

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner

Patent No. 7,774,280

Issued: August 10, 2010

Filed: October 4, 2004

Inventors: Nguyen, *et al.*

Title: System and Method for Managing Transfer of Rights Using Shared State
Variables

CBM2015-00160

MOTION FOR JOINDER TO CBM2015-00040

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 325(c), 37 C.F.R. § 42.222, and 37 C.F.R. § 42.300 Petitioner Apple Inc. (“Petitioner” or “Apple”) moves to join its concurrently filed petition for *Contested Business Method* Review of U.S. Patent No. 7,774,280 (the ’280 patent) with the *Contested Business Method* Review of the ’280 patent requested by Google Inc., CBM2015-00040 (the “Google CBM”). On June 24, 2015, the Board instituted trial on claims 1, 5, and 11 of the ’280 patent in the Google CBM. This Motion for Joinder is timely filed under 37 C.F.R. §§ 42.22 and 42.222(b) as it is submitted no later than one month after the June 24, 2015 institution date of CBM2015-00040.

Joinder is appropriate because the Apple petition and the Google CBM petition are substantially *identical*. The Apple petition relies on the *same* grounds as those advanced by Google. Joinder is appropriate because it will permit Apple to protect its interests related to the validity of the ’280 patent,¹ and Apple could be prejudiced if it is not permitted to join this proceeding. Joinder is also appropriate because it will not disrupt the efficient resolution of the validity of the involved patent and it will not prejudice the parties of the Google CBM. Thus, the factors relevant to joinder favor granting this motion, including that: (i) the same schedule

¹ Apple has been sued for infringement of the ’280 patent in the Eastern District of Texas.

for various proceedings can be adopted, (ii) Apple is not advancing any new grounds or any expert testimony, and thus, discovery will not be impacted by joinder, and (iii) joinder will not materially affect the range of issues needing to be addressed by the Board and by the parties in the joined proceedings. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper No. 15 at 4 (Apr. 24, 2013).

Because all these factors support joining these proceedings, Apple requests the Board to grant this motion.

II. RELEVANT FACTS

On December 9, 2014, Google Inc. (“Google”), 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. CBM2015-00040, Paper 1. On April 6, 2015, Patent Owner, ContentGuard Holdings, Inc. (“ContentGuard”), filed a Preliminary Response. *Id.*, Paper 8. On June 24, 2015, the Board instituted trial on claims 1, 5, and 11 the ’280 patent on the following grounds:

- Claims 1, 5, and 11 as being anticipated under § 102(b) by Stefik (Ex. 1002, US 5,634,012); and
- Claims 1, 5, and 11 as being unpatentable under § 103(a) over the combination of Stefik and the knowledge of one of ordinary skill in the art.

The Apple CBM petition (CBM2015-00160) is substantially identical to the Google CBM petition (CBM2015-00040). With the exception of Exhibit 1031 (the complaint in *ContentGuard Inc. v. Amazon.com Inc., et al.*, showing Apple has been sued for infringement of the '280 patent), all exhibits in the Apple CBM petition (CBM2015-00160) are identical to the exhibits in the Google CBM petition (CBM2015-00040).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Leahy-Smith America Invents Act (“AIA”) provides for joinder of CBM proceedings. *See* 35 U.S.C. § 325(c). In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *See Dell Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17, July 29, 2013 at 3 (“*Dell*”); *Trulia, Inc. v. Zillow, Inc.*, Case CBM2014-00115, Paper No. 8, May 1, 2014 at 18-19 (“*Trulia*”); *Motorola Mobility LLC v. Softview, LLC*, IPR2013-00256, Paper 10 at 5 (“*Motorola*”); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 157, 48758 (Aug. 14, 2012) (“The rules are to be construed so as to ensure the just, speedy, and inexpensive resolution of a proceeding ...”).

Under this framework, joinder of the present petition with CBM2015-00040 is appropriate.

Joinder with the Google CBM is justified because each factor identified by the Board as supporting joinder is met. For example, the Board has explained that a motion for joinder should: (1) explain the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (representative order); *see also Skimlinks, Inc. v. Linkine, Inc.*, CBM2015-00087, Paper No. 14, June 15, 2015 at 24 (*citing* Frequently Asked Question H5, <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0> (last visited June 2, 2015)). Each of these factors is addressed below, and when considered together, strongly support granting this motion for joinder.

A. Joinder Is Appropriate

This Motion for Joinder is timely because it is being filed within one month of the date, June 24, 2015, on which the Board instituted a trial in CBM2015-00040. *See* 37 C.F.R. § 42.222(b). Granting the present motions will further the interests of justice in that it will permit Apple to protect its interests related to the

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.