

No. 25-

IN THE
Supreme Court of the United States

SURFCAST, INC.,
Petitioner,

v.

MICROSOFT CORPORATION,
Respondent.

On Petition for a Writ of Certiorari to the United
States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Section 144 of the Patent Act directs the Federal Circuit to decide appeals from the Patent Trial and Appeal Board (PTAB) by issuing “opinion[s].” 35 U.S.C. § 144. Congress had also required the Federal Circuit’s predecessor to issue opinions in patent agency appeals. And it made sense for Congress to retain that reasoning-giving directive when it created the Federal Circuit: the court’s man-date was to clarify the legal standards for invention patents. Uncertainty stifles innovation. The Federal Circuit’s first Chief Judge, the Honorable Howard T. Markey, thus said: “In our Court there will be an opinion explaining enough to tell you what the law is in every case.” He added: “We do not just render a one-worded decision and go away.” In recent years, though, the Federal Circuit has routinely issued one-word “judgment[s] of affirmance without opinion” under Federal Circuit Rule 36(a), saying only “AFFIRMED” rather than issuing an opinion. That happened here. The PTAB invalidated claims in SurfCast’s issued patents through *inter partes* review, a process that flouts due-process principles; and the Federal Circuit summarily affirmed. SurfCast has thus been deprived of vested property rights, yet no court has ever explained why, despite the guidance of § 144.

The question presented is: Whether 35 U.S.C. § 144, which requires the Federal Circuit to issue “opinion[s]” in PTAB appeals, is a reasoning-giving directive that prohibits the Federal Circuit’s practice, under Federal Circuit Rule 36(a), of summarily affirming PTAB decisions without issuing opinions.

PARTIES TO THE PROCEEDINGS

Petitioner

- SurfCast, Inc.

Respondent

- Microsoft Corporation

RULE 29.6 STATEMENT

SurfCast has no parent corporation and no publicly held corporation owns 10% or more of its stock.

LIST OF PROCEEDINGS

U.S. Court of Appeals for the Federal Circuit,
SurfCast, Inc. v. Microsoft Corp.,
Nos. 24-1156, 24-1160, 24-1161, and 24-1162
Denial of Petition for Panel Rehearing and
Rehearing *En Banc*: August 6, 2025

Patent Trial and Appeals Board
Nos. IPR2022-00591, IPR2022-00423
Microsoft Corp. v. SurfCast, Inc.,
Date of Final Decision: October 2, 2023

U.S. Court of Appeals for the Federal Circuit,
SurfCast, Inc. v. Microsoft Corp.,
Nos. 24-1156, 24-1160, 24-1161, and 24-1162
Date of Final Judgment: June 4, 2025

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PETITION FOR A WRIT OF CERTIORARI

SurfCast respectfully requests a writ of certiorari to review the judgment of the U.S. Court of Appeals for the Federal Circuit.

DECISIONS BELOW

The Federal Circuit's judgment is unreported but available at *SurfCast, Inc. v. Microsoft Corporation*, No. 2024-1156, 2025 WL 1576569 (Fed. Cir. June 4, 2025). It is reprinted in the Appendix to the Petition (App.) at App. 1a-2a. The final written decision of the PTAB is unreported but reprinted at App. 3a-38a.

JURISDICTION

The Federal Circuit entered its judgment on June 4, 2025. SurfCast filed a Combined Petition for Panel Rehearing and Rehearing *En Banc*, which the Federal Circuit denied on August 6, 2025. This petition is thus timely filed under Sup. Ct. R. 13. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

35 U.S.C. § 144 provides

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its

determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

STATEMENT OF THE CASE

Under § 144 of the Patent Act, the Federal Circuit “shall issue” an “opinion” in an appeal from a final decision by the Patent Trial and Appeal Board (PTAB), an administrative body of the U.S. Patent and Trademark Office (PTO). 35 U.S.C. § 144. The word *opinion* has deep roots in American law. It is a legal term of art. Since the founding, it has meant—and it still means—a court’s statement of reasons for its decision. It is distinct from the *judgment*, which is the final determination of the parties’ rights.

Congress understood—or must be presumed to have understood—that by requiring the Federal Circuit to issue an *opinion* in a PTAB appeal, it was requiring the Federal Circuit to give reasons for its decision. When Congress employed *opinion*, Congress swept in the word’s old soil: a rich history and tradition, in American legal culture, of calling a court’s statement of reasons an *opinion*. Indeed, reasoning-giving is at the heart of the cluster of ideas constituting the term.

Here, however, the Federal Circuit summarily affirmed the PTAB’s patent-invalidation decisions under Federal Circuit Rule 36—without issuing opinions and saying only “AFFIRMED.” The Federal

Circuit therefore violated § 144. As a result of the Federal Circuit's statutory violations, no court has ever explained to SurfCast and numerous other technology companies why claims in their already issued patents were invalidated, and why their vested property rights were canceled.

Congress had good reason to require the Federal Circuit to give reasons. From 1929 to 1982, the Federal Circuit's predecessor, the Court of Customs and Patent Appeals (CCPA), was statutorily required to issue "opinion[s]" in appeals from the PTO's predecessor, the Patent Office. 28 U.S.C. § 216 (repealed 1982). After Congress replaced the CCPA with the Federal Circuit in 1982, Congress promptly revived the statutory opinion-writing requirement. By requiring the Federal Circuit to give reasons for its decisions in patent agency appeals, Congress promoted the very point of the Federal Circuit: to bring uniformity, stability, and coherence to the legal standards for invention patents. So in 1984, Congress amended 35 U.S.C. § 144 to its current form. The Federal Circuit's first Chief Judge, the Honorable Howard T. Markey, declared: "In our Court there will be an opinion explaining enough to tell you what the law is in every case." *The First Annual Judicial Conference of the United States Court of Appeals for the Federal Circuit*, 100 F.R.D. 499, 511 (1983) ("We do not just render a one-worded decision and go away.").

Interpreting § 144 as a reasoning-giving requirement also makes sense, and cannot be an absurd literalism, given that reasoning-giving serves multiple

adjudicative goals: accountability, transparency, perceived legitimacy, accuracy, and dignity, to name a few. As Professor Mary Ann Glendon put it, the “[d]iscipline of writing out the reasons for a decision and responding to the main arguments of the losing side has proved to be one of the most effective curbs on arbitrary judicial power ever devised.” *A Nation Under Lawyers: How the Crisis in the Legal Profession is Transforming American Society* 147-48 (1994).

Resisting an atextual interpretation of § 144 avoids serious constitutional problems, as well. Here, the PTAB invalidated claims in SurfCast’s patents through *inter partes* review, a highly idiosyncratic administrative process where a panel of PTAB members reassesses the validity of already issued patents. The PTO Director, a political appointee, decides which PTAB members will serve on a particular panel, and how many, and determines their salary. They receive bonuses based on their productivity and commitment to the PTO’s mission. They decide both (i) whether to institute an *inter partes* review (based on a petition, brought by anyone who does not own the patent, challenging the patent), and (ii) whether to invalidate the patent (based on the petitioner’s and the patent-holder’s papers). Additional petitioners may join the *inter partes* review midstream, and if all the petitioners drop out, the PTAB panel may proceed. Given *inter partes* review’s deviations from the principles of judicial independence and justiciability that underlie our Article III courts, due process may very well demand that if a patent holder challenges, in the Federal Circuit, an *inter partes* review that

invalidated an already issued patent, the Federal Circuit must give reasons for its decision.

The question presented is important and recurring, and this case is an ideal vehicle to resolve it. Inventors, technology companies, parties before the PTAB and the Federal Circuit, the patent bar, judges (including former Federal Circuit judges), and scholars have been protesting the Federal Circuit's use of Rule 36 for several years. The chorus of criticism is only growing louder. The petition for certiorari should be granted.

REASONS FOR GRANTING THE PETITION

I. THE FEDERAL CIRCUIT'S RULE 36 PRACTICE OF SUMMARILY AFFIRMING PTAB DECISIONS WITHOUT ISSUING OPINIONS VIOLATES THE PATENT ACT.

A. Section 144 of the Patent Act Requires the Federal Circuit to Issue an Opinion.

Under § 144 of the Patent Act—titled “Decision on Appeal”—the Federal Circuit “shall review the decision from which an appeal is taken on the record before the [PTO],” and “[u]pon its determination, the court shall issue to the Director [of the PTO] its mandate *and opinion*, which shall be entered of record in the [PTO] and shall govern the further proceedings in the case.” 35 U.S.C. § 144 (emphasis added); *see also id.* § 141 (showing that § 144 applies to PTAB appeals).

When Congress amended § 144 of the Patent Act in 1984¹ to require the Federal Circuit to issue an “opinion” in an appeal from the PTAB, Congress knew—or it must be presumed to have known—that it was requiring the Federal Circuit to issue a statement of reasons for its decision. An *opinion* is a legal term of art with a settled meaning: a court’s “expression of the reasons why a certain decision (the judgment) was reached in a case.” *See* BLACK’S LAW DICTIONARY 985 (5th ed. 1979). An *opinion* is distinct from a *judgment*, which is the “final decision of the court resolving the dispute and determining the rights and obligations of the parties.” *Id.* at 755. A *mandate*, meanwhile, is an appellate court’s order “directing action to be taken, or disposition to be made of case,” by the “inferior” adjudicative body, *id.* at 867; *see also Comm’r v. Bedford’s Est.*, 325 U.S. 283, 287 (1945) (distinguishing “Opinion” from “Order for Mandate”); *Rogers v. Hill*, 289 U.S. 582, 587 (1933) (“The court’s decision of a case is its judgment thereon. Its opinion is a statement of the reasons on which the judgment rests.”).

What is more, “[w]here Congress borrows terms of art in which are accumulated the legal tradition and meaning of centuries of practice, it presumably knows and adopts the cluster of ideas that were attached to each borrowed word in the body of learning from which it was taken and the meaning its use will convey to the

¹ *See* Act of Nov. 8, 1984, Pub. L. No. 98-620, title IV, § 414(a), 98 Stat. 3363 (1984).

judicial mind unless otherwise instructed.” *Molzof v. United States*, 502 U.S. 301, 307 (1992) (discussing *punitive damages*) (quoting *Morissette v. United States*, 342 U.S. 246, 263 (1952)). Put differently, “[w]hen a statutory term is obviously transplanted from another legal source, it brings the old soil with it.” *Taggart v. Lorenzen*, 587 U.S. 554, 560 (2019) (punctuation omitted).

