

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case IPR2015-00456
Patent 7,269,576 B2

Before MICHAEL R. ZECHER, MICHAEL J. FITZPATRICK, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Apple, Inc., filed a Petition to institute an *inter partes* review of claims 1, 2, 4, 7–10, and 15 of U.S. Patent No. 7,269,576 B2 (“the ’576 patent”). Paper 1 (“Pet.”). Patent Owner, ContentGuard Holdings, Inc., filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 8 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). We deny the Petition.

A. *Related Matters*

The Director requires a petitioner to include certain mandatory notices as part of its petition. 37 C.F.R. § 42.8(a)(1). The mandatory notices include a requirement to “[i]dentify any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding.” 37 C.F.R. § 42.8(b)(2) (titled “Related matters”). “Judicial matters include actions involving the patent in federal court. Administrative matters include every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party’s involved patent or application as well as any *ex parte* and *inter partes* reexaminations for an involved patent.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012).

Pursuant to these rules, the Petition includes a section titled “Mandatory Notices (37 CFR § 42.8(b)),” which includes a subsection titled “Other Proceedings (§ 42.8(b)(2)).” Pet. 1–2. Within the latter, Petitioner identifies the following lawsuits: *ContentGuard Holdings, Inc. v. Amazon.com, Inc.*, Case No. 2:13-cv-01112 (E.D. Tex.); *Google Inc. v. ContentGuard Holdings, Inc.*, Case No. 2:14-cv-0498 (N.D. Cal.); and *ContentGuard Holdings, Inc. v. Google Inc.*, Case

No. 14-cv-0061 (E.D. Tex.). Pet. 2. Petitioner also identifies four other petitions for *inter partes* reviews of the '576 patent that it filed contemporaneously with the instant Petition. Pet. 2 (identifying Cases IPR2015-00452 through -00455).

Petitioner does *not* identify, as a related matter, *ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00139 (PTAB) (the “ZTE IPR”), which resulted in a final written decision (Paper 57) regarding some claims of the '576 patent. Pet. 2. Although the Petition elsewhere references the ZTE IPR, *see, e.g.*, Pet. 16, the Petition fails to comply with the requirement to identify it as a related matter.

B. The Asserted Ground

Petitioner challenges claims 1, 2, 4, 7–10, and 15 as obvious over Kahn (Ex. 1018)¹, Linn (Ex. 1058),² and Shear (Ex. 1055).³ Pet. 3.⁴

¹ U.S. Patent No. 6,135, 646, issued Oct. 24, 2000.

² R.J. Linn, *Copyright and Information Services in the Context of the National Research and Education Network*, 1 IMA INTELLECTUAL PROPERTY PROJECT PROCEEDINGS 9 (Jan. 1994).

³ U.S. Patent No. 4,977,594, issued Dec. 11, 1990.

⁴ In setting forth its ground, Petitioner erroneously cites Linn as Exhibit 1019, whereas the correct exhibit number is 1058. Pet. 3. Petitioner repeatedly cites Linn by the wrong exhibit number (either Exhibit 1019 or Exhibit 1055) throughout its Petition. *See, e.g.*, Pet. ii, 3, 22, 23, 24, 25, 33, 44, 46, 50, 58, and 59. This is one example of a poorly presented record by Petitioner. Another example is the 474-page declaration that includes voluminous information not relevant to this Petition and which contains numerous internal citations. *See* Ex. 1013. Yet another example is Petitioner’s filing of sixty-three exhibits, forty-six of which are not cited in the Petition.

C. The '576 Patent

The '576 patent generally relates to the distribution and usage rights enforcement of digitally encoded works. Ex. 1009, 1:5–6.

