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Paper 32
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RACKSPACE HOSTING, INC.,
Petitioner,

v.

ROTATABLE TECHNOLOGIES LLC,
Patent Owner.

Case IPR2013-00248
Patent 6,326,978

Before MICHAEL P. TIERNEY, MICHAEL W. KIM, and MIRIAM L. QUINN, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

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

I. BACKGROUND

A. Introduction

Rackspace Hosting, Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1-18 of U.S. Patent No. 6,326,978 (Ex. 1001, "the '978 patent"). Paper 2 ("Pet."). Rotatable Technologies LLC ("Patent Owner") timely filed a Patent Owner Preliminary Response. Paper 9

("Prelim. Resp."). On October 1, 2013, the Board instituted trial for claims 1-18 on the following grounds of unpatentability:

Reference(s)	Basis	Claims Challenged
Martinez[1] and Capps[2]	§ 103(a)	1-4, 6-9, 11-14, 16, and 18
Martinez, Capps, and Adobe[3]	§ 103(a)	5, 10, 15, and 17
Bruder[4]	§ 102(e)	1, 2, 4, 6, 7, 9, 10, 13-15, and 18
Bruder and Takano[5]	§ 103(a)	3, 11, and 16
Bruder and Kreegar[6]	§ 103(a)	8
Bruder and Adobe	§ 103(a)	5

Paper 10 ("Dec.").

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 18, "PO Resp."), and filed a Contingent Motion to Amend (Paper 19, "Motion"). Petitioner subsequently filed a Reply to the Response (Paper 22, "Reply") and an Opposition to Patent Owner's Contingent Motion to Amend (Paper 21, "Opp."). Patent Owner then filed a Reply in support of its Contingent Motion to Amend (Paper 24, "Reply to Opp."). An oral hearing was held on May 14, 2014. The transcript of the hearing has been entered into the record. Paper 31.

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[1] U.S. Patent No. 6,137,468 (Ex. 1006).
[2] U.S. Patent No. 5,345,543 (Ex. 1007).
[3] Adobe Photoshop 5.0 User Guide ("Adobe") (Ex. 1008).
[4] U.S. Patent No. 6,327,393 (Ex. 1003).
[5] U.S. Patent No. 5,045,844 (Ex. 1005).
[6] U.S. Patent No. 5,396,590 (Ex. 1004).

We have jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a).

Claims 1-18 of the '978 patent are *unpatentable*.

Patent Owner's Contingent Motion to Amend is *denied*.

B. Related Proceedings

Both Petitioner and Patent Owner indicate that the '978 patent was asserted against Petitioner in a co-pending district court case captioned *Rotatable Tech., LLC v. Petroleum Geo-Services, Inc.*, Case No. 2:13-cv-00177 (E.D. Tex.). Pet. 1; Paper 8, 2.

C. The '978 patent

The subject matter of the '978 patent relates to graphical user interfaces ("GUIs") and display methods for selectively rotating windows on a computer display. Ex. 1001, 1:7-10. According to the '978 patent, a need exists for a display method for selectively rotating windows on a computer display, such that a user may experience greater interface flexibility. Ex. 1001, 2:18-22. A system employing such a display method would operate by providing a mechanism for the user selectively to rotate the windows as needed or desired, thus providing the user with a more manageable computer interface. Ex. 1001, 2:22-26.

To that end, Figure 1 of the '978 patent, shown below, depicts a window 10 for the computer display that provides selective rotation in a manner that facilitates human interfacing. Ex. 1001, 2:57-59.

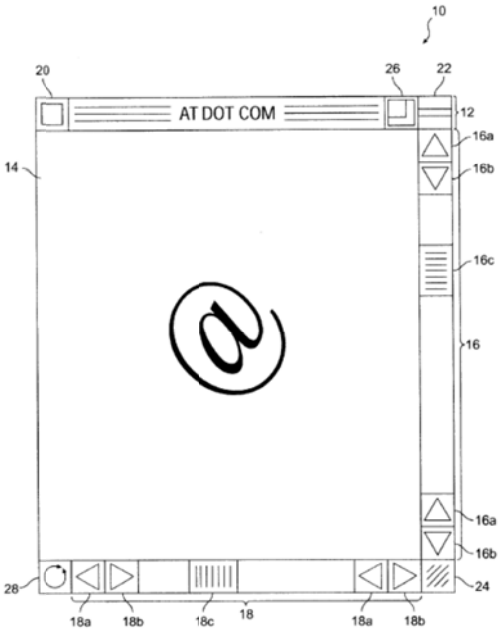


FIG. 1

Figure 1 illustrates a schematic of a window for a computer display that provides selective rotation in a manner which facilitates human interfacing.

Window 10, depicted above in Figure 1, is generated by a program running on the computer, such as the operating system or the application program. Ex. 1001, 2:59-61. In the lower left hand corner of window 10 is rotation button 28. Ex. 1001, 3:39-40. To rotate window 10, the user clicks and holds rotation button 28 with an input device (e.g., a mouse) while dragging window 10 to a selected orientation, which is depicted in the example shown below in Figure 2. Ex. 1001, 1:21-23, 3:42-44.

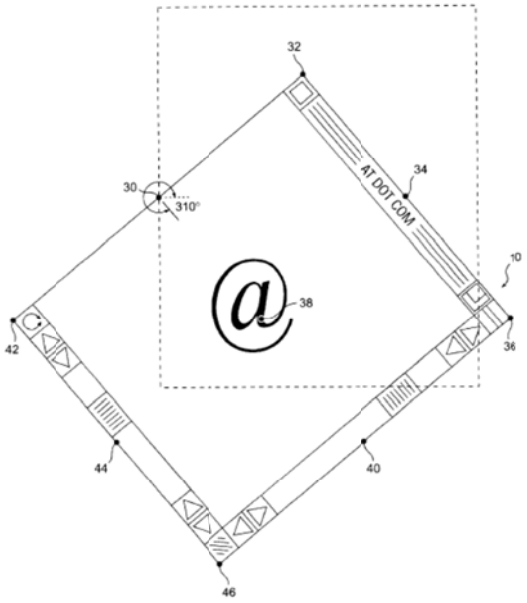


FIG. 2

Figure 2 illustrates a schematic of a window for a computer display that has been rotated approximately 310 degrees and that shows potential preselected rotation points.

During the rotation, window 10 rotates about a rotation point, an example of which is shown above in Figure 2 as rotation point 30. Ex. 1001, 3:44-46, 4:22-24. By clicking and holding rotation button 28, the user may choose any orientation within the 360 degree circle or the choices may be limited to certain preselected orientations such as 0, 90, 180, and 270 degrees. Ex. 1001, 3:46-50.

D. Illustrative Claims

Of challenged claims 1-18, claims 1, 9, and 14 are the only independent claims, and provide as follows:

> 1. A computer display window comprising:
> a display portion;
> a frame surrounding the display portion; and
> means for selectively rotating the window about a rotation point at the discretion of the user;

wherein the plane of the window, the plane of rotation, and the rotation point are coplanar.

9. A method of selectively rotating a computer display window having a display portion and a frame surrounding the display portion, the method comprising the steps of:

determining a rotation point; and

rotating the window about the rotation point at the discretion of the user;

wherein the plane of the window, the plane of rotation, and the rotation point are coplanar.

14. A system for selectively rotating a computer display window having a display portion and a frame surrounding the display portion, the system comprising:

means for determining a rotation point; and

means for rotating the window about the rotation point at the discretion of the user;

wherein the plane of the window, the plane of rotation, and the rotation point are coplanar.

Ex. 1001, 5:5-6:20.

II. ANALYSIS

For the challenged claims, Petitioner has to prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). In patent law, "the name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998). Therefore, we begin with claim construction, and then follow with specific analysis of the prior art.