An *opinion* is a legal term of art with a rich history and tradition, and its meaning has never wavered. As Thomas Jefferson recounted: “From the earliest ages of English law, from the date of the year-books, at least, to the end of the II^d George, the judges of England in all but self-evident cases, delivered their opinions seriatim, with the reasons and authorities which governed their decisions.” Karl M. ZoBell, *Division of Opinion in the Supreme Court A History of Judicial Disintegration*, 44 CORNELL L. REV. 186, 190 (1959) (quoting Paul L. Ford, *The Writings of Thomas Jefferson* 223-25 (1899) (quoting Letter to Justice William Johnson (1822))). The premise of Jefferson’s preference for seriatim opinion delivery was that *opinions give reasons*—in a seriatim system, no judge can hide. *Id.* at 194. As a fledgling institution, this Court adopted the tradition of the King’s Bench and delivered “opinions” seriatim, which resulted in the Court’s speaking “with multiple voices”—precisely because, again, *opinions give reasons*. William P. McLauchlan, “Opinions, Assignment and Writing Of,” in *The Oxford Companion to the Supreme Court of the United States* 705 (Kermit L. Hall. ed., 2d ed. 2005). Chief Justice Marshall stopped the seriatim custom, and during his stewardship, this Court started rendering a

univocal “opinion of the Court”—a reasoning-giving document. *Id.*

Today, of course, “[o]pinions announce the decision(s) reached by the Supreme Court and explain the reasons for those results.” *Id.* This Court also issues concurring and dissenting opinions, which offer alternative reasons, or what to the author should have been the reasons. *See id.* And beyond this Court, the understanding of *opinion* as a reasoning-giving document has remained a fixture of American legal culture more generally. *See* GARNER’S DICTIONARY OF LEGAL USAGE 636 (3d ed. 2011). The old soil therefore resolves the statutory-interpretation question presented: when Congress, in § 144, directed the Federal Circuit to issue an “opinion,” Congress was imposing a reasoning-giving obligation on the court.

Here, however, the Federal Circuit summarily affirmed the PTAB under Federal Circuit Rule 36. That rule provides: “The court may enter a judgment of affirmance without opinion, citing this rule, when it determines” (i) that “an opinion would have no precedential value” and (as relevant here) (ii) that either “the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review,” or “a judgment or decision has been entered without an error of law.” Fed. Cir. R. 36(a).²

² The Federal Circuit promulgated its Rule 36 in 1989, five years after § 144 took its current form. *The Seventh Annual Judicial*

In summarily affirming the PTAB under Rule 36 without issuing an opinion, the Federal Circuit violated § 144’s plain text. There is no sense in which a Rule 36 summary affirmance is an *opinion*. Rather than stating reasons, the document states “AFFIRMED.” Rule 36(a) itself says that the document it authorizes is a “judgment of affirmance” that the court may enter “without opinion.” Fed. Cir. R. 36(a). And the Federal Circuit recognizes that a Rule 36 summary affirmance (i) “simply confirms” that the adjudicative body below “entered the correct judgment” and (ii) “does not endorse or reject any specific part” of the “reasoning” under review. *Phil-Insul Corp. v. Airlite Plastics Co.*, 854 F.3d 1344, 1354-55 (Fed. Cir. 2017) (citation and punctuation omitted).

Nor may the Federal Circuit seek refuge in 28 U.S.C. § 2071(a). That statute authorizes courts to “prescribe rules for the conduct of their business,” but it proceeds to state: “Such rules shall be consistent with Acts of Congress.” *Id.* Rule 36 is inconsistent with § 144.

B. The Context Confirms That § 144 Is a Reasoning-Giving Directive.

Even if there were reason to look beyond the text, § 144’s surrounding context reinforces the conclusion that the statute means what it says.

Statutory history is relevant when, as here, it is an “important part” of the context. *See United States v.*

Conference of the United States Court of Appeals for the Federal Circuit, 128 F.R.D. 409, 420 (1989).

Hansen, 599 U.S. 762, 775 (2023). In 1929, Congress created the Court of Customs and Patent Appeals (“CCPA”), the Federal Circuit’s predecessor, and directed that “[t]he opinion of the Court . . . in every case on appeal from decision of the Patent Office shall be rendered in writing, and shall be filed in such case as part of the record thereof, and a certified copy of said opinion shall be sent to the Commissioner of Patents and shall be entered of record in the Patent Office.” Act of Mar. 2, 1929, ch. 488, § 3, 45 Sta. 1475, 1476 (1929).

In 1948, that requirement was codified at 28 U.S.C. § 216. *See* Act of June 25, 1948, ch. 646, 62 Stat. 899 (1948) (codifying 28 U.S.C. § 216 (“The Court of Customs and Patent Appeals, on each appeal from a Patent Office decision, shall file a written opinion as part of the record and send a certified copy to the Commissioner of Patents who shall record it in the Patent Office.”)). That provision remained on the books until 1982, when Congress scrapped the CCPA, repealed the statutory chapter governing it, and created the Federal Circuit—which, unlike the CCPA, would have exclusive jurisdiction over patent appeals, including from district courts, and which was accordingly positioned to unify patent law. *See* Pub. L. No. 97-164, 96 Stat. 28 (1982); 28 U.S.C. § 216 (repealed 1982).

Then, in 1984, § 144 of the 1952 Patent Act was amended from (i) its prior form, which operated alongside 28 U.S.C. § 216 and required the CCPA to return “to the Commissioner a certificate of its proceedings and decision, which shall be entered of

record in the Patent Office and govern the further proceedings in the case,” *see* Act of July 19, 1952, Pub. L. No. 593, § 144, 66 Stat. 792, 802 (1952), to (ii) its current form, which requires the Federal Circuit to issue to the PTO Director its “mandate and opinion,” *see* Act of Nov. 8, 1984, Pub. L. No. 98-620, title IV, § 414(a), 98 Stat. 3363 (1984).

In other words, Congress imposed on the Federal Circuit the same opinion-writing requirement that for decades had constrained the court’s predecessor, the CCPA. That requirement had become the norm. The Federal Circuit’s first Chief Judge, the Honorable Howard T. Markey, made the following assurance about the new court in 1983: “In our Court there will be an opinion explaining enough to tell you what the law is in every case.” 100 F.R.D. at 511. He explained that this patent-appeal “tradition”—“We do not issue fiats. We do not just render a one-worded decision and go away”—reflected a foundational principle of “the American judicial system”: courts ordinarily should “explain [their] decisions.” *Id.* After all, “you would never know what the law is otherwise.” *Id.*

One year later, Congress erased any doubt that the Federal Circuit would not issue one-word decisions in patent agency appeals by reviving the opinion-writing requirement that had previously constrained the CCPA and by imposing it on the court’s new iteration. *See* Dennis Crouch, *Wrongly Affirmed Without Opinion*, 52 WAKE FOREST L. REV. 561, 565 (2017).

Interpreting § 144 as a reasoning-giving requirement promotes Congress’s objectives in creating

the Federal Circuit: to “provide nationwide uniformity in patent law,” and to “make the rules applied in patent litigation more predictable.” H.R. Rep. No. 97-312, at 20 (1981); *see also* S. Rep. No. 97-275, at 2 (1981) (“to improve the administration of the patent law by centralizing appeal in patent cases”). Section 144’s reasoning-giving requirement advances those purposes by facilitating the Federal Circuit’s articulation, development, and clarification of the legal standards applicable to invention patents. The Federal Circuit’s explication of legal standards, through a steady stream of opinions, ensures that all patent-law adjudicators—the Federal Circuit itself, district courts, and PTAB judges—apply a uniform and predictable set of rules. A set of coherent rules, in turn, simplifies patent litigation and preempts unnecessary legal battles. Still more, a shared comprehension of what is, and what is not, patentable enables inventors to focus their research-and-development efforts on productive pursuits, allows for effective business planning, encourages investment in new technologies, reduces barriers to entry, and supports a fair competitive environment. *See Hunter Douglas, Inc. v. Harmonic Design, Inc.*, 153 F.3d 1318, 1331 (Fed. Cir. 1998) (listing uniformity’s benefits); Paul R. Gugliuzza & Mark A. Lemley, *Can a Court Case Change the Law by Saying Nothing?*, 71 VAND. L. REV. 765, 792 (2018) (arguing that Rule 36 distorts the public perception of patent-law trends).

Through its Rule 36 practice, however, the Federal Circuit is defying Congress’s reasoning-giving mandate, thereby creating the precise uncertainty that Congress sought to avoid. An appellant-inventor

challenging the PTAB’s invalidation of an already issued patent— along with other inventors, the patent bar, and the public—is left in the dark about what specific aspects of the PTAB’s final written decision the Federal Circuit agreed with: one aspect; some aspects; or the decision in its entirety. The Federal Circuit might even have largely disagreed with the PTAB’s decision but nonetheless affirmed because the PTAB committed no *reversible* error.

The interaction between PTAB invalidity proceedings and district court patent-infringement proceedings further exposes the uncertainty that Rule 36 has injected into patent law. A patent challenger quite often seeks an *inter partes* review after the patent holder has brought a patent-infringement action in district court. The challenger will then often move for, and secure, a stay of the district-court action pending the *inter partes* review. If the Federal Circuit affirms the PTAB’s invalidity decision in an *inter partes* review, that “*affirmance* of [the] invalidity finding . . . has a collateral estoppel effect on all pending or co-pending actions.” *United Therapeutics Corp. v. Liquidia Techs., Inc.*, 74 F.4th 1360, 1372 (Fed. Cir. 2023) (emphasis added) (citation omitted). Collateral estoppel precludes re-litigation of issues “actually litigated and determined.” *Laguna Hermosa Corp. v. United States*, 671 F.3d 1284, 1288 (Fed. Cir. 2012). So, if the Federal Circuit issues a Rule 36 affirmance, the patent holder, the accused infringer, and the district court may have divergent interpretations of collateral estoppel’s scope, because what was “actually determined” is unclear. And the same PTAB decision may end up having inconsistent

collateral-estoppel effect in different pending actions. All this further undermines the coherence that creating the Federal Circuit was supposed to engender.

