Consolidated Nos. 24-1156, 24-1160, 24-1161, and 24-1162

United States Court of Appeals
For the Federal Circuit

SURFCAST, INC.,
Appellant,

v.

MICROSOFT CORPORATION,
Appellee.

Appeal from the Patent Trial and Appeal Board,
Case Nos. IPR2022-00423, IPR2022-00590,
IPR2022-00591, and IPR2022-00592

APPELLANT SURFCAST, INC.'S COMBINED PETITION FOR PANEL REHEARING AND REHEARING *EN BANC*

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SURFCAST, INC.

July 7, 2025

CERTIFICATE OF INTEREST

Counsel for Appellant SurfCast, Inc. certifies the following:

1. The full name of every party represented by me is: SurfCast, Inc.

2. The name of the Real Party in Interest represented by me is: SurfCast, Inc.

3. All parent corporations and publicly held companies that own 10 percent or more of the stock of the party represented by me are: N/A.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Taft Stettinius & Hollister, LLP – Brian S. Seal, Shaun D. Gregory, Jason A. Houdek

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this Court's decision in the pending appeal: *SurfCast, Inc. v. Microsoft Corporation*, No. 2:22-cv-01298-JNW (W.D. Wash.).

Any information required under Fed. R. App. P. 26.1(b) and 26.1(c): N/A.

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STATEMENT OF COUNSEL UNDER RULE 35(b)(2)

The Panel's Rule 36 affirmance conflicts with decisions of this Court, including *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). Based on my professional judgment, I believe rehearing is necessary to secure and maintain uniformity of this Court's decisions. The rehearing would address the following questions:

1. Whether the Panel failed to apply its own precedent in Phillips and subsequent cases when reviewing the PTAB's claim construction.

2. Whether the Panel erred in upholding the PTAB's claim construction based on plain and ordinary meaning, and more particularly, erred in not recognizing that the inventors' lexicography overcomes any plain and ordinary meaning.

Based on my professional judgment, I believe the Panel's decision is contrary to the following regulations and decisions of this Court:

- *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*) ("Consistent with that general principle, our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs."); and

- *Trustees of Columbia Univ. in City of New York v. Symantec Corp.*, 811 F.3d 1359, 1364 (Fed. Cir. 2016) (express disclaimer not required to overcome plain and ordinary meaning).

- *Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC*, 57 F.4th 1001, 1010 (Fed. Cir. 2023) (the specification may define terms by implication).

Dated: July 7, 2025

/s/ Brian S. Seal
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For Appellant

I. INTRODUCTION

Despite the established rules of claim interpretation issued by this Court in *Phillips* and in other decisions, the PTAB adopted a plain and ordinary meaning construction contrary to the inventors' lexicography in violation of this Court's precedent. Then, armed with a faulty claim interpretation, the PTAB proceeded to find the challenged claims invalid when, following a proper claim interpretation under *Phillips*, the challenged claims would have been found valid.

Specifically, the PTAB wrongfully departed from the *Phillips* standard by interpreting the term "grid" in U.S. Patent No. 9,946,434 (the "'434 Patent") and U.S. Patent No. 9,032,317 (the '317 Patent") simply to mean a regular arrangement of content into rows and columns, when the inventors acted as their own lexicographers to define a grid as a structure separate from that content and that enforces conformity by controlling the layout and properties of that content. The incorrect construction was the basis for the PTAB's determination that the claims of the '434 and '317 Patents were not patentable. No written, reasoned opinion from this Panel supports the PTAB's finding of invalidity. The absence of a written opinion masks the PTAB's improper departure from the *Phillips* standard and risks a continued and expanded departure from that standard going forward.

II. POINTS OF FACT OR LAW OVERLOOKED OR MISAPPREHENDED BY THE PANEL OF THE COURT

The Panel overlooked the inventors' defintional statements that a grid, as claimed in the '434 and '317 Patents, is a structure (also identified as a "grid object") that exists separate from a tile and that controls the tiles and the properties of those tiles. Br. at 36-37. Under the proper construction, the Board's decision requires reversal as the prior art "grid" on which it relied is an arrangement of content into rows and columns, but has no separate underlying grid structure and does not control the tiles and tile properties.

