

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

MICROGRAFX, LLC,
Patent Owner.

Case IPR2014-00532
Patent 5,959,633

Before SALLY C. MEDLEY, RICHARD E. RICE, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73(b)

I. INTRODUCTION

Google Inc., Samsung Electronics America, Inc., and Samsung Electronics Co., Ltd. (collectively, “Petitioner”) filed a Petition (Paper 5, “Pet.”) for *inter partes* review of claims 1–4, 6, 8–11, 13, and 15 (the “challenged claims”) of U.S. Patent No. 5,959,633 (Ex. 1001, “the ’633 Patent”). Petitioner also filed a Declaration of Dr. Anselmo Lastra (Ex. 1003).

On August 12, 2014, we instituted an *inter partes* review of all of the challenged claims under 35 U.S.C. § 102, as anticipated by Walton,¹ and under 35 U.S.C. § 103, as obvious over Eick² and Kruglinski³. Paper 11 (“Inst. Dec.”), 19.

After institution of trial, Micrografx, LLC (“Patent Owner”), deposed Petitioner’s declarant, Dr. Lastra, and filed a Patent Owner Response (Paper 22, “PO Resp.”), a transcript of Dr. Lastra’s deposition (Ex. 2004), and a Declaration of Garry Kitchen (Ex. 2005). Patent Owner also filed a Motion to Amend (Paper 21, “Mot.”).

Petitioner deposed Patent Owner’s declarant, Mr. Kitchen, and filed a Reply to the Patent Owner Response (Paper 37, “Pet. Reply”), a transcript of Mr. Kitchen’s deposition (Ex. 1012), and a Second Declaration of Dr. Lastra (Ex. 1011). Petitioner also filed an Opposition to the Motion to Amend

¹ U.S. Patent No. 5,883,639, issued Mar. 16, 1999 (Ex. 1004).

² U.S. Patent No. 5,564,048, issued Oct. 8, 1996 (Ex. 1005).

³ David J. Kruglinski, *INSIDE VISUAL C++* (Dean Holmes et al. eds., 2d ed., Version 1.5, Microsoft Press 1994) (Ex. 1006).

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(Paper 26, “Opp. Mot.”), to which Patent Owner then filed a Reply (Paper 32, “Reply Mot.”).

Patent Owner deposed Dr. Lastra a second time and filed a transcript of the second deposition (Ex. 2008). Patent Owner also filed a Motion for Observations regarding Cross-Examination of Dr. Lastra (Paper 35), to which Petitioner then filed a Response (Paper 37).

An oral hearing was held on May 18, 2015. The transcript of the oral hearing has been entered into the record. Paper 39 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons explained below, Petitioner has shown, by a preponderance of the evidence, that the challenged claims are unpatentable. Patent Owner, however, has not met its burden with respect to its Motion to Amend and, therefore, the motion is *denied*.

A. Related Lawsuits

The parties represent that *Micrografx, LLC v. Google, Inc.*, No. 3:13-cv-03595-N (N.D. Tex.), and *Micrografx, LLC v. Samsung Telecommunications America, LLC*, No. 3:13-cv-03599-N (N.D. Tex.), involve the ’633 Patent. Pet. 2; Amended Mandatory Notices of the Patent Owner pursuant to 37 C.F.R. § 42.8, 2 (Paper 9).

B. The ’633 Patent (Ex. 1001)

The ’633 Patent, titled “Method and System for Producing Graphical Images,” issued on September 28, 1999, from U.S. Patent Application No.

08/726,091, which was filed on October 4, 1996. Ex. 1001, at [54], [45], [21], [22].

The '633 Patent Specification describes a system for producing graphical images. Ex. 1001, 1:51–54. Included in the system is a computer program “operable to access an external shape stored outside the computer program.” *Id.* at 1:54–56. As described, “[t]he external shape has external capabilities.” *Id.* at 1:56. “Capabilities are action methods, symbol methods, or any other functions that allow the generation of information required to produce a graphical image.” *Id.* at 3:29–31.

In an embodiment, external shape library 124 contains information used by computer graphics application 122 to produce graphical images on output device 116. Ex. 1001, 3:3–6, Fig. 1. The Specification states that “[t]he ability to place the capabilities of a shape outside computer graphics application 122” facilitates use of shapes not contemplated at the time of creation of the computer graphics application. *Id.* at 3:32–51. The shape library comprises shape collection modules 212 and 214. *Id.* at 3:52–54. In one embodiment, the shape collection modules “comprise a dynamic link library (DLL) that allows executable routines to be stored separately as files with DLL extensions and to be loaded only when needed by the program that calls them.” *Id.* at 3:54–57.

Figure 3A of the '633 Patent is reproduced below.

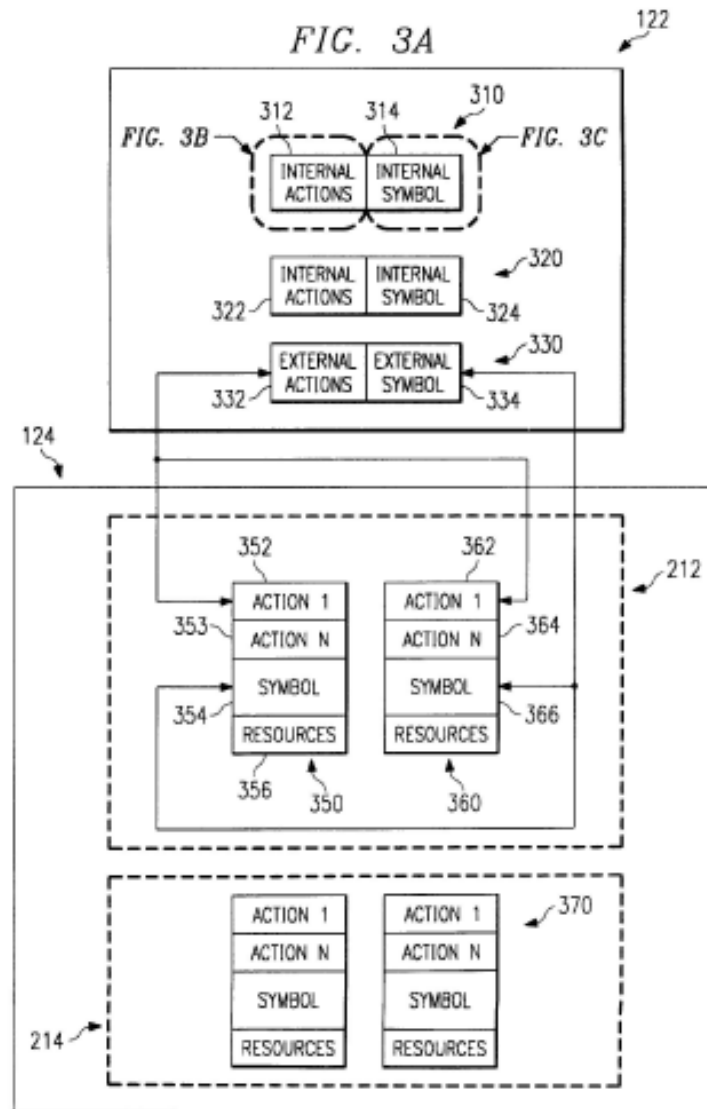


Figure 3A is a schematic of computer application 122 and its interaction with external shape library 124 in block diagram form. Ex. 1001, 4:54–56. As depicted in Figure 3A, computer graphics application 122 comprises internal shapes 310 and 320 and external shape template 330. *Id.* at 4:57–59. “Internal shapes 310 and 320 each comprise information used by computer graphics application 122 to produce a different graphical image