In other statutes, Congress has shown that it knows how to avoid imposing reasoning-giving responsibilities on courts. The Copyright Act provides: “Within one month after any final order or judgment is issued in the [copyright infringement] case, the clerk of the court shall notify the Register [of Copyrights] of it, sending with the notification a copy of the order or judgment together with the written opinion, *if any*, of the court.” 17 U.S.C. § 508(b) (emphasis added). Because Congress has shown that it knows how to use language to render an opinion optional (*e.g., if any*), Congress’s decision not to use any such qualifying language in § 144 of the Patent Act should be treated as a deliberate drafting choice.

Reasoning-giving requirements are not foreign to our federal system. In *United States v. Nugent*, the Sixth Circuit held that the district court had violated a statutory provision (since repealed) requiring courts to issue “written opinion[s]” in Tucker Act actions. 100 F.2d 215, 216 (6th Cir. 1938) (applying 28 U.S.C. § 764 (repealed 1948)). Federal Rule of Civil Procedure 52(a) requires district courts to make findings of fact and draw conclusions of law in bench trials and when adjudicating interlocutory injunctions, and Federal Rule of Civil Procedure 59 requires district courts to state reasons when they *sua sponte* grant new trials.

Taylor is not to the contrary. There, the Fifth Circuit summarily reversed, without issuing an opinion. *Taylor*

v. McKeithen, 407 U.S. 191, 192 (1972). The appellees sought review in this Court, which granted the petition, vacated, and remanded “[b]ecause this record does not fully inform us of the precise nature of the litigation and because we have not had the benefit of the insight of the Court of Appeals.” *Id.* at 194. This Court added that, despite its direction to the Fifth Circuit, “the courts of appeals should have wide latitude in their decisions of whether or how to write opinions. That is especially true with respect to summary affirmances.” *Id.* at 194 n.4.

SurfCast’s position comports with *Taylor*’s cautionary footnote. Nothing in the Constitution, and no statute generally applicable to the appellate courts, precludes them from issuing summary affirmances. But § 144 is a specific statute aimed at a particular court, thus disabling that background presumption in this case. As then-Justice Rehnquist noted in dissent, no “existing statute or rule of procedure” barred the Fifth Circuit from deciding the *Taylor* appeal without issuing an opinion, which to him established that the Fifth Circuit was well within its rights to withhold an opinion. *Id.* at 195-96 (Rehnquist, J., dissenting).

Section 144 is what Justice Rehnquist had in mind: it expressly and specifically obligates a particular court, the Federal Circuit, to issue an “opinion.”

More fundamentally, interpreting § 144 as a reasoning-giving requirement harmonizes with bedrock principles of our democracy. Justice Brennan observed that when a court “explain[s] *why* and *how* a given rule has come to be,” such reasoning-giving “serves a

function within the judicial process similar to that served by the electoral process with regard to the political branches of government”: “[i]t restrains judges and keeps them accountable to the law and to the principles that are the source of judicial authority.” William J. Brennan, Jr., *In Defense of Dissents*, 37 HASTINGS L.J. 427, 435 (1986). As Judge Leventhal put the point, “there is accountability in the giving of reasons,” and “[g]rave questions are raised when a court uses ‘judgments’ and ‘orders’ to dispense with any indication of reasons”— as here. Harold Leventhal, *Appellate Procedures: Design, Patchwork, and Managed Flexibility*, 23 UCLA L. REV. 432, 438 (1976). Those grave questions concern nothing less than our government’s structure of separated and limited powers. According to Professor Glendon, *supra*, at 147-48, the “[d]iscipline of writing out the reasons for a decision and responding to the main arguments of the losing side has proved to be one of the most effective curbs on arbitrary judicial power ever devised.” Yet “[t]hose important safeguards are lost when, as is increasingly the case, decisions are rendered without written opinions.” *Id.*; accord Joseph W. Singer, *Normative Methods for Lawyers*, 56 UCLA L. REV. 899, 489-49 (2009) (“the biggest check on the use of judicial power is the duty to give public reasons for decisions, justifying choices by writing judicial opinions”). Professor Schauer similarly noted that when an institutional designer seeks to rein in a decision-maker, a reasoning-giving mandate is a reasonable design choice. Frederick Schauer, *Giving Reasons*, 47 STAN. L. REV. 633, 657-58 (1995). The relevant institutional

designer here—Congress—reasonably obligated the Federal Circuit, through § 144, to show its work in PTAB appeals.

Giving reasons also serves the adjudicative goal of accuracy. As Chief Judge Wald recognized, “the discipline of writing even a few sentences or paragraphs explaining the basis for the judgment insures a level of thought and scrutiny by the court that a bare signal of affirmance, dismissal, or reversal does not.” Patricia A. Wald, *The Problem with the Courts: Black-Robed Bureaucracy or Collegiality Under Challenge?*, 42 MD. L. REV. 766, 782 (1983). Judge Rubin, too, recognized that “the discipline of opinion writing does affect the result,” an empirical reality reflected in the oft-recounted judicial experience of sitting down to “prepare an opinion stating the decision and its rationale,” only to find that “it won’t write.” Alvin B. Rubin, *Book Review of The Ways of a Judge by Frank M. Coffin*, 130 U. PA. L. REV. 220, 227 (1981).

In addition, reasoning-giving generates a body of coherent, predictable law around which public and private actors can orient their decision-making. See Benjamin N. Cardozo, *Nature of the Judicial Process* 30 (1921). Reasoning-giving requirements safeguard parties’ dignity, as well. See Rachel Bayefsky, *Dignity and Judicial Authority* 118 (2024).

In light of the above, there is no basis to suggest that interpreting § 144 as a reasoning-giving directive is an absurd literalism. See *Pub. Citizen v. U.S. Dep’t of Just.*, 491 U.S. 440, 470-71 (1989) (Kennedy, J.,

concurring in the judgment) (absurdity doctrine should be limited to the genuinely absurd).

As for the anticipated objection that interpreting § 144 as a reasoning-giving directive is absurd because the additional work will overwhelm the Federal Circuit, that fear is unfounded. Not even former Chief Judge Michel shares that concern: he has urged the court to cease its Rule 36 practice because it is a “dereliction of duty.”³ “A minimum opinion need not be unduly time consuming to write.” Wald, *supra*, at 782.

SurfCast submits that the Federal Circuit would satisfy § 144 by issuing a one-paragraph document identifying the grounds for reversal or vacatur that the appellant has raised and stating why they fail. That document would qualify as an “opinion” under § 144, and preparing it would not add significantly to the time that the panel already would have spent analyzing the case. *See U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1556 (Fed. Cir. 1997) (“Appeals whose judgments are entered under Rule 36 receive the full consideration of the court, and are no less carefully decided than the cases in which we issue full opinions.”).

In any event, even if Congress’s § 144 reasoning-giving directive to the Federal Circuit were an unwise policy choice, “[t]he wisdom of Congress’s judgment on

³ Eileen McDermott, *Chief Judge Paul Michel: Patent Reform Progress Is Likely, But We Must Stay Focused on the Big Picture*, [IPWatchDog.com](https://ipwatchdog.com/2019/09/15/chief-judge-paul-michel-patent-reform-progress-likely-must-stay-focused-big-picture/id=113326/) (Sept. 15, 2019), <https://ipwatchdog.com/2019/09/15/chief-judge-paul-michel-patent-reform-progress-likely-must-stay-focused-big-picture/id=113326/>.

this matter is not [this Court’s] concern.” *See Burwell v. Hobby Lobby Stores, Inc.*, 573 U.S. 682, 736 (2014).

Equally unavailing is the anticipated objection that construing § 144 as a reasoning-giving directive presents a line-drawing predicament. If an opinion is too concise, a party can raise the issue whether the document qualifies as an “opinion” with the *en banc* Federal Circuit, which can administer the line. Appellate courts regularly determine whether district courts have rendered adequate findings of fact and conclusions of law under Fed. R. Civ. P. 52(a).

**C. The Constitutional-Doubt Canon and
Elemental Principles Further Counsel
for Interpreting § 144 as a Reasoning-
giving Directive.**

The canon of constitutional doubt is another reason to reject an atextual reading of § 144. Even if the “statutory language” were “susceptible of multiple interpretations,” “a court may shun an interpretation that raises serious constitutional doubts and instead may adopt an alternative that avoids those problems.” *See Jennings v. Rodriguez*, 583 U.S. 281, 286 (2018). Of particular relevance here, this Court has recognized that “there are occasions when an explanation of the reasons for a decision may be required by the demands of due process.” *Harris v. Rivera*, 454 U.S. 339, 344 (1981). Due process may very well demand that when a patent holder has been deprived of its vested property rights through a strange agency proceeding that stacks the deck for the challenger, the holder is entitled to at least some judicial explanation for the property

deprivation. Adopting a textual reading of § 144 would avoid this constitutional problem.

Inter partes review may *itself* violate the Fifth Amendment’s Due Process Clause. In *Oil States*, this Court emphasized the “narrowness of [its] holding” that *inter partes* review comports with Article III and the Seventh Amendment, and it clarified that the Due Process Clause was not at issue. *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 344 (2018) (“our decision should not be misconstrued as suggesting that patents are not property for purposes of the Due Process Clause”). The question is therefore open under this Court’s precedents, and the procedure may indeed fall short.

First, *inter partes* review empowers an executive agency “to cancel a vested property right in an already-issued patent”—a “feat that, under the Constitution, can be performed only by a judicial actor in accordance with governing law.” See Gary S. Lawson, *Appointments and Illegal Adjudication: The America Invents Act Through A Constitutional Lens*, 26 GEO. MASON L. REV. 26, 28 (2018); see also *id.* at 50 (“It requires judicial process. That is what the idea of due process of law has been about at least since Magna Carta in the thirteenth century.”).

Second, *inter partes* review reflects a “retreat from the promise of judicial independence.” *Oil States*, 584 U.S. at 347 (Gorsuch, J., dissenting). The Patent Office Director—a political appointee who serves at the President’s pleasure—supervises the PTAB members who hear *inter partes* reviews and selects which

members, and how many, will hear any particular challenge. 35 U.S.C. §§ 1(a), 6(c). If the PTAB panel reaches a result that the Director disagrees with, the Director may add members or order a rehearing. *Id.* §§ 6(a), (c).

