

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

SURFCAST, INC.,
Patent Owner.

IPR2022-00592
Patent 9,363,338 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 1–13 (“the challenged claims”) of U.S. Patent No. 9,363,338 B2 (Ex. 1001, “the ’338 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 ’338 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.

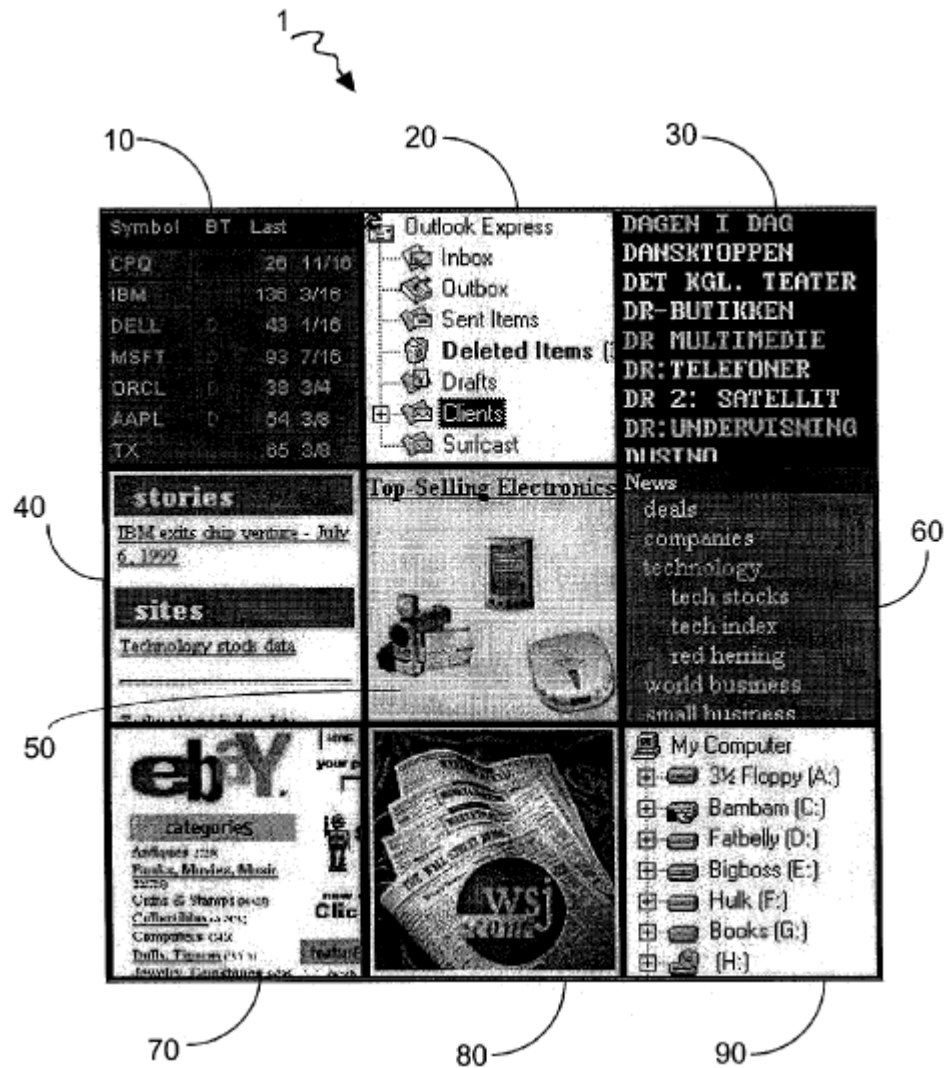
B. RELATED MATTERS

The parties both identify the following matter related to the ’338 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, IPR2022-00591. Pet. 3–4.

C. THE '338 PATENT

The '338 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 '338 patent describes a graphical user interface comprising a grid of tiles that resides on the user's computer desktop. *Id.* at 4:60–61. 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 4:61–64. 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 6:32–34; *see also id.* at 7:34–61 (describing the various tiles).

