

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 CONTINGENT MOTION TO AMEND UNDER
37 C.F.R. § 42.121

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Patent Trial and Appeal Board
United States Patent and Trademark Office
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¹ Case CBM2015-00160 has been joined with this proceeding.

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I. INTRODUCTION

This contingent motion to amend is submitted in compliance with 37 C.F.R. §42.121. If original claim 1 of U.S. Patent No. 7,774,280 (“the ‘280 patent”) is found unpatentable, the Board is requested to cancel independent claim 1 and replace it with proposed substitute claim 37. *See* 37 C.F.R. §42.22(a)(2); 35 U.S.C. § 316(d). Proposed substitute independent claim 37 amends original independent claim 1 to expressly incorporate the meaning of the term “meta-right” as it would be interpreted in district court litigation. Claims 2-11 depend from original claim 1, would be unchanged in scope, and would depend from proposed substitute claim 37. *See Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-0419, Paper 32 at 2 (PTAB Mar. 7, 2014)(when independent claim cancelled and replaced with substitute claim, an unchanged dependent claim retains its same scope and need not be rewritten as substitute claim); *ZTE Corporation et al. v. ContentGuard Holdings Inc.*, IPR2013-00136, Paper 33 at 3-4 (PTAB Nov. 7, 2013)(not necessary to present unchanged dependent claims as substitute claims when substituting for independent claim).

ContentGuard has satisfied the conference requirement of 37 C.F.R. § 42.221(a) for this motion. (*See* Paper 13.)

II. CLAIM LISTING

The following is a complete listing of the proposed claim amendment with a

correlation of the substitute claim to the original claim. *See* C.F.R. ¶42.121(b).

1. (Cancelled)

2-11. (Unchanged claims to depend from proposed substitute claim 37)

37. (Proposed substitute for original claim 1) A computer-implemented method for transferring rights adapted to be associated with items from a rights supplier to a rights consumer, the method comprising:

obtaining a set of rights associated with an item of content, the set of rights including a meta-right specifying a usage right or another meta-right that can be created when the meta-right is exercised, wherein the meta-right is provided in digital form and is enforceable by a repository;

determining, by a repository, whether the rights consumer is entitled to the right specified by the meta-right; and

exercising the meta-right to create the right specified by the meta-right if the rights consumer is entitled to the right specified by the meta-right, wherein the created right includes at least one state variable based on the set of rights and used for determining a state of the created right, and wherein the meta-right is not itself a usage right because exercising the meta-right does not result in action to the content.

III. SCOPE OF THE SUBSTITUTE CLAIM

The proposed substitute claim presents one substitute claim for the cancelled original claim, satisfying the general presumption that “only one substitute claim would be needed to replace each challenged claim.” *See* 37 C.F.R. §42.121(a)(3).

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