

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case IPR2015-00455
Patent 7,269,576 B2

Before MICHAEL R. ZECHER, GEORGIANNA W. BRADEN, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 312(a)(4) and 37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Apple (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 3, 4, and 7–10 of U.S. Patent No. 7,269,576 B2 (Ex. 1009, “the ’576 patent”). ContentGuard Holdings, Inc. (“Patent Owner”) timely filed a Preliminary Response (Paper 8, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition and Patent Owner’s Preliminary Response, we conclude Petitioner has not established a reasonable likelihood it would prevail with respect to at least one of the challenged claims. Accordingly, we deny the Petition.

B. Related Matters

The ’576 patent has been asserted in the following three district court cases: (1) *ContentGuard Holdings, Inc. v. Amazon.com, Inc.*, No. 2:13-cv-01112 (E.D. Tex.); (2) *Google, Inc. v. ContentGuard Holdings, Inc.*, No. 3:14-cv-00498 (N.D. Cal.); and (3) *ContentGuard Holdings, Inc. v. Google, Inc.*, No. 2:14-cv-00061 (E.D. Tex). Pet. 2; Paper 7, 3. In addition to this Petition, Apple filed at least four other Petitions challenging the patentability of a certain subset of claims of the ’576 patent: Cases IPR2015-00452, IPR2015-00453, IPR2015-00454, and IPR2015-00456. Pet. 1; Paper 7, 1–2.

Petitioner does *not* identify, as a related matter, *ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00139 (PTAB) (the “ZTE IPR”), which resulted in a Final Decision (Paper 57) regarding a certain

subset of claims of the '576 patent. *See* Pet. 2. Patent Owner, however, does identify this related matter. Paper 7, 2.

C. The '576 Patent

The '576 patent, titled "Content Rendering Apparatus," issued September 11, 2007, from U.S. Patent Application No. 10/773,306, filed on February 9, 2004. Ex. 1009, at [54], [45], [21], and [22]. The '576 patent generally relates to a method and system for distributing and enforcing usage rights associated with digitally encoded content. Ex. 1009, 1:5–6.

D. Illustrative Claim

Claim 1 is independent, and the remainder of the challenged claims depend from claim 1. Claim 1 is reproduced below:

1. An apparatus for rendering digital content in accordance with rights that are enforced by the apparatus, said apparatus comprising:

a rendering engine configured to render digital content;
a storage for storing the digital content;
means for requesting use of the digital content stored in the storage; and

a repository coupled to the rendering engine,
wherein the repository includes:
means for processing a request from the means for requesting,

means for checking whether the request is for a permitted rendering of the digital content in accordance with rights specified in the apparatus,

means for processing the request to make the digital content available to the rendering engine for rendering when the request is for a permitted rendering of the digital; and

means for authorizing the repository for making the digital content available for rendering, wherein the digital content can be made available for rendering only by an authorized repository, the repository comprising:

means for making a request [sic] for an authorization object [sic] required to be included within the repository for the apparatus to render the digital content; and

means for receiving the authorization object [sic] when it is determined that the request should be granted.

Ex. 1009, 52:45–53:5.

E. The Evidence of Record

Petitioner relies upon the following references, as well as the Declaration of Alan Sherman, Ph.D. (Ex. 1013):

Reference	Patent/Printed Publication	Date	Exhibit
Rosen	U.S. Patent No. 5,557,518	Sept. 17, 1996	Ex. 1020
Hartrick	EP 0 567 800 A1	Nov. 3, 1993	Ex. 1021

F. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of certain claims of the '576 patent based on the following ground:

References	Basis	Claims Challenged
Rosen and Hartrick	§ 103(a)	1, 3, 4, and 7–10

II. DISCUSSION

In an *inter partes* review, we construe claims by applying the broadest reasonable interpretation in light of the specification.¹ 37 C.F.R.