on output device 116 . . . for example, a circle or a rectangle.” *Id.* at 4:59–63. In contrast, “[e]xternal shape template 330 comprises pointers to shapes contained within [external] shape library 124, which are used by computer graphics application 122 to produce graphical images that are not supported by internal shapes 310 or 320.” *Id.* at 4:63–67. External shape library 124 comprises a plurality of shape collection modules, each of which contains a plurality of external shapes. *Id.* at 5:31–35.

C. Illustrative Claim

Claims 1 and 8 are independent. Claims 2–4 and 6 depend directly or indirectly from claim 1, and claims 9–11, 13, and 15 depend directly or indirectly from claim 8. Claim 1, which is reproduced below, is illustrative:

1. A computerized system comprising:
 - a storage medium;
 - a processor coupled to the storage medium;
 - a computer program stored in the storage medium, the computer program operable to run on the processor, the computer program further operable to:
 - access an external shape stored outside the computer program, the external shape comprising external capabilities; and
 - delegate the production of a graphical image of the external shape to the external capabilities.

D. The Instituted Grounds

We instituted an *inter partes* review on the following grounds (Inst. Dec. 19):

Reference(s)	Basis	Claims Challenged
Walton	§ 102	1–4, 6, 8–11, 13, and 15
Eick and Kruglinski	§ 103	1–4, 6, 8–11, 13, and 15

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we give claim terms in an unexpired patent their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Technologies, LLC*, No. 2014-1301, 2015 WL 4097949, at *7–*8 (Fed. Cir. July 8, 2015) (“We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA” and “the standard was properly adopted by PTO regulation.”). Under the broadest reasonable interpretation standard, and absent any special definitions, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Further, “the specification and prosecution history only compel departure from the plain meaning in two instances: lexicography and disavowal.” *GE Lighting Solutions, LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1309 (Fed. Cir. 2014) (citing *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)). The standards for lexicography and disavowal are exacting, and require clear intent to define or narrow a term.

Thorner, 669 F.3d at 1365–66. Any special definition for a claim term must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

1. “*An external shape stored outside the computer program, the external shape comprising external capabilities*”

Claims 1 and 8 each recite “*an external shape stored outside the computer program, the external shape comprising external capabilities*” (emphasis added). In the Institution Decision, we determined that the broadest reasonable interpretation consistent with the Specification of “an external shape stored outside the computer program” is computer code stored outside the computer program that defines a graphical image. Inst. Dec. 9. We also determined, based on an express definition set forth in the ’633 Patent Specification, that “external capabilities” means computer code stored outside a computer program, comprising action methods, symbol methods, or any other functions, that allow the generation of information required to produce a graphical image. *Id.*; *see* Ex. 1001, 3:29–31 (“Capabilities are action methods, symbol methods, or any other functions that allow the generation of information required to produce a graphical image.”).

Neither party proposes any change to our interpretation of “external capabilities,” but Patent Owner argues that our initial interpretation of “an external shape stored outside the computer program” is “overly broad” and “improperly divorced from the context of the specification of the ’633

patent.” PO Resp. 10.⁴ Patent Owner proposes to add the words “that can be developed and provided for use by the computer program without modifying the computer program”⁵ to our interpretation of “an external shape stored outside the computer program.” *Id.*; Tr. 30–31. Patent Owner relies on passages from the ’633 Patent Specification, such as the following, to support its proposed claim construction:

The *invention* also provides an architecture that allows for the *integration of additional shapes with an existing computer program* without modifying that existing program.

...

Therefore, the invention provides a system for the production of graphical images that allows the shapes to be stored outside the computer program using the shapes. New shapes may be *added to the system without incurring the disadvantages associated with revising the computer program.*

PO Resp. 11 (quoting Ex. 1001, 2:6–9, 3:48–51); *see id.* (citing Ex. 1001, 8:24–28). Patent Owner argues that these passages “explain[] that the

⁴ Patent Owner argues, generally, that “claim construction in this proceeding should be governed by the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).” Prelim. Resp. 7. *But see In re Cuzco Speed Technologies*, 2015 WL 4097949, at *7–*8.

⁵ The proposed claim construction in the Patent Owner Response not only added “that can be developed and provided for use by the computer program without modifying the computer program,” but also omitted “that defines a graphical image.” PO Resp. 10. We accept Patent Owner’s explanation, however, that the omitted words were left out by mistake. Ex. 1012, 15:15–16:16; Tr. 31.

capability of providing additional shapes to the computer program *without modifying the computer program* is a characteristic of the invention.” *Id.* (emphasis added).

We are not persuaded by Patent Owner that the advantage of integrating additional shapes with an existing computer program without modifying that existing program, as described in the Specification, is uniquely attributable to use of external shapes stored outside the computer program. *See* Pet. Reply 2. The passages from the Specification cited by Patent Owner attribute the touted advantage to “an architecture” or “a system,” rather than to external shapes stored outside the computer program. *See* PO Resp. 11 (quoting Ex. 1001, 2:6–9, 3:48–51, 8:24–28). The Specification also appears to attribute the touted advantage to “[t]he ability to place the *capabilities* of a shape outside [the computer program].” Ex. 1001, 3:33–35 (emphasis added). As used in the Specification and recited in the claims, “capabilities” and “shape” are distinct terms. *See, e.g., id.* at 1:45–46 (“The shape library defines a shape having associated capabilities.”), 3:18–51 (describing a computer program “operable to access generic capabilities associated with an external shape and delegate the production of a graphical image of the external shape to the capabilities associated with the shape”). The Specification additionally appears to attribute the touted advantage to use of “shape collection modules” that are separate from the computer program. *Id.* at 4:5–10. Accordingly, we do not agree that the Specification requires adding “that can be developed and provided for use by the computer program without modifying the computer

program” to our initial interpretation of “an external shape stored outside the computer program.” *See* PO Resp. 10; Tr. 30–31.

