–52.

We agree that MSIE Kit was previously presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8, 10 (PTAB Feb. 13, 2020) (precedential). Although it was before the Examiner as listed in an IDS, the record does not indicate any substantive consideration. See Pet. 7. Our evaluation of Petitioner’s challenge based on MSIE Kit leads us to conclude the Examiner

⁶ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

overlooked MSIE Kit and therefore erred in a manner material to the patentability of the challenged claims. *See Advanced Bionics*, IPR2019-01469, Paper 6, 10–11. Moreover, the prior art and grounds based on Excel97 were not previously presented to the Office. Accordingly, we decline to exercise our discretion to deny institution under 35 U.S.C. § 325(d).

B. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner contends that a person of ordinary skill in the art “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. 11. Petitioner submits further that skilled artisans “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.* Patent Owner adopts Petitioner’s definition. Prelim. Resp. 11–12.

C. CLAIM CONSTRUCTION

We construe claims according to the standard used in the federal courts in civil actions 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 *Phillips*, 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.

A number of terms were construed in IPR2013-00292, addressing U.S. Patent No. 6,724,403 (“the ’403 patent”) and resulting in a final written decision determining all claims unpatentable (the “403 FWD”). Pet. 1, 11–18. Because the ’403 patent is the “ultimate parent” of the ’434 patent (through a chain of continuations and continuations in part), Petitioner submits that those prior constructions inform those of the terms at issue here. *Id.* The parties also discuss constructions by the United States District Court for the District of Maine, which construed terms of the ’403 patent. *See* Pet. 12–18; Prelim. Resp. 11–20.

Having considered the parties’ unpatentability arguments, we conclude that no claim term requires construction at this stage. *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))). Should either party believe that a position taken during trial depends on a particular claim construction, it should explain that dependence and why the asserted construction is correct.

D. UNPATENTABILITY OVER 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 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 Channel Definition Format, or “CDF” file. *Id.* at 177, 183, 188, 212–15, 223.

1. Anticipation

Petitioner provides contentions showing how MSIE Kit discloses each limitation of claims 1–2, 4–10, 12–18, and 20–24. Pet. 23–42. Patent Owner disputes only certain aspects of Petitioner’s contentions, and we address those disputes below. We have reviewed the undisputed aspects of Petitioner’s contentions and conclude that they are sufficient to warrant institution.

Patent Owner argues that MSIE Kit does not disclose a grid of nonoverlapping tiles. Prelim. Resp. 28–31. According to Patent Owner, the claims require “tiles be placed in a regular arrangement of rows and columns such that any two adjacent tiles are positioned touching one another without overlap.” *Id.* at 28. Because MSIE Kit permits Active Desktop items to be placed in arbitrary locations and further discloses that “[a]s more items are added to the desktop they will start to overlap each other,” (Ex. 1010, 175, 183), Patent Owner reasons that MSIE Kit does not satisfy the claims. Prelim. Resp. 29.

We do not agree with Patent Owner because it attempts to limit MSIE Kit’s discloses to particular circumstances. MSIE Kit discloses that, “[b]y default, Internet Explorer lays out new Active Desktop items on a 3 by 2

grid.” Ex. 1010, 183. Thus, a default configuration in MSIE Kit discloses a grid (a regular arrangement of rows and columns). And MSIE Kit discloses an exemplary configuration for a 640 x 480 pixel desktop using items with a “maximum size of no more than 200 × 200 pixels” so that the layout “allow[s] for reasonable spacing between items.” *Id.* Thus, MSIE Kit discloses a specific example of nonoverlapping items on a grid. Although Patent Owner points to an example in MSIE Kit where Active Desktop items are located in an assertedly non-grid arrangement (Ex. 1010, xxx), that does not undermine MSIE Kit’s other disclosures.

Patent Owner disputes also that MSIE Kit discloses a system where each tile has “a first selection operation that calls the application program associated with the tile.” Prelim. Resp. 31–33. In particular, Patent Owner argues that “not every Active Desktop item is required to include a hyperlink or hot spot,” and MSIE Kit therefore does not disclose *each* tile has a selection operation. *Id.* at 32. Patent Owner criticizes MSIE Kit for indicating that whether a particular tile has an “application launching selection operation” depends on the tile’s content. *Id.* at 32–33. But just because MSIE Kit allows for items without a hyperlink or hot spot does undermine its disclosures that each tile may have that functionality. *See ParkerVision, Inc. v. Qualcomm Inc.*, 903 F.3d 1354, 1361 (Fed. Cir. 2018) (“[A] prior art reference may anticipate or render obvious an apparatus claim . . . 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 MSIE Kit discloses that each tile may be configured with a hyperlink, it is reasonably capable of operating so as to meet the claim limitations.

Patent Owner does not otherwise challenge Petitioner’s showing as to anticipation of claims 1–2, 4–10, 12–18, and 20–24. Having reviewed the record, we conclude that Petitioner has shown a reasonable likelihood of prevailing with respect to anticipation of those claims by MSIE Kit.

2. Obviousness

Petitioner asserts that all claims would have been obvious over MSIE Kit, thus encompassing a larger set of claims than with its anticipation challenge—by including claims 3, 11, and 19. Pet. 43–45. As to the claims challenged also as anticipated, Petitioner submits that, while “disclosures to Active Desktop Items and their related functionality . . . are . . . properly considered together in an anticipation analysis,” it would have been obvious to consider those aspects of MSIE Kit together “because they are provided by the same software program, and described in the same publication, suggesting they could advantageously be used together.” Pet. 43 (citing Ex. 1003 ¶ 52).