D. CHALLENGED CLAIMS

Claims 1 and 9 are independent. Claim 1 is reproduced below:

1. An electronic readable memory to direct an electronic device to function in a specified manner, the memory comprising:
 - a first set of instructions to partition at least a portion of a visual display of a client device 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;
- a second set of instructions for the client device to assign a first update rate to the first tile;
- a third set of instructions to, at a first update time in accordance with the first update rate, send a conditional request from the 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;
- a fourth set of instructions for the client device to receive a response to the conditional request from the first server device; and
- a fifth set of instructions for determining whether the client device updates the first tile in accordance with the response from the first server device.

Ex. 1001, 30:29–50. Claim 9 is reproduced below:

9. An electronic readable memory to direct an electronic device to function in a specified manner, the memory comprising:
 - a first set of instructions to partition by a first device at least a portion of a visual display into an array of tiles, a first information source being associated with a first tile in the array of tiles, the first information source being located on a second device, wherein the visual display is rendered according to instructions executed on the first device;
 - a second set of instructions for the second device to assign first update rate for updating information from the first information source;
 - a third set of instructions for the second device to, at a time for updating the information from the first information source in accordance with the first

update rate, determine whether the information from the first information source has changed since the last update time and to send to the first device an update message including the updated information in accordance with the determination;

a fourth set of instructions for the first device to receive an update message from the second device including updated information for updating the first tile; and

a fifth set of instructions for the first device to update the tile in accordance with the updated information.

Id. at 31:23–32:12. The remaining claims depend directly from claim 1 or 9.

Id. at 30:51–32:31.

E. ASSERTED GROUNDS

Petitioner asserts the following unpatentability grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–13	102	MSIE Kit ¹
1–13	103	MSIE Kit
1–13	103	MSIE Kit, Jones ²
1–8	103	MSIE Kit, RFC2068 ³
1–8	103	MSIE Kit, RFC2068, Jones
1–13	103	Excel97 ⁴ , Igra ⁵

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 *Hypertext Transfer Protocol -- HTTP/1.1*, Network Working Group, Request for Comments 2068, R. Fielding, January 1997 (Ex. 1012).

⁴ Person, R. (1997). *Special Edition Using Microsoft Excel 97* (Ex. 1005). All citations are to the native pagination.

⁵ U.S. Patent No. 6,701,485 B1, filed June 15, 1999 (Ex. 1007).

Claims Challenged	35 U.S.C. §	References/Basis
9–13	103	Excel97, Igra, Perez ⁶

Pet. 4. 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 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

⁶ U.S. Patent No. 5,319,777, issued June 7, 1994 (Ex. 1013).

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.⁷ *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).

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. 50–51 (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

⁷ Patent Owner has not submitted such objective evidence here.

Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, at 3, 7–8, Memorandum, June 21, 2022.⁸

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 '338 patent's prosecution and because Excel97, like MSIE Kit, discloses "hyperlinks or hot spots as the mechanism used to open an associated application." Prelim. Resp. 58.

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 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

⁸ Available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

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 ’338 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, other than as follows, no other 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.

1. “tile”

Petitioner submits that the 403 FWD interpreted “tile” as “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). It submits further that the Main Court interpreted “tile” as “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.” Pet. 13 (quoting Ex. 1018, 27). Petitioner focuses on a tile’s persistence, but that aspect is not in dispute at this stage.

Patent Owner seeks to clarify that a “tile” provides a graphical representation of an associated information source, but “content displayed by the tile is distinct from the website or the website as displayed in a web browser.” Prelim. Resp. 12–16. Patent Owner recognizes that such a graphical representation “may include ‘content’” from the information source and may take the form of “a miniaturized, ‘thumbnail’ view of the

underlying information” (Ex. 1001, 11:36–41). Prelim. Resp. 14. Patent Owner points to the ’338 patent’s description that a tile may “function[] as a transparent panel placed on top of a document, thus permitting a portion of the document to be displayed.” *Id.* at 15 (quoting Ex. 1001, 11:51–54).