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the

specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the disclosure. *In re Translogic Tech., Inc*., 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. Computer Display Window

Independent claims 1, 9, and 14 each recite "computer display window." The term "computer display window" is cited only in the preamble of these claims, but it is given patentable weight as it provides an antecedent basis for "the window" recited in the body of each of these claims. *C.W. Zumbiel Co., Inc. v. Kappos*, 702 F.3d 1371, 1385 (Fed. Cir. 2012) (*citing Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002)) (the preamble constitutes a limitation when the claim(s) depend on it for antecedent basis).

The Specification does not provide an explicit definition of "computer display window." The Petition proposes the following construction:

> "*computer display window*": a window generated by an operating system or an application program. (RACK-1009, ¶31.) One example of a computer display window is generated by an operating system is a file explorer window. (*Id*. at ¶32.) One example of a computer display window generated by an application program is a bounding box used by an application to manipulate graphical objects. (*Id*. at ¶32.)

Pet. 9-10. In setting forth this proposed construction, however, Petitioner does not propose a construction for "window." Later, Petitioner and its expert, Dr. Don Turnbull, cite a dictionary definition of "window" in

proposing the following construction based on the analysis set forth in the Decision to Institute: "A division of a display screen in which a set of information is displayed." Reply 1-3 (citing Exs. 1012; 1013 ('window' in ACADEMIC PRESS DICTIONARY OF SCIENCE AND TECHNOLOGY 2372 (Christopher Morris ed., 1992); 2003). Patent Owner disagrees with this proposed construction for the reasons set forth below. Even when Patent Owner's positions are taken into account, however, we are persuaded that Petitioner's later-proposed construction is correct.

To be sure, the proposed construction is broad. As Petitioner notes, however, the Specification recites explicitly that "[o]ne of ordinary skill in the art will realize that the window 10 may take any one of a number of configurations containing any one of a number of elements." Ex. 1001, 2:60-64. Accordingly, Petitioner's proposed construction comports with the Specification, in that the Specification itself indicates that "window" is to be construed broadly, and thus is the broadest reasonable construction in light of the Specification.

Patent Owner asserts that no construction is necessary for a well-understood term such as "window." PO Resp. 5-6. We disagree. Petitioner and Patent Owner disagree as to whether the "deformable window" identified in Bruder corresponds properly to the recited "computer display window." Pet. 35; PO Resp. 35-38. Such a disagreement indicates that "window" is not a well-understood term, and, thus, that an express construction is warranted.

If an express construction is necessary, Patent Owner asserts that "window" should be construed as follows: "[i]n application and graphical

interfaces, a portion of the screen that can contain its own document or message." PO Resp. 6 (citing Ex. 2005, 567). Patent Owner provides several reasons as to why its construction truly represents the broadest reasonable construction in light of the Specification.

Patent Owner first asserts that Patent Owner was not provided a copy of the source relied upon for the definition of "window," and thus Patent Owner was not provided with a fair opportunity to evaluate the construction. We agree with Patent Owner insofar as we failed to include as an Exhibit to the Decision to Institute a copy of the dictionary pages with the "window" definition. We are not persuaded that Patent Owner was prejudiced by the oversight, however, because the dictionary definition itself was provided to Patent Owner (Dec. 8-9), Patent Owner did not request a copy from the Board, and Petitioner provided a copy to Patent Owner as Exhibit 1013.

Patent Owner asserts that there is no evidence of record that one of ordinary skill could have or would have referenced this source at the time of the invention. Petitioner provides evidence that the ACADEMIC PRESS DICTIONARY OF SCIENCE AND TECHNOLOGY was accessible to the public, which is unrebutted by Patent Owner. Reply 2 (citing Exs. 1012, 1013, 2003).

Patent Owner further asserts that its proposed construction should be adopted over the Petitioner's because its construction "clearly distinguishes the commonly-known window from non-window objects like icons, text boxes, spreadsheet cells, taskbars, etc." PO Resp. 6. We first disagree with Patent Owner's assertion, because Patent Owner provides no credible evidentiary basis for us to determine objectively that a broadest reasonable

construction of "window" should exclude "non-window objects like icons, text boxes, spreadsheet cells, taskbars." Although we agree with Patent Owner that the Specification makes no reference to "icons, text boxes, spreadsheet cells, taskbars," we are not persuaded that their absence indicates to one of ordinary skill that a broadest reasonable construction of "window" should exclude them, especially where the Specification recites explicitly that "[o]ne of ordinary skill in the art will realize that the window 10 may take any one of a number of configurations containing any one of a number of elements." Ex. 1001, 2:60-64.

Additionally, we are not persuaded that Patent Owner's proposed construction excludes "icons, text boxes, spreadsheet cells, taskbars." Patent Owner proposes a construction of "window" as follows: "[i]n application and graphical interfaces, a portion of the screen that can contain its own document or message." We note that all of "icons, text boxes, spreadsheet cells, taskbars" would meet Patent Owner's proposed construction, as all "can contain its own . . . message." Accordingly, we do not adopt Patent Owner's proposed construction.

Patent Owner also asserts that its cited source, MICROSOFT COMPUTER DICTIONARY 567 (5th ed., Microsoft Press 2002), is superior to the source relied upon by Petitioner for the reasons set forth above. As we do not determine that any of the reasons set forth above are persuasive, however, we are not persuaded that Patent Owner's cited source is superior, nor that it requires a modification of our proposed construction.

For the reasons set forth above, we construe "window" as "a division of a display screen in which a set of information is displayed."

2. Display Portion

Independent claims 1, 9, and 14 each recite a "display portion" of the "computer display window." "[D]isplay portion" is recited only in the preamble of independent claims 9 and 14. However, it is a structural element of the "computer display window," which is given patentable weight for the reasons set forth above. Accordingly, we also give patentable weight to "display portion" in those claims.

The Specification does not provide an explicit definition of "display portion." Petitioner first contends that "display portion" should be construed as "an interior portion of a computer display window." Pet. 10. Later, Petitioner and its expert, Dr. Don Turnbull, cite the Specification in proposing the following construction of "display portion" based on the analysis set forth in the Decision to Institute: "the portion of 'computer display window' that provides viewable information." Reply 3-4 (citing Exs. 1001, 2:61-64; 1012; 2003). Patent Owner first asserts that no express construction is necessary for such a well-understood term such as "display portion," and then asserts alternatively that "display portion" should be construed as follows: "the portion of the computer display window that contains the document or message of the window." PO Resp. 6-8. After considering both parties' positions as well as supporting evidence, we are persuaded that Petitioner's later-proposed construction is correct.

Specifically, when reviewing the word "portion," it is clear that "display portion" must be a portion of the "computer display window." As for "display," the '978 patent discloses the following:

> If the window displays only a portion of the total information, then the user is provided with one or more scroll bars that allow the user to move the ***display portion*** to view other portions of the total information.

Ex. 1001, 1:46-49 (emphasis added). Accordingly, in light of the Specification, we are persuaded that a broadest reasonable construction of "display portion" is "the portion of 'computer display window' that provides viewable information."

Patent Owner asserts that no construction is necessary for such a well-understood term such as "display portion." We disagree. Petitioner and Patent Owner disagree as to whether a portion of the "deformable window" identified in Bruder actually displays information. Such a disagreement indicates that "display portion" is not a well-understood term, and, thus, that an express construction is warranted.

If an express construction is necessary, Patent Owner asserts that "display portion" should be construed as follows: "the portion of the computer display window that contains the document or message of the window." PO Resp. 8. Patent Owner asserts that this construction truly represents the broadest reasonable construction in light of the Specification, because Petitioner's later-proposed construction is overbroad. Specifically, Patent Owner asserts that when a computer displays an entire window, all parts of the window provide viewable information. Thus, to adopt Petitioner's later-proposed construction would render "display portion" meaningless. By contrast, Patent Owner asserts that its construction is not overbroad, because it "clearly distinguishes the commonly-known window from non-window objects like icons, text boxes, spreadsheet cells, taskbars,

etc." PO Resp. 6. As set forth above, we first disagree with Patent Owner's assertion, because Patent Owner provides no credible evidentiary basis for us to determine objectively that a broadest reasonable construction of "window" should exclude "non-window objects like icons, text boxes, spreadsheet cells, taskbars."

