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Paper 13
Entered: August 25, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case CBM2015-00040
Patent 7,774, 280 B2

Before MICHAEL R. ZECHER, BENJAMIN D. M. WOOD, and GEORGIANNA W. BRADEN, *Administrative Patent Judges.*

ZECHER, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

I. DISCUSSION

A conference call in this proceeding was held on August 25, 2015, between respective counsel for Petitioner and Patent Owner, and Judges Zecher, Wood, and Braden. Patent Owner, ContentGuard Holdings, Inc. ("ContentGuard"), requested the conference call to discuss issues regarding a proposed amendment that it intends to submit in a Motion to Amend.

ContentGuard began the conference call by explaining that it intends to file a Patent Owner Response, along with a contingent Motion to Amend that effectively narrows independent claim 1. ContentGuard represented that it intends to amend independent claim 1 by including a definition for the claim term "meta-right" that it proposed in its Preliminary Response, which it believes is consistent with the district court's construction of the same claim term. ContentGuard noted that, because there are large number of proceedings involving U.S. Patent No. 7,774,280 B2 and related patents, as well as the extensive prosecution history for these patents, the prior art known to ContentGuard is voluminous. ContentGuard requested guidance as to what prior art it should focus on in its Motion to Amend. As we explained during the conference call, ContentGuard should, at a minimum, focus on the prior art of record, which, in this case, is Stefik (Ex. 1002). As to the prior art known to ContentGuard, the focus should be on the prior art ContentGuard discerns is the most relevant to each added limitation. *See MasterImage 3D, Inc. v. RealD Inc.*, Case IPR2015-00040, slip op. 3 (PTAB July 15, 2015) (Paper 42).

We then took this opportunity to explain that, in general, consideration of a motion to amend is contingent on us determining that the claim for which the substitute claim is proposed is unpatentable. Entry of

proposed amendments is not automatic, but only upon ContentGuard demonstrating the patentability of each proposed substitute claim. *See* 37 C.F.R. § 42.20(c). This includes demonstrating that each proposed substitute claim is supported by the written description of the application upon which the substitute claims rely, addressing the patentability of each proposed substitute claim over the prior art of record and the prior art known to ContentGuard, and accounting for the basic knowledge and skill set possessed by a person of ordinary skill in the art even without reliance on any particular prior art reference. *See* 37 C.F.R. § 42.121(b). For further guidance on a motion to amend, we directed the parties to the following representative decisions: (1) *Idle Free Systems, Inc. v. Bergstrom, Inc.*, Case IPR2012-00027 (PTAB June 11, 2013) (Paper 26) (informative); (2) *Corning Optical Commc'n RF, LLC, v. PPC Broadband, Inc.*, Case IPR2014-00441 (PTAB Oct. 20, 2014) (Paper 19); and (3) *MasterImage 3D*, Case IPR2015-00040, Paper 42.

II. ORDER

In consideration of the foregoing, it is hereby ORDERED that ContentGuard has satisfied the conference requirement of 37 C.F.R. § 42.221(a) for this proceeding.

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