Petitioner contends that it would be inconsistent with the specification to interpret “tile” as excluding “a structure that displays content from the information source” because the specification discloses examples that “are merely rectangles showing content from the associated information source.” Pet. 15–17 (citing Ex. 1001, Figs. 1, 4, 7:33–36, 11:3–5, 11:45–49).

Other than giving examples of a thumbnail image (i.e., scaled view) and transparent panel (i.e., partial view), Patent Owner does not support that the specification excludes information unchanged from how it might be viewed directly from the information source. The specification distinguishes tiles from icons or windows, describing that tiles are dynamic, unlike icons, and “will typically be smaller in size than a window” and lack the multiple active areas that a window would have. Ex. 1001, 10:39–11:22. When describing that a tile may present a miniaturized thumbnail view or a “porthole” partial full-size view, the ’338 patent states that such examples are preferred embodiments. *Id.* at 11:35–41. Additionally, the specification instructs that a tile may provide “a custom interface designed to allow rapid access to the underlying information,” suggesting that the difference between the tile and conventionally accessing the underlying information may relate not to the depiction of content itself but rather to controls surrounding the depiction. *Id.* at 11:40–41.

Based on the specification’s broad description and multiple examples, without limiting language, we do not agree with Patent Owner that “tile”

excludes displaying a representation from an information source that appears as it would in a web browser. No other aspects of “tile” appear to be in dispute at this stage.

2. “send a conditional request from the 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”

Claim 1 recites the above “conditional request” language. When disputing Petitioner’s unpatentability showing for MSIE Kit, Patent Owner contends that the conditional-request language requires a client device determine whether currently displayed content has not changed since a last update. Prelim. Resp. 33. Petitioner contends that prior art disclosing a conditional request sent in *all* circumstances satisfies the claim language. Pet. 29–30 (“Those conditional GET requests will be sent whether or not the information from the information source displayed in the tile has changed, and therefore will be sent when it has not changed.”).

Patent Owner’s proposed construction reasons that the client must determine “whether currently displayed content has not changed since a last update” because “the first tile, which is currently displaying the information, is part of the array of tiles into which the client device’s visual display is partitioned.” Prelim. Resp. 33. We agree with Patent Owner that reading the “if” clause as modifying “send a conditional request” would support that the client device makes the change determination. That said, we do not agree the claim language requires what Patent Owner asserts.

As an initial matter, based on the present record, we are not inclined to conclude that the server device may not be involved in determining whether information has been updated. It is possible that a client device

determines by inquiring to the server whether “information from the first information source” on the server has changed. We expect that the parties will better develop this issue through trial.

Further, how one reads the “if” clause greatly affects the proper claim construction. If the conditional request is sent only if information in the first tile has not changed since a last update (i.e., the “if” clause modifies “sending”), that seems to support Petitioner’s view of the claim. In particular, it seems that “a last update” must refer to the most recent update of information displayed in the first tile. In that case, the tile’s information could not have changed since a last update (because any change in the tile’s information is “a last update”). Thus, the “if” clause would always be true, and a “conditional request” would always be sent. Although Patent Owner submits that the determination must be made by a client device, determining the state of a condition with only one possibility could not meaningfully limit the claim. Such a claim interpretation is consistent with Petitioner’s application of the claim language.

On the other hand, the “if” clause may modify “an update” such that it clarifies the meaning of a “conditional request.” In that case, the claim appears to contain an error, because it would indicate that a conditional request is a request that seeks an update only if the information has *not* changed. One would ordinarily expect an update if information *has* changed.