Additionally, we are not persuaded that Patent Owner's proposed construction excludes "icons, text boxes, spreadsheet cells, taskbars." All of "icons, text boxes, spreadsheet cells, taskbars" would meet Patent Owner's proposed construction of "display portion," as all are "portions" of a "window" that "can contain its own . . . message." Accordingly, we do not adopt Patent Owner's proposed construction.

For the reasons set forth above, we construe "display portion" as "the portion of 'computer display window' that provides viewable information."

3. Toggling the window between two preselected orientations

Dependent claims 12 and 17 each recite "toggling the window between two preselected orientations." Petitioner contends that "toggling . . ." should be construed as "switching the window from one preselected orientation to another preselected orientation." Pet. 10. Patent Owner does not provide a proposed construction of "toggling . . ." The Specification does not provide a definition of "toggling." The dictionary defines "toggle" as follows: "A switching action performed on an object with two states." 'toggle' in THE AUTHORITATIVE DICTIONARY OF IEEE STANDARD TERMS (Standards Information Network, IEEE Press 2000) *available at* http://ieeexplore.ieee.org/stamp/stamp.jsp?tp=&arnumber=4116808 (last viewed Sept. 17, 2013). This definition is consistent with

the Specification and claim language, which recites two states: one preselected orientation and another preselected orientation. Accordingly, we construe "toggle" as "a switching action performed on an object with two states," and construe "toggling the window between two preselected orientations" as "a switching action performed on a window with two preselected orientations."

4. Means for [selectively] rotating the window about the rotation point at the discretion of the user

Independent claim 1 recites "means for selectively rotating the window about a rotation point at the discretion of the user." Independent claim 14 recites "means for rotating the window about the rotation point at the discretion of the user." We note that independent claim 1 recites "*selectively* rotating" as opposed to just "rotating" in independent claim 14. However, we cannot discern a difference between "selectively rotating" and "rotating" in the context of the rest of the claim limitation, as "rotating . . . at the discretion of the user" would be commensurate with being "selective." Accordingly, we construe both "means for rotating . . ." phrases together.

Petitioner proposes that both "means for rotating . . ." be construed as covering "a rotation button, ([Ex. 1001], 3:57-59); menu commands, (*id*. at 3:65-66); key strokes, (*id*. at 3:66-67); or a rotation cursor that appears over a designated portion of the frame (*id*. at 4:1-4)." Pet. 11. Patent Owner asserts that both "means for rotating . . ." are means-plus-function limitations under 35 U.S.C. § 112, sixth paragraph, and that the Specification should be consulted to identify the structure, material, or acts which are described as performing the recited functions. Patent Owner asserts further that a correct construction of both "means for rotating . . ."

should not require that any "rotation option" be displayed with the window, as any such construction would exclude both menu commands and key strokes, which are disclosed explicitly in the Specification (col. 3, l. 64 through col. 4, l. 1) and claims 3 and 4 as viable "rotation option[s]." PO Resp. 8-9.

The claimed function is "rotating the window about the rotation point at the discretion of the user." The Specification discloses the claimed function as follows:

> In the lower left hand corner of the frame of the window 10 is the rotation button 28. This represents the preferred location for the rotation button 28, but other locations are possible. The ***user clicks and holds the rotation button 28*** with the input device while dragging the window to the selected orientation. The window 10 rotates about a rotation point (not shown) which will be discussed in greater detail with respect to FIG. 2 below. ***Through clicking and holding the rotation button 28, the user may be able to choose any orientation*** within the 360 degree circle or the choices may be limited to certain preselected orientations such as 0, 90, 180, and 270 degrees. ***By single clicking on the rotation button 28, the user can rotate the window 10 by a preselected amount or to a preselected orientation.*** For example, single clicking could rotate the window 10 by small angles such as 1 or 5 degrees for minor reorientations or by large angles such as 90 or 180 degrees for major reorientations. [Alternatively], single clicking could toggle between two preselected orientations. By double clicking on the rotation button 28, the user can return the window 10 to the home orientation. Rotation could of course be in either the counter-clockwise direction or the clockwise direction as desired. One of ordinary skill in the art will realize that ***the above described functions of the rotation button 28 could also be the result of other input device combinations of clicking, holding, or both.*** Such skilled

> persons will further realize that the above described functions could be accomplished through menu driven commands or special key strokes in addition to or in place of the use of the rotation button 28. Under Microsoft® Windows® the rotation button 28 could be replaced with a rotation cursor (not shown) that appears when the user moves the cursor over a designated portion of the frame.

Ex. 1001, 3:39-4:4 (emphases added). *See*, Ex. 1001, 2:56-66, 4:5-11, 4:57-59. All of the above disclosures in the Specification show rotation being accomplished via a computer on a computer display. Based on these disclosures in the Specification, the structure corresponding to the recited "means for rotating . . ." covers a computer. However, because the claimed function is not implemented just by a computer, but also by software running on a general purpose computer, the corresponding structure under § 112, sixth paragraph, is not the general purpose computer, but the disclosed algorithm for performing the claimed function.

We discern the following algorithm from the aforementioned portions of the Specification: (1) generating a window on a computer display that is operatively connected to a rotation option; (2) receiving user input into the computer via the rotation option; and (3) based on the user input, using a phantom frame to show the new location of the rotated window ***or*** rotating the window simultaneously with the user input. Accordingly, we construe both "means for rotating . . ." as corresponding to a computer that implements the aforementioned algorithm. We note that this construction addresses Patent Owner's concerns, as both menu commands and key strokes would viable "rotation options" under this construction.

5. Means for determining a rotation point

Independent claim 14 recites "means for determining a rotation point." Petitioner proposes that "means for determining a rotation point" be construed as "a mouse or similar input device." Pet. 11. As this limitation also invokes 35 U.S.C. § 112, paragraph 6, however, we mirror the analysis set forth above in our construction of "means for rotating . . .," and construe "means for determining a rotation point" as corresponding to a computer that implements an algorithm. The Specification discloses the following concerning the function of "determining a rotation point:"

> Turning now to FIG. 2, a schematic of a window 10 for a computer display that has been rotated approximately 310 degrees and that shows potential ***preselected rotation points*** according to one embodiment of the present invention is shown. The window 10 shown has the same elements as described with respect to FIG. 1 above but the reference numerals have been omitted for clarity. The home orientation is shown in phantom for reference purposes. In this case, the ***rotation point has been selected*** as point 30 which is located at the midpoint of the left frame. Eight other potential rotation points are shown as points 32, 34, 36, 38, 40, 42, 44, and 46. Together, these nine points represent the corners, the midpoints of the sides, and the center of the window 10. Preferably, ***these points would not be shown to the user except as part of a preselection routine***. Any of the nine points could be initially ***selected as the default rotation point***. One of ordinary skill in the art will realize that any number of points within or on the window 10 are ***potential rotation points***. Such skilled persons will further realize that any number of points outside of the window, such as the upper left corner of the display, may be selected as rotation points. ***Selection of a rotation point outside of the window 10*** will result in both rotation and translation of the window from the starting orientation to the final orientation.

Ex. 1001, 4:15-40 (emphases added). Using the analysis set forth above in our construction of "means for rotating . . .," we discern the following algorithm for "means for determining a rotation point" from the aforementioned portions of the Specification: determining a default rotation point ***or*** receiving a user selection into a computer of any rotation point within, on, or outside of a window on a display of the computer. Accordingly, we construe "means for determining a rotation point" as corresponding to a computer that implements the aforementioned algorithm.