In the Institution Decision, we observed that the Specification uses the term “shape” in different ways. Inst. Dec. 8. In a narrow sense, the Specification describes “external shape 350” as comprising plurality of external actions 352, 353, external symbol 354, and external resources 356. Ex. 1001, 5:37–39; 6:1–7:38, Fig. 3A. As described, the external actions and the external symbol are executable to produce a graphical image. *See id.* at 6:1–12, 7:12–17, 8:14–23. In a broader sense, the Specification uses the term “shape” to mean, simply, a graphical image defined by computer code. *See, e.g., id.* at 1:6–34. A third example is the reference in the Specification to “external shape 330” (*id.* at 4:59), which is elsewhere referred to as “external shape template 330” (*see, e.g., id.* at 5:43–56). “[E]xternal shape template 330 does not comprise a predetermined set of actions and a symbol,” but rather “comprises pointers to shapes contained within shape library 124.” *Id.* at 5:43–44, 4:63–64. With the exception of external shape template 330, which is stored inside the computer program (*see, e.g., id.* at Fig. 3A), the Specification uses the term “external” to refer to computer code stored outside the computer program (*see, e.g., id.* at 5:1–42, Fig. 3A) (distinguishing “external shapes,” which are stored outside a computer program, from “internal shapes,” which are stored inside a computer program). We determine that our initial claim interpretation—that “an external shape stored outside the computer program” means a graphical image stored outside the computer program that is defined by computer

code—is the broadest reasonable interpretation consistent with the Specification.

We, therefore, maintain our initial claim interpretation, set forth in the Institution Decision, that “an external shape stored outside the computer program” is computer code stored outside the computer program that defines a graphical image.

2. “*Delegate*”

Claims 1 and 8 each recite “the computer program further operable to . . . delegate the production of a graphical image of the external shape to the external capabilities.” In the Institution Decision, we determined that the broadest reasonable interpretation consistent with the specification of “delegate” is to commit or entrust to another. Inst. Dec. 10. Neither party proposes any change to that interpretation. Based on the record adduced during trial, we see no reason to modify or further address the above construction.

3. “*External action*” and “*external symbol*”

Claims 2–4 and 9–11 require “an external shape stored outside the computer program, the external shape comprising an external action and an external symbol.” In the Institution Decision, we determined that the broadest reasonable interpretation consistent with the Specification of “external action” is executable computer code stored outside the computer program, and that the broadest reasonable interpretation consistent with the Specification of “external symbol” is computer code stored outside the

computer program that is associated with a graphical image. Inst. Dec. 10–11. Neither party proposes any change to that interpretation. Based on the record adduced during trial, we see no reason to modify or further address the above constructions.

B. Asserted Anticipation by Walton

Petitioner challenges claims 1–4, 6, 8–11, 13, and 15 of the ’633 Patent as anticipated by Walton. Pet. 11–14, 20–39. To anticipate a patent claim under 35 U.S.C. § 102, “a single prior art reference must expressly or inherently disclose each claim limitation.” *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008). The evidentiary standard in this case is a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). For the reasons given below, after consideration of the Petition, the arguments in the Patent Owner Response, and the evidence of record, we conclude that Petitioner has shown, by a preponderance of the evidence, that each of claims 1–4, 6, 8–11, 13, and 15 of the ’633 Patent is unpatentable as anticipated by Walton.

1. Overview of Walton

Walton discloses an object-oriented system for creating user interfaces, termed the “Visual Software Engineering (VSE)” system, that defines both input to and output from graphical objects. Ex. 1004, Abstract, 3:55–60. As disclosed, a “VSE object” preferably “consists of two major parts, the graphic element and the behavior element.” *Id.* at 13:15–17. Walton further discloses: “As is typical of objects in object-oriented

systems, a graphical object in accordance with the invention must be able to draw itself if asked to do so and to indicate that it has been selected.” *Id.* at 13:19–22. Walton also discloses that objects can be stored in an object-oriented database system and accessed via a client server for use in a computer program. *Id.* at 8:54–65.

2. *Petitioner’s Contentions with Respect to Claims 1 and 8*

Petitioner provides argument and a claim chart, supported by the testimony of Dr. Lastra, identifying where every limitation of claims 1 and 8 may be found in Walton. Pet. 11–14, 20–27, 37–38; Ex. 1003 ¶¶ 26–49, 78–81. For instance, with respect to the limitation “the computer program further operable to[] access an external shape stored outside the computer program, the external shape comprising external capabilities,” Petitioner asserts that “Walton describes accessing external shapes in the form of graphical objects, each object including an external shape (‘graphic element’) and external capabilities (‘behavior element’).” Pet. 22 (citing Ex. 1004, 13:13–17; Ex. 1003 ¶¶ 36–45). Petitioner cites Walton’s disclosure that “user software may be used to access the graphical object, and . . . the graphical object may be manipulated on the display screen directly from the user application code.” *Id.* at 23 (quoting Ex. 1004, 8:16–21).

As to the “stored outside the computer program” requirement, Petitioner relies on Walton’s disclosure that:

“[t]he *resulting objects are then stored as objects in an object-oriented database system* and connected to other objects or user code 120 in accordance with techniques commonly used in object-oriented systems. *The information so stored is accessed*

by the user code 120 by . . . communicating to a client server via an interprocess communications mechanism of a type known to those skilled in the art.”

Pet. 24 (quoting Ex. 1004, 8:54–62).

Walton’s graphical objects, according to Petitioner, “have external capabilities in the form of ‘behavior states’ that are stored external to user source code.” Pet. 25 (citing Ex. 1004, 9:35–42). Dr. Lastra testifies that “the behavior elements of Walton correspond to the recited ‘external capabilities’ because . . . the behavior elements define behavior functions (graphic output) for creating and manipulating graphics on a display in response to behavior events (user input).” Ex. 1003 ¶ 37 (citing Ex. 1004, 13:19–41, 11:8–9, 11:23–30).

Further, with respect to the limitation “the computer program further operable to . . . delegate the production of a graphical image of the external shape to the external capabilities,” Petitioner asserts that “Walton further discloses that the production of the graphical object is delegated to the external capabilities of an object in that ‘the graphical object is responsible for controlling itself.’” Pet. 27 (quoting Ex. 1004, 11:8–9). Petitioner additionally relies on Walton’s disclosure that “a graphical object in accordance with the invention *must be able to draw itself* if asked to do so.” *Id.* (quoting Ex. 1004, 13:19–21).

