

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZTE CORPORATION AND ZTE (USA) INC.  
Petitioner

v.

Patent of CONTENTGUARD HOLDINGS INC.  
Patent Owner

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CASE NO. IPR2013-00454  
PATENT NUMBER 7,225,160

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***MAIL STOP "PATENT BOARD"***

Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**MOTION FOR JOINDER TO RELATED  
INSTITUTED *INTER PARTES* REVIEW (37 C.F.R. § 42.122(b))**

Petitioner, ZTE Corporation and ZTE (USA) Inc. ("ZTE"), files this Motion for Joinder of the Petition For *Inter Partes* Review of U.S. Patent No. 7,225,160 filed on even date herewith ("Second Petition"), with the instituted *inter partes* review, *ZTE Corporation and ZTE (USA) Inc. v. ContentGuard Holdings Inc.*,

Case No. IPR2013-00134 (“First Petition”), pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b).

**I. APPLICABLE RULES**

37 C.F.R. § 42.122(b) states the following:

Request for joinder. Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

**II. RELIEF REQUESTED**

In this Motion, ZTE requests that the Second Petition be joined with the First Petition, IPR2013-00134.

**III. STATEMENT OF MATERIAL FACTS**

1. On February 11, 2013, ZTE filed a Petition for *Inter Partes* Review requesting review of claims 1-38 of U.S. Patent No. 7,225,160 (“160 Patent”), now styled, *ZTE Corporation and ZTE (USA) Inc. v. ContentGuard Holdings Inc.*, Case No. IPR2013-00134.

2. On June 19, 2013, the Board instituted trial on claims 12-22 and 30-38. *ZTE Corp. et al. v. ContentGuard Holdings Inc.*, Case No. IPR2013-00134,

Dkt. 12, (P.T.A.B. June 19, 2013) (“Institution Decision”). The Board did not institute trial on claims 1-11 and 23-29.

3. Concurrent with this Motion, ZTE is filing the Second Petition, which challenges the validity of claims 1-11 and 23-29. The grounds of invalidity presented in the Second Petition are consistent with the grounds adopted by the Board. The Second Petition cites to relevant portions of European Patent Publication No. 0 567 800 (“EP 800”) and the 160 Patent to address the “digital work” discussed by the Board in the Institution Decision of the First Petition. (Institution Decision at pp. 23-25). The Second Petition also includes new reference U.S. Patent No. 5,477,263 to O’Callaghan et al., which renders claims 1-11 and 23-29 obvious when viewed in light of EP 800, to address the “digital work” discussed by the Board. (*Id.*)

4. The Board already found that EP 800 teaches each and every limitation of remaining independent claims 12 and 30, and instituted trial as to claims 12 and 30 and their dependent claims. Claims 12 and 30 include the same limitations of claims 1 and 23—the only difference among these claims is the non-limiting preamble.

5. For this reason ZTE considers the filing of the Second Petition necessary and appropriate.

**IV. ARGUMENT**

The Board has authority under 35 U.S.C. § 315(c) to join a properly-filed second *inter partes* review petition to an instituted *inter partes* review proceeding. This request for joinder is timely and the time periods set forth in 37 C.F.R. § 42.101(b) do not apply to the Second Petition because it is accompanied by this request for joinder. 37 C.F.R. § 42.122(b).

The Second Petition raises a limited number of new issues in that the grounds of invalidity presented in the Second Petition are consistent with the same grounds in the First Petition and add only citations and references necessary to address the reasoning in the Board’s decision not to institute *inter partes* review for claims 1 and 23.

The 160 Patent includes independent claims 1, 12, 23 and 30. In the First Petition, trial was instituted with respect to claims 12 and 30 and trial was not instituted with respect to claims 1 and 23. Claims 1 and 23 are directed to a computer readable medium and claims 12 and 30 are directed to a method for creating a digital work. However, claims 1 and 23 overlap substantially with claims 12 and 30 as shown below.

<b>Claim 1</b>	<b>Claim 12</b>
<b>1.</b> A computer readable medium having embedded thereon a digital work adapted to be distributed within a system for controlling use of digital works, <b>said digital work comprising:</b>	<b>12.</b> A method for creating a digital work to be used in a system for use of the digital work, said method comprising:

Claim 1	Claim 12
a digital content portion that is renderable by a rendering device;	obtaining a digital content portion that is renderable by a rendering device;
<p>a usage rights portion associated with said digital content portion and</p> <p>comprising one or more computer readable instructions configured to permit or prohibit said rendering device to render said digital content portion,</p> <p>said usage rights portion being expressed as statements from a usage rights language having a grammar defining a valid sequence of symbols, and</p> <p>specifying a manner of use relating to one or more purposes for which the digital work can be used by an authorized party; and</p>	<p>associating a usage rights portion with the digital content portion,</p> <p>the usage rights portion comprising one or more computer readable instructions configured to permit or prohibit said rendering device to render said digital content portion,</p> <p>said usage rights portion being expressed as statements from a usage rights language having a grammar defining a valid sequence of symbols, and</p> <p>specifying a manner of use relating to one or more purposes for which the digital work can be used by an authorized party;</p>
<p>a description structure comprising a plurality of description blocks,</p> <p>each of said description blocks comprising address information for at least one part of said digital work, and</p> <p>a usage rights part for associating one or more usage rights portions.</p>	<p>describing said digital work by a description structure comprising a plurality of description blocks,</p> <p>each of said description blocks comprising address information for at least one part of said digital work, and</p> <p>a usage rights part for associating one or more usage rights portions; and</p>
	<p>combining the digital content portion and the usage rights portion to create the digital work.</p>

