Trials@uspto.gov
571-272-7822

Paper 12
Date: March 13, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case IPR2015-00400
Patent 8,583,556 B2

Before JAMESON LEE, MICHAEL R. ZECHER,
and JENNIFER S. BISK, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge*.

Order
Conduct of Proceedings
37 C.F.R. § 42.5

On February 25, 2015, Petitioner was ordered to provide a clarification of precisely what grounds of unpatentability are asserted by Petitioner. Paper 10. Petitioner filed a Notice of Clarification on February 27, 2015. Paper 11. The response, however, exceeded the scope authorized by the Board, by adding a column to a table, which articulates, for each alleged obviousness ground of unpatentability, the differences between each challenged claim and the primary reference relied on in each alleged ground of unpatentability. Paper 11, 3–4.

The unauthorized material is inappropriate. If differences between the claimed invention and the prior art are identified in the petition, they need not be identified once again. If differences were not presented in the Petition, it is inappropriate for Petitioner to add them for consideration subsequent to the filing of the Petition. In submitting its Preliminary response, Patent Owner should only refer to differences identified in the Petition, if any, and not to differences identified by Petitioner subsequent to the filing of the Petition. We have not authorized the filing of a revised or corrected petition.

If Patent Owner's Preliminary Response relies on differences identified by Petitioner subsequent to the filing of the Petition, the arguments in that regard will not be considered, because they would not be directed to the Petition. Petitioner may not add to its Petition in the name of providing a clarification.

Petitioner in its Notice of Clarification filed on February 27, 2015, also states that it "proposes to withdraw the proposed obviousness grounds based on Doherty or Hollar considered alone, and to proceed with the obviousness grounds in the petition based on combinations of each primary reference with one or more secondary references." Paper 11, 2. It is unclear what Petitioner intends by use of language "proposes." It is clear, however, that by using the word "proposes," Petitioner has not withdrawn any ground from consideration.

For the foregoing reasons, it is

ORDERED that Petitioner shall file, within 5 days of the date of this Order, a second response to our Order dated February 25, 2015, that is free of the above-noted deficiencies;

FURTHER ORDERED that Paper 11 will be expunged from the record as non-compliant to the Order dated February 25, 2015, after filing of a compliant second response by Petitioner; and

FURTHER ORDERED that if Petitioner desires that certain alleged grounds of unpatentability no longer be considered, it may include in its second response a clear statement to the effect that Petitioner withdraws and removes these grounds from consideration.

For Petitioner:

Jeffrey Kushan
Michael Franzinger
iprnotices@sidley.com

For Patent Owner:

Thomas Lebens
Timothy Maloney
Robert Cote
tom@fitcheven.com
tpmalo@fitcheven.com
rcote@mckoolsmith.com