In support, Dr. Lastra testifies:

Walton further describes that the production of the graphical object is delegated to the external capabilities of an external graphical object. For example, Walton indicates that

“a graphical object in accordance with the invention *must be able to draw itself* if asked to do so” (emphasis added) ([Ex. 1004,] 13:19–21.) Walton discloses that this drawing functionality is performed by the behavior functions of a graphical object.” (*Id.* at 13:26–40). For example, Walton discloses that each “graphical object is responsible for controlling itself” and that one or more “behavior function[s] (graphics manipulation [functions])” stored as part of a graphical object are responsible for “chang[ing] its graphical representation . . . on the display” in response to “a value change” or “behavior event.” (*Id.* at 11:8–9, 13:26–30).

Ex. 1003 ¶ 47.

3. Patent Owner’s Contentions with respect to Claims 1 and 8

In opposition, Patent Owner contends that Walton does not anticipate claims 1 and 8 “at least because it does not disclose external shapes with external capabilities or a computer program that delegates the production of a graphical image of the external shape to the external capabilities.” PO Resp. 13. Patent Owner argues that Petitioner mistakenly relies on the “user code” in Walton’s system as the “computer program” required by the claims, because “the user code interfaces with the VSE system and does not directly access any graphical objects in the VSE system.” *Id.* at 20. To support this argument, Patent Owner quotes Walton:

The behavior router 412 is the part of the VSE system 400 that routes behavior events to the objects within the VSE system 400. As noted above, a behavior event is the setting of a given behavior state to a state value. User code, VSE objects, and the behavior editor 408 send out behavior events to the behavior router 412. The behavior router 412 then sends the

events to any objects or other VSE components registered for that particular behavior state name.

Id. at 20–21 (citing Ex. 1004, 13:51–58). Thus, Patent Owner contends, “[t]he user code simply interfaces with the VSE system as a client and not with the VSE objects themselves” (*id.* at 21 (citing Ex. 2005 ¶ 55)), and “the VSE system as a whole produces graphical images, not the graphical objects themselves” (*id.* at 22).

Patent Owner additionally asserts that the graphical objects of Walton do not satisfy Patent Owner’s proposed construction of “external shape stored outside the computer program.” PO Resp. 23. As discussed above (*see supra* Section II.A.1), Patent Owner’s proposed construction requires computer code “that can be developed and provided for use by the computer program without modifying the computer program.” Based on its proposed construction, Patent Owner argues that “Walton simply does not disclose that a user of the VSE system can create a new VSE object and make use of that VSE object in the user’s user code without modifying the user code.” *Id.* (citations omitted).

Patent Owner also contends that Walton does not disclose a computer program operable to delegate the production of a graphical image of the external shape to the external capabilities. *See* PO Resp. 24–34; Ex. 2005 ¶¶ 45–56. Patent Owner argues that the production of a graphical image in the VSE system does not involve just the graphical objects themselves, but rather always involves other components of the VSE system, such as the graphics editor, and, thus, “[t]he graphical objects themselves cannot be

entrusted to produce a graphical image.” PO Resp. 28 (citing Ex. 2005 ¶ 51). Patent Owner also argues that “[t]he user code cannot delegate any task to the graphical objects because the graphics editor and other components control the graphical objects.” *Id.* at 30. Patent Owner argues on that basis that Walton’s graphical objects lack the “external capabilities” required by the claims:

Walton’s VSE system controls the production of graphical images of objects within the VSE system. The VSE system also controls the graphical objects within the system. Thus, there are no external capabilities in the graphical objects of Walton to which the production of a graphical image of the external shape could be delegated. The graphical objects of Walton simply do not work outside the VSE system and thus do not meet the claim limitations.

Petitioners rely on “behavior elements” disclosed in Walton as providing the external capabilities required by the claims. But Petitioners’ reliance is misplaced.

Id. at 31.

Relying on Mr. Kitchen’s testimony, Patent Owner further argues that Petitioner has misapprehended the statement in Walton that “*a graphical object . . . must be able to draw itself if asked to do so and to indicate that it has been selected.*” PO Resp. 31–32 (quoting Ex. 1004, 13:19–25; citing Ex. 2005 ¶¶ 50–51). As Patent Owner understands that disclosure, Walton “is not saying that a VSE object must be able to draw itself outside the context of the VSE system,” but rather “that from a user’s perspective, a ‘graphical object’ must be able to draw itself—*i.e.*, when requested via user interaction, such as by selection of a symbol, the system must be able to

draw the selected graphical object.” *Id.* at 32. Mr. Kitchen similarly testifies:

when read in context . . . , one skilled in the art would understand that this statement is describing the interactive capabilities of an on-screen object, rather than the specifics of how it is being rendered on screen. The paragraph is describing the fact that an object should graphically react in some way when selected, and this “may be done using little boxes that appear on the object.” In other words, “a graphical object . . . must be able to [trigger the system] to draw itself if asked to do so.”

Ex. 2005 ¶ 50 (insert shown in brackets supplied by Mr. Kitchen).

Similarly, Patent Owner argues that Petitioner has misapprehended Walton’s disclosure that “[o]nce created, the graphical object is responsible for controlling itself, and the graphics editor 404 simply makes requests of the graphical object.” PO Resp. 32 (citing Ex. 1004, 11:8–9). As Patent Owner understands that disclosure, “Walton is not saying that a graphical object can draw itself or even actually control itself from the perspective of separate code, such as user code.” *Id.* at 32–33. Rather, according to Patent Owner, “that sentence itself makes clear that it is the graphics editor that controls the production of a graphical image by making requests of the graphical object.” *Id.* at 33.

Patent Owner concludes:

Petitioners’ anticipation argument . . . rest[s] on the assertion that the VSE objects are simply *involved* in the production of a graphical image. But *mere involvement* is insufficient to satisfy the requirement that the computer

program commit or entrust the production of a graphical image of the VSE objects to the VSE objects.

PO Resp. 34 (emphasis added).

4. *Analysis—Claims 1 and 8 as Anticipated by Walton*

- a. “[T]he computer program further operable to[] access an external shape stored outside the computer program, the external shape comprising external capabilities”

We are persuaded by Petitioner that Walton discloses “the computer program further operable to[] access an external shape stored outside the computer program, the external shape comprising external capabilities,” recited in each of claims 1 and 8. *See, e.g.*, Pet. 22; Ex. 1004, 8:16–21, 13:13–17; Ex. 1003 ¶¶ 36–45. Patent Owner’s argument that the user code (“computer program”) disclosed in Walton does not “*directly*” access any graphical objects in the VSE system (PO Resp. 20, emphasis added) is inconsistent with both the claim language, which does not recite “*directly*,” and Walton’s express disclosure that “user software may be used to access the graphical object, and . . . the graphical object may be manipulated on the display screen directly from the user application code.” Ex. 1004, 8:16–21; *see* Pet. 23. We are persuaded, moreover, that Walton’s graphical objects are stored outside the user code (“computer program”), as the claims require. *See* Pet. 24 (quoting Ex. 1004, 8:54–62). Patent Owner’s argument that Walton does not disclose adding graphical objects to the VSE system without modifying user code is not commensurate with our interpretation of

the claim term “an external shape stored outside the computer program.”
See PO Resp. 15, 23; *supra* section II.A.1.