6. Means for rotating the window by predetermined increments

Dependent claim 16 recites "means for rotating the window by predetermined increments." Petitioner proposes that this "means for rotating . . ." be construed as "a rotation button, ([Ex. 1001], 3:57-59); menu commands, (*id*. at 3:65-66); key strokes, (*id*. at 3:66-67); or a rotation cursor that appears over a designated portion of the frame, (*id*. at 4:1-4)." Pet. 11-12. As this limitation also invokes 35 U.S.C. § 112, paragraph 6, however, we construe this "means for rotating . . ." as corresponding to a computer that implements an algorithm. The Specification discloses the following examples of the function of "rotating the window by predetermined increments":

> Through clicking and holding the rotation button 28, the user may be able to choose any orientation within the 360 degree circle or the choices may be limited to certain ***preselected orientations*** such as 0, 90, 180, and 270 degrees. By single clicking on the rotation button 28, the user can rotate the window 10 by a ***preselected amount or to a preselected orientation***. For example, ***single clicking could rotate the window 10 by small angles such as 1 or 5 degrees for minor reorientations or by large angles such as 90 or 180 degrees for***

> ***major reorientations***. Alteratively, [sic] single clicking could toggle between two ***preselected orientations***.

Ex. 1001, 3:46-57 (emphases added). Using the analysis set forth above, we discern the following algorithm for "means for rotating the window by predetermined increments" from the aforementioned portions of the Specification: (1) generating a window on a computer display that is operatively connected to a rotation option having predetermined increments; (2) receiving user input into the computer via the rotation option; and (3) based on the user input, using a phantom frame to show the new location of the rotated window at the predetermined increments ***or*** rotating the window through the predetermined increments simultaneously with the user input. Accordingly, we construe "means for rotating the window by predetermined increments" as corresponding to a computer that implements the aforementioned algorithm.

7. Means for toggling the window between two preselected orientations

Dependent claim 17 recites "means for toggling the window between two preselected orientations." Petitioner proposes that "means for toggling . . ." be construed as "a rotation button, ([Ex. 1001], 3:57-59); menu commands, (*id*. at 3:65-66); key strokes, (*id*. at 3:66-67); or a rotation cursor that appears over a designated portion of the frame, (*id*. at 4:1-4)." Pet. 12. As this limitation also invokes 35 U.S.C. § 112, paragraph 6, however, we construe "means for toggling . . ." as corresponding to a computer that implements an algorithm. The Specification discloses the following concerning the function of "toggling the window between two preselected orientations": "single clicking could toggle between two preselected

orientations." Ex. 1001, 3:56-57 (emphasis added). Taking into account our previous construction of "toggling the window between two preselected orientations," we discern the following algorithm for "means for toggling . . ." from the aforementioned portions of the Specification: (1) generating a window on a computer display including only two preselected orientations; (2) receiving user input into the computer; and (3) based on the user input, switching from one to the other of two possible preselected window orientations. Accordingly, we construe "means for toggling . . ." as corresponding to a computer that implements the aforementioned algorithm.

Patent Owner asserts that step (1) of the aforementioned algorithm is vague and overly narrow to the extent that it requires that the "rotation option" be displayed with the window. PO Resp. 8-9. We are not persuaded by Patent Owner's assertion, however, as neither the "means for toggling" nor its corresponding algorithm recites "rotation option." Accordingly, we see no reason to modify our construction of "means for toggling."

8. Means for returning the window to a zero degree orientation

Dependent claim 18 recites "means for returning the window to a zero degree orientation." Petitioner proposes that this "means for returning . . ." be construed as "a rotation button, ([Ex. 1001], 3:57-59); menu commands, (*id*. at 3:65-66); key strokes, (*id*. at 3:66-67); or a rotation cursor that appears over a designated portion of the frame, (*id*. at 4:1-4)." Pet. 12. As this limitation also invokes 35 U.S.C. § 112, paragraph 6, however, we construe "means for returning . . ." as corresponding to a computer that implements an algorithm. The Specification discloses that the home orientation is the

equivalent of a zero degree orientation. Ex. 1001, 3:5-8; 3:46-59. We discern the following algorithm for "means for returning . . ." from the aforementioned portions of the Specification: (1) generating a window on a computer display including a home or zero degree orientation; (2) receiving user input into the computer; and (3) based on the user input, returning the window to a home or zero degree orientation. Accordingly, we construe "means for returning . . ." as corresponding to a computer that implements the aforementioned algorithm.

Patent Owner asserts that step (1) of the aforementioned algorithm is vague and overly narrow to the extent that it requires that the "rotation option" be displayed with the window. PO Resp. 8-9. We are not persuaded by Patent Owner's assertion, however, as neither the "means for returning" nor its corresponding algorithm recites "rotation option." Accordingly, we see no reason to modify our construction of "means for returning."

B. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) 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. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of 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 skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

In that regard, an obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418; *see also Translogic*, 504 F.3d at 1259. A prima facie case of obviousness is established when the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976). The level of ordinary skill in the art may be reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

We analyze the instituted grounds of unpatentability in accordance with the above-stated principles.

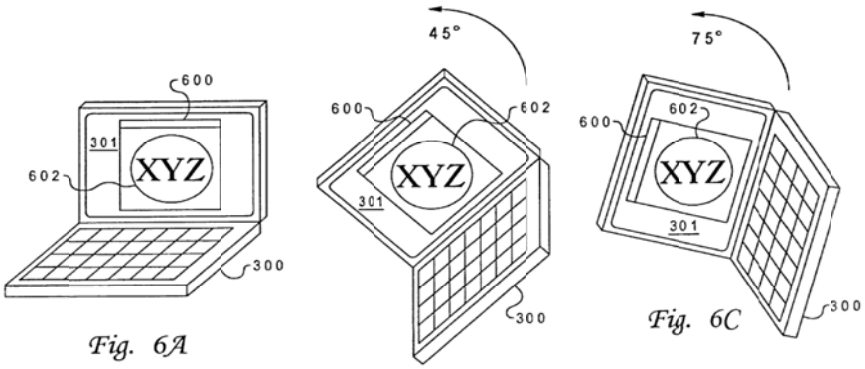
C. Alleged Obviousness Over Martinez and Capps

Petitioner contends that claims 1-4, 6-9, 11-14, 16, and 18 are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez and Capps. Pet. 13-31; Reply 4-9. Petitioner explains how a combination of Martinez and Capps allegedly discloses or suggests the claimed subject matter, and also relies on the Declarations of Dr. Turnbull to support its positions. Exs. 1009, 1012.

1. Martinez (Exhibit 1006)

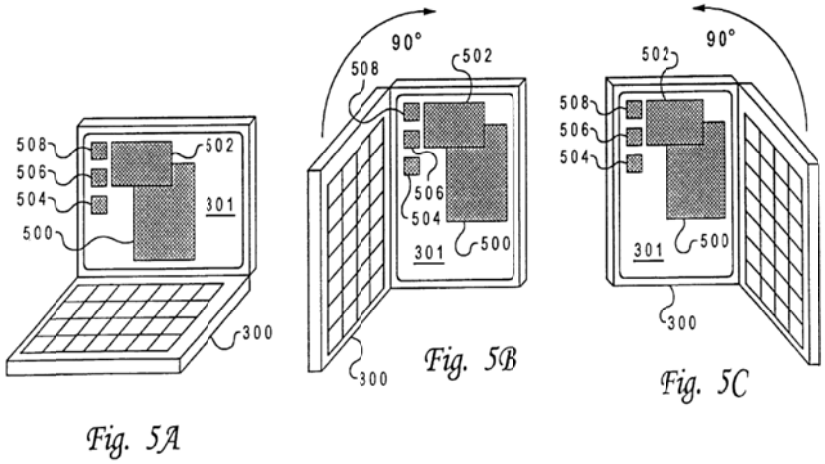
Martinez discloses rotating a laptop around one axis that results in a change in orientation in another axis, and maintaining windows level with

respect to a preselected reference plane during such a rotation. Ex. 1006, 4:21-22, 5:42-44. For example, Figures 6A-6C of Martinez depict window 600 containing object 602 on display 301 of laptop 300. Ex. 1006, 4:61-65.