D. The Challenged Claims

The challenged claims are 1, 2, 4, 7–10, and 15. Pet. 3. Claim 1 is independent, and the remainder of the challenged claims depend from claim 1. Claim 1 is reproduced below:

1. An apparatus for rendering digital content in accordance with rights that are enforced by the apparatus, said apparatus comprising:

a rendering engine configured to render digital content;

a storage for storing the digital content;

means for requesting use of the digital content stored in the storage; and

a repository coupled to the rendering engine,

wherein the repository includes:

means for processing a request from the means for requesting,

means for checking whether the request is for a permitted rendering of the digital content in accordance with rights specified in the apparatus,

means for processing the request to make the digital content available to the rendering engine for rendering when the request is for a permitted rendering of the digital; and

means for authorizing the repository for making the digital content available for rendering, wherein the digital content can be made available for rendering only by an authorized repository, the repository comprising:

means for making a [request] for an authorization [object] required to be included within the repository for the apparatus to render the digital content; and

means for receiving the authorization [object] when it is determined that the request should be granted.

Ex. 1009, 52:45–53:5.

II. ANALYSIS

A. Claim Construction

“A claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.”⁵ 37 C.F.R. § 42.100(b). Pursuant to that standard, the claim language should be read in light of the specification, as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.”) (internal quotation marks omitted).

A petition for an *inter partes* review must identify how each challenged claim is to be construed. 37 C.F.R. § 42.104(b)(3). As part of that requirement, a petitioner must “identify the specific portions of the specification that describe the

⁵ Petitioner contends that the ’576 patent will expire no later than July 21, 2015, and suggests that the claim construction standard used in district court would apply here “if trial is instituted.” Pet. 6–7 (citing *In Re Rambus*, 694 F.3d 42, 46 (Fed. Cir. 2012)). Trial is not being instituted, and our decision to deny institution would be the same even if we applied the district court standard.

structure, material, or acts corresponding to each claimed function” of any means- or step-plus-function limitation. *Id.*; *see also* 35 U.S.C. § 112 ¶ 6 (“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”).⁶

Independent claim 1 recites several limitations that presumptively are means-plus-function limitations: “means for requesting . . .”; “means for processing . . .”; “means for checking . . .”; “means for authorizing . . .”; “means for making . . .”; and “means for receiving” *See Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 649 F.3d 1350, 1356 (Fed. Cir. 2011) (“The use of the term ‘means’ triggers a rebuttable presumption that § 112, ¶ 6 governs the construction of the claim term.”).

Petitioner does not rebut the presumption that these limitations are governed by § 112 ¶ 6. Yet, Petitioner fails to “identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” 37 C.F.R. § 42.104(b)(3). Instead, Petitioner states that “[t]he Board construed certain of these means-plus function elements in IPR2013-00139, Paper No. 15 (July 9, 2013),” and “Petitioner proposes to use the Board’s constructions of the ‘means’ terms from IPR2013-00139 where available.”

⁶ Section 4(c) of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) (“AIA”) re-designated 35 U.S.C. § 112 ¶ 6 as 35 U.S.C. § 112(f). Because the ’576 patent has a filing date prior to September 16, 2012, the effective date of § 4(c) of the AIA, we refer to the pre-AIA version of 35 U.S.C. § 112.

Pet. 16–17. These statements do not fulfill Petitioner’s obligation to identify the corresponding structure. First, the applicable rule requires that “the *petition* set forth” the identification of the corresponding structure. 37 C.F.R. § 42.104(b)(3) (emphasis added); *see also* 37 C.F.R. § 42.6(a)(3) (prohibiting incorporation by reference). Second, in the relied-upon decision from the ZTE IPR, the Board denied institution with respect to claim 1 because the petitioner in that proceeding (ZTE Corp.) did not identify the correct structure corresponding to each means-plus-function limitation recited in claim 1. *ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00139, Paper 15 at 27, 33, 35, 37–38 (PTAB July 9, 2013).

