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Paper 14
Entered: September 11, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case CBM2015-00160
Patent 7,774,280 B2

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

ZECHER, *Administrative Patent Judge.*

DECISION
Institution of Covered Business Method Patent Review and Granting Petitioner's Motion for Joinder
35 U.S.C. § 324(a), 37 C.F.R. §§ 42.208 and 42.222

I. INTRODUCTION

On July 17, 2015, Petitioner, Apple Inc. ("Apple"), filed a Petition requesting a review under the transitional program for covered business method patents of claims 1, 5, 11, 12, and 22 of U.S. Patent No. 7,774,280 B2 ("the '280 patent," Ex. 1001). Paper 1 ("Pet."). Apple filed its Petition along with a Motion for Joinder requesting that we join Apple as a party with *Google Inc. v. ContentGuard Holdings, Inc.*, Case CBM2015-00040 ("Google CBM"). Paper 2 ("Apple Mot.").

We previously instituted a covered business method patent review in the Google CBM on June 24, 2015, only as to claims 1, 5, and 11 of the '280 patent. *See* Google CBM, Paper 9 ("Google CBM Dec. to Inst."). The Petition filed in this proceeding is essentially the same as the Petition filed in the Google CBM. *Compare* Google CBM, Paper 1, *with* Pet. Apple, however, represents that is willing to limit the asserted grounds of unpatentability ("grounds") in this proceeding to only those grounds that we already determined satisfy the "more likely than not" threshold standard for institution in the Google CBM. Apple Mot. 6; Google CBM Dec. to Inst. 43.

Patent Owner, ContentGuard Holdings, Inc. ("ContentGuard"), filed a Response to Apple's Motion for Joinder. Paper 6 ("ContentGuard Resp."). In its Response, ContentGuard represents that is does not oppose joining this proceeding to the Google CBM subject to certain conditions. ContentGuard Resp. 1. ContentGuard also represents that, if we grant Apple's Motion for Joinder, it is willing to waive its right to file a Preliminary Response in this proceeding. *Id.*

We have jurisdiction under 35 U.S.C. § 324.[1] For the reasons discussed below, we institute a covered business method patent review only as to claims 1, 5, and 11 of the '280 patent, and only based on the same grounds instituted in the Google CBM. We also grant Apple's Motion for Joinder.

II. INSTITUTION OF COVERED BUSINESS METHOD PATENT REVIEW

In the Google CBM, we instituted a covered business method patent review only as to claims 1, 5, and 11 of the '280 patent based on the following grounds: (1) claims 1, 5, and 11 as being anticipated under 35 U.S.C. § 102(b) by Stefik[2]; and (2) claims 1, 5, and 11 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Stefik and the knowledge of one of ordinary skill in the art. Google CBM Dec. to Inst. 30–43. As we indicated previously, although the Petition filed in this proceeding is essentially the same as the Petition filed in the Google CBM, Apple is willing to limit the asserted grounds in this proceeding to only those grounds that we already determined satisfy the "more likely than not" threshold standard for institution in the Google CBM. Apple Mot. 6; Google CBM Dec. to Inst. 43.

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[1] *See* Section 18(a)(1) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011) ("AIA"), which provides that the transitional program for covered business method patents will be regarded as a post-grant review under Chapter 32 of Title 35 of the United States Code, and will employ the standards and procedures of a post-grant review, subject to certain exceptions.

[2] U.S. Patent No. 5,634,012, filed Nov. 23, 1994, issued May 27, 1997 (Ex. 1002, "Stefik").

As we explain below, we grant Apple's Motion for Joinder. Because we are granting Apple's Motion for Joinder, ContentGuard waives its right to file a Preliminary Response in this proceeding. *See* ContentGuard Resp. 1 ("ContentGuard hereby waives its right to file a Preliminary Response in this proceeding, while reserving its right to do so if joinder is denied."). Consequently, we conclude that the information presented in the Petition establishes that claims 1, 5, and 11 of the '280 patent are more likely than not unpatentable under §§ 102(b) and 103(a). We, however, determine that the information presented in the Petition does not establish that claims 12 and 22 are more likely than not unpatentable. Pursuant to 35 U.S.C. § 324 and § 18(a) of AIA, we institute a covered business method patent review only as to claims 1, 5, and 11 of the '280 patent, and only based on the same grounds instituted in the Google CBM.

III. GRANTING APPLE'S MOTION FOR JOINDER

Based on authority delegated to us by the Director, we have discretion to join a covered business method patent review with another covered business method patent review under 35 U.S.C. § 325(c). The regulatory provisions governing covered business method patent review proceedings address the appropriate timeframe for filing a motion for joinder. Section 42.222(b) of Title 37 of the Code of Federal Regulations provides, in relevant part, "[a]ny request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any post-grant review for which joinder is requested."

The Petition and the accompanying Motion for Joinder were both accorded filing dates of July 17, 2015. *See* Paper 4, 1. As such, Apple's Motion for Joinder was filed timely because joinder was requested no later

than one month after June 24, 2015—the institution date of the Google CBM.

In its Motion for Joinder, Apple contends that joinder between this proceeding and the Google CBM is appropriate because both proceedings involve the same patent, the same prior art reference, the same expert declaration, and the same arguments and rationales. Apple Mot. 5. In other words, Apple asserts that the Petition and supporting evidence filed in this proceeding does not raise new substantive or procedural issues. *See id*. Apple then represents that it is willing to adhere to the Scheduling Order already established for the Google CBM. *Id*. at 6. Apple also represent that it is willing to accept reasonable restrictions on discovery, so long as they do not preclude Apple from participating in the joined proceedings. *Id*. at 7. Apple further represents that it is willing to limit its participation to providing joint comments with Google, so long as Google remains a party in the joined proceedings. *Id*.

In its Response, ContentGuard represents that it is does not oppose joining this proceeding to the Google CBM subject to each of the following conditions: (1) the schedule from the Google CBM remain unchanged; (2) discovery is limited to the scope previously agreed to by ContentGuard and Google—namely, the cross-examination depositions of experts; and (3) Apple's participation in briefing, depositions, and oral argument is limited to sharing the briefing and time allotted with Google. ContentGuard Resp. 1. ContentGuard also represents that, in the event that Google ends its participation in the Google CBM, e.g., via settlement, it agrees to let Apple participate as the sole party subject to the same conditions outlined above. *Id*.

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