Figures 6A-6C illustrate a process for maintaining window objects level through changes in attitude.

As shown in Figures 6B and 6C above, object 602 in window 600 remains level even though laptop 300 has been rotated 45 degrees and 75 degrees, respectively. Ex. 1006, 4:65-5:4. Furthermore, as shown below, Figures 5A-5C of Martinez disclose windows 500, 502 on display 301 of laptop 300. Ex. 1006, 4:52-55.



Figures 5A-5C illustrate diagrams of different displays.

When laptop 300 has been rotated 90 degrees from Figure 5A to Figure 5C, windows 500, 502 also have been rotated 90 degrees.

2. Capps (Exhibit 1007)

Capps discloses that a user may wish to rotate an image on a screen of a computer system. Ex. 1007, 1:20-23. According to Capps, these functions are accomplished by selecting items to be manipulated and then requiring that the user choose a desired rotation function from a menu, and then "rotate" the selected items through use of a screen pointer which grabs a "gravity point" or "handle" on the selected item. Ex. 1007, 1:27-32. For example, as shown below, Figure 4 of Capps depicts crank 62, crank axle 65, and crank handle 67.

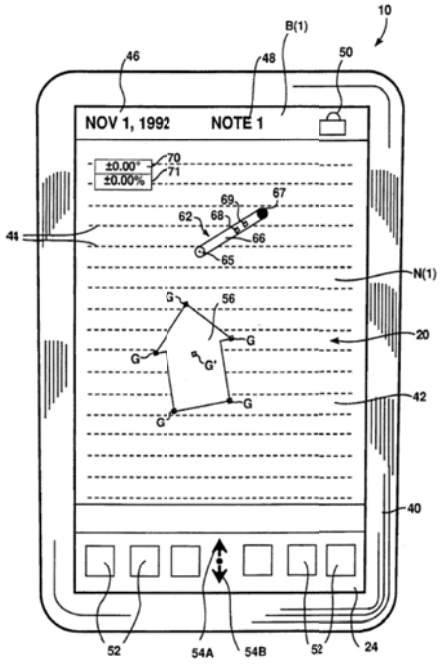


FIG. 4

Figure 4 illustrates a screen of a computer display assembly including a crank icon.

To rotate a selected object using crank 62, a rotate mode is selected, and crank 62 is moved to a position such that axle 65 is located at a desired center of rotation. Ex. 1007, 6:58-62. Then, stylus 38 is placed on or near crank handle 67 and is moved roughly in a circular direction about axle 65. Ex. 1007, 6:61-63. The computer system routinely updates the screen so that the selected object rotates as crank 62 is being rotated. Ex. 1007, 7:1-3. Capps discloses that, while the method of its present invention is described in the context of a pen-based system, other pointing devices such as a computer mouse, a track ball, or a tablet can be used to manipulate a pointer on a screen of a general purpose computer. Ex. 1007, 3:43-48.

3. "Rotating the Window" (Claims 1, 9, 14)

Independent claim 1 recites "means for selectively rotating the window about a rotation point at the discretion of the user." Independent claims 9 and 14 recite limitations that are similar to, but not narrower than, the aforementioned limitation. Accordingly, if a combination of prior art references meets the aforementioned limitation, it will also meet the other limitations. Thus, we choose the aforementioned "means for selectively rotating" as representative of all such corresponding limitations recited in independent claims 1, 9, and 14.

Patent Owner asserts that the combination of Capps and Martinez does not disclose or suggest the "means for selectively rotating," because (1) Capps does not discloses "windows," and thus cannot disclose "rotating the window," and (2) Martinez only discloses rotation of a device relative to a reference plane while the windows remain level. PO Resp. 14-16. We are not persuaded by Patent Owner's assertions for several reasons.

First, Patent Owner attacks the references individually, where the ground of unpatentability is based on a combination of references. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981) ("one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references"). Accordingly, it is immaterial whether Capps discloses "windows," for Martinez, and not Capps, is asserted as disclosing "windows." Similarly, it is immaterial whether Martinez discloses rotating a window relative to a reference plane, as Capps is asserted as disclosing rotating objects relative to a reference plane. Specifically, Capps is asserted as disclosing the rotation of a generic object, Martinez is cited for disclosing "windows," and so the combination suggests "rotating the window."

Additionally, it is immaterial that Martinez only discloses rotation of a device relative to a reference plane while the windows remain level. As set forth above, we construe "means for selectively rotating" as a special purpose computer implementing the following algorithm: "(1) generating a window on a computer display that is operatively connected to a rotation option; (2) receiving user input into the computer via the rotation option; and (3) based on the user input, using a phantom frame to show the new location of the rotated window or rotating the window substantially simultaneously with the user input." This construction makes no mention of what a window is rotated relative to, indicating that Patent Owner appears to be attempting to import improperly a limitation from the Specification. *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005) (while the specification can be examined for proper context of a claim term, limitations

from the specification will not be imported into the claims). Given this, even rotation of a window relative to something other than a reference plane, as in Martinez, would correspond properly to the "means for selectively rotating."

Patent Owner further asserts that Figures 6A-6C of Martinez only disclose rotating object 602, and not window 600. We are not persuaded by Patent Owner's assertion, as while literally true, other portions of Martinez disclose rotating windows, for example, Figures 5A-5C. Additionally, even for the window 600, Martinez discloses that "Fig. 6C shows object 602 remaining level although display 301 and window 600 have changed orientation. This process may be applied to other objects, such as window 600 or icons." Ex. 1006, 5:3-6.

4. "Determining a Rotation Point" (Claims 9 and 14)

Independent claim 14 recites "means for determining a rotation point." Independent claim 9 recites "determining a rotation point." For the same reasons as set forth above with respect to our treatment of "means for selectively rotating," we choose "means for determining a rotation point" as representative of all such corresponding limitations recited in independent claims 9 and 14.

Patent Owner asserts that the combination of Capps and Martinez does not disclose or suggest "means for determining a rotation point." Specifically, Patent Owner asserts that because we construed the aforementioned claim limitation as "determining a default rotation point or receiving a user selection into a computer of any rotation point within, on, or outside of a window on a display of the computer," and Capps does not

disclose "windows," Capps cannot disclose receiving any user selection relative to a window. PO Resp. 16-18. We are not persuaded by Patent Owner's assertions for several reasons.

First, the broadest reasonable construction of "means for determining a rotation point" includes an "or," and the portion of the construction preceding the "or" does not mention a window. Thus, Capps would satisfy that portion of the "means for determining a rotation point," and, thus, correspond properly to that claim limitation, whether or not Capps discloses "windows."

Additionally, Martinez, and not Capps, is asserted as disclosing "windows." Our analysis here is the same as that set forth above with respect to a similar assertion concerning "means for selectively rotating," and, thus, need not be repeated.

5. "Means for Rotating the Window by Predetermined Increments" (Claims 11 and 16)

Claim 16 recites "means for rotating the window by predetermined increments." Claim 11 recites "rotating the window by predetermined increments." For the same reasons as set forth above with respect to our treatment of "means for selectively rotating," we choose "means for rotating the window by predetermined increments" as representative of all such corresponding limitations recited in claims 11 and 16.

Patent Owner asserts that the combination of Capps and Martinez does not disclose or suggest "means for rotating the window by predetermined increments" for several reasons. PO Resp. 19-21. First, Patent Owner asserts that Martinez only discloses default one degree "increments" ranging from -179° to +179° that denotes a sensor's

sensitivity, and that "predetermined" requires a further aggregation of these default increments in order to be considered "predetermined." We are not persuaded by Patent Owner's assertion, as even if "predetermined increments" requires further aggregation, Martinez discloses rotating windows between "landscape" mode and "portrait" mode (i.e., 0° to 90°) without intermediate positions. Ex. 1006, 1:58-62, 4:40-46.