The specification does not provide much guidance regarding the conditional request. It notes in passing that a “pre-fetch utility” may “periodically check the validity of items in the cache to make sure they are up to date” and that the “conditional gets” methods from the HTTP1.1

standard would be useful to do so. Ex. 1001, 25:29–33.⁹ Based on that description of a conditional request, it appears that the claim language should recite a request that seeks updated information if the information *has* changed.

Additionally, there is a question of whether the claim requires *any* determination of whether the displayed information has changed. As described above, Petitioner takes the position that the claim reads on a system sending conditional requests regardless of whether the displayed information has changed. Pet. 29–30. Patent Owner argues that “Petitioner’s statement would effectively write the if condition out of this limitation in an impermissible fashion.” Prelim. Resp. 35 (referring to Petitioner’s contention that a device always sending conditional requests satisfies the claim). But the claim does not recite “a specific action be taken in response to each of two alternative specified conditions,” as was significant to the Federal Circuit in *Hytera Communications Co. v. Motorola Solutions, Inc.*, 841 F. App’x. 210, 216 (Fed. Cir. 2021) (nonprecedential). In that case, the Federal Circuit noted the Board decision *Ex Parte Schulhauser*, No. 2013-007847, (PTAB. Apr. 28, 2016) (precedential), which holds that prior art need only show one of multiple possible paths to render a claim with conditional language unpatentable. Based on claims that defined “each of two alternative specified conditions,” the Federal Circuit reasoned that the claim in *Hytera* could not be viewed as two separate methods, each with one

⁹ The specification describes “conditional content” where “the content of one tile depends on the content of another.” Ex. 1001, 13:26–37. That description does not appear related to the “conditional request” claim language at issue here.

possible path. 841 F. App'x at 217. The claims here, in contrast, do not recite any action if determining that the displayed information has changed. Thus, it appears that Petitioner has the more persuasive view of whether the claim requires any specific determination.

Given the considerable ambiguity in the claim language and minimal guidance from the specification, we decline to construe the claim as Patent Owner seeks at this stage. During trial, the parties should address the proper construction, basis for that construction, and impact on unpatentability of the “conditional request” limitation.

3. “assign first update rate for updating information
from the first information source”

Independent claim 9 requires the second device assign a “first update rate for updating information from the first information source.” Ex. 1001, 32:1–3. Challenging unpatentability, Patent Owner argues that an interaction where a client (first device) downloads a file from a server (second device) does not satisfy the claim language because having a schedule set by a server-provided file “is not the same as the [server] second device assigning the first update rate.” Prelim. Resp. 36–38. According to Patent Owner, in that interaction, the author of the file is the entity that “assigns the schedule.” *Id.* at 37.

We do not agree that “assign” should be read so narrowly. The claim language recites that the second device includes instructions “to assign first update rate” but does not limit how that rate is assigned or what it means to be “assigned.”

The specification discloses that a tile’s refresh rate may be assigned using “a bit or bits in a packet header, or a tag that accompanies or is in the

header of a cell or packet.” Ex. 1001, 10:21–24; *accord id.* at 17:35–39 (“It is to be understood that an identifier such as a QoS tag can be used to assign to a tile a priority”).¹⁰ In that case, the refresh rate itself is not contained in the information used to “assign” a refresh rate—rather, the rate is assigned by setting flags in the transmitted information and the receiving device must interpret those flags to use the assigned refresh rate. Thus, the specification appears to support that assigning a refresh rate includes providing information that causes a client (first device) to use a particular schedule.

During trial, the parties should address the proper construction for the claimed “assign” operation and which aspects it controls of the overall process that results in an update rate.

D. ANTICIPATION BY 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,

¹⁰ The specification also includes an example of operating on “thin client” technology. Ex. 1001, 29:32–30:15. In that example, the ’338 patent states that “the thin-client implementation preferably allows for the automatic allocation of tile priorities based on the type of information content being transmitted.” *Id.* at 29:65–30:1.

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.

Petitioner provides contentions showing how MSIE Kit discloses each limitation of claims 1–13. Pet. 23–37. 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.