Third, the same PTAB panel decides whether to institute *inter partes* review and proceeds to adjudicate that very case. *Inter partes* review thus contravenes the ancient maxim that “[n]o man is allowed to be a judge in his own cause,” see THE FEDERALIST NO. 10, p. 59 (J. Cooke ed. 1961) (J. Madison). The principle of *nemo iudex in causa sua*—an unassailable premise of any “free society,” see *In re Murchison*, 349 U.S. 133, 137 (1955)—is woven into the fabric of the Due Process Clause, see *Williams v. Pennsylvania*, 579 U.S. 1, 9 (2016). Although Congress in the AIA had assigned the institution decision to the Director, thereby lodging the investigative and adjudicative functions in different executive actors, see 35 U.S.C. § 314(a), the Director has delegated the institution power to the PTAB, see 37 C.F.R. § 42.4(a). The consequent commingling of functions casts doubt on the PTAB’s objectivity. Even the most well-intentioned bureaucratic body will, upon removing the investigator’s cap and donning the adjudicator’s cap, experience a degree of cognitive lock-in.⁴

⁴ See Pharm. Researchers & Mfrs. of Am., *Comments on Trial Proceedings Under the America Invents Act* 14 (Oct. 16, 2014) (warning that combining functions would threaten “patent owners’ due process protections”), https://www.uspto.gov/sites/default/files/ip/boards/bpai/phrma_20141016.pdf

Another anomaly is that additional patent challengers who were not initially part of the petition may join the *inter partes* review midstream; and even if all the patent challengers drop out, the PTAB panel may continue reviewing the patent on its own. 35 U.S.C. §§ 315(c), 317(a). That power collides with the principles of standing, mootness, and party presentation that, in our Article III system, ensure that the judge is focused on resolving an actual, concrete dispute and is not stepping outside the judicial role and into matters of self-interest. *See Baker v. Carr*, 369 U.S. 186, 204 (1962).

Several other features of *inter partes* review may not raise due-process issues on their own but nonetheless contribute to the process's overall inadequacy. For example, the PTAB employs a preponderance-of-the-evidence standard, meaning that for a petitioner to prevail and invalidate a patent holder's already issued patent, the petitioner need only show that it is more likely than not that a patent claim is unpatentable. In district court, though, because a patent is presumed valid, *see* 35 U.S.C. § 282, a defendant in a patent-infringement action arguing patent invalidity as a defense must satisfy a higher standard of "clear and convincing evidence" to prove invalidity, *see Microsoft Corp. v. I4I Ltd. P'ship*, 564 U.S. 91, 95 (2011).

Discovery in PTAB proceedings is also "limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is otherwise necessary in the interest of justice." 35 U.S.C. § 316(a)(5); *see also* 37

C.F.R. § 42.51(b) (“A party is not entitled to discovery” except initial disclosures and limited items constituting “routine discovery”). By contrast, the scope of discovery in district court litigation is broad, enabling patent holders to gather comprehensive evidence and information through depositions, interrogatories, requests for production, and other mechanisms— and thereby to mount a robust defense of their vested property rights. *See* Fed. R. Civ. P. 26.

Additionally, *inter partes* review is decided solely on a paper record. Expert and fact-witness testimony “must be submitted in the form of an affidavit,” except for the rare circumstance when the PTAB panel authorizes live testimony. 37 C.F.R. § 42.53(a). But in deciding between battling experts who offer competing narratives, the ability to observe them in real time, and thereby to assess their credibility, can be critical. *See Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 843 F.3d 1315, 1341 (Fed. Cir. 2016) (crediting jury’s credibility assessments of competing experts testifying on patent validity).

Although SurfCast is not challenging, in this petition, *inter partes* review on due-process grounds, the point remains that the procedural infirmities of *inter partes* review could necessitate a single, minimal explanation why the patent holder’s already issued patent was invalidated, rendered by an independent court sitting above the fray. Congress, through § 144, has already selected the court to perform that function: the Federal Circuit. Granted, a patent holder whose already issued patent is invalidated through an *inter*

partes review will receive a written decision from the PTAB. *See* 35 U.S.C. § 318(a). But a decision that is the product of a deficient process could not cure that process's inadequacy. One instance of *judicial* reasoning-giving—and its corresponding adjudicative benefits, such as accountability, accuracy, and dignity—could be necessary to compensate for *inter partes* review's severe departures from established rules of court procedure that are designed to safeguard rights.

In *Oil States*, this Court observed that “because the Patent Act provides for judicial review by the Federal Circuit, *see* 35 U.S.C. § 319, we need not consider whether *inter partes* review would be constitutional without any sort of intervention by a court at any stage of the proceedings.” 584 U.S. at 344 (other citation and punctuation omitted). As mentioned, this Court noted that the Due Process Clause was not at issue there. *Id.* For due-process purposes, it may be that a Rule 36 summary affirmance is an inadequate level of “intervention” to resolve *inter partes* review's due-process shortcomings. For due-process purposes, that is, more could be needed: an opinion setting forth reasons, the writing of which will obligate the Federal Circuit to carefully and thoroughly review the proceeding below.

In this vein, then-Judge Wald observed that an appellate court's summary affirmance of an agency decision is “quite a different matter” from an appellate court's summary affirmance of a district court opinion: “In the latter case, the parties have had the benefit of an

independent judicial decision whereas in the former the parties are seeking judicial review of the agency decision in the first instance in this court.” *Nat’l Classification Comm. v. United States*, 765 F.2d 164, 174 (D.C. Cir. 1985) (Wald, J., separately stating). For that reason, continued Judge Wald, when an appellate court is reviewing an appeal from an agency decision, the court “should at least give the parties a statement of reasons in the court’s own words, if for no other reason than to indicate that the court in fact thoughtfully reviewed the agency’s determination.” *Id.* That point is doubly true for *inter partes* review, a rare breed of administrative process. A plain-language reading of § 144, however, avoids the foregoing host of constitutional concerns.

Yet another consideration militating against an atextual reading of § 144 is the “elemental proposition,” which this Court recently addressed in *Loper Bright*, that “courts decide legal questions by applying their own judgment.” *Loper Bright Enters. v. Raimondo*, 144 S.Ct. 2244, 2261 (2024). As the framers envisioned, the “judicial function” of courts—the very purpose of them—would be to “exercise independent judgment” in determining “questions of law” and “the meaning of statutory provisions.” *Id.* at 2262; *see also* THE FEDERALIST NO. 78, p. 525 (J. Cooke ed. 1961) (A. Hamilton) (“The interpretation of the laws is the proper and peculiar province of the courts.”). This Court embraced that view in *Marbury v. Madison*, where Chief Justice Marshall pronounced: “It is emphatically the province and duty of the judicial department to say what the law is.” 1 Cranch 137, 177 (1803) (emphasis added);

see also Decatur v. Paulding, 14 Pet. 497, 515 (1840) (holding that the judicial role is to “interpret the act of Congress, in order to ascertain the rights of the parties”). That traditional conception of the judicial function—that is, the conception that “courts must exercise independent legal judgment”—has held true from the founding era to present day. *Loper Bright*, 144 S.Ct. at 2262, 2265.

When the Federal Circuit issues a summary affirmance of a PTAB decision in an *inter partes* review under Rule 36, however, it becomes impossible to determine whether the Federal Circuit has satisfied its longstanding duty to exercise independent legal judgment. This Court, further, has held that the petition must “guide the life of the litigation,” and that the “petitioner is the master of its complaint.” *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 363, 366 (2018). And the Federal Circuit, for its part, has held that “[a]ny marked departure from the grounds identified with particularity in the petition would impose unfair surprise on the patent owner and, consequently, violate the IPR statute.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1002 (Fed. Cir. 2023) (citation and punctuation omitted).

Despite this settled law, the PTAB’s plain violation of it, and the plainly unfair surprise of the reply, the Federal Circuit summarily affirmed the PTAB under Rule 36. Consequently, it is impossible to assess whether the Federal Circuit independently applied 32 U.S.C. § 312(a)(3) and the surrounding case law. Its independent analysis of this legal issue is essential because courts possess the institutional

competence to analyze legal technicalities such as forfeiture. Legal analysis is what “[c]ourts do.” *Loper Bright*, 144 S.Ct. at 2266.

If the Federal Circuit did not exercise its independent legal judgment, the absence of an opinion denies SurfCast the ability to challenge the Federal Circuit’s breach of its judicial role in the *en banc* Federal Circuit or in this Court. Because there is no record of the Federal Circuit’s breach, there is no basis for further review. *See* Fed. Cir. R. 54 Practice Notes (“A petition for rehearing *en banc* is rarely appropriate if the appeal was the subject of a nonprecedential opinion by the panel of judges that heard it.”). And if the Federal Circuit did exercise its independent legal judgment, the absence of an opinion causes SurfCast the indignity of not knowing why, or how, the Federal Circuit sidestepped the weight of authority.

In this way, the Federal Circuit’s Rule 36 practice stands in tension with the elemental principle that courts must exercise independent legal judgment. But Congress has already resolved this fundamental problem: through § 144, Congress imposed a reasoning-giving requirement on the Federal Circuit, thereby enabling parties on appeal to discern whether the Federal Circuit has fulfilled its judicial role.

**II. THIS CASE IS AN IDEAL VEHICLE TO RESOLVE THE
IMPORTANT AND RECURRING QUESTION
PRESENTED.**

This case presents no vehicle problem that would preclude this Court’s review of the question presented. The PTAB invalidated claims in SurfCast’s already

issued patents through *inter partes* review. SurfCast timely appealed, and the Federal Circuit summarily affirmed the PTAB’s decision under Rule 36, without issuing an opinion—despite § 144.

As a consequence of the Federal Circuit’s heavy reliance on Rule 36, patent holders rarely receive a judicial explanation why their already issued patents have been invalidated. A study of 300 Federal Circuit inter-partes-review decisions from 2019 to the first half of 2020 found that “patent owner-appellants seldom succeeded at the Federal Circuit, with PTAB unpatentability determinations being affirmed 85% of the time.”⁵ Further, “[w]ith approximately 60% of such affirmances being made under Rule 36, approximately half of all patent owner IPR appeals were rejected without a substantive appellate opinion.” *Id.*

These staggering figures have prompted numerous practice-oriented and academic comments⁶ arguing that the Federal Circuit’s use of Rule 36 is unlawful. To stakeholders in the patent system, the Federal Circuit’s Rule 36 practice has become a lightning rod. It is a

⁵ See Larry Sandell, *What 18 Months of IPR Stats Teach Us About Winning Appeals*, Law360 (July 20, 2020), <https://www.law360.com/articles/1293373/what-18-months-of-ipr-stats-teach-us-about-winning-appeals>.

