

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

SURFCAST, INC.
Patent Owner

Case IPR2014-00271
Patent 6,724,403

Before MICHAEL P. TIERNEY, JONI Y. CHANG, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Motion for Joinder,
and Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

Microsoft Corporation (“Petitioner”) filed a Corrected Petition requesting *inter partes* review of claims 1, 3-5, 7-13, 17-28, 30-33, 35-37, 40-43, and 46-50 (“the challenged claims”) of U.S. Patent No. 6,724,403 (Ex. 1083, “the ’403 patent”). Paper 6 (“Pet.”). Petitioner also filed a Motion for Joinder of this proceeding with IPR2013-00292, which also involves the ’403 patent. Paper 2. SurfCast, Inc. (“Patent Owner”) filed an Opposition to the Motion for Joinder (Paper 14) and a Preliminary Response (Paper 17, “Prelim. Resp.”). Petitioner later requested withdrawal of its Motion for Joinder, but Patent Owner opposed withdrawal of the Motion, and we denied Petitioner’s request. Paper 18. We have jurisdiction under 35 U.S.C. § 314. For the reasons that follow, the Motion for Joinder is denied and, therefore, the Corrected Petition is denied under 35 U.S.C. § 315(b).

A. *Related Proceedings*

Petitioner indicates that the ’403 patent is involved in a co-pending district court case, *SurfCast, Inc. v. Microsoft Corp.*, No. 2:12-cv-00333 (D. Me), filed October 30, 2012. Pet. 2; Paper 10, 2. Petitioner also filed four petitions for *inter partes* review of the ’403 patent: IPR2013-00292, IPR2013-00293, IPR2013-00294, and IPR2013-00295. *Id.*

B. *The ’403 Patent*

The subject matter of the ’403 patent relates 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 independent of the others. Ex. 1083, Abstract. As described in the “Background of the Invention,” at

the time of the invention, display technologies lacked a user interface capable of presenting any type of information in a consistent manner, and in such a way that all open channels could indicate their activity on a continual basis. *Id.* at 4:24-31. In response to this need, the '403 patent describes a graphical user interface comprising a grid of tiles that resides on the user's computer desktop. *Id.* at 4:37-38. 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 4:37-41. Figure 1 is reproduced below:

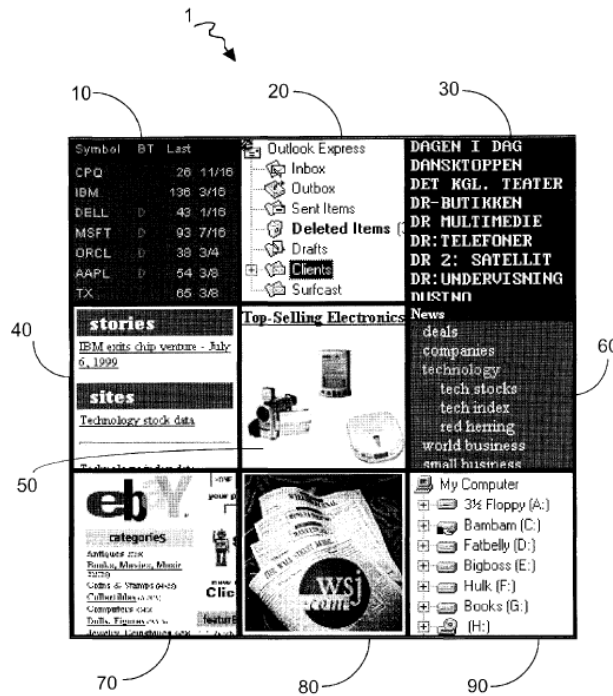


Figure 1 illustrates an embodiment of the graphical user interface.

C. Illustrative Claims

Of the challenged claims, claims 1, 22, and 46 are independent claims. Claims 1 and 22 are reproduced below:

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

selecting a plurality of information sources;

partitioning a visual display of the device into an array of tiles, wherein each tile in said array of tiles is associated with an information source in said plurality of information sources;

assigning a first refresh rate to a first tile of said array of tiles and a second refresh rate to a second tile of said array of tiles;

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

simultaneously updating information from a second information source in said plurality of information sources presented to said second tile in accordance with said second refresh rate.

22. An electronic readable memory to direct an electronic device to function in a specified manner, comprising:

a first set of instructions to control simultaneous communication with a plurality of information sources;

a second set of instructions to arrange a display into an array of tiles;

a third set of instructions to associate a first information source of said plurality of information sources to a first tile of said array of tiles and a second information source of said plurality of information sources to a second tile of said array of tiles;

a fourth set of instructions to retrieve information from said first information source in accordance with a first retrieval rate and retrieve information from said second information source in accordance with a second retrieval rate; and

a fifth set of instructions to present information to said first tile in accordance with said first retrieval rate and present

information to said second tile in accordance with said second retrieval rate.