To that, Patent Owner responds that such a rotation from "landscape" mode to "portrait" mode would still constitute a single, albeit larger increment. We are not persuaded. Martinez discloses that rotation from "landscape" mode to "portrait" mode is "rotating the display 90° either way around one axis" (Ex. 1006, 4:42-45), which indicates that one of ordinary skill was aware that a rotation from "landscape" mode to "portrait" mode was an aggregation of single degree increments.

Patent Owner further asserts that because Martinez requires detecting "a selected amount of predefined movement" prior to rotating the display, Martinez does not meet a broadest reasonable construction of "means for rotating the window by predetermined increments," which recites that the detecting and rotating occur "simultaneously with the user input." As set forth above, we construe the algorithm for the "means for rotating" as not requiring detection and rotation to occur absolutely simultaneously, for such a requirement is logically impossible.

If Patent Owner is asserting that during the movement to, but not fulfillment of, the predetermined increment, window rotation does not occur and thus is not "simultaneous," we note that such a requirement is also an unreasonable application of "simultaneous," as there must be some, albeit

small, predetermined increment of movement that must occur prior to detection and rotation. Accordingly, absent any evidence by Patent Owner that a default sensitivity of one degree and subsequent rotation in Martinez does not meet "simultaneous," we determine that Petitioner's position is more persuasive.

6. Toggling the Window (Claim 12)

Claim 12 recites "wherein the step of rotating comprises the step of toggling the window between two preselected orientations." We construe "toggling the window between two preselected orientations" as "a switching action performed on a window with two preselected orientations." Patent Owner asserts that the combination of Capps and Martinez does not disclose or suggest the recited "toggling" for several reasons. PO Resp. 21-25.

Patent Owner first asserts that Martinez does not disclose "toggling," because the device in Martinez is free to be rotated between -179° and +179° in either or both orthogonal axes. As support, Patent Owner cites the testimony of Dr. Turnbull. PO Resp. 23 (citing Ex. 2003, 83:12-15). We are not persuaded by Patent Owner's assertion, as Martinez discloses the following: "display systems are presently available in which the monitor can be pivoted to either a landscape or a portrait mode." Ex. 1006, 1:53-55; *see* Ex. 1006, 4:43-46. The use of the word "either" at least suggests that there are only two display modes. Additionally, even if we agree that Martinez does not disclose "toggling" expressly, the asserted ground of unpatentability is based on obviousness.

For obviousness, Patent Owner asserts that to modify Martinez so as to limit movements to only two preselected orientations would

(1) impermissibly frustrate a stated goal of Martinez to level a display "regardless of the attitude of the display device at any rotation granularity," (2) be directly contrary to an express disparagement of the prior art, and (3) not be directed to a problem faced in Martinez. PO Resp. 24 (citing Ex. 1006, 1:58-62, 4:45-48). We are not persuaded, because the fact that a known modification has disadvantages does not negate the fact that the modification was known, and thus obvious. Every modification has its advantages and disadvantages. As long as such a modification would have been within the abilities of one of ordinary skill, however, and the results would have been predictable, such a modification would have been obvious, notwithstanding any potential disadvantages.

When that analysis is applied here, it becomes clear that the cited background section of Martinez actually discloses that having fewer preselected orientations was known, even if such a configuration had disadvantages. This understanding of Martinez is further supported by the other portions of Martinez cited by Patent Owner, for example, when Martinez discloses leveling a display "regardless of the attitude of the display device at any rotation granularity." Ex. 1006, 4:46-49. Any rotation granularity would include all rotation granularities, including a 180° granularity which would limit the number of preselected orientations to just two.

Patent Owner asserts further that the proposed modification is not directed to a problem faced in Martinez. We are not persuaded by Patent Owner's assertion, as any problem in the field may provide the underlying basis for a modification. *KSR*, 550 U.S. at 420 ("Under the correct analysis,

any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed"). This is especially true where there are only a finite number of identified, predictable solutions. *Id.* at 421. Here, an object in Martinez can only be rotated a maximum of 360°, and so all granularities would be a finite subset of 360°, which would include 180°.

Patent Owner also asserts that "the kind of modification proposed by the Board is one that would fundamentally alter the principle of operation of *Martinez*." PO Resp. 24. We disagree, as the principle of operation of Martinez is rotating windows, a principle which would be unaltered by the proposed modification.

7. Rationale to Combine Martinez and Capps

Petitioner sets forth several rationales for modifying Martinez in view of Capps, and vice versa. Pet. 14-15; Reply 8-9. In support of these rationales, Petitioner relies on excerpts from both Martinez and Capps, as well as on the Declaration of Dr. Turnbull. Ex. 1009 ¶¶ 95-98; Ex. 1012 ¶¶ 34-37. We have considered fully Petitioner's proffered rationales, and are persuaded that it would have been obvious to modify Martinez in view of Capps, and vice versa, in the manner articulated in the Petition.

Patent Owner asserts that the proffered rationales are inadequate, because neither Petitioner nor the Board accounts for the many technical differences in Martinez and Capps that are directed to solving different, incompatible problems. PO Resp. 25-27. We are not persuaded by Patent Owner's assertions, as it is immaterial whether two different prior art references have a myriad of differences. So long as the proposed

modification of either Martinez or Capps in view of the other would have been within the abilities of one of ordinary skill, the requirements for obviousness are satisfied. To that end, Patent Owner has not indicated how the many alleged technical differences between Martinez and Capps are relevant to showing that any proffered modification of Martinez or Capps in view of the other would not have been within the abilities of one of ordinary skill, and thus we are not persuaded that Petitioner's proffered rationales are inadequate.

At oral argument, Patent Owner cited the Declaration and deposition of Dr. Turnbull to support its argument that the proffered combination of Martinez and Capps, and more specifically, the modification of the window of Martinez to be rotated using the crank system of Capps, would not have been obvious to one of ordinary skill. Specifically, the cited portion of Dr. Turnbull's Declaration is as follows:

> In my opinion, the level of ordinary skill in the art needed to have the capability of understanding the scientific and engineering principles applicable to the '978 Patent is a bachelor's degree in computer engineering or computer science; or equivalent industry or trade school experience as one programming software applications.

Ex. 1009 ¶ 12; *see also* Ex. 2003, 32:1-33:7. According to Patent Owner, a person possessing this level of skill at the time of the invention would have been unable to make the then-considered-complicated technical programming modifications necessary to combine the rotating window system of Martinez with the crank rotating system of Capps. We are not persuaded for several reasons. First, it is undisputable that both Martinez and Capps are directed to rotating objects. Accordingly, we are not

persuaded that one of ordinary skill, even at the time of the invention, would not have known, given Martinez and Capps, that objects could be rotated using different techniques. Second, Patent Owner does not explain, or provide sufficient evidence, as to what was deficient about the level of ordinary skill at the time of the invention that would have rendered incapable the implementation of the proffered modifications. In particular, Patent Owner does not explain persuasively, or provide any supporting evidence, as to why the cited technical level would have been sufficient for one of ordinary skill to practice each of Martinez and Capps individually, but insufficient to practice the combination. Finally, Capps, in it is introductory paragraph, notes that it is directed to "methods of rotating, scaling and otherwise altering the image of an object on the screen using an icon-based tool." Ex. 1007, 1:8-10. With this explicit reference to the rotation of a generic "object" made known to one of ordinary skill, we are not persuaded that there would be any reason to exclude the windows of Martinez from the class of objects to be rotated.

8. Other Claims (Claims 2-4, 6-8, 13, and 18)

On considering anew the evidence and arguments advanced in the Petition with regards to the unpatentability claims 2-4, 6-8, 13, and 18 as obvious over Martinez and Capps, we determine, by a preponderance of the evidence, that Petitioner has shown that claims 2-4, 6-8, 13, and 18 are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez and Capps.

9. Conclusion

By a preponderance of the evidence, Petitioner has shown that claims 1-4, 6-9, 11-14, 16, and 18 are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez and Capps.