⁶ See, e.g., Charles Macedo et al., *Justice Is Not Silent: The Case Against One-Word Affirmances in the Federal Circuit*, Patently-O (Sept. 22, 2024), <https://patentlyo.com/patent/2024/09/appellate-decision-reasoning.html>; Crouch, *supra*, at 570; Rebecca A. Lindhorst, Comment, *Because I Said So: The Federal Circuit, the PTAB, and the Problem with Rule 36 Affirmances*, 69 Case W. RES. L. REV. 247, 260-61 (2018).

constant topic of conversation and, quite often, consternation.

As this Court knows, among the courts of appeals, only the Federal Circuit deploys a one-word affirmance with any meaningful degree of frequency. The First, Second, Third, Fourth, Sixth, Seventh, Ninth, Eleventh, and D.C. Circuits have no local rule authorizing one-word affirmances. The Fifth, Eighth, and Tenth Circuits have such a rule—*see* 5th Cir. R. 47.6, 8th Cir. R. 47B, and 10th Cir. R. 36.1—but in the past year, it appears that only the Fifth Circuit has applied it, and only twice.⁷ Yet the Federal Circuit, which is statutorily required to issue an “opinion” in PTAB appeals, issues one-word summary affirmances at a rate that dwarfs other circuits’ rates.

There is a pressing need for this Court’s intervention because “[i]n the area of patents, it is especially important that the law remain stable and clear.” *Bilski v. Kappos*, 561 U.S. 593, 613 (2010) (Stevens, J., concurring). The Federal Circuit’s Rule 36 practice shrouds the legal principles that govern patentability, and makes it difficult for inventors to predict whether their inventions will receive and retain patent protection. (See *supra* at 16-17.) The practice thus disincentivizes inventors from investing the time and energy to invent, and undermines the purpose of patents as laid down in the Constitution: “[t]o promote the Progress of Science and useful Arts.” U.S. Const.

⁷ *Merkle v. Thomas*, No. 23-50692, Doc. 65-1 (5th Cir. July 12, 2024); *Am. Longshore v. Aries Marine*, No. 23-30564, Doc. 63-1 (5th Cir. Apr. 4, 2024).

art. I, § 8, cl. 8. At bottom, “[r]eliable application of legal principles underlies the economic incentive purpose of patent law, in turn implementing the benefits to the public of technology-based advances, and the benefits to the nation of industrial activity, employment, and economic growth.” *CLS Bank Int’l v. Alice Corp. Pty.*, 717 F.3d 1269, 1321 (Fed. Cir. 2013) (en banc) (Newman, J., concurring in part and dissenting in part), *aff’d*, 573 U.S. 208 (2014).

To be sure, there are plenty of circumstances where it makes perfect sense for a court not to give reasons for a decision. But here, the Federal Circuit must give reasons in PTAB appeals because—and only because—the statutory text and context demand it. And although our Article III courts *are* overburdened, the sixty or so additional opinions that the Federal Circuit would need to prepare per year need not be tomes. An opinion can be concise.

This Court should therefore intervene to stop the Federal Circuit’s practice of issuing Rule 36 affirmances, without opinions, in contravention of the plain statutory text. Our nation’s elected representatives chose to impose a reasoning-giving requirement on the Federal Circuit, and their choice, which embodies the people’s will, should not be so easily and frequently brushed aside.

Even if this Court disagrees that § 144 is a reasoning-giving directive, there would be significant value in granting certiorari to consider the question on a fully developed record and in publicly explaining

why a one-word affirmance suffices. This Court's reasoning-giving would—fittingly—advance the dignity of appellants who have been Rule 36-ed, including patent holders who have been deprived of their vested property rights. *See* Bayefsky, *supra*, at 118. They and other critics of Rule 36 would finally come to understand why the rule is compatible with the statute. An explanation would thus alleviate public apprehensions and restore public trust.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

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1a

NOTE: This disposition is nonprecedential.

United States Court of Appeals
for the Federal Circuit

SURFCAST, INC.,

Appellant

v.

MICROSOFT CORPORATION,

Appellee

2024-1156, 2024-1160, 2024-1161, 2024-1162

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

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2a

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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



Jarrett B. Perlow
Clerk of Court

June 4, 2025
Date

3a

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Paper No. 21
Entered: October 2, 2023

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.*

JUDGMENT
Final Written Decision

Determining All Challenged Claims Unpatentable
35 U. S. C. § 318(a)

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. We instituted review. Paper 9 (“Institution Decision” or “Inst.”).

Patent Owner filed a Response (Paper 13, “PO Resp.”), Petitioner filed a Reply (Paper 14, “Pet. Reply”), and Patent Owner filed a Sur-Reply (Paper 15, “PO Sur-Reply”). We held a hearing on July 12, 2023 (Paper 20, “Tr.”).

We have jurisdiction under 35 U.S. C. § 6. This Final Written Decision is issued pursuant to 35 U. S. C. § 318(a). For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that all of the challenged claims are unpatentable.

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.

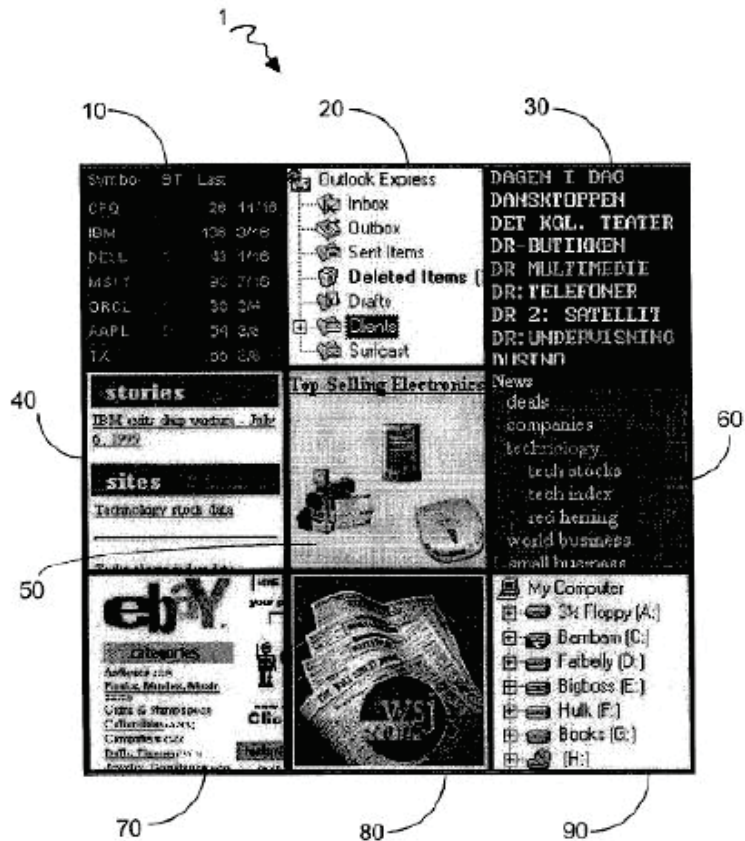
B. RELATED MATTERS

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).



C. 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.

D. UNPATENTABILITY GROUNDS

Petitioner asserts the following unpatentability grounds:

Claims	35 U.S.C. §	Reference(s)/Basis
1–13	102	MSIE Kit ¹
1–13	103	MSIE Kit, Jones ²
1–8	103	MSIE Kit, RFC2068 ³

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).

1–8	103	MSIE Kit, RFC2068, Jones
1–13	103	Excel97 ⁴ , Igra ⁵
1–13	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*

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).

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

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 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”)).

II. ANALYSIS

A. 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

⁷ Patent Owner has not submitted such objective evidence here.

equivalent experience working in industry) and several years of experience 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 does not challenge or otherwise address Petitioner’s definition (*see generally* PO Resp.), and we adopt it here because it reflects the level of skill in the prior art.

B. 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.

In IPR2013-00292, the Board construed a number of terms in the ’403 patent,⁸ which is the “ultimate parent” of the ’338 patent through a chain of continuations and continuations in part. IPR2013-

⁸ U.S. Patent No. 6,724,403 (Ex. 1019).

00292, Paper 93 (Ex. 1017, the “403 FWD”).⁹ *See* Pet. 1. Because the ’403 patent is the ’338 patent’s “ultimate parent,” Petitioner submits that the 403 FWD constructions drive the proper constructions here. *Id.* at 12–19; Pet. Reply 1– 13. Moreover, Petitioner argues, collateral estoppel bars Patent Owner from contesting constructions of the same terms in the ’434 patent.¹⁰ Pet. Reply 1 (citing *XY, LLC v. Trans Ova Genetics*, 890 F.3d 1282, 1294–95 (Fed. Cir. 2018)). Patent Owner argues that because the 403 FWD applied the “broadest reasonable interpretations,” it does not have preclusive effect here, where we construe claims using the *Phillips* standard. PO Sur-Reply 1 (citing *SkyHawke Techs., LLC v. Deca Int’l Corp.*, 828 F. 3d 1373, 1376 (Fed. Cir. 2016)). We need not resolve that dispute, because we conclude that, to the extent the 403 FWD construed terms applicable in this proceeding, those constructions comport with the *Phillips* standard.

Petitioner also discusses constructions by the United States District Court for the District of Maine, which also construed terms of the ’403 patent. *See* Pet. 13–19; Pet. Reply 7, 23; Ex. 1018.

Other than as discussed below, we conclude no additional claim term requires construction. *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’”

⁹ The Federal Circuit affirmed the 403 FWD’s unpatentability determinations. *SurfCast, Inc. v. Microsoft Corp.*, 639 F. App’x 651 (Fed. Cir. 2016).

¹⁰ Patent Owner does not dispute that the ’403 patent and ’434 patent specifications substantively match.

(quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

1. “tile”

Claim 1 recites “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.” Ex. 1001, 30:32–35. Claim 9 recites a parallel limitation. *Id.* at 31:26–29.

Petitioner argues that a “tile” is “a graphical user interface element whose content may be refreshed and that, when selected, provides access to an information source.” Pet. 11–15; Pet. Reply 1–8. The 403 FWD construed “tile” the same as Petitioner’s proposed construction here. Ex. 1017, 7–10.

Patent Owner submits that a “tile” is “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, but providing a representation of the underlying information that is more limited than the representation provided by a window.” PO Resp. 11 (emphasis omitted); PO Sur-Reply 2–10.

We do not read the claim language as counseling in favor of one party’s proposed construction.

The specification discusses “Tile Objects” at some length. Ex. 1001, 10:34–14:12. It states that “[a] tile

presents content from any information source.” *Id.* at 10:37–38. Further, “[t]iles are selectable and live” and the specification explains that “tiles are live in that each contains real-time or near real-time information” and, when selected, “the tile instantly provides the user with access to the underlying information.” *Id.* at 12:8–10.

The specification frames tiles as contrasting with two other graphical user interface elements—icons and windows. *Id.* at 10:38–11:14. It presents tiles as “a third graphical representation of programs and files” and explains that “each tile is a viewer of a single information source.” *Id.* at 11:1–4. To distinguish tiles, the specification states that, unlike icons, a tile “contains continually refreshed content” and compared to windows, “a tile will typically be smaller in size than a window, allowing the user to view multiple tiles simultaneously if desired.” *Id.* at 11:9–14. Significantly, that comparison to windows uses exemplary characteristics without defining aspects applicable to all tiles. The specification asserts that “many tiles may be displayed simultaneously without overlapping with one another in the way that windows must necessarily do.” *Id.* at 11:19–22. That said, the specification also gives an example of “expanding tile 406 to occupy the full area of the display” (*id.* at 11:54–56), demonstrating that size does not define a tile or distinguish a tile from a window.

According to Patent Owner, a tile is a “graphical representation of an associated information source,” not merely a graphical user interface element. PO Resp. 9–11. Patent Owner submits that “a graphical user interface element,” as Petitioner proposes, “does not require a tile to be graphically displayed and does not require it to be a representation of anything.” *Id.* at 10.

In Patent Owner's view, while such an element is used for user interaction, it "need not be a representation of an information source or its underlying information." *Id.* at 10. As Petitioner points out, however, other claim language requires tiles be displayed. Pet. Reply 2. We therefore do not agree with Patent Owner that Petitioner's construction is deficient.

Moreover, in light of Petitioner's unpatentability contentions for MSIE Kit discussed below, the graphical-representation aspect of Patent Owner's construction would not impact our conclusion. Patent Owner contends otherwise, in a general way, but does not explain that contention. *See* PO Resp. 11 ("These differences impact the prior art analysis."), 35–43 (the cited discussion, which does not distinguish MSIE Kit's asserted tiles based on whether they provide a representation of an information source or its underlying information).

Next, Patent Owner argues that a tile must provide "a representation of the underlying information that is more limited than the representation provided by a window." PO Resp. 6–7, 11–16; *see also* Tr. 53:10–54:8. We do not agree.

While, as described above, the specification purports to distinguish tiles from windows, it does so with permissive terms rather than a restrictive definition. *See* Ex. 1001, 11:11–32. During the hearing, Patent Owner was unable to describe particular restrictions that would embody the limited representation. For example, Patent Owner asserted that degraded resolution would satisfy its proposed construction (Tr. 64:24–65:11) but that does not

comport with a distinction from a window. A window may depict content at a variety of zooms, some of which would show an image with degraded resolution. *See* Tr. 68:6–15 (Patent owner discussing how pixels can be lost on a zoomed image). Patent Owner asserts that a window with zoom functionality lacks “a fundamentally or different in nature likeness or image.” Tr. 68:11–15. But that assertion is detached from Patent Owner’s proposed construction and unsupported by the specification. We conclude that the specification does not sufficiently distinguish a tile from a window to support Patent Owner’s proposed construction.

In fact, Patent Owner admits that the specification does not have a clear definition but insists that it nonetheless defines a tile “as something other than either an icon or a window.” Tr. 48:20–25. We do not agree. When identifying features that the specification describes to distinguish tiles from windows, Patent Owner points to other claim limitations, such as “[s]electability to provide access to the underlying information.” Tr. 49:7–10; *see also id.* at 50:3–8 (asserting a tile must be refreshable). Although such limitations may capture aspects that the specification uses to distinguish tiles from other graphical interface elements, they do not support further construing “tile” narrowly as Patent Owner asserts. Stated otherwise, the specification’s distinctions for tiles over icons or windows already appear as claim limitations and do not counsel in favor of further limiting “tile.”

Further, Patent Owner’s construction is unclear whether a tile must provide a graphical representation of its associated information source or of the

information underlying that source. The proposed construction first requires a tile represent the source but then additionally requires it “provid[e] a representation of the underlying information,” seemingly allowing no room for a tile that represents only the information source. PO Resp. 6–7. Those competing requirements would not comport with the specification. The exemplary tiles do not necessarily represent a source’s underlying information, but instead may relate to the source itself. *See* Ex. 1001, Fig. 4 (tile 410, displaying the name of a broadcast signal; tile 408, displaying an icon indicating “New Mail!”), 11:56–65 (describing tile 408), 11:66–12:12 (describing tile 410). Patent Owner, at oral hearing, stated that tile 410 is an example of the claimed tile, thus confirming that the claimed “tile” encompasses at least one such exemplary tile. Tr. 50:5–22. Thus, Patent Owner’s proposed addition regarding the nature of a tile’s representation would create an internal inconsistency in the meaning of a tile. We do not adopt Patent Owner’s proposed restriction on the nature of a tile’s representation.

Next, Patent Owner attempts to distinguish a tile “whose content may be refreshed” from one “capable of displaying refreshed content.” PO Resp. 16–17. In this regard, Patent Owner distinguishes Petitioner’s construction, which Patent Owner asserts “does not require that [tile] element to be capable of displaying the refreshed content.” *Id.* We agree with Petitioner that the parties’ different language regarding refreshed content does not implicate any aspect of our unpatentability analysis. *See* Pet. Reply 4–5.

Finally, Patent Owner contends that a tile must be “selectable to provide access to underlying information of the associated information source,” not just an element that, “when selected, provides access to an information source.” PO Resp. 17–20. As Patent Owner explains, it seeks a distinction that “tiles themselves are selectable to provide access to underlying information of associated information sources, rather than access being provided by selecting the contents of a tile.” *Id.* at 18. Patent Owner argues that Petitioner’s construction, referring to an element “that, when selected, provides access to an information source,” does not require the tile itself be selectable. *Id.* at 19–20. Patent Owner relies primarily on the specification’s description that “[t]iles are selectable and live” and that, “[w]hen a tile is selected, whether by mouse click or otherwise, the tile instantly provides the user with access to the underlying information.” *Id.* at 17–18 (quoting Ex. 1001, 12:8–10). Petitioner relies on that same specification disclosure to argue that we should not restrict the manner of selecting a tile. Pet. Reply 6. The specification indicates that a tile may be selected “by mouse click or otherwise.” Ex. 1001, 12:8–9.

Petitioner points out that the 403 FWD concluded that when “a user selects a link *included* in an Active Desktop item, the user necessarily selects the Active Desktop item.” Ex. 1017, 36. That conclusion, which was part of a decision affirmed on appeal, *Surfcaster, Inc. v. Microsoft Corp.*, 639 F. App’x 651 (Fed. Cir. May 9, 2016), indicates that Patent Owner’s proposed claim construction here would not preclude the claims from reading on MSIE Kit, because selecting a link within an item selects the item itself. Thus, Patent Owner’s construction would not affect the

outcome here. Regardless, we agree with Petitioner that, when the specification discloses a tile may be selected “by mouse click or otherwise,” it indicates a broader range of selection mechanisms than proposed by Patent Owner. *See* Pet. Reply 7.

Although Patent Owner asserts that its proposed construction alone focuses on tiles themselves being selectable, we do not view the two constructions as supporting that distinction. As Petitioner points out, its proposed construction requires that a tile, “when selected, provides access to an information source” and therefore requires “that tiles can be selected.” *Id.* at 7. Although Patent Owner seeks a construction that would not permit selection through activation of a link within a tile, we do not read the specification as so restrictive.

Based on the foregoing, and consistent with the Board’s prior construction, we construe “tile” as “a graphical user interface element whose content may be refreshed and that, when selected, provides access to an information source.”

2. “partition at least a portion of a visual display of a client device into an array of tiles”

Claim 1 recites “instructions to partition at least a portion of a visual display of a client device into an array of tiles.” Ex. 1001, 30:32–33. Claim 9 recites a parallel limitation. Ex. 1001, 31:26–27; *see* PO Resp. 20.

The Petition construes the partition limitation according to how the 403 FWD construed a similar phrase, “partitioning a visual display of the device into an array of tiles,” to mean “dividing a display or

window into two or more tiles.” Pet. 18 (quoting Ex. 1017, 12–13). Petitioner notes that the Maine court construed that phrase to mean “dividing some or all of a display into an array of tiles,” where “array of tiles” meant “multiple tiles displayed in an orderly fashion.” *Id.* ; Ex. 1018, 27–38.

Patent Owner submits that the partitioning limitation means “dividing some or all of a display into multiple tiles displayed in an orderly fashion.” PO Resp. 20. In Patent Owner’s view, because the claim already recites “tiles,” it is insufficient for “array” to require simply two or more tiles. *Id.* at 21. Rather, argues Patent Owner, “array” should require the tiles be displayed in an orderly fashion. *Id.*

We conclude, below, that our unpatentability analysis would not change by adopting one party’s construction for “array of tiles.” Accordingly, we decline to construe the phrase.

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

Claim 1 recites a set of instruction for a “client device to assign a first update rate to the first tile.” Ex. 1001, 30:37–38. Independent claim 9 recites “the first information source being located on a second device” and a set of instructions “for the second device to assign a first update rate.” *Id.* at 31:29–30, 32:1–3. In other words, claim 1 requires the device displaying tiles assign an update rate, while claim 9 requires the device hosting the information source assign an update rate.