With respect to application of the “external capabilities” requirement to Walton, we credit the testimony of Dr. Lastra as consistent with our interpretation of that requirement⁶ and Walton’s disclosure. For instance, we credit Dr. Lastra’s testimony that: “the behavior elements of Walton correspond to the recited ‘external capabilities’ because . . . the behavior elements define behavior functions (graphic output) for creating and manipulating graphics on a display in response to behavior events (user input).” Ex. 1003 ¶ 37 (citing Ex. 1004, 13:19–41, 11:8–9, 11:23–30). We are not persuaded by Patent Owner’s response that, in Walton’s VSE system, the graphical objects themselves do not control the production of graphical images. *See* PO Resp. 24–34; Ex. 2005 ¶¶ 45–56. Rather, we credit Dr. Lastra’s rebuttal testimony that Walton’s graphical objects control how the graphical images actually are drawn:

Contrary to Patent Owner’s assertion that “the graphical objects of Walton may only be drawn by the VSE system as a whole,” once created, the graphical objects are accessed by user code to allow the graphical image information generated by the graphical objects to be “utilized in the user’s program” for producing graphical images. [Ex. 1004, 8:54–65.]

⁶ As discussed above, “external capabilities” means computer code stored outside a computer program, comprising action methods, symbol methods, or any other functions, that allow the generation of information required to produce a graphical image. *See supra* section II.A.1.

Even though Walton describes the graphics editor and view objects of the VSE system as being involved in displaying graphic images in certain contexts, it is the graphical objects that store the particular behavior functions which define specific graphical images and how they are to be drawn. *See* [Ex. 1004, 8:16–21, 9:4–8, 17:50–58, 18:15–17.] When a graphical object is called by the user source code using the behavior state name of the graphical object, the graphical objects control how the graphical images are actually drawn. *Id.*

Ex. 1011 ¶¶ 25, 26. Dr. Lastra’s rebuttal testimony is consistent with Walton’s disclosure. *See, e.g.,* Ex. 1004, 8:17–21 (“[T]he user software may be used to access the graphical object, and by providing the behavior function name and the desired behavior state, the graphical object may be manipulated on the display screen directly from user application code.”)

b. “[T]he computer program further operable to . . . delegate the production of a graphical image of the external shape to the external capabilities

We are persuaded by Petitioner that Walton also discloses “the computer program further operable to . . . delegate the production of a graphical image of the external shape to the external capabilities,” required by each of claims 1 and 8. *See* Pet. 27; Ex. 1003 ¶ 47; Ex. 1004, 11:8–9, 13:19–21, 26–40. We credit Dr. Lastra’s testimony on this point, including his analysis of Walton’s disclosure that “a graphical object in accordance with the invention must be able to draw itself if asked to do so.” *See* Ex. 1003 ¶ 47; Ex. 1004, 13:19–21. We are not persuaded by Patent Owner’s contention (*see* PO Resp. 32), or Mr. Kitchen’s testimony (*see* Ex. 2005

¶¶ 49–51), that Walton’s graphical objects really do not draw themselves. Rather, we credit Dr. Lastra’s opinion that “a person of ordinary skill in the art at the time would have recognized the opposite to be true.” Ex. 1011 ¶ 31. In support of that opinion, Dr. Lastra persuasively testifies as follows:

In particular, Mr. Kitchen contends that Walton’s disclosure that a graphical object “must be able to draw itself” is really referring to objects “graphically react[ing] in some way when selected.” Ex. 2005 at ¶¶ 49–50. However, the cited portion of Walton clearly discloses two separate functions of an object drawing itself and an object indicating that it has been selected in that a “graphical object in accordance with the invention must be able to draw itself if asked to do so *and* to indicate it has been selected.” [Ex. 1004, 13:19–22 (emphasis added).]

Id. We also credit, as consistent with Walton’s disclosure, Dr. Lastra’s testimony, set forth below, that Walton contains other passages that disclose delegating the production of a graphical image of the external shape to the external capabilities:

Walton reveals numerous different descriptions of Walton’s shapes having the ability to draw themselves. *See* [Ex. 1004, 13:26–30] (“when a value change occurs (a behavior event), *the VSE object* can change its graphical representation and *update itself on the display*” i.e., redraw itself) (emphasis added); 8:33–37 (“behavior information [of a graphical object] may represent any possible graphics transformation of a graphics object.”); 23:50–51 (“[t]he universe 420 then *tells the gray box to draw itself.*”) (emphasis added); 12:43–45 (“refreshes the screen so that *all objects . . . are told to redraw themselves.*”) (emphasis added); 25:67–26:2 (“The user then creates the desired application code and *runs the application which calls upon particular objects.*”) (emphasis added); 9:34–42.

Id.

For the reasons given, we conclude that Petitioner has shown, by a preponderance of the evidence, that claims 1 and 8 of the '633 Patent are unpatentable as anticipated by Walton.

*5. Analysis—Claims 2–4, 6, 9–11, 13,
and 15 as Anticipated by Walton*

Patent Owner argues the patentability of dependent claims 2–4, 6, 9–11, 13, and 15 based *only* on their dependency from independent claims 1 and 8. *See* PO Resp. 22, 25, 34. Accordingly, below, we discuss only the contentions and evidence of Petitioner in regard to the dependent claims.

Claims 2 and 9 each recite that “the computer program is further operable to: access an external shape stored outside the computer program, the external shape comprising an external action and an external symbol; and delegate the production of [the] graphical image of the external shape to the external action and the external symbol.” Under our claim interpretation, discussed above, “an external action” is executable computer code stored outside the computer program, and “an external symbol” is computer code stored outside the computer program that is associated with a graphical image. *See supra* section II.A.3. In connection with claims 2 and 9, Petitioner contends that Walton discloses accessing external shapes in the form of graphical objects, each external shape comprising an external symbol (graphic element) and an external action (behavior element). Pet. 27–30 (citing Ex. 1003 ¶¶ 55–61). Petitioner further contends that “Walton discloses delegating the production of [the] graphical image of the external

shape to the external action and the external symbol.” *Id.* at 30–32 (citing Ex. 1003 ¶¶ 62–66).