D. Alleged Obviousness Over Martinez, Capps, and Adobe

Petitioner contends that claims 5, 10, 15, and 17 are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez, Capps, and Adobe. Pet. 31-35; Reply 9-11. Petitioner explains how a combination of Martinez, Capps, and Adobe allegedly discloses or suggests the claimed subject matter, and also relies on the Declarations of Dr. Turnbull to support its positions. Exs. 1009, 1012.

1. Adobe (Exhibit 1008)

Adobe is a user guide for Adobe Photoshop®. Ex. 1008, 1. Adobe discloses that holding down a mouse button on a tool is the equivalent of performing a dragging function on the tool. Ex. 1008, 14. Adobe discloses that in order to rotate an image, a pointer is moved outside a bounding border (it turns into a curved, two-sided arrow), and then dragged. Ex. 1008, 185. An example of such a rotation is shown in the excerpt below.

The above excerpt illustrates an image with a curved, two-sided arrow.

Ex. 1008, 185. For example, as shown in the excerpt above, a pointer may be moved outside selection handles, where the pointer then changes into the curved, two-sided arrow, and then the arrow is dragged clockwise to rotate a CD. Ex. 1008, p. 14.

2. "Wherein the Means for Selectively Rotating Comprises a Rotation Cursor" (Claim 5)

Claim 5 depends from independent claim 1. Patent Owner asserts that Adobe does not cure the aforementioned deficiencies of Martinez and Capps with respect to underlying independent claim 1, because Adobe discloses rotating only "selection rectangles," and not the recited windows.
PO Resp. 27-30. We are not persuaded by Patent Owner's assertion, as we have determined above that there is no deficiency with respect to the combination of Martinez and Capps. Martinez, and not Adobe, is asserted as disclosing rotating windows. Adobe is asserted only as disclosing a rotation cursor.

3. "Clicking and Holding the Window While Dragging the Window to the Selected Orientation" (Claims 10 and 15)

Claim 10 depends from independent claim 9, and claim 15 depends from independent claim 14. Patent Owner asserts several deficiencies with respect to the application of this combination of references to claims 10 and 15. PO Resp. 30-32. First, Patent Owner asserts that Adobe does not cure the aforementioned deficiencies of Martinez and Capps with respect to underlying independent claim 1, because Adobe discloses rotating only "selection rectangles," and not the recited windows. Our analysis is the same as set forth above with respect to claim 5, and thus need not be repeated here.

Patent Owner further asserts that "claims 10 and 15 require 'clicking and holding the window,' whereas the pointer in Adobe is outside of the selection rectangle." PO Resp. 31. We agree with Patent Owner's assertion. However, we also agree with Petitioner that this is an insignificant distinction that is a design choice insufficient to confer patentability. Reply 10-11 (citing Ex. 1009 ¶¶ 61-62). The ground of unpatentability is based on obviousness, and Patent Owner has not provided any analysis or evidence to show why "clicking and holding the window" by clicking the window itself is patentably distinct from clicking pixels adjacent to the window. Indeed, it would appear that performing the former would be easier than performing the latter.

3. "Means for Toggling the Window Between Two Preselected Orientations" (Claim 17)

Claim 17 depends from independent claim 14. Patent Owner asserts that even though the Board substantively determined that claim 17 was

unpatentable over Martinez and Capps alone, the Board erroneously instituted trial on a combination of Martinez, Capps, and Adobe. PO Resp. 32. We are not persuaded by Patent Owner's assertion, as claim 17 is unpatentable over Martinez and Capps, and it is also unpatentable over Martinez, Capps, and Adobe.

Patent Owner then asserts that Adobe does not remedy the deficiency of Martinez and Capps with respect to claim 17. PO Resp. 32-34. We are not persuaded by Patent Owner's assertion, as Martinez and Capps alone do meet every limitation of claim 17 for the same reasons as set forth above in our analysis of claim 12, which recites similar limitations.

4. Rationale to Combine Martinez, Capps, and Adobe

Petitioner sets forth several rationales for modifying Martinez and Capps in view of Adobe. Pet. 31-32. In support of these rationales, Petitioner relies on excerpts from Martinez, Capps, and Adobe, as well as on the Declaration of Dr. Turnbull. Ex. 1009 ¶ 100. We have considered fully Petitioner's proffered rationales, and are persuaded that it would have been obvious to modify Martinez and Capps in view of Adobe in the manner articulated in the Petition.

Patent Owner asserts that the proffered rationales are inadequate, because neither Petitioner nor the Board accounts for the many technical differences in Martinez and Adobe that are directed to solving different, incompatible problems. PO Resp. 34-35. We are not persuaded by Patent Owner's assertions for the same reason as set forth above in our analysis concerning the rationale to combine Martinez and Capps. That analysis need not be repeated here. Moreover, we note that Patent Owner admits that

Adobe is like Capps (PO Resp. 34), thus indicating that it would have been within the abilities of one of ordinary skill to combine features from Capps and Adobe.

5. Conclusion

By a preponderance of the evidence, Petitioner has shown that claims 5, 10, 15, and 17 are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez, Capps, and Adobe.

E. Alleged Anticipation by Bruder

Petitioner contends that claims 1, 2, 4, 6, 7, 9, 10, 13-15, and 18 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Bruder. Pet. 35-47. In light of our determination that these claims are unpatentable under 35 U.S.C. § 103(a) as obvious over various combinations of Martinez, Capps, and Adobe, we take no position on whether the same claims are also anticipated by Bruder.

F. Alleged Obviousness Over Bruder and Takano

Petitioner contends that claims 3, 11, and 16 are unpatentable under 35 U.S.C. § 103(a) as obvious over Bruder and Takano. Pet. 48-52. In light of our determination that these claims are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez and Capps, we take no position on whether the same claims are also obvious over Bruder and Takano.

G. Alleged Obviousness Over Bruder and Kreegar

Petitioner contends that claim 8 is unpatentable under 35 U.S.C. § 103(a) as obvious over Bruder and Kreegar. Pet. 52-56. In light of our determination that this claim is unpatentable under 35 U.S.C. § 103(a) as

obvious over Martinez and Capps, we take no position on whether the same claim is also obvious over Bruder and Kreegar.

H. Alleged Obviousness Over Bruder and Adobe

Petitioner contends that claim 5 is unpatentable under 35 U.S.C. § 103(a) as obvious over Bruder and Adobe. Pet. 56-58. In light of our determination that this claim is unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez, Capps, and Adobe, we take no position on whether the same claims are also obvious over Bruder and Adobe.

I. Contingent Motion to Amend

As we determine that all of the challenged claims are unpatentable, we turn to Patent Owner's Contingent Motion to Amend. Patent Owner proposes claims 19-22 as substitutes for claims 9, 12, 14, and 17, respectively. Motion 1-3. As the moving party, Patent Owner bears the burden of establishing that it is entitled to the relief requested in its Contingent Motion to Amend. 37 C.F.R. § 42.20(c). Patent Owner must show it has met its burden by a preponderance of the evidence. *Int'l Flavors & Fragrances, Inc. v. The United States of America, as Represented by the Secretary of Agriculture*, Case IPR2013-00124, slip op. at 16, 18 (PTAB May 20, 2014) (Paper 12).

1. Proposed Claim 19

Patent Owner's proposed claim 19 seeks to amend independent claim 9 as follows (paragraphing added):

> 19. A method of selectively rotating a computer display window having a display portion and a frame surrounding the display portion, the method comprising the steps of:

> determining a rotation point, wherein the rotation point is a preselected rotation point for the window, the window having a top side that includes a header portion including information to identify the window, the display portion including graphic and text elements generated by an application, and the window having only two preselected orientations relative to a computer screen displaying the window; and
>
> rotating the window relative to the screen displaying the window about the preselected rotation point by toggling the window between the two preselected orientations at the discretion of the user;
>
> wherein the plane of the window, the plane of rotation, and the rotation point are coplanar.

