

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and APPLE INC.,
Petitioners,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case CBM2015-00040¹
(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
Granting the Parties' Joint Motion to Limit Petition
37 C.F.R. § 42.71

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

I. INTRODUCTION

On October 9, 2018, the parties filed a Joint Motion to Limit Petition under 35 U.S.C. § 42.71. Paper 42 (“Mot.”). The parties jointly request to limit the Petitions filed in Cases CBM2015-00040 and CBM2015-00160 only to claims 1, 5, and 11 of the U.S. Patent No. 7,774,280 B2 (Ex. 1001, “the ’280 patent”). Mot. 1. The parties jointly request that the panel remove the following claims and grounds of unpatentability (“grounds”) from the trial:

Reference(s)	Basis	Challenged Claims
	§ 101	1, 5, 11, 12, and 22
Stefik ² (U.S. Patent No. 5,634,012, issued May 27, 1997 (Ex. 1002))	§ 102(b)	12 and 22
Stefik and the knowledge of one of ordinary skill in the art	§ 103(a)	12 and 22

Mot. 1. For the reasons discussed below, we *grant* the parties’ Joint Motion to Limit Petition.

II. PROCEDURAL HISTORY

On June 21, 2016, we issued a Final Written Decision in accordance with 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73, in which we determined that the ’280 patent is a covered business method patent eligible for review, we determined that claims 1, 5, and 11 of the ’280 patent are unpatentable under 35 U.S.C. §§ 102(b) and 103(a), and we granted Patent Owner’s Motion to Amend. Paper 34. Petitioners appealed our grant of Patent Owner’s Motion to Amend to the U.S. Court of Appeals for the Federal Circuit. Papers 35, 36. Patent Owner cross-

² For clarity and ease of reference, we only list the first named inventor.

appealed our determination that the '280 patent is a covered business method patent eligible for review. Paper 37. On July 11, 2018, the Federal Circuit remanded this case for us to determine whether the '280 patent qualifies as a covered business method patent eligible for review, without relying on the “incidental to” or “complementary to” standard. Paper 39. The Federal Circuit’s mandate issued on September 4, 2018. Paper 40. On October 1, 2018, we issued an Order that modifies our Decisions on Institution to include the previously non-instituted claims and grounds identified above, and authorizes the parties to file a Joint Motion to Limit the Petitions. Paper 41, 6.

III. ANALYSIS

In the Motion, the parties contend that we should limit the Petitions filed in Cases CBM2015-00040 and CBM2015-00160 for the following three reasons: (1) we previously authorized “the parties to file a Joint Motion to Limit the Petitions by removing the previously non-instituted claims and grounds from the trial” (Mot. 2 (quoting Paper 41, 6)); (2) the parties have reached an agreement to limit the Petitions (*id.*); and (3) because the panel already issued a Final Written Decision and the Federal Circuit appeal was limited to a subset of the challenged claims and grounds set forth in the Petitions, reducing the number of claims and grounds at issue promotes the efficient use of Board resources and saves the parties additional expenses (*id.* at 2–3).

For all the reasons identified by the parties, we agree that limiting the Petitions would allow the focus of the trial going forward to remain on the explicit instructions provided in the Federal Circuit’s remand decision—namely, whether the '280 patent qualifies as a covered business method patent eligible for review, without relying on the “incidental to” or “complementary to” standard. *See* Paper

39, 7 (“On remand, the Board must determine whether the ’280 patent qualifies as a [covered business method] patent in the first instance without relying on the ‘incidental to’ or ‘complementary to’ standard.”). Limiting the trial in this way also facilitates our mandate “to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

IV. ORDER

It consideration of the foregoing, it is

ORDERED that the parties Joint Motion to Limit Petition is *granted*; and FURTHER ORDERED that the following claims and grounds are removed from trial:

- A. Claims 1, 5, 11, 12, and 22 as being directed to patent-ineligible subject matter under 35 U.S.C. § 101;
- B. Claims 12 and 22 as being anticipated under 35 U.S.C. § 102(b) by Stefik; and
- C. Claims 12 and 22 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; and

FURTHER ORDERED that the focus of the trial going forward remains whether the ’280 patent qualifies as a covered business method patent eligible for review, without relying on the “incidental to” or “complementary to” standard.

CBM2015-00040
Patent 7,774,280 B2

For PETITIONERS:

Robert R. Laurenzi
Kaye Scholer LLP
robert.laurenzi@kayescholer.com

Jeffrey P. Kushan
Sidley Austin LLP
jkushan@sidley.com

For PATENT OWNER:

Timothy P. Maloney
Nicholas T. Peters
Fitch Even Tabin & Flannery LLP
tpmalo@fitcheven.com
ntpete@fitcheven.com

Robert A. Cote
McKool Smith, P.C.
rcote@mckoolsmith.com