Trial@uspto.gov
571-272-7822

Paper 11
Entered: August 5, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case IPR2015-00352
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
Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner, Apple Inc. ("Apple"), timely filed a Request for Rehearing under 37 C.F.R. § 42.71(d) on July 24, 2015. Paper 10 ("Req. Reh'g").

Apple's Request for Rehearing seeks reconsideration of our Decision Denying Institution (Paper 9, "Dec.") entered on June 24, 2015, particularly our determination to deny review of challenged independent claim 1 of U.S. Patent No. 7,774,280 B2 ("the '280 patent") as being unpatentable under 35 U.S.C. § 103(a) over Gruse.[1] *See* Dec. 10–17.

In its Request for Rehearing, Apple contends that our determination to deny review of challenged independent claim 1 of the '280 patent was improper for at least three reasons. First, Apple argues that we misapprehended or overlooked Apple's argument that it would have been obvious to one of ordinary skill in the art to modify Gruse's scheme to employ the functionality of Stefik's repository,[2] which, according to the Background of the Invention section of the '280 patent, was an old and well-known trusted system. Req. Reh'g 2–11. Second, Apple argues that we misapprehended or overlooked the testimony of Apple's expert witness, Dr. Atul Prakash, which purportedly supports its explanation as to why it would have been obvious to one of ordinary skill in the art to modify Gruse's scheme to include the functionality of Stefik's repository. *Id*. at 11–13. Finally, Apple argues that we misapprehended or overlooked that another Board panel previously determined that Downs,[3] which is incorporated by reference in Gruse, anticipated the claims in the '280 patent's parent

[1] U.S. Patent No. 6,389,538 B1, issued May 14, 2002 (Ex. 1008, "Gruse").
[2] U.S. Patent No. 5,634,012, issued May 27, 1997 (Ex. 1012, "Stefik").
[3] U.S. Patent No. 6,226,618 B1, issued May 1, 2001 (Ex. 1014, "Downs").

application[4] that are similar to the claims of the '280 patent challenged in this proceeding. *Id*. at 13–15.

As we explain below, we have considered the arguments presented by Apple in its Request for Rehearing, but we discern no sufficient reason to modify the Decision Denying Institution. As a consequence, we deny Apple's Request for Rehearing.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id*. When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). With this in mind, we address the arguments presented by Apple in turn.

---

[4] U.S. Patent Application No. 10/162,701, filed on June 6, 2002 ("the '701 application"). Ex. 1001, at [63].

III. ANALYSIS

A. Apple Does Not Identify Explicitly the Background of the Invention Section in the '280 Patent, Which Incorporates by Reference Stefik, as Prior Art That Serves as the Basis of the Grounds Identified in the Petition

Apple directs us to disparate portions of the Petition that purportedly explain why it would have been obvious to one of ordinary skill in the art to modify Gruse's scheme to employ the functionality offered by Stefik's repository, which, according to the Background of the Invention section of the '280 patent, was an old and well-known trusted system. Req. Reh'g 2–6 (citing Paper 1 ("Pet."), 18, 19, 24, 34, 36–38, 50–56). Apple also argues that the Petition provides evidence in the form of Dr. Prakash's testimony to support this explanation. *Id.* at 6–7 (citing Ex. 1003 ¶¶ 504–09). Apple then asserts that we did not appreciate that the Petition included such a contention because the Decision Denying Institution makes no reference to pages 53–56 of the Petition, much less the analysis and reason presented therein. *Id.* at 8.

As an initial matter, we are not persuaded by Apple's assertion that the Petition includes an asserted ground based on Gruse and the admitted prior art contained in the Background of the Invention section in the '280 patent. Under 35 U.S.C. § 312(a)(3), a petition requesting an *inter partes* review must "*identif[y]*, in writing and *with particularity*, each claim challenged, *the grounds on which the challenge to each claim is based*, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. § 312(a)(3) (emphases added). Our rules governing *inter partes* review proceedings further address the showing required in a petition. In

particular, 37 C.F.R. § 42.104(b)(2) provides that the petition must identify "[*t*]*he specific statutory grounds* under 35 U.S.C. 102 or 103 on which the challenge to the claim is based and *the patents or printed publications relied upon for each ground*." 37 C.F.R. § 42.104(b)(2) (emphases added).

In its Petition, Apple identifies the specific statutory grounds on which the challenge to each claim is based in the section titled "Identification of Claims Being Challenged ([37. C.F.R.] § 42.104(b))." Pet. 2–3 (emphasis omitted). In that section, Apple indicates that claims 1–5, 8, 11–16, 19, 22, 24–28, 31, and 34 of the '280 patent would have been unpatentable based on the following two grounds: (1) obviousness over Gruse; and (2) obviousness over the combination of Gruse and Wiggins. Apple, however, does not identify explicitly the Background of the Invention Section in the '280 patent, which incorporates by reference Stefik, as prior art that serves as the basis of the asserted grounds identified above. Consequently, we could not have misapprehended or overlooked Apple's argument that it would have been obvious to one of ordinary skill in the art modify Gruse's scheme to employ the functionality of Stefik's repository.

Even if we were to assume that the Petition identifies a ground based on Gruse and the admitted prior art contained in the Background of the Invention section in the '280 patent, we still would not have been persuaded by Apple's argument that it would have been obvious to one of ordinary skill in the art modify Gruse's scheme to employ the functionality of Stefik's repository. Apple's argument in this regard focuses primarily on the explanation set forth on pages 53–56 of the Petition. *See* Req. Reh'g 5–6.

DOCKET ALARM

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.