Patent Owner points to Petitioner's contention that MSIE Kit satisfies claim 9's update-rate assignment when a CDF file on the hosting computer is used to set the update rate for an Active Desktop item on a client computer. PO Resp. 23. In Patent Owner's view, a "server cannot assign a schedule because the author of the CDF file has already assigned the schedule." *Id.* Patent Owner therefore proposes we construe "assign" to mean "to deterministically impose a specific refresh rate on a tile based on whatever input factors and algorithms have been provide by the system designer and/or user." *Id.* at 25.

Petitioner responds that Patent Owner's proposed construction departs from the ordinary meaning of "assign" without adequate support. Pet. Reply 10. Petitioner additionally submits that, in the 403 FWD, the Board determined that downloading a CDF file satisfied claim language directed to "[automatically] assigning a first refresh rate to a first tile." *Id.* at 11 (citing Ex. 1017, 31–38; Ex. 1019, 24:23–25, 24:61–62).

Patent Owner points to the specification's description of Figure 24, in which "grid generator 2404 on the server creates a grid of tiles according to user-specified content." PO Resp. 24 (quoting Ex. 1001, 27:57–59). The specification adds that, in an alternative embodiment, "the tile creator automatically assigns a priority to the tile based on the type of the information content." Ex. 1001, 27:67–28:2. Petitioner submits that Patent Owner's cited passages discuss "priority" rather than "update rate" and that Patent Owner fails to explain why the passages

would support Patent Owner's proposed construction. Pet. Reply 10.

We agree with Petitioner that there is no need to construe "assign" here, beyond holding that Patent Owner's proposed construction is unwarranted. The specification uses "assign" in various ways, without indicating the special meaning Patent Owner seeks. For example, it states that the software "is able to recognize the type or format of the information source and assign properties to tiles according to the type." Ex. 1001, 7:54–56. It explains that, when assigning "a refresh rate to a tile according to an identifier presented with each source of information, the nature of the identifier may vary according to the type of date or the protocol that is employed for its transmission." *Id.* at 9:55–59; *accord id.* at 9:40–10:24 (explaining the ability to assign tile update rates depending on a variety of identifiers).

Moreover, the specification makes clear that "assign" is not used in a deterministic fashion. When discussing automatically assigning an update rate, it states that "in the absence of initial preferences specified by the user, the present technology is able to assign a rate at which the display of a tile is refreshed according to" a number of factors. Ex. 1001, 9:40–46. That assignment does not "deterministically impose a specific refresh rate" as Patent Owner would have us construe "assign," because it depends on multiple factors and may be overridden by a user's preferences.

We are also not persuaded that the specification's description of "grid generator 2404" supports Patent Owner's proposed construction. That portion of the specification describes a manner of creating a grid of

tiles on a server and delivering that grid to a client. Ex. 1001, 27:51–28:67. In the described embodiment, although “tile creator 2408-1” can assign a priority to a tile and tile refresh rates are preferably “allocated according to the priorities associated with each tile,” a user may nonetheless manually update a tile (*id.* at 27:64–28:2, 28:49–56), showing that even an assigned update rate is not “deterministic” as Patent Owner contends.

We conclude that the specification does not provide a sufficient basis on which to limit the “assign” claim language beyond its ordinary meaning.

4. “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 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 contends that the conditional-request limitation “imposes a condition precedent that must be satisfied before sending the conditional request.” PO Resp. 25–29. Petitioner, on the other hand, reads the claim language to require that the server determine whether relevant information has changed and sending a response. Pet. Reply 11–13.

Based on the full record, and for the reasons given below, we do not agree with Patent Owner that the “if clause” imposes a condition precedent before the request is sent from the first client device to the server. Instead, we agree with Petitioner that the limitation simply requires sending a conditional request that asks if tile-displayed information that is stored at the server “has not changed since a last update.”

Both parties direct us to the specification’s recitation of a conditional GET of HTTP1.1. *See* PO Resp. 27 (citing Ex. 1001, 25:32–33); Pet. Reply 12 (“Rather, as the petition pointed out, the only plausible support for this claim language comes from a passage in the specification that refers to the two ‘conditional gets’ of HTTP1.1, neither of which entail a client making a determination that information displayed at a client ‘has not changed’ before sending a conditional request.”). That section of the specification states that “a pre-fetch utility such as URL pre-fetch manager 2208 can be implemented.” Ex. 1001, 25:23–24. One strategy for performing the pre-fetch is the conditional GET:

Another function of a pre-fetch utility is to periodically check the validity of the items in the cache to make sure they are up to date. As would be familiar to one skilled in the art, some of the new HTTP1. 1 methods would prove very useful for this, namely the conditional gets.

Ex. 1001, 25:29–33. According to the HTTP1. 1 protocol (Ex. 1012), a GET request “retrieve[s] whatever information (in the form of an entity) is identified by the Request-URI.” Ex. 1012, 50. Such a

GET is called a “conditional GET” if the request message includes an If-Modified-Since, If-Unmodified-Since, If-Match, If-None-Match, or If-Range header field. A conditional GET method requests that the entity be transferred only under the circumstances described by the conditional header field(s).” Ex. 1012, 50.

That conditional GET, which both parties point to as support, is consistent with Petitioner’s construction, which we adopt. The conditional GET has the condition in the request, not as a condition precedent to sending the request. *See* Ex. 1012, 50; Ex. 1003 ¶¶ 180–181. The conditional GET in the HTTP1.1 protocol does not discuss a condition precedent to sending the request.

In its Sur-reply, Patent Owner also directs us to a different portion of the specification relating to conditional tile content. PO Sur-reply 12 (citing Ex. 1001, 13:26–28). We do not agree with Patent Owner’s argument based on that portion of the specification. That section of the specification involves tiles communicating with each other and having “conditional content.” *See* Ex. 1001, 13:26–28. Such conditional content refers to “the content of one tile depend[ing] upon the content of another.” Ex. 1001, 13:28. This has nothing to do with the conditional request claimed. *See* Ex. 1001, 13:26–28.

We have considered Patent Owner’s remaining arguments and, for the reasons given below, do not find they support imposing a condition precedent.

First, we do not agree that the conditional request construction “encompass a mere coincidence.”

PO Resp. 26–27. In making that argument, Patent Owner does not accurately represent Petitioner’s arguments. Petitioner never argues that the claim was broad enough to cover a mere coincidence. *See* Pet. 29–30. Instead, as discussed above, Petitioner’s construction requires a specific type of request to be sent. *See id.* ; Pet. Reply 13, 16–17.

Second, we do not agree with Patent Owner’s arguments relating to the difference between the words “while” and “if” or the definition of the word “if.” *See* PO Resp. 26–27; PO Sur-reply 13. As with the prior argument, Patent Owner is not accurately representing Petitioner’s claim construction, which focuses on the type of request that is sent as opposed to its timing. *See* Pet. 29–30; Pet. Reply 13.

Third, we agree with Patent Owner that its condition precedent construction does not always result in the claim language being satisfied. *See* PO Sur-reply 14. But we find Patent Owner’s argument inapposite. For the reasons discussed above, we do not believe that the “if clause” imposes a condition precedent on when the conditional request is sent.

Accordingly, for the reasons set forth above, the “if clause” does not impose a condition precedent on when the conditional request is sent. Instead, the “if clause” describes the content of the conditional request.

C. OBVIOUSNESS OVER MSIE KIT AND RFC2068

Petitioner contends that MSIE Kit discloses each limitation of claims 1–13. Pet. 23–37. It

additionally asserts obviousness over MSIE Kit and RFC2068 for claims 1–8, based on an alternative view of the conditional-request limitations (referred to as “elements [1.d] and [6.b]”). Pet. 42–46. For other limitations, Petitioner relies on MSIE Kit alone, as set forth in its anticipation ground. *See* Pet. 23 (“Additional grounds, building on and incorporating the basic analysis and addressing arguments Patent Owner may raise, are also included below.”).

Because Petitioner’s obviousness contentions are consistent with our construction for the conditional-request limitations, we address them first. 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 Petitioner has shown that MSIE Kit discloses those limitations for the reasons given by Petitioner. Pet. 23– 37, 42–46.

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, 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.

RFC2068 is a specification describing the Hypertext Transfer Protocol, version 1.1. Ex. 1012. It describes conditional GET requests, and provides that such requests may use an “If-Unmodified-Since” statement, which cause the server to return the requested information only if it has not changed since a specified time. *Id.* at 124.

1. “partition at least a portion of a visual display of a client device into an array of tiles”

Claim 1 recites “instructions to partition at least a portion of a visual display of a client device into an array of tiles.” Ex. 1001, 30:32–33. Petitioner contends that MSIE Kit discloses partitioning a client display into an array of tiles by disclosing that, “[b]y default, Internet Explorer lays out new Active Desktop Items on a 3 by 2 grid.” Ex. 1010, 183. According to Petitioner, “[a] ‘grid’ is a form of an array because it is an ordered arrangement of items in a non-overlapping row/column format.” Pet. 24–25. Petitioner contends that Active Desktop items are tiles because they are “rectangular, borderless frames on the user’s display that a user may interact with,” “provide access to an information source when selected,” and “can be refreshed at a specified rate assigned to that desktop item.” Pet. 26.

Patent Owner argues that Active Desktop items are not tiles and are not partitioned into an array. PO Resp. 35–43. Patent Owner argues that Active Desktop items are not tiles because they do not provide a representation of an associated information source more limited than the full information provided by a window. PO Resp. 36–38. Patent Owner’s argument is

premised on its claim construction, which we do not adopt. *See supra* at 10–14 (§ II.B. 1). Accordingly, the argument is not persuasive.

Next, Patent Owner argues that Active Desktop items are not selectable to provide access to underlying information of the associated information source. PO Resp. 38–40. In particular, Patent Owner argues that clicking a hyperlink or host spot within an Active Desktop item cannot select the item because that action relates to the item’s content rather than the item itself. *Id.* at 38–39. We do not agree. As discussed above, we do not construe “tile” as limited to being selectable in a certain manner. *See supra* at 14–15 (§ II. B. 1). Accordingly, Patent Owner’s argument is not persuasive.