For the reasons discussed above in connection with claims 1 and 8, and based on Petitioner’s additional argument and evidence relating specifically to claims 2 and 9, we conclude that Petitioner has shown, by a preponderance of the evidence, that claims 2 and 9 are unpatentable as anticipated by Walton.

Claims 3 and 10 depend from claims 2 and 9, respectively. Claims 3 and 10 each recite that “the computer program is further operable to: [1] receive user input in a manner defined by the external action; and [2] manipulate the graphical image in response to the user input in a manner defined by the external symbol.” Petitioner has identified where each feature of claims 3 and 10 may be found in Walton. *See* Pet. 32–35; Ex. 1003 ¶¶ 67–72.

For the reasons discussed above in connection with claims 1, 2, 8, and 9, and based on Petitioner’s additional argument and evidence relating specifically to claims 3 and 10, we conclude that Petitioner has shown, by a preponderance of the evidence, that claims 3 and 10 are unpatentable as anticipated by Walton.

Claims 4 and 11 depend from claims 2 and 9, respectively. Claims 4 and 11 each recite that “the external action comprises a plurality of external methods and external data.” Petitioner has identified where each feature of claims 4 and 11 may be found in Walton. *See* Pet. 35–36; *see, e.g.*, Ex. 1003 ¶ 74 (quoting Ex. 1004, 9:40–42) (“Walton discloses that the external action

methods and data are accessed by user code from a stored location and that they define multiple functions and data in that ‘the user may access the stored behavior function and values for both input and output.’”).

For the reasons discussed above in connection with claims 1, 2, 8, and 9, and based on Petitioner’s additional argument and evidence relating specifically to claims 4 and 11, we conclude that Petitioner has shown, by a preponderance of the evidence, that claims 4 and 11 are unpatentable as anticipated by Walton.

Claims 6 and 13 depend from claims 2 and 9, respectively. Claims 6 and 13 each recite that “the external symbol comprises a plurality of external methods and external data.” Petitioner has identified where each feature of claims 6 and 13 may be found in Walton. *See* Pet. 36–37. Further, with respect to claim 6, Dr. Lastra testifies:

[A] POSITA would have recognized that the Walton patent discloses that the external symbol comprises a plurality of external methods and external data. For example, Walton discloses that graphical objects are saved as multiple files, each file including information for rendering the object, including graphical files (external data) and design files (external methods).

Ex. 1003 ¶ 75 (citing Ex. 1004, 11:23–30).

For the reasons discussed above in connection with claims 1, 2, 8, and 9, and based on Petitioner’s additional argument and evidence relating specifically to claims 6 and 13, we conclude that Petitioner has shown, by a preponderance of the evidence, that claims 6 and 13 are unpatentable as anticipated by Walton.

Claim 15 depends from claim 8 and recites that “the external capabilities comprise a plurality of external methods and external data.” Similar to claims 4 and 11, Petitioner has identified where each feature of claim 15 may be found in Walton. *See* Pet. 35–39; Ex. 1003 ¶¶ 83–86.

For the reasons discussed above in connection with claim 8, and based on Petitioner’s additional argument and evidence relating specifically to claim 15, we conclude that Petitioner has shown, by a preponderance of the evidence, that claim 15 is unpatentable as anticipated by Walton.

6. Conclusion

For the reasons given above, we conclude that Petitioner has shown, by a preponderance of the evidence, that each of claims 1–4, 6, 8–11, 13, and 15 of the ’633 Patent is unpatentable as anticipated by Walton.

C. Remaining Ground of Unpatentability

Based on the finding of anticipation by Walton of claims 1–4, 6, 8–11, 13, and 15, it is not necessary to reach the ground of obviousness of those claims over Eick and Kruglinski.

D. Motion to Amend

1. Introduction

Patent Owner’s Motion to Amend seeks to substitute new claims 29 and 30 for original claims 1 and 8, respectively. Mot. 1. For the reasons discussed below, Patent Owner’s Motion to Amend is *denied*.

Patent Owner’s proposed new claims are set forth below, with underlining to show language added to the original claims:

29. A computerized system comprising:
a storage medium;
a processor coupled to the storage medium;
a computer program stored in the storage medium, the computer program operable to run on the processor, the computer program further operable to:
access an external shape stored outside the computer program, the external shape comprising external capabilities;
and
delegate the production of a graphical image of the external shape to the external capabilities using an external shape template.

30. A computer program encoded on a computer-readable medium, the computer program operable to:
access an external shape stored outside the computer program, the external shape comprising external capabilities,
and
delegate the production of a graphical image of the external shape to the external capabilities using an external shape template.

Mot. 1–2. Patent Owner asserts that the newly-added feature “using an external shape template” finds support in the description of external shape template 330 set forth in the original specification. *Id.* at 3 (citing Ex. 1002, 30:4–9; Ex. 2005 ¶ 91).

2. Claim Construction

Patent Owner contends that an “external shape template” is a “generic interface for accessing capabilities of an external shape.” Mot. 4. Patent Owner argues that “the word template when used in the context in which it

is used in the claim means a preset format, pattern, or model”; and further argues that “[w]hen used in the context of accessing external capabilities, one of ordinary skill in the art would interpret the external shape template disclosed in the ’633 patent to be a type of a generic interface.” *Id.* at 5 (citing Ex. 1002, 28:25–29:2; Ex. 2005 ¶¶ 92–94; Ex. 2006⁷; Ex. 2007⁸). Patent Owner additionally argues that the description of external shape template 330 in the original specification, as comprising pointers to shapes in shape library 124, would mean to one of ordinary skill in the art that external shape template 330 is an interface that is generic in the sense that it is not specific to a particular shape or shape type. *Id.* at 5–6 (citing Ex. 1002, 28:25–29:2).

In opposition to Patent Owner’s construction, Petitioner argues that Patent Owner “offers two definitions of the word ‘template’ published long after the filing date of the ’633 patent, and then later ignores these two definitions altogether.” Opp. Mot. 4 (citing Mot. 5). Petitioner asserts that “the ’633 patent uses the term ‘external shape template’ in a manner that is consistent with its traditional plain meaning—‘one or more pointers to an external shape,’ especially when construed under the broadest reasonable interpretation [standard].” *Id.* at 5 (citing Ex. 1011 ¶ 44).

⁷ *IEEE 100: THE AUTHORITATIVE DICTIONARY OF IEEE STANDARDS TERMS* 1161 (7th ed. 2000).

⁸ *IBM Terminology*, <http://www-01.ibm.com/software/globalization/terminology/t.html> (last accessed Nov. 21, 2014).