§ 42.100(b). 37 C.F.R. § 42.100(b); see *In re Cuozzo Speed Tech., LLC*, 778

¹ Petitioner contends that the '576 patent will expire no later than July 21, 2015, and suggests that the claim construction standard used in district court would apply here “if trial is instituted.” Pet. 7 (citing *In re Rambus*, 694 F.3d 42, 46 (Fed. Cir. 2012).” Trial is not being instituted, and our Decision to Deny Institution would be the same even if we applied the district court standard for claim construction.

F.3d 1271, 1281–82 (Fed. Cir. 2015) (“Congress implicitly adopted the broadest reasonable interpretation standard in enacting the AIA,” and “the standard was properly adopted by PTO regulation”); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Under the broadest reasonable interpretation standard, and absent any special definitions, claim terms or phrases are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definitions for claim terms or phrases must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

A petition for an *inter partes* review must identify how each challenged claim is to be construed. 37 C.F.R. § 42.104(b)(3). As part of that requirement, a petitioner must “identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function” of any means- or step-plus-function limitation. *Id.*; see also 35 U.S.C. § 112 ¶ 6 (“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”).²

² Section 4(c) of the Leahy-Smith America Invents Act, Pub. L. No. 112–29, 125 Stat. 284 (2011) (“AIA”) re-designated 35 U.S.C. § 112 ¶ 6 as 35 U.S.C. § 112(f). Because the ’576 patent has a filing date prior to September 16, 2012, the effective date of § 4(c) of the AIA, we refer to the pre-AIA version of 35 U.S.C. § 112.

Independent claim 1 recites several limitations that presumably are means-plus-function limitations: “means for requesting . . .”; “means for processing . . .”; “means for checking . . .”; “means for authorizing . . .”; “means for making . . .”; and “means for receiving . . .” *See Williamson v. Citrix Online, LLC*, No. 2013-1130, 2015 WL 3687459, at *6–7 (Fed. Cir. June 16, 2015) (en banc in relevant part) (““use of the word ‘means’ creates a presumption that § 112, ¶ 6 applies.”).

Petitioner does not rebut the presumption that these limitations are governed by § 112 ¶ 6. Yet, Petitioner does not “identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.” *See* 37 C.F.R. § 42.104(b)(3). Instead, Petitioner states that “[t]he Board construed certain of these means-plus function elements in IPR2013-00139, Paper No. 15 (July 9, 2013),” and “Petitioner proposes to use the Board’s constructions of the ‘means’ terms from IPR2013-00139 where available.” Pet. 18. These statements do not fulfill Petitioner’s obligation to identify the corresponding structure. First, the applicable rule requires that “the *petition* set forth” the identification of the corresponding structure. 37 C.F.R. § 42.104(b)(3) (emphasis added); *see also* 37 C.F.R. § 42.6(a)(3) (prohibiting incorporation by reference). Second, in the relied-upon decision from the ZTE IPR, the Board denied institution with respect to claim 1 because the petitioner in that proceeding (ZTE Corp.) did not identify the correct structure corresponding to each means-plus-function limitation recited in claim 1. *ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00139 (PTAB July 9, 2013), Paper 15, at 27, 33, 35, 37–38.

Petitioner further states that “[i]n ongoing litigation, Patent Owner has identified allegedly corresponding structures for each [means-plus-function limitation recited in claim 1].” Pet. 18 (citing Ex. 1069, 6–15). This statement also does not fulfill Petitioner’s obligation to identify the corresponding structure for each means-plus-function limitation. First, as already discussed, it is the Petition, and not an extraneous document, that must set forth an identification of the corresponding structure. *See* 37 C.F.R. § 42.104(b)(3); *see also* 37 C.F.R. § 42.6(a)(3) (prohibiting incorporation by reference). Second, by requiring an identification of the corresponding structure be set forth in the Petition, the rule squarely places the burden to fulfill the requirement on Petitioner. Exhibit 1069 cited in the Petition, however, is a Declaration by Dr. Michael Goodrich in support of a *Patent Owner* claim construction brief filed in *ContentGuard Holdings, Inc. v. Amazon.com, Inc.*, Case No. 2:13-cv-01112 (E.D. Tex.).³

