

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC. and APPLE INC.,
Petitioners,

v.

CONTENTGUARD HOLDINGS, INC.
Patent Owner

Case CBM 2015-00040¹

U.S. Patent 7,774,280

Filed October 4, 2004

Issued August 10, 2010

Title: SYSTEM AND METHOD FOR MANAGING TRANSFER OF
RIGHTS USING SHARED STATE VARIABLES

Attorney Docket No. 20318-134361

Customer No: 22242

**PATENT OWNER'S REPLY IN SUPPORT OF CONTINGENT
MOTION TO AMEND UNDER 37 C.F.R. § 42.121**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

¹ Case CBM2015-00160 has been joined with this proceeding.

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I. INTRODUCTION

Petitioners' response to Patent Owner's contingent motion to amend challenges the patentability of proposed substitute claim 37 solely on written description grounds and in view of the prior art Stefik '012 patent. It does not dispute Patent Owner's showing of patentability over the other references identified as the closest known prior art. The specific objections to the motion are addressed below.

II. THE PROPOSED AMENDMENT RESPONDS TO THE PATENTABILITY ISSUES RAISED

The proposed substitute claim 37 amends original claim 1 to expressly require that a meta-right "is not itself a usage right because exercising the meta-right does not result in action to the content," and to provide proper antecedent basis for this language. In its Institution Decision, the Board applied a broader definition of "meta-right" under the claim construction standard applicable in CBM proceedings. Applying this broader construction, the Board found that Stefik raised issues of patentability as to claim 1 and dependent claims 5 and 11. (Paper 9 at 15-17 and 43.) The proposed substitute claim expressly recites characteristics of meta-rights not included in the Board's initial construction. In the event that the Board maintains its initial construction of meta-right, and ultimately finds claim 1 unpatentable over Stefik using that construction, the proposed substitute claim would distinguish Stefik on grounds unavailable under that construction. The

amendment is thus directly related and responsive to issues of patentability involved in this proceeding.

Contrary to Petitioners' representation, the motion does not characterize the amendment as having no effect on the scope or meaning of claim 1. Patent Owner has shown that the scope of the amended claim is substantially identical to the scope given to the original claim in pending district litigation, which is a distinct issue relevant to intervening rights. (Paper 16 at 24-25.) That does not make the substitute claim any less responsive to the grounds of patentability in this proceeding, which are based on a broader claim construction than the district court applied.

III. THE SUBSTITUTE CLAIM IS NOT ANTICIPATED BY STEFIK

The Goldberg declaration submitted in support of the Petition asserts that Stefik discloses meta-rights because certain usage rights may include a NSOR grammar element identifying rights to be added to or deleted from the usage rights for the transferred digital work. According to this theory, the right being exercised is the encapsulating usage right. (See, e.g., Ex. 1014 at ¶72 (“the meta-right is ‘Loan,’ which allows the repository that receives that right to create Play and Delete usage rights for subsequent distribution”) and ¶80 (“the Loan right allows a repository to create new rights, Play and Delete, when a Loan transaction is completed”.) Dr. Goldberg further opined that exercising the alleged meta-right

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