1. Claims 1–8

Patent Owner argues that MSIE Kit does not disclose an array of tiles. Prelim. Resp. 29–33. According to Patent Owner, the claims require “multiple tiles displayed in an orderly fashion.” *Id.* at 29. 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. 30.

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 (an orderly 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. *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.”).

Patent Owner contends also that, “[s]ince an Active Desktop item displays the underlying information of the associated information source, the Active Desktop item cannot display refreshed content that is a graphical representation of the associated information source.” Prelim. Resp. 32–33. In this regard, Patent Owner appears to rely on its proposed construction for “tile,” which attempts to exclude representations of an information source as would be appear in a web browser. *Id.* As discussed above, we do not agree with Patent Owner that “tile” excludes such representations. *See supra* at 11, § II.C.1. Moreover, MSIE Kit's items do not appear to depict information the same as it would appear with a web browser. For example, Active Desktop items appear to depict information with scaling, as the '338 patent describes for a tile. *See* Ex. 1010, xxx. Additionally, “[t]he Active Desktop doesn't include all of the browser's user interface elements” (*id.* at 174), which follows the '338 patent's description that tiles may provide “a custom interface designed to allow rapid access to the underlying information” (Ex. 1001, 11:40–41).

Accordingly, we conclude that MSIE Kit discloses “tiles” as claimed, even under Patent Owner's proposed construction.

Patent Owner disputes also that MSIE Kit discloses sending a conditional request as claimed. Prelim. Resp. 33–36. Claim 1 recites instructions to “send a conditional request from the 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.” Ex. 1001, 30:40–44. Patent Owner submits that the limitation “requires a determination of whether the first tile has not changed since the last update” and that “[s]uch determination can only be made by the client device” because the first tile resides on the client device. Prelim. Resp. 33. Patent Owner contrasts Petitioner’s contention that Internet Explorer, as used in MSIE Kit, may use a “conditional GET request that causes the Web server to send back web page content only if the server determines such content has been updated since a prior update time.” Pet. 29 (citing Ex. 1010, 192, 191).

As discussed above, the claim language is ambiguous at best. *See supra* at 13, § II.C.2. We decline, at this stage, to adopt Patent Owner’s proposed construction that would require a particular determination by a client device. But even accepting that the client device must make a determination, Petitioner separately contends that the claim reads on Internet Explorer’s ability to check a web site for updates. Pet. 29 (citing Ex. 1010, 190 (“In order to Webcast content from conventional Web site Internet Explorer performs scheduled site-crawl of the site content checking for updated content and optionally downloading information for offline use”)); *accord id.* (citing Ex. 1010, 191–92, 215–16, 176, 177, 180, 182; Ex. 1003 ¶ 160). Thus, even under Patent Owner’s view of the claim, it appears that Petitioner’s contentions would satisfy the claim language.

Patent Owner does not otherwise challenge Petitioner’s showing as to anticipation of claims 1–8. 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. Claims 9–13

Independent claim 9 requires the second device assign a “first update rate for updating information from the first information source.” Ex. 1001, 32:1–3. Petitioner contends that the update rate for an Active Desktop item may be set when a server provides a CDF file to a client. Pet. 34.

Patent Owner argues that the “assign” claim language does not read on the server providing a file to the client. Prelim. Resp. 36–38; *id.* at 37 (“IE4 on the client interprets the CDF file to assign the schedule.”). As discussed above, however, we do not adopt Patent Owner’s implicit construction limiting the claims. *See supra* at 16, § II.C.3. Viewing the claim language consistently with the specification, the limitation reads on a server providing a file that defines the update rate for an item.

Patent Owner does not otherwise challenge Petitioner’s showing as to anticipation of claims 9–13. 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.