Claim 23	Claim 30
<p><b>23.</b> A computer readable medium having embedded thereon a digital work adapted to be distributed within a system for controlling use of digital works, <b>said digital work comprising:</b></p>	<p><b>30.</b> A method for creating a digital work to be used in a system for controlling use of the digital work, said method comprising:</p>
<p>a digital content portion that is renderable by a rendering device;</p>	<p>obtaining a digital content portion that is renderable by a rendering device;</p>
<p>a usage rights portion associated with said digital content portion and comprising one or more computer readable instructions configured to permit or prohibit said rendering device to render said digital content portion, said usage rights portion being expressed as statements from a usage rights language having a grammar defining a valid sequence of symbols, and specifying conditions relating to one or more purposes for which the digital work can be used by an authorized party; and</p>	<p>associating a usage rights portion with the digital content portion, the usage rights portion comprising one or more computer readable instructions configured to permit or prohibit said rendering device to render said digital content portion, the usage rights portion being expressed as statements from a usage rights language having a grammar defining a valid sequence of symbols, and specifying conditions relating to one or more purposes for which the digital work can be used by an authorized party;</p>
<p>a description structure comprising a plurality of description blocks, each of said description blocks comprising address information for at least one part of said digital work, and a usage rights part for associating one or more usage rights portions.</p>	<p>describing said digital work by a description structure comprising a plurality of description blocks, each of said description blocks comprising address information for at least one part of said digital work, and a usage rights part for associating one or more usage rights portions; and</p>

Claim 23	Claim 30
	combining the digital content portion and the usage rights portion to create the digital work.

Claims 12 and 30 include all of the limitations of claims 1 and 23 other than the preamble of “said digital work comprising.” Regarding other portions of the preamble, the Board found that recitations of “adapted to be distributed within a system for controlling use of digital works” in claims 1 and 23 and “to be used in a system for use of the digital work” in claims 12 and 30 are mere statements of intended use and provides no patentable significance to the claimed subject matter. (See the Institution Decision at pp. 18-19).

The Board found that EP 800 discloses all of the limitations of claims 12 and 30. (See the Institution Decision at pp. 25-27). Thus, the Board found that EP 800 discloses all of the limitations in the body of claims 1 and 23, including the “description structure.” However, the Board did not institute claims 1 and 23 because the Board found that EP 800 does not disclose the preamble of claims 1 and 23, i.e., “said digital work comprising,” because EP 800 does not disclose that the “description structure” is “included within, or part of,” the “digital work.” (See the Institution Decision, pp. 23-25 (“EP ’800’s parameter table is not included within, or part of, the softcopy book as is required by independent claims 1 and 23.”)).

The Second Petition includes new citations to relevant portions of EP 800 and the 160 Patent that account for a digital work that includes a description structure in support of the position that EP 800 anticipates claims 1-11 and 23-20. The Second Petition also includes new reference, U.S. Patent No. 5,477,263 to O'Callaghan et al. that, when combined with EP 800, addresses the claim limitations, "said digital work comprising . . . a description structure," which were the basis for not instituting *inter partes* review for claims 1 and 23. (See the Institution Decision at pp. 23-25). The Second Petition involves the same patent, the same primary reference, and addresses the reasons provided by the Board in partially denying the First Petition. Substantial overlap of issues presented in the First and the Second Petitions indicate that a joinder of the Second Petition with the First Petition is warranted. The joinder of the Second Petition with the First Petition will ensure the just, speedy, and inexpensive resolution of a proceeding. (See the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48758 (Aug. 14, 2012) and 37 CFR § 42.1(b)).

Patent Owner will not be prejudiced by joinder of the Second Petition with the First Petition. In fact, the First and Second Petitions challenge patentability of identical claim limitations expressed in different claim categories. Patent Owner will benefit from addressing the identical subject matter in a single proceeding before a single panel. Patent Owner will also benefit from obtaining the Board's



decision on the entire set of claims of the 160 Patent within one year from the Institution Decision. Additionally, Petitioner believes that parties will be able to consolidate the case schedule for the First and the Second Petitions and complete the First and the Second Petitions without substantially impacting the one year deadline of the First Petition. (*See* the Consolidated Schedule of two petitions (Doc. # 37) (Ex. 1018) and Order adopting the Consolidated Schedule by the Board (Doc. # 39) (Ex. 1019) in Case Nos. IPR2012-00022 and IPR2013-00022 (MPT), respectively). Furthermore, Patent Owner's status as non-practicing entity also minimizes any purported prejudice from a joinder.

In addition, Petitioner has not unduly delayed filing the Second Petition. Nevertheless, Petitioner is willing to forfeit a reasonable portion of its response period to the extent that is deemed necessary to provide Patent Owner sufficient time to address the additional issues raised in the Second Petition. Petitioner will also accommodate any reasonable scheduling request of Patent Owner in order to accommodate joinder of proceedings. Therefore, joining the Second Petition with the First Petition would not prejudice Patent Owner. At least for those reasons, Petitioner requests joinder of the Second Petition with the First Petition.

No fee is required for consideration of this Motion. The undersigned has authorized payment of fees for the Second Petition. The undersigned further

authorizes payment for any additional fees that might be due in connection with this Motion to be charged to Deposit Account 23-1925.

Dated: July 19, 2013

Respectfully submitted,

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**Certificate of Service in Compliance With 37 C.F.R. § 42.6(e)(4)**

The undersigned certifies that a complete copy of Petitioner's MOTION FOR JOINDER TO RELATED INSTITUTED INTER PARTES REVIEW (37 C.F.R. § 42.122(b)) and supporting materials (Exhibit 1018 and Exhibit 1019) has been served in its entirety to the attorneys of record for the Patent Owner this July 19, 2013, by Federal Express:

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