Patent Owner counters that the Specification supports its proposed claim construction. Reply Mot. 1–2. Patent Owner asserts that external action template 332 and external symbol template 334, of external shape template 330, “reference external action methods and external symbol methods, which are ‘generic action methods’ and ‘generic symbol methods,’ respectively.” *Id.* at 1 (citing Ex. 1001, 5:55–61, 6:1–6, 6:19–39, 7:11–14, 7:17–37). Patent Owner further asserts that, as described in the Specification, the generic action methods and generic symbol methods “are not specific to any one shape” (*id.* at 1 (citing Ex. 1001, 6:28–29, 7:22–23)), but rather each is “a queryable interface” (*id.* at 1-2 (citing Ex. 1001, 6:66–7:10, 7:38–46)).

We determine that the broadest reasonable interpretation consistent with the Specification of an “external shape template” is a template (i.e., a preset format, pattern, or model) by which a computer program can access an external shape stored outside the computer program, to utilize the capabilities of the external shape. *See* Ex. 1001, 5:42–54. We do not adopt Patent Owner’s proposed construction at least because it does not capture sufficiently the meaning of “template.” We do not adopt Petitioner’s proposed construction for essentially the same reason.

3. *Patentability over the Prior Art*

In bringing a motion to amend, as the moving party, the patent owner “has the burden of proof to establish that it is entitled to the requested relief.” *See* 37 C.F.R. § 42.20(c). As explained in *Idle Free Sys., Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 7 (PTAB June 11, 2013)

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(Paper 26, “*Idle Free*”) (informative), § 42.20(c) “places the burden on the patent owner to show a patentable distinction of each proposed substitute claim over the prior art.” In that regard, there are several important requirements for a patent owner’s motion to amend claims:

A patent owner should identify specifically the feature or features added to each substitute claim, as compared to the challenged claim it replaces, and *come forward with technical facts and reasoning about those feature(s)*, including construction of new claim terms, *sufficient to persuade the Board that the proposed substitute claim is patentable over the prior art of record*, and over prior art not of record but known to the patent owner. The burden is not on the petitioner to show unpatentability, but on the patent owner to show patentable distinction over the prior art of record and also prior art known to the patent owner. Some representation should be made about the specific technical disclosure of the closest prior art known to the patent owner, and not just a conclusory remark that no prior art known to the patent owner renders obvious the proposed substitute claims.

Id. (emphasis added). While not required to prove that the claims are patentable over every item of prior art known to a person of ordinary skill, the patent owner is required to explain why the claims are patentable over the prior art of record. *Id.*; *see Microsoft Corp. v. Proxyconn, Inc.*, Nos. 2014-1542, 2014-1543, 2015 WL 3747257, at *13 (Fed. Cir. June 16, 2015) (affirming the Board’s denial of a motion to amend claims where the patent owner failed to establish the patentability of the substitute claims over the prior art of record).

The petitioner then has the opportunity, in its opposition, to argue any deficiency in the patent owner's motion and "come forward with specific evidence and reasoning, including citation and submission of any applicable prior art and reliance on declaration testimony of technical experts, to rebut the patent owner's position on patentability." *Idle Free*, slip op. at 8.

We note the following with respect to Patent Owner's Motion to Amend in this case.

On November 13, 2014, we conducted a telephone conference with counsel for the parties with regard to Patent Owner's then-contemplated motion to amend claims. On November 14, 2014, we filed an Order (Paper 20) summarizing the conference and providing guidance with respect to Patent Owner's contemplated motion.

Patent Owner filed its Motion to Amend (Paper 21) on November 21, 2014. Petitioner filed its Opposition to Patent Owner's Motion to Amend (Paper 26) on February 13, 2015. On the same date, Petitioner filed Exhibits numbered 1011–21, including Dr. Lastra's Second Declaration (Ex. 1011) and *The C++ Programming Language, Second Edition* (1991) by Bjarne Stroustrup ("the Stroustrup manual," Ex. 1014).

On March 27, 2015, Patent Owner cross-examined Dr. Lastra on his Second Declaration. On April 1, 2015, Patent Owner filed its Reply in Support of Motion to Amend (Paper 32) and a copy of the transcript of Dr. Lastra's March 27, 2015 deposition (Ex. 2008). On April 3, 2015, Patent Owner filed a Motion for Observations Regarding Cross-Examination of Dr. Lastra (Paper 35).

In its Motion to Amend, Patent Owner argues that proposed new claims 29 and 30 are patentable over the prior art on which we instituted *inter partes* review. Mot. 6. Patent Owner argues, for example, that “neither [Walton] nor [Eick] discloses the use of an external shape template in accessing what Petitioners assert are external shapes in those references.” *Id.* at 7 (citing Ex. 2005 ¶¶ 97). Patent Owner also asserts: “As far as Patent Owner is aware, Walton and Eick apparently represent the closest art.” *Id.* at 9 (citing Ex. 2005 ¶¶ 96). Patent Owner additionally asserts that its “expert, Mr. Kitchen, opines that the claims as a whole are novel and nonobvious over the state of the art at the time of filing the application that issued as the ’633 patent in October 1996 to the best of his knowledge.” *Id.* at 9–10 (citing Ex. 2005 ¶¶ 96–99). Patent Owner contends, furthermore, that “[t]he governing statute [35 U.S.C. § 316(d)] and rule for amendment [37 C.F.R. § 42.121] do not place the burden of showing patentability (*i.e.*, proving that the claims are not invalid) on Patent Owner.” *Id.* at 10.

In opposition, Petitioner argues, *inter alia*, that Patent Owner’s Motion to Amend fails to include any discussion of the ordinary skill in the art with respect to use of templates, even though Patent Owner’s declarant, Mr. Kitchen, “was well aware of the use of templates in the mid-1990’s.” Opp. Mot. 3–4 (citing Ex. 1012, 71:25–72:23). Petitioner asserts, moreover, that “use of templates for accessing code objects/classes was well known not just in the field of object-oriented programming, but specifically in the field of computer graphics programming long before the priority date of the ’633 patent.” *Id.* at 9 (citing Ex. 1011 ¶ 48).

As additional evidence that use of templates was known in the prior art, Petitioner directs us to the Stroustrup manual, which is a prior art programming manual authored by Bjarne Stroustrup, the creator of the C++ programming language. Opp. Mot. 10 (citing Ex. 1011 ¶ 48). Petitioner asserts that the Stroustrup manual includes an entire chapter devoted to use of templates in C++. *Id.* (citing Ex. 1014, 255–92). With supporting testimony from Dr. Lastra, Petitioner argues that a person of ordinary skill would have been motivated, by the advantages of templates as taught in the Stroustrup manual, to apply the teachings of the Stroustrup manual regarding templates to Walton’s VSE system, discussed above. *Id.* at 10–11 (citing Ex. 1011 ¶ 48). For example, Petitioner argues that “a POSITA would have been prompted to apply Stroustrup’s teachings regarding templates to the VSE system taught by Walton to provide ‘a powerful model for composition of code from separate parts’ and to ‘allow generic functions . . . to be defined once for a family of types’ as suggested by Stroustrup.” *Id.* at 11 (citing Ex. 1014, 276, 255; Ex. 1011 ¶ 48). Petitioner further argues that Patent Owner’s “newly added language in claims 29–30 recites nothing more than a traditional C++ feature described in standard textbooks.” *Id.* (citing Ex. 1011 ¶ 48).