III. ARGUMENT

Although claim terms in a patent generally receive their plain and ordinary meaning, "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*). Here, despite the inventors acting as their own lexicographers for the term "grid," the PTAB applied plain and ordinary meaning. Appx51 (applying "the everyday meaning" of the term "grid"). The Panel's summary affirmance perpetuates that error and creates confusion about the priority of lexicography over plain and ordinary meaning under *Phillips*.

A. The inventors defined a "grid" as a structure separate from a tile that also controls the tiles and tile properties.

The '434 and '317 Patents claim a graphical interface that combines refreshable images called "tiles" (or "tile objects") with an organizational structure called a "grid" (or a "grid object"). Br. at ii, iv. "Together, the grid and tiles comprise the application through which a user can view simultaneously information from a multitude of available sources including multiple sites on the Internet or some other distributed computer network …." Appx199 at 15:3-6. Fig. 1 shows an exemplary grid of nine tiles as it might appear on a user's display screen:

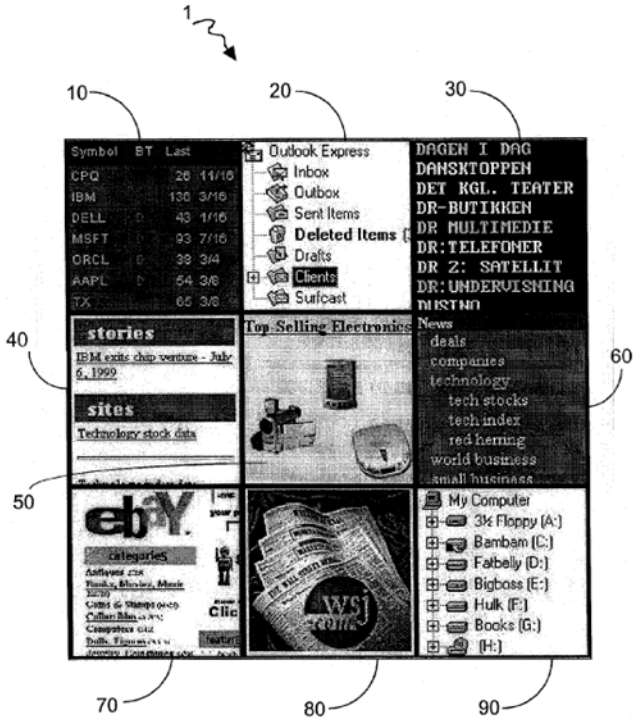

Fig. 1

Appx165 (Fig. 1); Appx194 at 6:32-34. In turn, Fig. 12 shows a schematic data structure of a grid object:

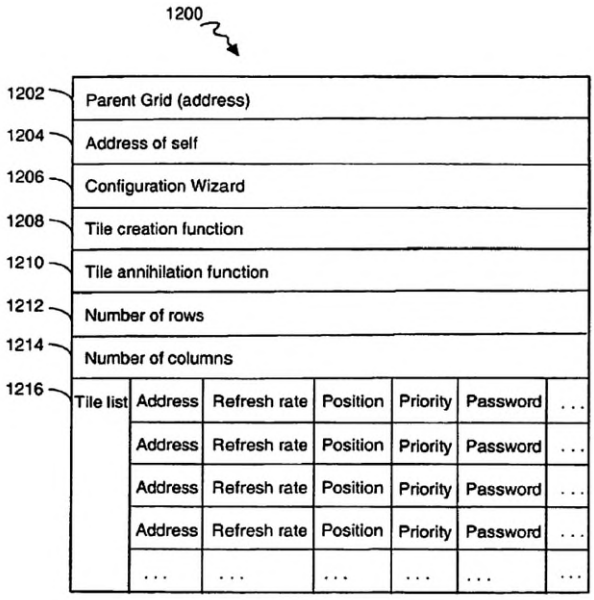

Fig. 12

Appx176 (Fig. 12); Appx199 at 16:60-61.