E. OBVIOUSNESS OVER EXCEL97 AND IGRA

Excel97 describes the Microsoft Excel 97 spreadsheet program. Ex. 1005. To that end, it describes that a cell may contain hyperlinks that, when clicked, take a user to another document. *Id.* at 2, 29, 70. It also

describes that a cell may link to data in an external data source. *Id.* at 1084–85.

Igra discloses an approach to bind spreadsheet cells to external objects using direct communication. Ex. 1007, code (57). An external object’s property or method may be used to update a spreadsheet cell’s value. *Id.* Such updating may occur automatically or upon request from the spreadsheet. *Id.* at 3:32–33. For example, Igra discloses that a spreadsheet control may issue requests for updated information “on a periodic basis.” *Id.* at 9:25–27. In one embodiment, Igra discloses that a spreadsheet control may allow a user to set the “refresh interval” that controls when a remote information source is checked for updates. *Id.* at 7:55–67. In another embodiment, Igra allows a spreadsheet control to “register itself as a change notification sink” of a remote information source; in that case, the remote information source will “notify requesting objects whenever a property of a bound object is changed.” *Id.* at 6:58–7:8.

Petitioner submits that it would have been obvious to use Igra’s method for linking and updating a remote information source with Excel97’s spreadsheet “to receive more timely update notifications to avoid spending time editing a spreadsheet in ways that may conflict with a colleague’s edits and ultimately be deleted.” Pet. 48–49 (citing Ex. 1003 ¶ 272). Petitioner further submits that using Igra’s method for user control of the refresh interval “would give the user of the client computer more control over how often the spreadsheet data is refreshed, thus providing up to date data needed by the user in a manner that made more efficient use of network bandwidth.” Pet. 53–54 (citing Ex. 1003 ¶ 315).

Petitioner provides contentions showing how the combination of Excel97 and Igra renders obvious the limitations of all challenged claims. Pet. 46–65. 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.

1. Claims 1–8

Patent Owner argues that Excel97 lacks “an array of tiles” because “any number of cells may be empty.” Prelim. Resp. 43. Patent Owner submits that, “for Excel97 to disclose ‘an array of tiles’, Excel97 would have to disclose a single spreadsheet workbook in which every cell contained a hyperlink.” *Id.* We see no basis in the claim language to impose such a requirement. Rather, we agree with Petitioner that “two or more such cells in a range are an ‘array of tiles’ as claimed because they are tiles displayed in an orderly row/column arrangement.” Pet. 50.

Patent Owner argues additionally that information in Excel97’s spreadsheet cell, when the cell is associated with a remote information source, “is the underlying information and not some representation of that information.” Prelim. Resp. 44. We do not agree that Patent Owner makes a meaningful distinction. As discussed above, we do not adopt Patent Owner’s proposed construction that would exclude a “tile” that displays the information from a source without alteration. *See supra* at 11, § II.C.1. Even agreeing with Patent Owner that “content displayed in a tile is distinct from any underlying information,” that appears to be satisfied by Petitioner’s contention that Excel97 discloses configuring a cell to display information from a “linked information source, such as an Excel file . . . an Office

document, a program, or a Web page.” Pet. 50 (citing Ex. 1005, 29, 39, 40–45, 70, 1084; Ex. 1003 ¶ 290); *accord id.* at 51 (“The cells of Excel97 – including the cells of the Global Quality Corporation example . . . are thus each a representation of an associated information source because they graphically depict some of the information from their associated source.”). Accordingly, we do not agree with Patent Owner that Petitioner fails to show Excel97 discloses the claimed tiles.

Patent Owner argues (Prelim. Resp. 45–46) that Igra does not disclose the claimed “conditional request” because Igra’s “request is sent periodically, and therefore does not depend on whether information from the server and displayed in the spreadsheet at the client has changed, *i.e.*, it will be sent whether or not such information has changed since the last update and therefore will be sent if that information ‘has not changed’” (Pet. 54 (citations omitted)). As discussed above, however, we do not construe the claim language to restrict what a system does when information in a tile *has* changed (as opposed to the claimed situation where it has *not* changed). *See supra* at 13, § II.C.2. As discussed above regarding MSIE Kit, Petitioner’s contentions are adequate to justify institution based on the present record.