Patent Owner argues that MSIE Kit does not disclose partitioning at least a portion of a visual display into an array of tiles. PO Resp. 40–43. In Patent Owner’s view, because MSIE Kit discloses that Active Desktop items may be placed in arbitrary positions (Ex. 1010, 175), its tiles are not displayed in an orderly fashion. PO Resp. 41. We do not agree. When the grid of Active Desktop items is created, the location of the relative position of the Active Desktop items is not arbitrary; instead, by default the Active Desktop items are arranged in a 3 by 2 grid. *See* Ex. 1010, iii; Ex. 1065 ¶¶ 7, 10–11.

Moreover, although we do not construe the claims to require enforced arrangement, MSIE Kit also discloses that the default grid arrangement can be enforced. As Petitioner’s expert testified, “MSIE Kit discloses that administrators can prevent users from rearranging or removing Desktop Items, including

locking down the ‘default’ Active Desktop layout of a ‘3 by 2 grid’ of Desktop Items.” Ex. 1003 ¶ 150 (citing Ex. 1010, 235, 601); *see also* Ex. 1065 ¶ 7; Ex. 1010, 235 (“Once you’ve built your custom packages, you can use the IEAK Configuration Wizard to lock down channel options and restrict users from changing settings.”), 601 (“You can control, or *lock down*, features and functions in these areas. . . . More important, you can prevent users from adding or deleting channels that you have preset, or *from rearranging or adding Active Desktop items*.” (second emphasis added)). When the default grid is locked according to MSIE Kit’s teachings, it necessarily maintains the grid without any arbitrary movement or overlap. *See* Ex. 1003 ¶ 150; Ex. 1065 ¶ 7.

Based on the evidence, and under either party’s definition of “partition at least a portion of a visual display of a client device into an array,” we agree with Petitioner that MSIE Kit discloses partitioning at least a portion of a visual display of a client device into an array of tiles.

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 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.” Ex. 1001, 30:39–44.

Petitioner submits that MSIE Kit discloses “web crawling functionality” in which Internet Explorer periodically examines a linked web page. Pet. 29 (citing Ex. 1010, 191–92, 215–16, 176, 177, 180, 182; Ex. 1003 ¶¶ 161–162). Petitioner submits further that it would have been obvious to include RFC2068’s conditional GET functionality in MSIE Kit’s client device “to, for example, download the remainder of a web page (or other web document) when an earlier download was interrupted.” Pet. 43 (citing Ex. 1012, 123; Ex. 1024, 160, 79). Petitioner points out that MSIE Kit discusses RFC2068 and discloses the conditional HTTP GET method. *Id.* at 44 (citing Ex. 1010, 125, 129–30, 192, 787). Petitioner contends that the combination would have involved arranging old elements with each performing a known function and yielding expected results. *Id.* at 44.

Patent Owner argues first that “send a conditional request” requires conditionally sending a request, in that the request must be sent only when a condition is satisfied. PO Resp. 44. As discussed above, we do not agree with Patent Owner’s proposed construction for the conditional-request limitation. *See supra* at 19 (§ II.B.4). Accordingly, Patent Owner’s argument that the claim language “imposes a condition precedent that must be satisfied before sending the conditional request” is not persuasive. *See* PO Resp. 44.

Patent Owner does not otherwise challenge Petitioner’s contentions. We conclude that Petitioner has shown by a preponderance of the evidence that it would have been obvious to use MSIE Kit’s web-crawling functionality with RFC2068’s conditional GET method to request an update if the server’s information has not changed since a last update.

3. Conclusion

Patent Owner does not otherwise challenge Petitioner's showing as to obviousness of claims 1–8. Having reviewed the record, we conclude Petitioner has shown by a preponderance of the evidence that MSIE Kit and RFC2068 render those claims unpatentable as obvious.

D. ANTICIPATION BY MSIE KIT

Petitioner contends MSIE Kit discloses each limitation of claims 1– 13. Pet. 23–37. Because our obviousness discussion already addresses Patent Owner's challenges to those contentions regarding claims 1–8, we need not repeat them. Additionally, having concluded that Petitioner has proven obviousness for claims 1–8, we do not address anticipation for those claims.

As discussed above, we conclude that MSIE Kit discloses claim 1's partition limitation. *See supra* at 23 (§ II. C. 1). Claim 9 recites a parallel limitation. Ex. 1001, 31:26–27; PO Resp. 20. Accordingly, our conclusion regarding claim 1 applies also to claim 9.¹¹

For independent claim 9, and claims 10–13, which depend from claim 9, Patent Owner disputes only one additional aspect of Petitioner's contentions, which we address below. We have reviewed the undisputed aspects of Petitioner's contentions and conclude that Petitioner has shown that MSIE Kit

¹¹ Claim 9 does not include the conditional-request limitation discussed above for claim 1. *See* Ex. 1001, 31:23–32:17.

discloses those limitations for the reasons given by Petitioner. Pet. 23–37. Claim 9 further recites instructions “for the second device to assign first update rate for updating information from the first information source.” Ex. 1001, 32:1–3. Petitioner contends that MSIE Kit discloses this limitation through a CDF file located on the server, which is downloaded to a client device and establishes an Active Desktop item with a particular update schedule. Pet. 34 (citing Ex. 1010, 186, 217; Ex. 1003 ¶ 237).

To the extent that Patent Owner relies on its proposed construction for the assigning limitation, we do not adopt that construction (*see supra* at 16 (§ II. B.3)) and therefore Patent Owner’s arguments are not persuasive.

Patent Owner argues that “a schedule set by a CDF file is not the same as the second device assigning the first update rate.” PO Resp. 45. According to Patent Owner, the update rate is assigned by an author when creating the CDF file and therefore cannot be assigned by the server. *Id.* Patent Owner, however, contends additionally that the client computer’s software (Internet Explorer 4) “interprets the CDF file to assign the schedule.” *Id.* at 46 (citing Ex. 1010, 186). Those two arguments suggest that assigning the update rate is not limited to a single event, but rather multiple assignments may occur for a particular tile—one when an author creates a file and another when the client computer interprets the file. In this regard, we agree with Petitioner that even if creating a CDF file “assigns” a tile’s update rate in some sense, transferring that file from the server to a client also assigns the tile’s update rate. Pet. Reply 17–18.

Patent Owner argues that “the ’338 Patent does not provide a single example of a user, a grid object, or a tile object assigning a priority based on ‘a file that defines the update rate for an item.’” PO Resp. 46 (quoting Inst. 21). The specification, however, discloses that a grid comprises a matrix or array of tiles and controls the layout and priorities of the tiles. Ex. 1001, 14:14–28. The grid may “manage the refresh rate of each tile in the grid.” *Id.* at 17:12–14. And “grids should also be sendable” or “transferred as a file,” for example using a markup language like HTML or XML. *Id.* at 18:4, 18:23–24, 18:42–44. Thus, it appears that the specification contemplates using a file to control the refresh rate of a tile. Patent Owner seems to recognize this, and argues that a grid object on a server is created by a “grid generator” whereas MSIE Kit’s CDF file is created by a user and uploaded to a server. PO Resp. 47. The problem with Patent Owner’s argument is that it attempts to limit the claims to one disclosed embodiment. *See* Ex. 1001, 27:42–28:67. Nothing about the description of grid objects elsewhere in the specification suggests that server-located grid objects must be created on a server by the server. *See* Ex. 1001, 18:4 (“grids should also be sendable”), 18:59–62 (“The application program may be downloaded from a predetermined web-site and preferably operates in a client-server mode. Users may download preconfigured grids from the predetermined server.”).

We conclude that a server transmitting a CDF file to a client assigns an update rate to the Active Desktop item created from the CDF file. *See* Ex. 1010, 186, 217; Ex. 1003 ¶ 237. Accordingly, Petitioner has

shown that MSIE Kit discloses the assigning limitation.

Patent Owner does not otherwise challenge Petitioner’s showing as to anticipation of claims 9–13. Having reviewed the record, we conclude Petitioner has shown by a preponderance of the evidence that MSIE Kit renders those claims unpatentable as anticipated.

III. CONCLUSION¹²

For the reasons discussed above, we conclude that Petitioner has shown by a preponderance of the evidence that the challenged claims are unpatentable.

In summary:

Claims	Claims	Reference/Basis	Claims Shown Unpatenable	Claims Not Shown Unpatenable
1–13	102(a), (b)	MSIE Kit ¹³	9-13	

¹² Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

¹³ Because we determine that claims 1–8 are unpatentable as obvious over MSIE Kit and RFC2068, we decline to address those claims in this ground.

1-13	103(a))	MSIE Kit ¹⁴		
1-13	103(a))	MSIE Kit, Jones ¹⁵		
1-8	103(a))	MSIE Kit, RFC2068	1-8	
1-8	103(a))	MSIE Kit, RFC2068, Jones ¹⁶		
1-13	103(a))	Excel97 ¹⁷		
9-13	103(a))	Excel97, Igra, Perez ¹⁸	1-13	
Over all Outc ome			1-13	

Accordingly, it is

¹⁴ Because we determine that claims 1-13 are unpatentable in other grounds, we decline to address this ground.

¹⁵ Because we determine that claims 1-13 are unpatentable in other grounds, we decline to address this ground.

¹⁶ Because we determine that claims 1-13 are unpatentable in other grounds, we decline to address this ground.

¹⁷ Because we determine that claims 1-13 are unpatentable in other grounds, we decline to address this ground.

¹⁸ Because we determine that claims 1-13 are unpatentable in other grounds, we decline to address this ground.

ORDERED that Petitioner has shown by a preponderance of the evidence that claims 1–13 of the '338 patent are unpatentable; and

FURTHER ORDERED that because this is a Final Written Decision, 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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NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

SURFCAST, INC.,

Appellant

v.

MICROSOFT CORPORATION,

Appellee

2024-1156, 2024-1160, 2024-1161, 2024-1162

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

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

Before MOORE, *Chief Judge*, LOURIE, SCHALL¹,
DYK, PROST, REYNA, TARANTO, CHEN,
HUGHES, STOLL, and STARK, *Circuit Judges*.²

PER CURIAM.

O R D E R

SurfCast, Inc. filed a combined petition for panel re hearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

¹ Circuit Judge Schall participated only in the decision on the petition for panel rehearing.

² Circuit Judges Newman and Cunningham did not participate.

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FOR THE COURT



Jarrett B. Perlow
Clerk of Court

August 6, 2025
Date