In asserting its ground of obviousness, the Petition again addresses the means-plus-function limitations of claim 1, but still does not fulfill its obligations under the rules. For instance, with respect to the “means for requesting” limitation, Petitioner acknowledges that the Board did not construe this limitation in IPR2013-00139, and then states that “[t]he parties” to the co-pending litigation have agreed the ‘[u]ser interface 1305 described [in Ex. 1009] at 16:35–44’ is this means element.” Pet. 49. Yet,

³ Exhibit 1069 also is captioned for *ContentGuard Holdings, Inc. v. Google Inc.*, Case No. 14-cv-0061 (E.D. Tex.). As indicated by the header, however, the copy that is Exhibit 1069 is from *ContentGuard Holdings, Inc. v. Amazon.com, Inc.*, Case No. 2:13-cv-01112 (E.D. Tex.).

disclosing what Petitioner allegedly agreed to in district court⁴ and simply citing to “user interface 1305” as this means element does not identify how this structure functions to request use of the digital content stored in the storage, as required by claim 1.

For the remainder of the means-plus-function limitations, Petitioner cites to the claim construction provided by the Board in IPR2013-00139, Paper 15 (July 9, 2013), but does not set forth an identification of corresponding structure from the ’576 patent. For example, with respect to the “means for authorizing” limitation, Petitioner states the following:

The Board found the following means for this element, which Patent Owner has not disputed in litigation:

[1], a communication channel is set up between the server and the remote repository. [2], the server repository performs a registration process with the remote repository. [3], the server repository invokes a “play” transaction to acquire the authorization object. [4], the server repository performs tests on the authorization object or executes a script before signaling that authorization has been granted for rendering content. ZTE Inst. Dec. at 24 (internal citations omitted); Ex. 1069 at 13.

Pet. 55. Petitioner then proceeds to map elements from the cited prior art to the challenged claims based on the Board’s claim construction in IPR2013-00139, Paper 15 (July 9, 2013). Neither this recitation of steps performed by an unidentified structure nor the mapping of claim elements

⁴ Petitioner’s statement that the parties allegedly agreed on a construction in district court is contradicted by Dr. Goodrich’s declaration. Specifically, Dr. Goodrich states that Petitioner asserts in court that the “means for requesting” limitation is indefinite and, thus, is not the user interface 1305 described at column 16, lines 35–44 of the ’576 patent. Ex. 1069 ¶ 16.

onto the prior art amounts to identification of corresponding structure for the “means for authorizing” element.

Another example is the following statement from Petitioner regarding the “means for making a request for an authorization object required to be included within the repository” limitation:

The Board held (and Patent Owner does not dispute) that this means element performs the first three steps of the “*means for authorizing*” except the server repository does so to “*request*” rather than “*acquire*” the authorization object. ZTE Inst. Dec. at 25; Ex. 1069 at 13-14. When the CTA is renewing a digital certificate or requesting an authentication message, it is both requesting and acquiring the digital certificate or authentication message, respectively. See Ex. 1020 at 11:14-25, 6:38-55.

Pet. 57. Stating the recited function of a means-plus-function limitation, however, does not provide an identification of the specific portions of the specification corresponding to the structure of that limitation. Put simply, the Petition does not identify a structure for a “means for making a request for an authorization object required to be included within the repository.”

III. CONCLUSION

Petitioner does not identify the specific portions of the specification of the '576 patent that describe the structure corresponding to each recited function of the means-plus-function limitations of claim 1. The means-plus-function limitations of claim 1 are incorporated by reference into dependent claims 3, 4, and 7–10 by virtue of their dependency on claim 1.

There is no exemption from the requirement to identify corresponding structure for means-plus-function limitations under 37 C.F.R. § 42.104(b)(3) for claims that may have been construed previously in a related matter. By failing to identify the corresponding structure or to provide even the alleged

prior constructions, the Petition does not show how the challenged claims are to be construed, *see* 37 C.F.R. § 42.104(b)(3), and also does not show how, as so construed, they are unpatentable under the statutory ground identified in the Petition. *See id.* at (b)(4).

Therefore, Petitioner fails to show there is a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.8(b)(2).

IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied and no trial is instituted.

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