

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 No. CBM2015-00040¹
U.S. Patent No. 7,774,280

**PETITIONERS' RESPONSE TO PATENT OWNER'S MOTION
FOR OBSERVATIONS ON CROSS-EXAMINATION
OF DR. GOLDBERG**

¹ Case No. CBM2015-00160 has been joined with this proceeding.

As authorized by the Board’s Scheduling Order (Paper 10), Petitioners submit the following responses to Patent Owner’s observations on cross-examination of Dr. Ben Goldberg (Paper 28).

I. Response to Observation 1

Patent Owner cites to Ex. 2024 at 88:17-23, where Dr. Goldberg agrees Stefik does not “explicitly disclose” any examples where the next-set-of-rights field is “processed” independently from a usage right. Patent Owner contends this is relevant to “whether Stefik discloses a right that can be exercised to create usage rights without resulting in actions to content.” Paper No. 28 (“Obs.”) at 1. Patent Owner is incorrect – the cited testimony does not address whether exercising the next-set-of-rights *results in* action to content, but instead whether Stefik expressly describes an example of a next-set-of-rights being exercised *separately* from a usage right. It is undisputed that the claims do not require a meta-right to be exercised separately from a usage right. *See* Ex. 1033 at 23:1-23 (testimony of Patent Owner’s expert).

II. Response to Observation 2

Patent Owner cites to Ex. 2024 at 91:22-92:9, where Dr. Goldberg states that the examples of usage rights creation explicitly disclosed in Stefik are in the context of exercising a different usage right to create a new copy of a digital work. This testimony is not relevant to any issue in this proceeding, because it does not

address whether exercising a next-set-of-rights *results in* action to content, but only whether the next-set-of-rights is exercised simultaneously with a usage right. It is undisputed that the claims do not require a meta-right to be exercised separately from a usage right. Ex. 1033 at 23:1-23 (testimony of Patent Owner’s expert).

III. Response to Observation 3

Patent Owner cites to Ex. 2024 at 105:22-106:6, where Dr. Goldberg is discussing one example of an “Embed” transaction described in Stefik at 41:58 to 42:14, and contends this testimony is inconsistent with Dr. Goldberg’s opinion that the “Embed” usage right can be exercised without an action to content. Patent Owner fails to bring to the attention of the Board Dr. Goldberg’s deposition testimony where he explains this passage of Stefik is describing only *one example* of an “Embed” operation, *see* Ex. 2023 at 112:16-114:1 (explaining passage at 41:58-42:14 is describing an example where a digital work would be copied and then embedded into a second digital work); *see id.* at 109:19-110:25 (same), and that other passages in Stefik show the “Embed” usage right being exercised without actions resulting to content, *see id.* at 107:14-108:4 (discussing Stefik example of “Embed” usage right being exercised to add fees to a digital work); *id.* at 109:5-18; Ex. 2023 at 111:1-112:12.

IV. Response to Observation 4

Patent Owner’s motion cites Ex. 2024 at 106:24-107:13, where Dr. Goldberg answers two different questions asked by Patent Owner’s counsel: the first relates to an example of the Stefik “Embed” usage right described in paragraph 27 of Dr. Goldberg’s supplemental declaration, and the second relates to the exemplary “Embed” transaction described in Stefik at 41:58-42:14. Patent Owner contends that Dr. Goldberg’s opinion that the “Embed” usage right can be exercised without an action to content is inconsistent with Stefik at 41:58-42:14. As it did with observation 3, Patent Owner overlooks Dr. Goldberg’s testimony describing how Stefik shows the “Embed” transaction being used in other contexts. *See* Ex. 2023 at 112:16-114:1, 109:19-110:25 (explaining Stefik at 41:58-42:14 is just an example of how the “Embed” transaction could work); Ex. 2023 at 107:14-108:4, 109:5-18, 111:1-112:12 (describing other examples disclosed in Stefik of the “Embed” transaction where fees are added without an action to content).

Dated: February 15, 2016

Respectfully submitted,

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Certificate of Service

I hereby certify that on this 15th day of February, 2016, a copy of this **Petitioners' Response to Patent Owner's Motion for Observations on Cross-Examination of Dr. Goldberg** has been served in its entirety by email on the following counsel of record for Patent Owner:

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