

Filed on behalf of:

Patent Owner Sightsound

Paper No. _____

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,

Petitioner,

v.

Patent of SIGHTSOUND TECHNOLOGIES, LLC,

Patent Owner.

Case CBM2013-00023
Patent 5,966,440

PATENT OWNER'S LIST OF PROPOSED MOTIONS

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S LIST OF PROPOSED MOTIONS

In view of the Board's decision to institute covered business review of U.S. Patent No. 5,966,440 ("the '440 Patent") and the initial conference to be held on October 30, 2013, SightSound Technologies, LLC ("Patent Owner") hereby files and serves the following list of proposed motions:

I. Motion Under 37 C.F.R. § 42.51(b)(2) to Conduct Additional Discovery as May be Required.

In addition to Patent Owner's right to depose and receive documents from declarants whose affidavits or other testimonial evidence is proffered by Petitioner, including third parties, Patent Owner seeks authorization to file one or more motions under 37 C.F.R. § 42.51(b)(2) for additional discovery related to secondary considerations of nonobviousness. Specifically, Patent Owner seeks authorization to conduct discovery regarding the commercial success of Petitioner's iTunes Music Store ("ITMS") which Patent Owner contends practices the '440 Patent.

Patent Owner is open to a stipulation that the ITMS practices the '440 patent solely for purposes of evaluating secondary considerations of nonobviousness for

this proceeding. In the event Petitioner disputes that the ITMS practices the ‘440 Patent, Patent Owner seeks authorization to conduct discovery of Petitioner’s technical documentation demonstrating the operation of the ITMS as well as an identification of and deposition of the appropriate witness on this topic.

To the extent that Petitioner disputes that there is a nexus between the patented invention and the commercial success of the ITMS, Patent Owner seeks authorization to conduct discovery of materials showing such a nexus, including but not limited to any consumer surveys Petitioners has conducted or commissioned, as well as internal analysis, concerning the ITMS and consumers’ preferences for purchasing digital video and audio signals, as well as an identification of and deposition of the appropriate witness on this topic.

II. Motion for Tracy Tosh Lane and Sean M. Callagy to be Permitted to Observe CBM Proceedings.

Patent Owner may move to permit Tracy Tosh Lane and Sean M. Callagy, who are outside counsel for Patent Owner in litigation involving Petitioner but not admitted to practice before the USPTO, to observe all proceedings in the trial of this matter. Ms. Lane and Mr. Callagy will not participate directly in the CBM review, including by appearing, arguing, or submitting documents in any capacity.

III. Contingent Motion to Amend under 37 C.F.R. § 42.221.

Patent Owner may move to amend one or more of the involved claims of the ‘440 patent. Any such claim amendments will be made to respond to one or more

of the grounds of unpatentability involved in the trial and will not enlarge the scope of the claims of the '440 patent.

IV. Motions for *Pro Hac Vice* Admission pursuant to Rule 42.10(c).

Patent Owner may make motions for *Pro Hac Vice* admission pursuant to Rule 42.10(c).

V. Additional Motions.

Patent Owner may also seek authorization, as necessary, to file additional motions not identified on the above list. See Office Trial Practice Guide, 77 Fed. Reg. 48756 at 48765 (“Submission of a list would not preclude the filing of additional motions not contained in the list.”).

Dated: October 28, 2013

Respectfully submitted,

/David R. Marsh/

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