Referring to the invention as a whole, the patentees defined a "grid" as a structure that is separate from the tiles it contains. Br. at 37 ("the specification defines a 'grid' as a particular structure (also called a 'grid object') that imposes a rule to control the layout of tiles contained in the grid across various arrangements and configurations."). "Grid" and "grid object" are used synonymously. Appx200 at 17:58-61.

The '434 Patent, for example, introduces a "Grid Object" (Appx244-47 at 14:35-19:36), describes the grid as a "matrix or array of tiles" (Appx244 at 14:44-45), and declares that "[t]he grid controls the layout and properties of the tiles" (*id*.

at 14:49-50). The grid structure includes presentational attributes that include "its dimensions (i.e., the number of tiles to display and their arrangement), and the programs or files to be associated with each tile." Appx245 at 15:20-23. "The grid also understands the interests of the user and acts as a repository for passwords and identifiers." *Id*. at 15:59-60. "[A] grid comprises instructions for assigning tile size intelligently when a user specifies, or receives, a number of tiles." *Id*. at 16:57-59. "Significantly, the grid manages the flow of information to the tiles." Appx246 at 17:24-25. The '317 Patent includes identical language. *See* Appx335-37 at 14:8-18:67; Appx335 at 14:17-18, 22, 59-61; Appx336 at 15:30-31; *Id*. at 16:25-27, 58-59).

The '434 Patent clearly defines the grid object as:

> The grid object stores the number of rows 1212 and the number of columns 1214 of tiles that are present. The grid also stores a tile list 1216 containing attributes of each respective tile. In particular, the address of each tile, its priority and its refresh rate are stored by the grid program. The grid also stores other attributes of tiles such as their respective positions on the grid as given by their column and row number. The priority of a tile may be used to determine its refresh rate in some embodiments of the present technology. A tile can have a password feature built into it if it is desired to restrict access to the tile's content.

Appx246 at 18:19-29. The '317 Patent includes this identical definitional language. *See* Appx337 at 17:51-61. Each of these statements, as well as the statements above, are definitional and reference the grid as an inventive whole without the use of exemplary language or reference to a particular embodiment. *See*

Appx244-47 at 14:35-19:36; Appx335-37 at 14:8-18:67 (introducing and describing a "grid object" generally).

The relationship between a grid and the tiles it contains is similar to the relationship between an egg carton and the eggs it contains. Appx10670 at ¶¶ 110-111. As such, the grid enforces conformity in the positioning of the tiles/eggs by controlling them and their properties. Reply Br. at 12.

This Court's decision in *Phillips* confirmed the longstanding principle that, when an inventor acts as a lexicographer, "the inventor's lexicography governs." *Phillips*, 415 F.3d at 1316. Here, as noted above, the inventors defined a grid as a structure ("grid object") that is separate from the tiles ("tile objects") and that "controls the layout and priorities of the tiles." Appx198 at 14:28. That definition, which covers the invention as a whole, is arguably explicit, but is at a minimum implicit. *Trustees of Columbia University in City of New York v. Symantec Corp.*, 811 F.3d 1359, 1362 (Fed. Cir. 2016) (express disclaimer not required to overcome plain and ordinary meaning); *Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC*, 57 F.4th 1001, 1010 (Fed. Cir. 2023) (the specification may define terms by implication).

In an earlier proceeding involving the parent application to the '434 and '317 Patents with the same specification, the district court expressly found that the inventors acted as their own lexicographer for the term "grid":

> [T]he patentee here shows his intent to act as his own lexicographer with respect to "grid." The specification provides a section entitled "Grid Object" that explains that it will teach what a "grid" is in the context of the patent. '403 Patent at 10:40-43. This section of the specification then goes on to give numerous details of a "grid." For instance, it is a "matrix of tiles," *id*. at 10:49; it "controls the layout and properties of the tiles," *id*. at 10:53-54; and its presentational attributes are "its dimensions (i.e., the number of tiles to display and their arrangement), and the programs or files to be associated with each tile." *Id*. at 11:10-12.

SurfCast, Inc. v. Microsoft Corp., 6 F. Supp. 3d 136, 175-76 (D. Me. Mar. 14, 2014). The same analysis applies here.

