

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case IPR2015-00448
Patent 8,370,956 B2

Before KARL D. EASTHOM, GLENN J. PERRY, and
PATRICK R. SCANLON, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(c, d)

INTRODUCTION

Petitioner, Apple Inc., filed a Request for Rehearing (Paper 10, “Reh’g Req.”) of our Decision Denying Institution of *Inter Partes* Review (Paper 9, “Dec.”). The Rehearing Request seeks rehearing of the Decision with respect to not instituting trial on claims 1–18 of U.S. Patent No. 8,370,956 B2 as unpatentable under 35 U.S.C. § 103(a) over Rosen (Ex. 1020) and Hartrick (Ex. 1021). See Reh’g Req. 1; Dec. 6, 34–35.

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

For the reasons discussed below, Petitioner’s Request for Rehearing is *denied*.

ANALYSIS

Petitioner argues that the panel “used an improperly rigid standard to measure the obviousness grounds presented in the Petition” and, in doing so, overlooked and misapprehended substantial portions of the Petition, “which explained in detail how the prior art references either individually described or together suggested each element of the contested claims.” Reh’g Req 1. Petitioner adds that the analysis in the Petition was “clear, well-organized, understandable[,] and supported by direct citations to Rosen and/or Hartrick, and to evidence showing how a person of ordinary skill would have understood their interrelated teachings.” *Id.* at 2.

Petitioner's arguments fail to show an overlooked or misapprehended matter arising to an abuse of discretion. Petitioner's Rehearing Request exemplifies the many problems the panel encountered with the Petition. For example, Petitioner states that the Petition clearly explains that Rosen discloses all the claim limitations except "how [restrictions on usage of the electronic object] are specified or enforced." *Id.* at 3. Petitioner then argues that the panel misapprehended that integrating Hartrick into Rosen only requires a "single change" to remedy this deficiency. *Id.* at 3–4 ("The Board also failed to appreciate the Petition actually described a single change to Rosen: integrating Hartrick's usage rights specification and enforcement features to support Rosen's 'Usage' field."). Nevertheless, in the next sentence, Petitioner explains that making this "single change" actually requires four separate modifications to Rosen. *Id.* at 4 ("The Petition explained doing this would cause the skilled person to make four modifications to Rosen.").

The Decision addresses the difficulty in understanding what Petitioner's proposed modifications were, how they were to be made, and why a person of ordinary skill would have made them. *See* Dec. 11–21. Petitioner's Rehearing Request—characterizing the modifications as "a single change" as noted—neither clarifies the Petition nor shows that the Board overlooked or misapprehended a matter. Petitioner correctly notes that the need for extensive modification, alone, does not necessarily doom a proposed ground of obviousness, *see* Reh'g Req. 5–6; however, extensive modification was just one of many problems obfuscating the asserted ground. The Decision explains that combined with the many other deficiencies of the Petition, Petitioner had not shown a reasonable likelihood of prevailing on any of the challenged claims. *See* Dec. 11–21 (discussing the

Petition's vague, nested string citations to broad swaths of references; clarity problems created by pervasive use of internal cross-references and nested citations; improper incorporation by reference of the Sherman Declaration to support conclusory statements, thin analysis, and inadequate reasoning; and lack of sufficient information to enable a proper *Graham* analysis).

Similarly, Petitioner asserts that the Decision requires an impermissibly rigid form of proof and shows a misunderstanding of substantial portions of the Petition. *See* Reh'g Req. 6–13. Much of the Petition is difficult to understand, because, as explained above, the combination of problems with the Petition, described in detail in the Decision, rendered deciphering Petitioner's contentions intractable. Petitioner fails to show that denying institution on this basis constitutes an abuse of discretion.

Finally, Petitioner asserts that “the Board misapprehended” its mapping of key claim terms, *id.* at 14, and concludes that “the Petition established that Rosen and Hartrick met every element of the claims,” *id.* at 15. Contrary to this assertion, setting aside the above-noted deficiencies, the Rehearing Request fails to address a key claim mapping deficiency specifically identified in the Decision: The Decision details why “the Petition fails to address, in more than a conclusory fashion, how the hypothetical ‘recipient computing device has been determined to be trusted’ as the independent claims require—i.e., ‘has been determined’ to have, for example, behavioral integrity.” Dec. 22 (citing Pet. 18–19, 22).

Based on the foregoing discussion, Petitioner fails to meet its burden of showing a previously addressed overlooked or misapprehended matter that amounts to an abuse of discretion and warrants a modification of the Decision.

ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314 (a), Petitioner's Rehearing Request is *denied*.

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