Petitioner also states that “[i]n ongoing litigation, Patent Owner has identified allegedly corresponding structures for each [means-plus-function limitation recited in claim 1].” Pet. 16 (citing Ex. 1069, 6–15). This statement also does not fulfill Petitioner’s obligation to identify the corresponding structure. First, as already discussed, it is the Petition, and not an external document, that must set forth an identification of the corresponding structure. *See* 37 C.F.R. § 42.104(b)(3); *see also* 37 C.F.R. § 42.6(a)(3) (prohibiting incorporation by reference). Second, by requiring an identification of the corresponding structure be set forth in the Petition, the rule squarely places the requirement on the Petitioner. Exhibit 1069, however, is a declaration by a Dr. Michael Goodrich in support of a *Patent Owner* claim construction brief filed in *ContentGuard Holdings, Inc. v. Amazon.com, Inc.*, Case No. 2:13-cv-01112 (E.D. Tex.).⁷

⁷ Exhibit 1069 is captioned also for *ContentGuard Holdings, Inc. v. Google Inc.*, Case No. 14-cv-0061 (E.D. Tex.). As indicated by the header, however,

In asserting its ground of obviousness, the Petition again addresses the means-plus-function limitations of claim 1 but still comes up short. For instance, with respect to the “means for requesting” limitation, Petitioner states that “[t]he parties to the co-pending litigation have agreed the ‘[u]ser interface 1305 described [in Ex. 1009] at 16:35-44’ is this means element.” Pet. 46 (no citation provided for language quoted). This is as close as the Petition gets to identifying affirmatively the structure Petitioner asserts corresponds to any means-plus-function limitation of claim 1. Thus, by couching it in terms of what Petitioner allegedly agreed to in district court,⁸ Petitioner has not identified necessarily what it considers to be the corresponding structure under the claim construction standard applicable to an *inter partes* review.

For the remainder of the means-plus-function limitations, Petitioner does not come close to setting forth an identification of corresponding structure. We address the shortcomings for some of those limitations below.

With respect to the “means for processing a request from the means for requesting” limitation, Petitioner states the following: “Each of the six steps of the Board’s construction, as well as each part of each means-plus-function element in claim 1, describes a process well-known to persons of ordinary skill in the art.”

Exhibit 1069 is from *ContentGuard Holdings, Inc. v. Amazon.com, Inc.*, Case No. 2:13-cv-01112 (E.D. Tex.).

⁸ Petitioner’s statement that the parties allegedly agreed on a construction in district court is contradicted by Dr. Goodrich’s declaration. Specifically, Dr. Goodrich states that Petitioner asserts in court that the “means for requesting” limitation is indefinite and, thus, not the user interface 1305 described at column 16, lines 35–44 of the ’576 patent (and its equivalents). Ex. 1069, 6.

Pet. 47. Presumably, “the Board’s construction” refers to Paper 15 in the ZTE IPR, but no citation of that decision is provided, let alone a page-specific citation where an identification of the structure is provided.⁹

With respect to the “means for authorizing” limitation, Petitioner states the following: “This element and the subsequent means-plus-function elements of claim 1 relate to *authorizing* a repository.” Pet. 54. But, stating the recited function of a means-plus-function limitation does not provide an identification of the specific portions of the specification corresponding to the structure of that limitation.

With respect to the “means for making” limitation, Petitioner states the following: “This element’s corresponding structure is a subset of the previous element’s [corresponding structure], and thus obvious for the same reasons.” *Id.* at 56. The Petition does not identify the purported subset of structure.

III. CONCLUSION

Petitioner does not identify the specific portions of the specification of the ’576 patent that describe the structure corresponding to each recited function of the means-plus-function limitations of claim 1. The means-plus-function limitations of claim 1 are incorporated by reference into dependent claims 2, 4, 7–10, and 15, by virtue of their dependency on claim 1.

⁹ Ironically, Petitioner wants us to identify the corresponding structure of each limitation by using a construction set forth in a prior *inter partes* review that Petitioner has not identified as a related matter pursuant to 37 C.F.R. §42.8(b)(2).

There is no exemption from the requirement to identify corresponding structure for means-plus-function limitations under 37 C.F.R. § 42.104(b)(3) for claims that may have been construed previously in a related matter. By failing to identify the corresponding structure or to provide even the alleged prior constructions, the Petition does not show how the challenged claims are to be construed, see 37 C.F.R. § 42.104(b)(3), and also does not show how, as so construed, they are unpatentable under the statutory ground identified in the Petition. *See id.* at (b)(4).

IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied and no trial is instituted.

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