Patent Owner does not otherwise challenge Petitioner’s showing as to obviousness of claims 1–8 over Excel97 and Igra. Having reviewed the record, we conclude that Petitioner has shown a reasonable likelihood of prevailing with respect to obviousness of the claims 1–8 over Excel97 and Igra.

2. Claims 9–13

For the claimed second device that assigns a first update rate for updating information from the first information source, Petitioner points to

Igra's disclosure of "change notification sink registration." Pet. 61–64 (citing Ex. 1007, 6:58–7:4). Petitioner asserts that the update rate "is assigned by the remote computer of Igra because the operations that implement it are carried out by the remote computer." *Id.* at 62 (citing Ex. 1007, 11:23–30, 10:32–37).

Patent Owner argues that Igra's change notification sink registration cannot be the claimed "assign[ing] first update rate" because Igra's process involves the client device registering with the server, so the client device (not the server) assigns the update rate. Prelim. Resp. 46–47 (citing Ex. 1007, 6:62–63, 65–67).

As discussed above, we do not limit the claimed assigning to a process carried out entirely by the second (remote) device. *See supra* at 16, § II.C.3. That said, the limits of what must be performed to "assign" an update rate depend on the proper construction for that phrase. Whether Petitioner sufficiently identifies operations carried out by Igra's remote computer may ultimately depend on the construction for the "assign" limitation. Because we otherwise determine that Petitioner meets the standard for institution, we need not conclusively determine whether Petitioner's showing is adequate for claims 9–13 based on Excel97 and Igra. The instituted review will include this ground.

F. OBVIOUSNESS OVER EXCEL97, IGRA, AND PEREZ

Perez discloses a system allowing multiple client users to work on a spreadsheet stored at a server, in which "changes in data effected by one user are reflected in the spreadsheets of all users." Ex. 1013, code (57). In Perez's system, the server notifies user devices of any change to a spreadsheet. *Id.* at 9:10–22.

Petitioner contends that skilled artisans had reason to further incorporate Perez’s teachings regarding spreadsheet updates from a server to client computers. Pet. 65–69. Petitioner asserts that Perez’s functionality for assigning a “first update rate” is implemented at the server and therefore that Perez discloses the server assigning the update rate. Pet. 66.

Patent Owner argues that Perez’s update rate “is assigned by the inventor or the system as a whole.” Prelim. Resp. 48. But as discussed above, that applies a narrow view of what must be done to “assign” an update rate. It appears that, in Perez’s system, the client computers do not play a role in requesting a particular update rate—in that way, the ground including Perez is different from the ground based on Excel97 and Igra without Perez.

We leave for trial determination of what is required to assign an update rate and whether the prior art satisfies the claims as properly construed.

Patent Owner argues also that “Perez is not analogous art to either Excel97 or Igra.” Prelim. Resp. 49. In that regard, Patent Owner distinguishes that “Perez is explicitly directed to storing data in multidimensional arrays as opposed to a common spreadsheet stored in a central location.” *Id.* That argument, however, appears to be somewhat misplaced, as the analogous-art test is directed to a comparison between a prior-art reference and the challenged patent. *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (“References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention.”). Whether Perez is properly considered as analogous art is a factual issue best suited for resolution at trial.

G. ADDITIONAL OBVIOUSNESS GROUNDS

Patent Owner challenges Petitioner's additional grounds only on the basis of those grounds not overcoming the alleged deficiencies discussed above. *See* Prelim. Resp. 38–39 (MSIE Kit), 39–40 (MSIE Kit and Jones), 40–41 (MSIE Kit and RFC2068). Those grounds are included in the instituted review and we will address any potential deficiencies raised during trial.

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 1–13 of the '338 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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