SurfCast's proposed construction of the term "grid" to mean "a regular arrangement of rows and columns, the regular arrangement enforcing conformity to the positions delimited by the rows and columns continuously," Br. at 18, captures that requirement as mandated by *Phillips*. As a separate object, the grid enforces conformity of the tiles by controlling the tiles and their properties, including controlling where the tiles may be placed into the rows and columns of the grid, just as the egg carton described above controls where the eggs may be placed. Br. at 17.

The Board's construction, summarily affirmed by the Panel, discarded the inventors' lexicography. The Board construed the term "grid" to mean only "a regular arrangement of rows and columns," with no separate structural requirement or any requirement of controlling the tiles and their properties such as enforced conformity. Opp. Br. at 56; Appx51. Despite acknowledging the references to the specification described above, the Board found that they were "not consistent with

the ordinary meaning of the word grid, which simply describes the arrangement of the elements" without imposing any additional requirements. Appx50. As shown above, the absence of such requirements impermissibly ignores the inventors' definitional distinction between grids and tiles. As such, the Board's construction cannot stand.

B. The alleged "grid" in MSIE Kit is neither separate from the tiles nor controls the tiles and tile properties.

The Board's failure to recognize the distinction between a grid and the tiles it contains led directly to an incorrect invalidation decision. The prior art reference on which the Board relied to invalidate the claims of the '434 and '317 Patents—the Microsoft Internet Explorer ("MSIE") Kit—does not disclose a grid structure that is separate from its alleged "tiles" and thus cannot invalidate those claims.

The Board concluded that MSIE Kit disclosed tiles in the form of windows called "Active Desktop items" that appear on a user's display and that MSIE Kit displayed those Active Desktop items in an arrangement of rows and columns. Appx52-54; Appx144-45. In particular, the Board relied on the following statement from MSIE Kit as evidence of the alleged "grid":

> By default, Internet Explorer lays out new Active Desktop items on a 3 by 2 grid. As more items are added to the desktop, they will start to overlap each other. For a desktop at a resolution of 640 x 480, allowing for reasonable spacing between items, this would translate into a size of no more than 200 x 200 pixels. This size specification is merely a guideline. Internet Explorer 4 does not itself enforce any restrictions on the size of an Active Desktop item.

Appx2943. Beyond that default layout, MSIE Kit's placement of Active Desktop items is arbitrary. Br. at 56; Appx2935. In any event, simply arranging Active Desktop items into rows and columns does not create a separate grid as that term is properly construed, nor does it control the tiles or tile properties, including enforcing conformity as the existence of a separate grid requires. If one were to remove the Active Desktop items from the display described above, the alleged "grid" would disappear.

Indeed, there is no showing anywhere in the record that MSIE Kit discloses a grid that exists independently from the Active Desktop items themselves. As a result, there is no evidence that the prior art MSIE Kit discloses a grid as that term is properly construed and the Board's decision requires reversal.

CONCLUSION

Because the prior art does not disclose a grid under the proper construction of that term, the Board's decisions in IPR2022-00591 and IPR2022-00423 should be reversed.

Date: July 7, 2025

/s/ Brian S. Seal

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CERTIFICATE OF COMPLIANCE

The foregoing petition complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because the petition has been prepared using a proportionally spaced typeface and includes 2,638 words, excluding the parts exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b).

Date: July 7, 2024

/s/ Brian S. Seal
Brian S. Seal

NOTE: This disposition is nonprecedential.

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Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2022-00423, IPR2022-00590, IPR2022-00591, IPR2022-00592.

JUDGMENT

BRIAN SHERWOOD SEAL, Taft Stettinius & Hollister LLP, Washington, DC, argued for appellant. Also represented by SHAUN DARRELL GREGORY; JASON A. HOUDEK, Indianapolis, IN.

JOSHUA JOHN FOUGERE, Sidley Austin LLP, Washington, DC, argued for appellee.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (DYK, SCHALL, and CHEN, *Circuit Judges*).

AFFIRMED. *See* Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

June 4, 2025
Date

Jarrett B. Perlow
Clerk of Court