Claim 3, which is not addressed in the anticipation ground, depends from claim 1 and further recites that “each of two grids is associated with a separate theme.” Ex. 1001, 31:51–52.^{7, 8} Petitioner submits that MSIE Kit renders that limitation obvious by “disclos[ing] organizing favorite web links by content” and “grouping Active Channels by content.” Pet. 43 (citing Ex. 1010, 113–14, 212–13). Petitioner reasons that adding additional grids

⁷ Patent Owner contends that a theme is not limited to a category of content in a tile and should be construed as “a categorization or grouping.” Prelim. Resp. 20–21.

⁸ Claims 11 and 19, which depend from claims 9 and 17, respectively, recite parallel limitations to those of claim 3. Ex. 1001, 32:40–41, 34:6–7.

of Active Desktop items would have been a predictable variation of the default 3x2 grid, and that it would have been obvious to use multiple grids to “organize Active Desktop Items in orderly, theme-based arrangements . . . by content” because doing so “would make it easier for a user to find an item she was looking for.” *Id.* at 43–44.

Patent Owner disputes Petitioner’s showing and argues that the default 3x2 grid is a division that “already covers the entire Active Desktop,” and therefore that “there is no reason to add additional grids.” Prelim. Resp. 34. Patent Owner points to MSIE Kit’s disclosure that “[a]s more items are added to the desktop, they will start to overlap each other” to argue that MSIE Kit discloses overlapping existing items with new items rather than adding additional grids. *Id.* (quoting Ex. 1010, 183).

While MSIE Kit discloses overloading a grid such that items overlap, that does not preclude using multiple grids. MSIE Kit discloses that an Active Channel may be used as an Active Desktop item. Ex. 1010, 213 (“Active Channels may be used as Active Desktop items, which appear directly in borderless frames on users’ desktops.”). It further discloses “applications” for using desktop items such as a stock ticker, new headlines, or lists of employee services or software updates. *Id.* at 213–14. Whether it would have been obvious to use multiple grids to organize those items, however, depends on factual determinations best suited for trial.

We conclude that any question as to obviousness of claims 3, 11, and 19 does not weigh against institution here.

E. OBVIOUSNESS OVER EXCEL97

Excel97 describes the Microsoft Excel 97 spreadsheet program. Ex. 1005. To that end, it describes how a cell may contain hyperlinks that, when clicked, take a user to another document. *Id.* at 2, 29, 1084.

Petitioner provides contentions showing how Excel97 renders obvious the limitations of all challenged claims. Pet. 47–70. Patent Owner disputes only certain aspects of Petitioner’s contentions, and we address those disputes below. We have reviewed the undisputed aspects of Petitioner’s contentions and conclude that they are sufficient to warrant institution.

Petitioner contends that a section of Excel97’s spreadsheet cells map to the claimed grid of non-overlapping tiles. Pet. 50–53. Patent Owner argues that Excel97 does not disclose a “grid of non-overlapping tiles” because “any number of cells may be empty” and only cells that “that include a hyperlink may arguably approximate a ‘tile.’” Prelim. Resp. 37. Petitioner, however, relies on an example from Excel97 showing a grid of four cells with hyperlinks. Pet. 55 (quoting Ex. 1005, 408 (Fig. 13.3)). Thus, Petitioner demonstrates a specific example from Excel97 that discloses a system configured as claimed. Whether Excel97 discloses a system that could be used in a manner outside the claims’ scope is inapposite. *ParkerVision*, 903 F.3d at 1361.

Petitioner relies on Excel97’s description of activating a cell’s hyperlink as the claimed tile selection that provides access to a linked information source. Patent Owner argues that Excel97 does not disclose “a first selection operation that call the application program associated with the tile” because selecting a hyperlink-containing cell does not activate the hyperlink, “only clicking the hyperlink calls the associated program.”

Prelim. Resp. 39. While that may accurately describe a cell's operation, Patent Owner does not support that "selecting" a cell as claimed is limited to particular action. Thus, based on the present record, Petitioner reasonably contends that clicking a cell's hyperlink is a "first selection operation." *See* Pet. 59–60.

Patent Owner does not otherwise challenge Petitioner's showing as to obviousness of the challenged claims over Excel97. Having reviewed the record, we conclude that Petitioner has shown a reasonable likelihood of prevailing with respect to obviousness of the challenged claims over Excel97.

F. ADDITIONAL OBVIOUSNESS GROUNDS

Patent Owner challenges Petitioner's additional grounds only on the basis of those grounds not overcoming the alleged deficiencies discussed above.⁹ *See* Prelim. Resp. 35–36 (MSIE Kit and Jones); 39–40 (Excel97 and Bhansali). Those grounds are included in the instituted review and we will address any potential deficiencies raised during trial.

⁹ Patent Owner contends that "it is unclear which claim, if any, are challenged under Ground 3." Prelim. Resp. 35. We do not agree. Petitioner relies on Jones for "the hardware elements of claims 1, 9 and 17" and for the additional limitations of claims 8, 16, and 24. Pet. 46–47. Because Petitioner asserts that all claims would have been obvious over MSIE Kit alone (Pet. 43–45), we understand the Jones ground to expand on that only as described by Petitioner. Stated otherwise, the ground including Jones challenges all claims and differs from the MSIE Kit obviousness ground only as to the independent claims' hardware elements and the additional limitations of claims 8, 16, and 24.

III. CONCLUSION

For the reasons discussed above, we conclude that Petitioner has shown a reasonable likelihood of prevailing with respect to unpatentability of at least one claim. Accordingly, we institute *inter partes* review.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 1–24 of the '434 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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