Petitioner additionally argues that “even a cursory search of the patent database . . . would have revealed numerous references indicating that the technique of using a ‘template’ of ‘pointers’ to call code objects/classes was well known in the field of object-oriented programming.” Opp. Mot. 12. As examples, Petitioner directs us to the following: U.S. Patent No. 5,999,987

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to O'Farrell et al., issued December 7, 1999 (Ex. 1015); U.S. Patent No. 5,923,877 to Berner et al., issued July 13, 1999 (Ex. 1016); PCT Publication WO/1996/008765 A1 to Foody et al., published March 21, 1996 (Ex. 1017); and U.S. Patent No. 4,622,633 to Ceccon et al., issued November 11, 1986 (Ex. 1018). *Id.* at 12–13.

In reply, Patent Owner argues that “Petitioners’ resort to other references that simply teach software templates completely divorced from the context of the claimed invention cannot cure the deficiency in the cited art.” Reply Mot. 1. Patent Owner also argues:

Petitioners cite a series of references as disclosing the use of “templates in computer graphics programming.” . . . But Petitioners cannot show that the amended claims as a whole would have been obvious in combination with Walton or Eick, which are the only references that Petitioners assert disclose external shapes.

Walton’s objects are managed by Walton’s system as has been well-established in Patent Owner’s filings. . . . Walton does not disclose or suggest providing any kind of direct access to its objects to outside user code. . . . Such direct access would fundamentally change the design of Walton’s system because it would circumvent the VSE routing systems. The only thing that suggests such a design is impermissible hindsight.

Id. at 4–5 (internal citations omitted).

We determine that Patent Owner has not met its burden to show patentable distinction over the prior art of record in this case. The prior art of record includes the references adduced by Petitioner in opposition to the Motion to Amend, such as the Stroustrup manual, as well as the prior art on which we instituted *inter partes* review. *See Idle Free*, slip op. at 8.

Patent Owner has failed to come forward with sufficient technical facts and reasoning about the newly-added feature to persuade us that the proposed substitute claims are patentable over the prior art of record, of which Walton and the Stroustrup manual are representative. *See Idle Free*, slip op. at 7. Patent Owner argues that Walton does not disclose or suggest providing any kind of direct access between its objects and outside user code. Reply Mot. 5. Implicit in Patent Owner’s argument is that “using an external shape template” in Walton’s system would result in such direct access. The argument that Walton does not suggest using any kind of direct access between Walton’s objects and outside user code is undercut, however, by Walton’s express disclosure that “user software may be used to access the graphical object, and . . . the graphical object may be manipulated on the display screen directly from the user application code.” Ex. 1004, 8:16–21. Patent Owner further argues that “[s]uch direct access would fundamentally change the design of Walton’s system because it would circumvent the VSE routing systems” (Reply Mot. 5), but Patent Owner has not provided technical facts and reasoning to persuade us that using an external shape template in Walton’s system would have been beyond the skill in the art, or yielded unpredictable results. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”). As such, Patent Owner’s argument is unpersuasive.

Patent Owner has not come forward with evidence to rebut Dr. Lastra's testimony with regard to prior art use of templates. *See* Ex. 1011¶ 48. Dr. Lastra testifies that "the use of templates was well known in the field of object-oriented programming long before the filing of the '633 patent." *Id.* Dr. Lastra further testifies: "In fact, the C++ programming manual written by Bjarne Stroustrup (the widely famous creator of C++) covers in detail how to use such templates in C++ programs." *Id.* (citing Ex. 1014, 255–92).

Further, Patent Owner has not proffered evidence to rebut Dr. Lastra's testimony that a person of ordinary skill in the art would have applied the teachings of the Stroustrup manual regarding templates to Walton's VSE system. Dr. Lastra testifies that "[t]he Stroustrup reference enumerates several advantages to using templates including that templates provide 'a powerful model for composition of code from separate parts' and 'allow generic functions . . . to be defined once for a family of types.'" *Id.* (citing Ex. 1014, 276, 255). Dr. Lastra further testifies:

Based upon my review of Walton and Stroustrup, I believe that a person of ordinary skill in the art would have sought out Stroustrup's programming manual and readily applied its teachings to the system of Walton to achieve the above recited benefits, and also because it is a fundamental textbook on C++ programming written by the creator of the language. A person of ordinary skill would have been able to readily apply the teachings of Stroustrup to the system of Walton to achieve predictable and beneficial results.

Id.

Patent Owner's Motion for Observations Regarding Cross-Examination (Paper 35) does not direct us to any cross-examination of Dr. Lastra challenging the above testimony. Further, we have located no such cross-examination in our review of the March 27, 2015 deposition transcript (Ex. 2008). Accordingly, Dr. Lastra's testimony, as set forth above, is unchallenged in this proceeding.

Patent Owner argues that only hindsight suggests using an external shape template in Walton's system. Reply Mot. 5. Missing from Patent Owner's argument, however, is any analysis of the Stroustrup manual. Patent Owner has not rebutted Petitioner's evidence that the Stroustrup manual teaches advantages arising from use of templates in C++ programming that would have been applicable to Walton's system, and that, by following the teachings of the manual, a person of ordinary skill in the art predictably would have modified Walton's system to achieve the known advantages. Opp. Mot. 10–11 (citing Ex. 1011 ¶ 48). Patent Owner also has not provided technical facts or reasoning about the newly-added feature to rebut Petitioner's argument that it is "nothing more than a traditional C++ feature described in standard textbooks." *Id.* at 11 (citing Ex. 1011 ¶ 48).

In view of the above, Patent Owner's Motion to Amend is *denied*.

III. CONCLUSION

Petitioner has shown, by a preponderance of the evidence, that each of claims 1–4, 6, 8–11, 13, and 15 of the '633 Patent is unpatentable as anticipated by Walton.

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Patent Owner has not met its burden of proof in its Motion to Amend.

IV. ORDER

In view of the foregoing, it is hereby:

ORDERED that claims 1–4, 6, 8–11, 13, and 15 of U.S. Patent No. 5,959,633 are unpatentable;

FURTHER ORDERED that Patent Owner’s Motion to Amend is *denied*; and

FURTHER ORDERED that this is a final written decision and that parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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