II. ANALYSIS

A. *Factual Background*

On November 19, 2013, in IPR2013-00292, the Board denied *inter partes* review of, *inter alia*, (1) claims 1, 3-5, 7-13, 18, 19, 21-24, 26, 27, 30-33, 35-37, 40-43, and 46-50 of the '403 patent as unpatentable under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 6,118,493 (“Duhault I”); and (2) claims 1, 17, 20, 22, 25, and 28 of the '403 patent as unpatentable under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,819,284 (“Farber”). *Microsoft Corp. v. SurfCast, Inc.*, IPR2013-00292, slip op. at 38-40 (PTAB Nov. 19, 2013) (Paper 19).

On December 19, 2013, in IPR2013-00292, Petitioner filed a Request for Rehearing arguing that the Board erred in denying as redundant the ground of unpatentability based on Duhault I and the ground of unpatentability based on Farber. IPR2013-00292, Paper 23.

Also on December 19, 2013, Petitioner filed a new Petition (Paper 1) in the instant proceeding seeking *inter partes* review based on the same grounds of unpatentability on which it sought rehearing: (1) claims 1, 3-5, 7-13, 18, 19, 21-24, 26, 27, 30-33, 35-37, 40-43, and 46-50 of the '403 patent as unpatentable under 35 U.S.C. § 102 as anticipated by Duhault I; and (2) claims 1, 17, 20, 22, 25, and 28 of the '403 patent as unpatentable under 35 U.S.C. § 102 as anticipated by Farber. In addition, Petitioner filed a Motion for Joinder with IPR2013-00292. Paper 2 (“Motion”).

On January 9, 2014, Petitioner filed a corrected Petition in the instant proceeding. Paper 8.

On January 21, 2014, Patent Owner filed an Opposition to Petitioner's Motion for Joinder. Paper 14 ("Opp. to Joinder").

On January 29, 2014, in IPR2013-00292, the Board issued its Decision on Request for Rehearing. *Microsoft Corp. v. SurfCast, Inc.*, IPR2013-00292 (PTAB Jan. 29, 2014) (Paper 29). In its Decision, the Board denied Petitioner's Request for Rehearing.

On February 21, 2014, in the instant proceeding, Petitioner filed a Reply in support of its Motion for Joinder. Paper 16.

On April 7, 2014, Patent Owner filed its Preliminary Response in the instant proceeding. Paper 17.

On April 16, 2014, a conference call was held between respective counsel for Petitioner and Patent Owner, and Judges Chang and Clements to discuss Petitioner's request for authorization to withdraw its Motion for Joinder. Paper 18. Petitioner argued that authorization to withdraw its Motion for Joinder was warranted because because (1) Patent Owner took different stance in its Preliminary Response in the instant proceeding than it did in its Preliminary Response in IPR2013-00292, which Petitioner characterized as an unwarranted complication that raises estoppel questions; and (2) joining the proceedings would delay the schedule for trial in IPR2013-00292. Patent Owner opposed withdrawal of the Motion, because Patent Owner seeks an opportunity to address the grounds asserted in the Corrected Petition and, without joinder, the Corrected Petition would be filed untimely. *Id.* The Board denied Petitioner's request for authorization to withdraw the Motion. *Id.*

B. Joinder

The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(b) normally bars institution of *inter partes* review when the petition is filed more than one year after the petitioner (or the petitioner’s real party in interest or privy) is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). However, this one-year time bar does not apply to a request for joinder. 35 U.S.C. § 315(b) (“The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).”); 37 C.F.R. § 42.122(b). This is an important consideration here because Petitioner was served with a complaint asserting infringement of the ’403 patent more than one year before filing this petition.¹ Thus, absent joinder of this proceeding with IPR2013-00292, the petition would be barred.

We are not persuaded that Petitioner has shown that joinder is justified. As Patent Owner correctly points out, the Petition does not identify any new grounds of unpatentability. Opp. to Joinder 8-9. Instead, it reasserts two grounds of unpatentability previously asserted in IPR2013-

¹ Petitioner was served with a complaint alleging infringement of the ’403 patent on October 30, 2012. Motion 1. Petitioner filed its Petition in the instant proceeding on December 19, 2013.

00292. Moreover, joinder would have a significant impact on the schedule of IPR2013-00292, and we are not persuaded by Petitioner's assertion that the Board can manage the joined proceeding in a way that does not impact the scheduling or conduct of the proceedings. *Id.*

On the record before us, Petitioner has not shown that joinder is justified.

III. CONCLUSION

The Board denies the Motion for Joinder and, therefore, denies the Corrected Petition because it was not filed within the time limits imposed under 35 U.S.C. § 315(b).

IV. ORDER

Accordingly, it is
ORDERED that the Motion for Joinder is *denied*; and
FURTHER ORDERED that the Corrected Petition is *denied* and no trial is instituted.

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