During an *inter partes* review, we enter proposed amended claims only upon a showing that the amended claims are patentable. *Idle Free Sys. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 33 (PTAB Jan. 7, 2014) (Paper 66) (informative). This burden may not be met merely by showing that the proposed claims are distinguished over the prior art references applied to the original patent claims. Instead, because there is no examination of the proposed claims, Patent Owner must show that the subject matter recited is not taught or suggested by the prior art in general for us to determine that they comply with 35 U.S.C. §§ 102 and 103. *Id.*

Patent Owner asserts that the window rotation method recited in proposed claim 19 is patentably distinct over a combination of the closest known prior art. Motion 8-13. Although it is Patent Owner's burden to show patentability over the prior art in general, Patent Owner does not assert, or direct us to evidence such as the testimony of one of at least ordinary skill in the art, that the window rotation method recited in proposed claim 19 was obvious generally over other window rotation methods known

in the art at the time the patent was filed. While Patent Owner does cite to Dr. Turnbull's Declaration to establish the level of education and experience to be considered one of ordinary skill, such a citation, by itself, denotes nothing without further specific testimony concerning the specific features set forth in the proposed claim. Instead, Patent Owner only presents arguments, not evidence, focusing only on the disclosures of Martinez and Horvitz. Accordingly, Patent Owner has not met the burden it undertook by putting forth proposed amended claims.

In any event, even if Patent Owner's burden was to show patentability over only the prior art of record, we would not be persuaded that the proposed claims are patentable. Specifically, Patent Owner, in essence, adds three features to proposed claim 19: (1) a window including a header portion and a display portion, (2) that the window is rotated relative to the screen displaying the window, and (3) toggling between two preselected orientations. As an initial matter, Patent Owner did not provide an analysis as to what was known generally in the art about each of these features individually, as required under *Idle Free Systems*, Paper 66 at 33-35.

Moreover, each of these features is met by the above referenced combination of Martinez and Capps. Specifically, for feature (1), Figures 6A-6C of Martinez disclose window 600 including a header portion and a display portion, the display portion including object 602. For feature (2), although Figures 6A-6C of Martinez do not disclose window 600 being rotated relative to the screen, Martinez discloses that "Fig. 6C shows object 602 remaining level although display 301 and window 600 have changed orientation. <u>This process may be applied to other objects, such as window</u>

600 or icons." Ex. 1006, 5:3-6 (emphasis added). Additionally, we have found that Capps discloses rotating objects relative to the screen. And for feature (3), we have already discussed above why toggling would have been obvious in view of Martinez, and, thus, that analysis need not be repeated here.

We are not persuaded that Patent Owner has shown, by a preponderance of the evidence, that proposed claim 19 is patentable over a combination of Martinez and Capps.

2. Proposed Claim 20

Patent Owner's proposed claim 20 depends from proposed claim 19, and seeks to amend claim 12 as follows:

> 20. The method according to claim 19, wherein the step of rotating comprises the step of toggling the window between the two preselected orientations such that (i) the header portion of the window including information to identify the window, and (ii) graphic and text elements generated by an application and included in the display portion rotate to remain parallel with edges of the screen.

Patent Owner asserts that the window rotation method recited in proposed claim 20 is patentably distinct over a combination of the closest known prior art. Motion 13-14. For the same reasons as set forth above with respect to proposed claim 19, Patent Owner analysis does not meet its burden under *Idle Free Systems*.

Moreover, the added feature of proposed claim 20 recites essentially toggling between a "landscape" mode and a "portrait" mode. We have discussed the art disclosing toggling above, and find that Martinez further

discloses expressly pivoting a display either between a landscape mode and a portrait mode. Ex. 1006, 1:53-59, 4:43-46.

We are not persuaded that Patent Owner has shown, by a preponderance of the evidence, that proposed claim 20 is patentable over a combination of Martinez and Capps.

3. Proposed Claim 21

Patent Owner's proposed claim 21 seeks to amend independent claim 14 as follows:

> 21. A system for selectively rotating a computer display window having a display portion and a frame surrounding the display portion, the system comprising:
>
> means for determining a rotation point <u>for the window, wherein the window includes a top side having a header portion including information to identify the window, the display portion includes graphic and text elements generated by an application, and the means for determining is a computer performing a first algorithm for determining a default rotation point for the window</u>; and
>
> means for rotating the window <u>relative to a screen displaying the window</u> about the <u>default</u> rotation point at the discretion of the user<u>, wherein the means for rotating is the computer performing a second algorithm of (i) generating the window on the screen including a rotation option, (ii) receiving user input into the computer, and (iii) based on the user input, rotating the window simultaneously with the user input</u>;
>
> wherein the plane of the window, the plane of rotation, and the rotation point are coplanar.

Patent Owner asserts that the window rotation method recited in proposed claim 21 would always include at least one element not met by the combination of Martinez, Capps, Bruder, and Takano. Motion 14-15. For

the same reasons as set forth above with respect to proposed claim 19, Patent Owner's analysis does not meet its burden under *Idle Free Systems.*

Substantively, Patent Owner adds to claim 21: (1) a window including a header portion and a display portion, (2) a first algorithm for determining a default rotation point for a window, (3) that the window is rotated relative to the screen displaying the window, and (4) defining specifically the "means for rotating" using an algorithm. For features (1) and (3), our analysis is the same for the corresponding features of proposed claim 19, and need not be repeated here.

For feature (2), Patent Owner cites to the Specification (Ex. 1002, 17:10-11) and Decision to Institute (Dec. 15) as providing written description support. Such citations are inadequate, however, as those citations only support "determining a default rotation point for the window," but the described "determining" does not provide written description support for an algorithm of itself. Moreover, Figures 5A-5C and 6A-6C of Martinez, among other portions, disclose a default rotation point at the center of display 301.

For feature (4), we determined above that a combination of Martinez and Capps discloses the "means for selectively rotating" recited in independent claim 1, which includes a similar algorithm.

We are not persuaded that Patent Owner has shown, by a preponderance of the evidence, that proposed claim 21 is patentable over a combination of Martinez and Capps.

4. Proposed Claim 22

Patent Owner's proposed claim 22 depends from proposed claim 21, and seeks to amend claim 17 as follows:

> 22. The system according to claim 21, wherein means for rotating comprises means for toggling the window between two preselected orientations, wherein the means for toggling is the computer performing a third algorithm of (i) generating the window on the screen including only two preselected orientations, (ii) receiving user input into the computer, and (iii) based on the user input, switching from one to the other of the two preselected orientations.

Patent Owner asserts that the window rotation method recited in proposed claim 22 is patentably distinct over a combination of the closest known prior art. Motion 15. For the same reasons as set forth above with respect to proposed claim 19, Patent Owner analysis does not meet its burden under *Idle Free Systems*.

Moreover, the added feature of proposed claim 22 explicitly imports the algorithm for the "means for toggling" into the claim. We have already discussed "means for toggling" above. Specifically, we determined that a combination of Martinez and Capps at least suggests the "means for toggling" recited in claim 17, which includes a similar algorithm.

We are not persuaded that Patent Owner has shown, by a preponderance of the evidence, that proposed claim 22 is patentable over a combination of Martinez and Capps.

5. Conclusion

Patent Owner has not shown, by a preponderance of the evidence, that proposed substitute claims 19-22 are patentable.

III. CONCLUSION

Petitioner has proved, by a preponderance of the evidence, that claims 1-4, 6-9, 11-14, 16, and 18 of the '978 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez and Capps.

Petitioner has proved, by a preponderance of the evidence, that claims 5, 10, 15, and 17 of the '978 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Martinez, Capps, and Adobe.

Patent Owner has not proved, by a preponderance of the evidence, that proposed substitute claims 19-22 are patentable.

IV. ORDER

It is

ORDERED that Petitioner has demonstrated by a preponderance of the evidence that claims 1-18 of U.S. Patent No. 6,326,978 are unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Amend is denied; 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.

IPR2013-00248
Patent 6,326,978

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