

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner,

v.

B.E. TECHNOLOGY, LLC,
Patent Owner

Case IPR2014-00040
Patent No. 6,771,290

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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I. Kikinis Anticipates Claim 1-2 of the '290 Patent

The Board found the evidence presented with the Petition sufficient to show that claims 1-2 of the '290 patent are anticipated by Kikinis. Decision at 11-19. In response, Patent Owner proposes strained descriptions of Kikinis unsupported by any credible evidence, and tries to improperly import limitations from the '290 patent specification. For the reasons below, the Board should maintain its determination that claims 1-2 are unpatentable.

A. Patent Owner Advances Constructions Inconsistent with Rule 42.100(b)

Patent Owner criticizes Kikinis as not describing a “direct” or “one-click” method of accessing remote files. Response at 1-5, 10-18, 34-35. This theory rests on Patent Owner’s confusion about the Board’s policy, articulated in Rule 42.100(b), of giving the claims their broadest reasonable interpretation consistent with the specification. *Vibrant Media, Inc. v. G.E. Co.*, IPR2013-00170, Paper 56 at 5 (PTAB June 26, 2014). In particular, as explained below, Patent Owner advances a meaning of “program” that would improperly import material limitations into the claims that is inconsistent with the plain language of the claims and the specification.

In proceedings before the Board, if a patent owner wishes a claim to exclude subject matter encompassed by its literal terms, the patent owner must amend the claims to expressly exclude that subject matter. The policy underlying this rule is

sound – it functions to ensure that the actual claim language is clear and precisely defines the bounds of the subject matter over which rights are granted. *See, e.g., SAP Am., Inc. v. Versata Dev. Grp., Inc.*, CBM2012-00001, Paper 70 at 7-8 (PTAB June 11, 2013) (“Through the use of the broadest reasonable interpretation standard, the Office is able to encourage inventors to amend their claims to remove uncertainties and over breadth of claim scope.”). Patent Owner’s arguments in this case vividly demonstrate why this rule exists – here, Patent Owner is seeking to import *significant unclaimed limitations* into the claims to avoid subject matter disclosed in Kikinis, which the claims, *by their actual language*, encompass.

Here, the Board found that Kikinis discloses a “program” of claims 1 and 2 of the ’290 patent. Decision at 14-18. Patent Owner does not dispute that the web browser of Kikinis is a program, is stored on the client computer or is used to access remotely stored documents. Response at 11-15. Instead, Patent Owner contends that Kikinis does not disclose a “program” within the meaning of the claims because it believes the claims should be read – contrary to their plain language and the specification of the ’290 patent – as encompassing only programs that provide “*direct*” access to electronic documents. Response at 2,11-15; *see also* Ex. 2003 at 24:3-23. Thus, Patent Owner contends that Kikinis does not disclose “a program stored on [a] non-volatile data storage device” that performs the specified functions of claims 1 and 2. Response at 10-18.

Patent Owner's attempt to distinguish Kikinis using its contorted reading of the claim term "program" should be rejected. Specifically, Patent Owner contends Kikinis does not describe a "program" per the claims because the web browser in Kikinis "requires remotely stored programs to access the remotely stored electronic documents." Response at 11. That construction rests on its incorrect and unsupported assertion that the claimed process cannot "utilize programs stored on servers to perform" the functions specified in claims 1 and 2. Response at 2; *see also* Response at 11. Patent Owner also asserts the browser in Kikinis "does not access the electronic document data base without additional software programs stored on remote servers," Response at 17, and "cannot access data sets or files in response to the selection of associated user-selectable items without initiating additional server-based programs." Response at 2. To support its contentions, Patent Owner asserts a person skilled in the art "understands that a system utilizing server-side CGI and remote server programs teaches a different system than the one disclosed in the '290 patent." Response at 13.

Patent Owner's distinctions are illusory as they are in conflict with the plain language of the claims, are contrary to the '290 specification and are contrary to the testimony of its own expert. Notably, the specification of the '290 patent defines a "server" as "[a] computer on a network that stores information and **that answers requests for information.**" Ex. 1001 at 4:65-66 (emphasis added). For

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